

O/866/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATIONS NOS. 3473941 AND 3421921

IN THE NAME OF CITY ELECTRICAL FACTORS LIMITED

AND OPPOSITIONS THERETO

UNDER NOS. 421466 AND 418644

BY IMO PRECISION CONTROLS LIMITED

BACKGROUND AND PLEADINGS

1. On 16 August 2019, City Electrical Factors Limited (“the applicant”) applied to register the following series of two trade marks in the UK under no. 3421921 (“the First Application”):



2. The First Application was published for opposition purposes on 6 September 2019.

3. On 10 March 2020, the applicant applied to register the following series of two trade marks in the UK under no. 3473941 (“the Second Application”):



4. The Second Application was published for opposition purposes on 27 March 2020. For both the First and Second Application, registration is sought for the following goods:

Class 6: *Ducting; trunking; ducting and cable trunking systems; cable management systems and installations; conduit systems; metal struts and framework comprised of metal struts; metallic trunking systems for electrical cables; metal ceiling roses; trunking channels of metal; metallic cavity trunking; metallic lighting trunking; conduits; cavity trunking; steel framework systems; cable trays, ladder racks, basket trays, boxes, conduit boxes and covers; power poles; metal hardware; locks, plates, clamps, brackets, bolts covers, end caps,*

fixings, washers, nuts, bolts, screws; cable clips of metal; parts and fittings for the aforesaid goods.

Class 9: *Electrical switchgear; electrical and electronic apparatus, devices, instruments and components for the control, distribution and monitoring of electric current; ducting; ducting systems for electrical cables; cable management systems and installations; non-metallic cable management systems and installations (electric); conduit systems; conduits; switches, sockets, socket outlets, digital socket outlets, fused connection units, cooker outlets, plugs, coaxial/satellite socket outlets, telephone socket outlets, dimmers, spur units, adaptor boxes, switch boxes, socket boxes, junction boxes, fuse boxes; computer data sockets, clip-in lighting distribution accessories; electrical distribution units comprising assemblies of plugs, sockets, switches, fused connection units, fuses, indicator lamps and cables; power distribution systems, power distribution units; fuses; electrical circuit protection devices circuit breakers, earth leakage breakers, relays, consumer units; electric relays, consumer units, electricity panel boards; electricity distribution boards, electricity distribution boxes, electrical distributing busbar chambers; switchboards; earth bars, termination boards; terminals; emergency stop push buttons; motor starters; contactors; fire alarm switches; feeder pillars; insulated enclosures for electrical apparatus; transformers, bells and timers; cables, power leads; battens; ammeters; parts and fittings for the aforesaid.*

Class 17: *Non-metallic flexible pipes; non-metallic fittings, couplings, connectors, seals and joints for flexible pipes and/or hose; non-metallic fittings, couplings, connectors, seals and joints, bends, elbows, tees, washers, adaptors; cable insulators; insulators for electric mains; electrical insulation tapes, pvc tapes, adhesive sealants for general industrial use, adhesive tapes (for technical purposes), sealants; parts and fittings for all the aforesaid goods.*

Class 19: *Ducting; ducting systems; flexible hose; flexible ducting, ducting (non-electrical) made from insulating materials; cavity trunking; non-metallic ceiling roses; conduit systems; conduits; non-metallic struts and frame work*

comprised of non-metallic struts; boxes; power poles; parts and fittings for the aforesaid goods.

Class 20: *Non-metallic trunking; non-metallic trunking for cables and leads; non-metallic cable trunking systems; non-metallic trunking systems for electrical cables; non-metallic cable management systems and installations (other than electricity); non-metallic trunking channels; non-metallic cavity trunking; non-metallic lighting trunking; non-metallic cable trays; non-metallic ladder racks; non-metallic fasteners; non-metallic cable clips; non-metallic hose clips and clamps; non-metallic cable straps, grips; non-metallic nuts; cable boxes of non-metallic materials; cable couplings and connectors of non-metallic material; non-metallic racks; non-metallic plates, clamps, brackets, bolts covers, end caps, fixings, nuts.*

5. On 5 December 2019 and 29 June 2020, IMO Precision Controls Limited (“the opponent”) opposed the First and Second Applications respectively. The oppositions are based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

6. Under Sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks:¹

UK00001491359 (“the 359 mark”)

IMO

Filing date: 15 February 1992; **Registration date:** 23 January 1998

The opponent relies upon all goods for which the 359 mark is registered, namely:

Class 7: *Variable speed drives for motors and starters for motors and parts and fittings therefor; all included in Class 7*

Class 9: *Motor control equipment, alternating current drives, inverters, motor controllers, relays, sockets, electronic timers, counters, meters, volt meters,*

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

ammeters, frequency meters, temperature controllers; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers, computer programmes, connectors, opto electronic devices, fuses and fuse-holders, sounders and sound transducers; parts and fittings for all the aforesaid goods; but not including meters for fluids.

EU000678110 (“the 110 mark”)

IMO

Filing date: 13 November 1997; **Registration date:** 18 April 2002

The opponent relies upon all goods for which the 110 mark is registered, namely:

Class 7: *Variable speed drives for motors and starters for motors; motors (standard and geared) and parts and fittings thereof; all included in class 7; all the aforementioned goods not intended for installation in fully automatic car washers.*

Class 9: *Electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes; data terminals; programming devices; electrical and electronic drives and controls, motor control equipment, alternating current drives, inverters, drivers, motor controllers, relays, sockets, electronic timers, counters, meters, volt meters, ammeters, frequency meters, temperature controller; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers, computer programmes, connectors, opto electric devices, fuses and fuse holders, sounders and sound transducers; parts and fittings for all the aforesaid goods; all the aforementioned goods not intended for installation in fully automatic car washers.*

7. Under Section 5(2)(b), the opponent claims that the parties' respective marks and the goods are similar or identical, resulting in a likelihood of confusion.

8. Under Section 5(3), the opponent claims that use of contested marks would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

9. By virtue of their earlier filing dates, the opponent's marks qualify as earlier marks in accordance with Section 6 of the Act. Both marks had completed their registration procedure more than five years before the date the applications were filed and are, as a consequence, subject to the proof of use provisions contained in Section 6A of the Act.

10. Under Section 5(4)(a), the opponent relies upon unregistered rights in the sign IMO, which it claims to have used throughout the UK since 1972 in relation to the following goods:

Metal hardware; nuts; bolts; brackets; boxes; racks; couplings; connectors; insulated enclosures for electrical apparatus, wires and cables.

Variable speed drives for motors and starters for motors; motors (standard and geared) and parts and fittings thereof.

Electrical and data cables; leads; cable harnesses; cable crimps; cable markers; cable tags; cable housing; cable glands; cable terminations; cable assemblies and looms; cable systems; electrical terminals; electrical switchgear; electrical and electronic apparatus, devices, instruments and components for the control, distribution and monitoring of electric current; surge suppressors; solar tracking units; mechanical switching components containing electrical contacts; electric and electronic components; electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes; data terminals; programming devices; electrical and electronic drives and controls; motor control equipment and motor controllers; alternating current drives; inverters; diverters; disconnectors; drivers; relays; sockets; electronic timers; socket boxes, junction boxes, fuse boxes; distribution boxes; counters; meters, including volt meters, ammeters and frequency meters; temperature controllers; control panels, switch boxes; switches, including push button switches, photo electric switches, proximity switches, limit switches, changeover switches and piezoelectric switches; level controllers, programmable controllers; computers; computer programmes; software; connectors; opto electric devices; fuses and fuse holders; sounders and sound transducers; buzzers; circuit breakers; isolators; surge suppressors; components for the emergency shut-down of electrical circuits; electronic power supplies; power optimisers; electric convertors; electrical terminals; photoelectric sensors, proximity sensors, piezoelectric sensors; display boards; distribution boards; terminal boards; star delta starters; magnetometers; antennas; routers; SIM cards; encoded cards; memory cards; smart cards; network interface cards; network adaptors; network servers; antennas; transmitters; fingerprint scanners; graphic display terminals; human machine interfaces; communication interface units and electric communication apparatus; screens; input modules; components; tracking devices; pilot lights; apparatus and components for use in connection with electric vehicles; charging apparatus; parts, fittings and enclosures for all the aforesaid goods.

Retail and wholesale services in respect of all the aforesaid goods.

Telecommunications services; providing access to portals on the internet.

Computer software technical support services; design and development of software, computer hardware, control systems, specialist machinery, communication systems, electronic systems, networks, and mechanical and electromechanical apparatus and instruments; engineering services; software installation, repair and maintenance; software consulting; software as a service; rental of computer software; hardware design services; industrial design services; scientific and technological design; design consultancy.

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

12. Both parties filed evidence during the evidence rounds. The opponent also filed written submissions in reply to the applicant's evidence. I shall refer to the evidence and submissions to the extent I consider necessary.

13. In these proceedings, the opponent is represented by Dechert LLP and the applicant by Marks & Clerk LLP. Neither party requested a hearing although both parties filed submissions in lieu of attendance at the hearing. This decision has been taken following a careful consideration of the papers.

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

THE OPPONENT'S EVIDENCE

15. The opponent's evidence consists of two witness statements by Fausto Furlotti. Mr Furlotti is the CEO of the opponent's company since 2009. His first witness statement is dated 2 February 2021 and contains 5 exhibits (FF1-FF5) one of which is confidential; the second is dated 22 March 2021.

16. In his first witness statement, Mr Furlotti states that its company has used the earlier marks in the five-year periods preceding the filing dates of the contested applications ("the relevant periods"). The main points emerging from Mr Furlotti's evidence are as follows:

- The opponent is an international business founded in the UK in 1972 that manufactures and sells a wide range of industrial and electronic components, systems, parts and solutions that have applications across a variety of businesses and industries. IMO sells its products principally to wholesalers² but it also uses the 'IMO' brand for sales direct to end-users;
- IMO is the opponent's trading name and its main brand. During, and prior to, the relevant periods, the trade mark IMO has been used by the opponent in its domain names (imopc.com, imopc.fr, imopc.it and imopc.co.uk),³ on marketing

² FF2

³ FF1

material,⁴ on products and their packaging,⁵ on product displays⁶ and on invoices;⁷

- In the year to 30 April 2020 the opponent's global revenue was £19,854,445. Revenue for the years 2015 to 2019 is as follows:

Year	Total Revenue (worldwide) (£) (Year to 30 April)	Total EU (inc. UK) Revenue (£)	UK Revenue (£)
2015	20,596,361	13,942,596	8,537,530
2016	19,006,994	12,988,685	7,836,847
2017	15,855,793	11,259,046	6,522,606
2018	18,791,113	11,676,131	6,818,501
2019	17,959,878	11,647,794	7,070,610

- During the relevant period the opponent had offices and distributors around the world including in the UK, France and Italy.⁸ It also had distributors in other EU member states;
- IMO sells a variety of industrial and electronic components, systems and infrastructure (including cables, casings, enclosures and DIN rails) under the IMO brand. During the relevant periods the mark IMO has been used in respect of over 15,000 different product lines, including each of the categories of the goods covered by the earlier marks;
- Historical pages from www.imopc.com⁹ (accessed using the website web.archive.org) dated as far back as 1 December 1998 describe the opponent as a UK leader in the business of the manufacture and supply of “*industrial control and electronic components and systems*”. One of the pages contains the following text: “*From a single product to complete application solutions, the IMO Automation and Controls range fully addresses the sense, control and switch demands of today’s factory automation and control environment. In terms of choice, the IMO line-up has no peer, offering everything to meet the needs of today’s OEMs, panel builders and end users, from circuit protection*”

⁴ FF2

⁵ FF1 FF2 and FF5


⁶ FF2 and FF5

⁷ FF4

⁸ FF1

⁹ FF1

and a complete range of panelware to PLCs, HMI's, Temperature Controllers, Signal Conditioning, Proximity Sensors, Photocells, Limit Switches, DIN terminals and AC drives” (2009). Another page states: “As a world recognised manufacturer of electrical components, IMO have a wide range of connection, power, control and interface products” (2018);

- Extracts from the following catalogues are provided: IMO ELECTRICAL WHOLESale (2017-2018 and 2019), IMO STARLINE (2017-2018), IMO CUSTOM-MADE CABLE ASSEMBLIES & LOOMS (undated), IMO JAGUAR AC VARIABLE SPEED DRIVERS (undated) and IMO SOLUTIONS FOR ELECTRICAL VEHICLE CHARGING (undated). Mr Furlotti states that the IMO catalogues are available for download from the opponent’s websites and are distributed in hard copy in-store, by mail, and within packaged orders sent to customers;
- Sample invoices¹⁰ are provided. All of the invoices were issued by the opponent to various customers in the UK and in France and display the mark . They show sales of electrical goods in the UK and in France amounting to over £40,000 and over £100,000 (respectively) between 2015 and 2020;
- Examples of advertising and marketing material¹¹ (undated) are also provided which show use of the mark IMO in relation to various electrical goods.

17. In his second witness statement Mr Furlotti states that IMO UK sales of cables and cable assemblies, enclosures, housing (including cable housing) and boxes (including junction boxes and distribution boxes) exceeded £350K in 2018 and £370K in 2019 and that IMO UK sales of mounting brackets and rails exceeded £55K both in 2018 and 2019.

THE APPLICANT’S EVIDENCE

18. The applicant’s evidence consists of a witness statement by Colin Raymond William Frank dated 21 June 2021 and accompanied by 5 exhibits (CF1-CF5). Mr Frank is the managing director of Installation Materials Division (IMD) which is a sub-

¹⁰ FF4

¹¹ FF5

division of the applicant's company and is the manufacturer and distributor of what are said to be some of the applicant's most well-known brands, including Tamlex, Proteus Switchgear, RPP, M2 and Centaur. Mr Frank's evidence is aimed at supporting the argument that his company has a reputation amongst consumers as an "umbrella" company for the brands it manages and that consumers have been educated to understand the strapline "THE NAME BEHIND THE BRAND" as meaning that the function of his company is not to provide products under the mark IMD but to manage individual brands under the wider IMD mark and branding, including advertising, promotional and marketing material. Mr Frank also states that his company does not use (or intend to use) the applied for marks in relation to specific products and that the marks are used as a badge of origin in relation to a number of the applicant's group of companies.

PROOF OF USE

19. The relevant statutory provisions are set out in Section 6A of the Act which reads:

"(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

21. As one of the earlier marks that is subject to proof of use is a EUTM, I must consider the EU as the market in which the opponent is required to show genuine use: see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 36.

22. The relevant period in which to show use of the earlier mark is the five-year period ending on the date of filing of the contested application. Consequently, the relevant periods in the oppositions at issue are 17 August 2014 to 16 August 2019 and 11 March 2015 to 10 March 2020.


Genuine use: assessment

23. It is clear from the evidence that the opponent is a successful business. This is very apparent in terms of sales figures which show that the opponent generated significant revenue from its sale of IMO products in the UK and in the EU during the relevant periods, with over £36million worth of sales made to customers in the UK and over £60million made to customers in the EU between 2015 and 2019.

24. The IMO ELECTRICAL WHOLE catalogue from 2017-2018 mentions that the IMO's iconic yellow trade displays (an example of which is shown below) are present in over 600 locations in the UK:



25. Finally, webpages from as far back as 2015 list 39 IMO distributors across the whole of the UK and 36 across 15 EU countries. I also consider that the invoices show a wide geographical spread of customers.

26. In terms of marks, there is enough evidence to show use of the word mark IMO as registered. I refer, in particular, to the evidence that the plain letters IMO are used on opponent's website and in the catalogues. Further, I consider that the mark  which is used on the invoices, on product packaging and on promotional material is an acceptable variant¹² of the marks as registered, as the font used is unremarkable and the distinctive character the square background and the colour add to the word IMO is extremely minor.

27. In its submissions in lieu the applicant criticised heavily the opponent's evidence. For example, it argued that it is impossible to know from the evidence how many customers visited the opponent's website, how many sales were made from the opponent's website and how many catalogues were circulated and/or downloaded. It also argued that that the financial data provided by the opponent does not give any breakdown as to where the money originates and that there is little evidence of use of the mark on the goods. I accept that there are some gaps in the opponent's evidence, however, I also think that some of the criticisms made by the applicant are unfair, for example, there is clear evidence of catalogues on display next to product displays (and these are said to be available in 600 locations in the UK) and the opponent has provided specific revenue figures for the UK and the EU. Further, use of the mark need not to be on the goods themselves, and I am satisfied that the evidence showing the mark being used on product packaging, product displays, catalogues and websites counts as evidence of use of the mark in relation to the goods concerned. I also bear in mind that the applicant waited until the closing submissions to challenge the opponent's evidence and to argue these points thereby without giving the opponent a chance to respond. In any event, one must remember that an assessment of genuine use is a global assessment, which includes considering the evidence as a whole rather than assessing whether each individual item of evidence can be said to show use of the mark by itself. Account must be taken, in particular, of the commercial volume of

¹² Nirvana Trade Mark, BL O/262/06

the overall use, as well as of the length of the period during which the mark was used and the frequency of use.

28. When the evidence relating to the sales figures is taken together with the catalogues and the evidence relating to the huge range of products offered under the mark and the geographical spread of the opponent's distribution and customer network, I am satisfied that the opponent has made genuine use of the earlier marks during the relevant periods.

Fair specification

29. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:¹³

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

30. Mr Furlotti provides specific sales figures for only two categories of products, namely 1) cables and cable assemblies, enclosures, housing (including cable housings) and boxes (including junction boxes and distribution boxes) whose sales are said to have exceeded £350K in 2018 and £370K in 2019 and 2) mounting brackets and rails whose sales are said to have exceeded £55K both in 2018 and 2019.¹⁴ This totals just over £400K per annum, which is only a small percentage of the revenue earned in 2018 and 2019 which amounts to £6.8million and £7million respectively. Although these goods might be relied upon in relation to the passing off claim, they are not listed in the specifications covered by the earlier marks.

¹³ See also *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) (at [47])

¹⁴ Second witness statement

31. In addition, Mr Furlotti says that the following goods are examples of some of the goods which were marketed and sold by the opponent during the relevant periods - although he did not provide a further breakdown of sales for these goods - : 1) variable speed drivers for motors and inverters; 2) starters for motors; 3) motors and parts and fitting for motors; 4) motor controllers and motor control equipment such as motor circuit breakers and miniature circuit breakers; alternating current drivers; motor controllers; relays; switches, emergency push buttons and isolators; 5) inverters, such as inverter drivers; 6) electronic timers; 7) sockets; 8) enclosures for electrical apparatus; 9) switch boxes, junction boxes and distribution boards/boxes; 10) electronic apparatus for controlling machines, machine tools, robots and industrial processing including Human Machine Interfaces (HMIs), controller product and programmable logic controllers (PLCs), motor circuit breakers and miniature circuit breakers; 11) computers, programmable controllers and programming devices such as HMIs, PLCs and the opponent's 'i range of computers that combines the functions of HMIs and PLCs; 12) sounders, such as audible devices; 13) terminals; 13) temperature controllers; 14) opto electric devices, including photoelectric switches and photoelectric sensors; 15) cables, including cable housing (which, it is explained, are products that provide channels for cables to run through, such as pipes, ducts and trunking); 16) electrical switchgear, such as switches and circuit breakers; 17) products for control of lighting systems; 18) a rapid shutdown solution called 'Fire Raptor' to protect against the risk of fire relating to solar panels; 18) pilot lights and push buttons; 19) fixings such as screws, nuts, metal cross connectors; 20) DIN rails (which, it is explained, are metal rails used for mounting industrial control equipment), brackets, racks and end plates for electrical components; 21) locks and keys, tightening tools and door mounting tools, metal shafts, metal roads, metal plates, hinges, DIN rail mounting kits, kits for joining footswitches, clamping yokes, end caps, ethernet ports and USB adaptors and 22) software. In his narrative, Mr Furlotti cross-references each category of goods to relevant examples from the exhibits filed.

32. Mr Furlotti also says that the mark IMO is used in relation to over 15,000 different product lines including each of the categories of goods covered by the earlier marks.

33. Catalogues, copies of webpages and invoices are also provided as evidence of the type of goods that are sold by the opponent. They show that the opponent is a

manufacturer and supplier of industrial automation and electronic components. In this connection I note the following:

- a. that webpages from 2015, 2016, 2017, 2018 and 2019 list a variety of goods in the “product search” including the following: inverter drivers, all-in-one controllers, PLCs, HMIs, solar cubes, relays, remote I/O, power supplies, miniature circuit breakers, controllers, din rail terminals, panel mount terminals, terminal blocks, contactors and overloads, motor circuit breakers, timers, isolators, switches, sensors and sensor-accessories, signal conditioning, star-delta starters, enclosures, audible devices, motor starter, temperature controllers, pilot lights and push buttons;
- b. that a list of the products offered by the opponent is reproduced in the catalogues produced at FF2; as it can be seen the goods are classified in the following product groups:

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- c. that webpages from 2017 and 2018 list other catalogues in addition to those exhibited at FF2 including the following: Jaguar Drivers, Panel Products, Solar Range, FireRaptor, MCB, iView HMI, Automation, SD1 Viable Speed Drivers, Relays, Terminal Blocks, Din Terminals, Spring Connection Pluggable Range, Cable Solutions, SIM Mini Solar Isolator, iConnect, Solar Cube, iDrive2, Push Buttons, Push Fit Terminals and i3 Intelligent Controllers;
- d. that the invoices produced in evidence show sales of the following goods: circuit breakers, inverters, isolators, terminals, sockets, switches and fuse switches, sensors, relays, solar cubes, programmable logic controllers, interlocks, power supplies units, filters, push buttons, din rails, rotary knobs, connectors and mobile solar connectors, emergency stop stations, HMIs, timers, voltage monitoring, brackets, programming cables USB, enclosure screw lids, contactors and modular contactors, shaft extensions, terminal junction boxes and wires;
 - that the marketing material show use of the mark in relation to, inter alia, contactors, relays, pushbuttons, dol starters, integrated controllers and solar panels for emergency shutdown.

34. Finally, I bear in mind that Mr Furlotti himself summarises the evidence by saying that it shows use of the earlier mark not only in relation to the registered goods but also in relation to “additional goods”.

35. The earlier marks are registered for:

The 359 mark:

Class 7: *Variable speed drives for motors and starters for motors and parts and fittings therefor; all included in Class 7.*

Class 9: *Motor control equipment, alternating current drives, inverters, motor controllers, relays, sockets, electronic timers, counters, meters, volt meters, ammeters, frequency meters, temperature controllers; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers, computer programmes, connectors, opto electronic devices, fuses and fuse-holders, sounders and*

sound transducers; parts and fittings for all the aforesaid goods; but not including meters for fluids.

The 110 mark:

Class 7: *Variable speed drives for motors and starters for motors; motors (standard and geared) and parts and fittings thereof; all included in class 7; all the aforementioned goods not intended for installation in fully automatic car washers.*

Class 9: *Electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes; data terminals; programming devices; electrical and electronic drives and controls, motor control equipment, alternating current drives, inverters, drivers, motor controllers, relays, sockets, electronic timers, counters, meters, volt meters, ammeters, frequency meters, temperature controller; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers, computer programmes, connectors, opto electric devices, fuses and fuse holders, sounders and sound transducers; parts and fittings for all the aforesaid goods; all the aforementioned goods not intended for installation in fully automatic car washers.*

36. Given what Mr Furlotti said in relation to the huge range of products sold by the opponent (which includes 15,000 different product lines) and the inclusion of evidence relating to “additional” goods, it is likely that a proportion of the revenue generated under the mark relates to goods other than those covered by the registrations. However, although there are not specific breakdown figures (other than for goods which are not listed in the specifications), I find that the sheer amount of evidence showing the listing of products on catalogues, websites and invoices (all of which are dated within the relevant periods) combined with the significant revenue earned during the relevant periods, is sufficient to offset the absence of specific sales information for some of the goods concerned.¹⁵ Taking all of the above into account my conclusions are as follows:

¹⁵ SKINY TRADE MARK BL-O-440-21

37. **Class 7.** The opponent's range of catalogues includes a dedicated "SD1 Viable Speed Drivers" catalogue and there are multiple references to *variable speed drives* in the ELECTRICAL WHOLESale CATALOGUES for 2017-2018 and 2019. Further Mr Furlotti says that these goods are "a kind of inverter" and are commonly referred as "Jaguar inverters" or "inverter drivers" on the invoices. Having gone through the invoices, I am satisfied that they include many sales of these goods.

38. As regards *starters for motors*, Mr Furlotti refers in his narrative to the opponent marketing and selling starter for motors such as star delta starters, DOL starters and manual starters. It is true that there is no reference to these goods on the invoices, but that is no fatal because the invoices exhibited are only representative examples and are far from providing a complete picture of all of the sales achieved by the opponent during the relevant periods. In any event, there is sufficient evidence of these goods being marketed on the opponent's website and on catalogues to offset the absence of specific sales information.

39. The evidence also shows that the opponent marketed goods which can be classified as *motors*, including 'brushless motors' and 'stepper motors'. There are also two invoices for the sale of motors, although given the cost of the goods, which is just over EUR 300, I do not put much weight on them.

40. As regards *parts and fittings*, Mr Furlotti referred to the evidence showing that the opponent sells 'brush tube holder' which, it is explained, is part of a motor.

41. **Class 9.** There are numerous references in the evidence to the goods included in the class 9 specifications of the earlier marks. Exceptions are *meters, volt meters, ammeters, frequency meters, counters* and *sound transducers* in relation to which I could not find any evidence of use.

42. As regard *computers, computer programmes*, Mr Furlotti says that HMIs, PLC and the opponent 'i3' range are examples of use of the mark for computers and computer programmes. The evidence is also clear in showing that these computer products are all used for remote monitoring, control and programming of machines and in industrial automation processes.

43. Taking all of this into account, I consider a fair specification for each earlier mark to be:

The 359 mark:

Class 7: *Variable speed drives for motors and starters for motors and parts and fittings therefor; all included in Class 7; all the aforementioned goods intended for installation in industrial control and electronic components and systems.*

Class 9: *Motor control equipment, alternating current drives, inverters, motor controllers, relays, sockets, electronic timers, temperature controllers; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers and computer programmes for remote monitoring, control and programming of machines, machine tools, robots and industrial processes, connectors, opto electronic devices, fuses and fuse-holders, sounders; parts and fittings for all the aforesaid goods; but not including meters for fluids; all the aforementioned goods intended for installation in industrial control and electronic components and systems.*

The 110 mark:

Class 7: *Variable speed drives for motors and starters for motors; motors (standard and geared) and parts and fittings thereof; all included in class 7; all the aforementioned goods not intended for installation in fully automatic car washers; all the aforementioned goods intended for installation in industrial control and electronic components and systems.*

Class 9: *Electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes; data terminals; programming devices; electrical and electronic drives and controls, motor control equipment, alternating current drives, inverters, drivers, motor controllers, relays, sockets, electronic timers, temperature controller; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers and computer programmes for remote monitoring, control and programming of machines, machine tools, robots and industrial processes, connectors, opto electric devices, fuses and fuse holders, sounders; parts and fittings for all the aforesaid goods; all the aforementioned goods not intended for installation in fully automatic car*

washers; all the aforementioned goods intended for installation in industrial control and electronic components and systems.

DECISION

SECTION 5(2)(B)

44. Section 5(2)(b) of the Act is as follows:

“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”.

45. 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 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

46. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

47. 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.

48. 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 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”.

49. The law requires that goods also be considered identical where one party’s description of its goods encompasses the specific goods covered by the other party’s description (and vice versa) - see *Gérard Meric v OHIM*, Case T- 133/05.

50. The goods to be compared are:

The applicant’s goods	The opponent’s goods (after POU)
<p>Class 6: <i>Ducting; trunking; ducting and cable trunking systems; cable management systems and installations; conduit systems; metal struts and framework comprised of metal struts; metallic trunking systems for electrical cables; metal ceiling roses; trunking channels of metal; metallic cavity trunking; metallic lighting trunking; conduits; cavity trunking; steel framework systems; cable trays, ladder racks, basket trays, boxes, conduit boxes and covers; power poles; metal hardware; locks, plates, clamps, brackets, bolts covers, end caps, fixings, washers, nuts, bolts, screws; cable clips of metal; parts and fittings for the aforesaid goods.</i></p>	

	<p>The 359 mark:</p> <p>Class 7: <i>Variable speed drives for motors and starters for motors and parts and fittings therefor; all included in Class 7; all the aforementioned goods intended for installation in industrial control and electronic components and systems.</i></p> <p>The 110 mark:</p> <p>Class 7: <i>Variable speed drives for motors and starters for motors; motors (standard and geared) and parts and fittings thereof; all included in class 7; all the aforementioned goods not intended for installation in fully automatic car washers; all the aforementioned goods intended for installation in industrial control and electronic components and systems.</i></p>
<p>Class 9: <i>Electrical switchgear; electrical and electronic apparatus, devices, instruments and components for the control, distribution and monitoring of electric current; ducting; ducting systems for electrical cables; cable management systems and installations; non-metallic cable management systems and installations (electric); conduit systems; conduits; switches, sockets, socket outlets, digital socket outlets, fused connection units, cooker outlets, plugs, coaxial/satellite socket outlets, telephone socket outlets, dimmers, spur</i></p>	<p>The 359 mark:</p> <p>Class 9: <i>Motor control equipment, alternating current drives, inverters, motor controllers, relays, sockets, electronic timers, counters, temperature controllers; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers and computer programmes for use in for remote monitoring, control and programming of machines, machine tools, robots and industrial processes, connectors, opto electronic devices,</i></p>

<p><i>units, adaptor boxes, switch boxes, socket boxes, junction boxes, fuse boxes; computer data sockets, clip-in lighting distribution accessories; electrical distribution units comprising assemblies of plugs, sockets, switches, fused connection units, fuses, indicator lamps and cables; power distribution systems, power distribution units; fuses; electrical circuit protection devices circuit breakers, earth leakage breakers, relays, consumer units; electric relays, consumer units, electricity panel boards; electricity distribution boards, electricity distribution boxes, electrical distributing busbar chambers; switchboards; earth bars, termination boards; terminals; emergency stop push buttons; motor starters; contactors; fire alarm switches; feeder pillars; insulated enclosures for electrical apparatus; transformers, bells and timers; cables, power leads; battens; ammeters; parts and fittings for the aforesaid.</i></p>	<p><i>fuses and fuse-holders, sounders; parts and fittings for all the aforesaid goods; but not including meters for fluids; all the aforementioned goods intended for installation in industrial control and electronic components and systems.</i></p> <p>The 110 mark:</p> <p>Class 9: <i>Electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes; data terminals; programming devices; electrical and electronic drives and controls, motor control equipment, alternating current drives, inverters, drivers, motor controllers, relays, sockets, electronic timers, counters, temperature controller; control panels, switch boxes; switches; photo electric switches, proximity switches, limit switches; level controllers, programmable controllers, computers, computer programmes, connectors, opto electric devices, fuses and fuse holders, sounders; parts and fittings for all the aforesaid goods; all the aforementioned goods not intended for installation in fully automatic car washers; all the aforementioned goods intended for installation in industrial control and electronic components and systems.</i></p>
<p>Class 17: <i>Non-metallic flexible pipes; non-metallic fittings, couplings,</i></p>	

<p><i>connectors, seals and joints for flexible pipes and/or hose; non-metallic fittings, couplings, connectors, seals and joints, bends, elbows, tees, washers, adaptors; cable insulators; insulators for electric mains; electrical insulation tapes, pvc tapes, adhesive sealants for general industrial use, adhesive tapes (for technical purposes), sealants; parts and fittings for all the aforesaid goods.</i></p>	
<p>Class 19: <i>Ducting; ducting systems; flexible hose; flexible ducting, ducting (non-electrical) made from insulating materials; cavity trunking; non-metallic ceiling roses; conduit systems; conduits; non-metallic struts and frame work comprised of non-metallic struts; boxes; power poles; parts and fittings for the aforesaid goods.</i></p>	
<p>Class 20: <i>Non-metallic trunking; non-metallic trunking for cables and leads; non-metallic cable trunking systems; non-metallic trunking systems for electrical cables; non-metallic cable management systems and installations (other than electricity); non-metallic trunking channels; non-metallic cavity trunking; non-metallic lighting trunking; non-metallic cable trays; non-metallic ladder racks; non-metallic fasteners; non-metallic cable clips; non-metallic hose clips and clamps; non-metallic cable straps, grips; non-metallic nuts;</i></p>	

<i>cable boxes of non-metallic materials; cable couplings and connectors of non-metallic material; non-metallic racks; non-metallic plates, clamps, brackets, bolts covers, end caps, fixings, nuts.</i>	
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The parties' submissions on the comparison of goods

51. In its written submissions, the applicant admitted that the following goods in the applications “*may be considered broadly similar to the goods covered under the earlier marks*” but it denies that the remaining goods are similar: *electrical switchgear; electrical and electronic apparatus, devices, instruments and components for the control, distribution and monitoring of electric current; switches, switch boxes, electrical distribution units comprising assemblies of switches; motor starters; fire alarm switches; ammeters*. The applicant states that the goods in classes 6, 19 and 20 might be broadly described as metallic and non-metallic ducting and trucking products and bear no similarity with the goods covered by the earlier marks which might be broadly described as controllers and switchers. According to the applicant, the goods have different uses and consumers will purchase the goods for different purposes. The applicant follows the same line of argument for the goods in class 17 which are described as covering broadly pipes, pipe fittings and insulation, and are said to have different uses and purposes.

52. The opponent relies on the exhibits filed by the applicant to argue that the goods share distributions channels, producers and relevant public and are complementary. In particular, the opponent refers to the following evidence:

- **Exhibit C1-2:** these consist of webpages from the website www.imdivision.co.uk. The opponent points out that this evidence show that the applicant offers conduit and trunking systems, cable trunking and cable trays, as well as switch boxes (such as ‘DIN type consumer units’), circuit breakers (such as ‘miniature circuit breakers’ and ‘RCDs’), socket boxes and wiring accessories (such as sockets and switches);

- **Exhibit C3:** this exhibit consists of marketing brochures. The opponent points out that it shows that the applicant offers the following goods: sockets, switches, conduits, enclosures, distribution boards, consumer units, isolator switches, terminal blocks, heating contactors, switchboards, trunking and switchgear, circuit breakers, distribution boards, consumer units, enclosures, isolators, contactors, earth bars, timers, circuit protection devices and cable management products (including trunking, power poles, conduits, socket boxes, cable trays basket trays, boxes, plates, switch boxes, socket boxes, strut framework and accessories and general fitting)

53. I now go on to consider whether (and to what extent) the competing goods are similar.

54. **Class 6.** Ducting; trunking; ducting and cable trunking systems; cable management systems and installations; conduit systems; metal struts and framework comprised of metal struts; metallic trunking systems for electrical cables; metal ceiling roses; trunking channels of metal; metallic cavity trunking; metallic lighting trunking; conduits; cavity trunking; steel framework systems; cable trays, ladder racks, basket trays, boxes, conduit boxes and covers; power poles; metal hardware; locks, plates, clamps, brackets, bolts covers, end caps, fixings, washers, nuts, bolts, screws; cable clips of metal; parts and fittings for the aforesaid goods.

55. The opponent states that the following goods (which it refers to as “the applicant’s cable management goods”) cover goods for supporting, enclosing, protecting and managing cables: *Ducting; trunking; ducting and cable trunking systems; cable management systems and installations; conduit systems; metal struts and framework comprised of metal struts; metallic trunking systems for electrical cables; metal ceiling roses; trunking channels of metal; metallic cavity trunking; metallic lighting trunking; conduits; cavity trunking; steel framework systems; cable trays, ladder racks, basket trays, boxes, conduit boxes and covers; power poles; cable clips of metal.* The opponent argues that those goods are similar to the applicant’s *switch boxes* because: 1) switch boxes are enclosures for electrical apparatus including the cabling that runs to the switches; 2) they have the same purpose, namely to protect and manage parts of electrical systems (including cabling); 3) their methods of use overlaps in that both

are likely to be installed in a similar manner; 4) they are complementary as in an electrical system the applicant's cable management goods are likely to be used to protect and manage cables running to a switch box and the switch box will protect the switches and cables within the switch box; 5) the product share distribution channels, e.g. electrical wholesalers and retailers of trade tools; 6) the goods coincide in the relevant public, e.g. operators of industrial plants and electricians; 7) the producers of these products are likely to overlap.

56. The opponent also states that the applicant's cable management goods are similar to the opponent's *electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes* and various electrical components, such as *switches, inverters and relays* because they are all constituent parts of an industrial electrical system and are highly complementary, share distribution channels, coincide in their relevant public and are producers. In this connection, the opponent points out that the evidence relating to its distributors¹⁶ shows that one of them (who is a building materials supplier) sells industrial control apparatus, switches and goods that are identical to the applicant's cable management goods; this is argued on the basis that the distributor's suppliers includes not only the opponent but also other companies which incorporate in their names the words 'Cable Management Systems', 'Cable Management', 'Industrial Controls' and 'Switches'. The opponent also refers to the evidence that other distributors of the opponent's goods offer 'automation products', 'control gear' and 'power distribution products' alongside 'Cable Management Products' and 'Cables & Accessories'¹⁷ and cable tray systems.¹⁸

57. Finally, the opponent argues that its *parts and fittings for electronic and electrical apparatus all for controlling machines, machine tools, robots and industrial processes* and for *switches, inverters and relays* include casings, enclosures and cables for such goods which are highly similar to the applicant's Cable Management Goods because they coincide in relevant public, distribution channels, intended purpose and origin, have a similar nature and are complementary. In this connection, the opponent points

¹⁶ Pages 105-108 of FF1

¹⁷ Pages 109 of FF1

¹⁸ Pages 113 of FF1

out that the evidence relating to the opponent's distributors¹⁹ shows that a distributor sells conduits, alongside the opponent's isolator switches, as well as other products such as industrial ethernet switches, industrial connectors, contactors and push buttons.

58. Although the nature and purpose of the goods are different, the opponent's goods being electrical goods and the applicant's goods being metal materials for building and construction, I agree that the opposed *ducting; trunking; ducting and cable trunking systems; cable management systems and installations; conduit systems; metallic trunking systems for electrical cables; trunking channels of metal; metallic cavity trunking; metallic lighting trunking; conduits; cavity trunking; cable trays, ladder racks, basket trays, boxes, conduit boxes and covers; cable clips of metal; parts and fittings for the aforesaid goods* are all goods that are suited for electrical cables and and/or serve as a raceway for wiring which means that they can be crafted into structures that are used to support the opponent's electrical goods, such as panel boxes and switch boxes, and can be used to provide support for electrical systems which incorporate the opponent's goods. I therefore accept that the goods are complementary, are likely to be sold by through the same trade channels and target the same users, e.g. builders and electricians. **These goods are similar to a low to medium degree.**

59. As regard *steel framework systems*, my understanding of the term is that it designs goods which consist of frames of vertical steel columns and horizontal beams that are used in fast construction of modern framed buildings. The goods are one step removed from the opponent's goods. I find these goods to be dissimilar. The same applies to *metal struts and framework comprised of metal struts*. *Struts* is defined as "a piece of wood or metal which holds the weight of other pieces in a building or other structure", and despite the opponent's claims, there is no evidence that electrical cables are run through struts. **These goods are dissimilar.**

¹⁹ Pages 104 of FF1

60. *Power poles* are used to carry electric wires. The goods target different users, i.e. suppliers of electricity or infrastructure, and have nothing in common with the opponent's goods. **These goods are dissimilar.**

61. Collins English dictionary defines 'ceiling rose' as "*architecture decorative plaster centrepiece*" and "*a circular boss attached to a ceiling through which the flexible lead of an electric-light fitting passes*". Although the contested *metal ceiling roses* are used for light fitting, they are not electrical goods themselves and there is no complementarity between these goods and the opponent's goods. **These goods are dissimilar.**

62. Finally, as regard *metal hardware; locks, plates, clamps, brackets, bolts covers, end caps, fixings, washers, nuts, bolts, screws* the opponent claims that they are highly similar to the opponent's *parts and fittings* because the opponent's goods include hardware such as DIN rails, lock, brackets, screws and nuts. I accept that the applicant's *metal hardware; locks, plates, clamps, brackets, bolts covers, end caps, fixings, washers, nuts, bolts, screws* are all goods which are used in the installation of equipment mounting in enclosures or for fixing to a flat surface; similarly to what I found in relation to the contested Cable Management Goods, these goods can be used to support the opponent's electrical goods and to provide support for electrical systems which incorporate the opponent's goods. Consequently, the users and trade channels coincide and there is a degree of complementarity, although it is less pronounced than the complementarity I found to exist in relation to the Cable Management Goods. **These goods are similar to a low degree.**

63. **Class 9.** *Electrical switchgear; electrical and electronic apparatus, devices, instruments and components for the control, distribution and monitoring of electric current; ducting; ducting systems for electrical cables; cable management systems and installations; non-metallic cable management systems and installations (electric); conduit systems; conduits; switches, sockets, socket outlets, digital socket outlets, fused connection units, cooker outlets, plugs, coaxial/satellite socket outlets, telephone socket outlets, dimmers, spur units, adaptor boxes, switch boxes, socket boxes, junction boxes, fuse boxes; computer data sockets, clip-in lighting distribution accessories; electrical distribution units comprising assemblies of plugs, sockets,*

switches, fused connection units, fuses, indicator lamps and cables; power distribution systems, power distribution units; fuses; electrical circuit protection devices circuit breakers, earth leakage breakers, relays, consumer units; electric relays, consumer units, electricity panel boards; electricity distribution boards, electricity distribution boxes, electrical distributing busbar chambers; switchboards; earth bars, termination boards; terminals; emergency stop push buttons; motor starters; contactors; fire alarm switches; feeder pillars; insulated enclosures for electrical apparatus; transformers, bells and timers; cables, power leads; battens; ammeters; parts and fittings for the aforesaid.

64. For similar reason to those outlined in relation to the contested Cable Management Goods in class 6, I accept that the contested *ducting; ducting systems for electrical cables; cable management systems and installations; non-metallic cable management systems and installations (electric); conduit systems; conduits; cables, power leads, battens* are also similar to the opponent's goods. **These goods are similar to a low to medium degree.**

65. The remaining goods, are all electronic components which are similar to the opponent's goods in the classes 6 and 7 because either: 1) **the applicant has accepted that they are similar**, e.g. *electrical switchgear; electrical and electronic apparatus, devices, instruments and components for the control, distribution and monitoring of electric current; switches, switch boxes, electrical distribution units comprising assemblies of switches; motor starters; fire alarm switches; ammeters* or 2) **they are self-evidently identical or highly similar** (or identical on the principle outlined in *Meric*) to the opponent's goods in class 6, i.e. *sockets, socket outlets, digital socket outlets, coaxial/satellite socket outlets, telephone socket outlets, socket boxes, computer data sockets, sockets* are identical/highly similar to the opponent's *sockets; fuse boxes; fused connection units, fused connection units, fuses* are identical/highly similar to the opponent's *fuses and fuse-holders; relays, electric relays* are identical to the opponent's *relays; timers* are identical to the opponent's *electronic timers; switchboards and electricity panel boards* are identical to the opponent's *control panels*; 3) **they are similar to, at least, a medium to high degree** to the opponent's goods because they have a similar nature, purpose and uses, i.e. they are electronic

components which are built into electrical systems, share trade channels, targets the same uses and are complementary.

66. **Class 17.** *Non-metallic flexible pipes; non-metallic fittings, couplings, connectors, seals and joints for flexible pipes and/or hose; non-metallic fittings, couplings, connectors, seals and joints, bends, elbows, tees, washers, adaptors; cable insulators; insulators for electric mains; electrical insulation tapes, pvc tapes, adhesive sealants for general industrial use, adhesive tapes (for technical purposes), sealants; parts and fittings for all the aforesaid goods.*

67. Collins English dictionary defines 'pipe' as "a tube used to convey water, gas, oil, or other fluid substances". The definition does not support the opponent's suggestion that pipes can be used for electrical installation of cabling and associated devices. Consequently, I find that the contested *non-metallic flexible pipes; non-metallic fittings, couplings, connectors, seals and joints for flexible pipes and/or hose; non-metallic fittings, couplings, connectors, seals and joints, bends, elbows, tees, washers, adaptors* are dissimilar. Although I accept the competing goods can be sold by suppliers of building material, they target different users and are unlikely to be found in close proximity to each other; further, their nature, purpose and methods of use is different and they are neither competitive nor complementary. **These goods are dissimilar.**

68. I extend the same conclusion to *pvc tapes, adhesive sealants for general industrial use, adhesive tapes (for technical purposes), sealants; parts and fittings for all the aforesaid goods* since it is not obvious to me that they are goods used for electrical installations. **These goods are dissimilar.**

69. To the extent that the *cable insulators; insulators for electric mains; electrical insulation tapes*, can be used for electrical insulation, they are similar to the opponent's goods. Although the nature and purpose of the goods is different, they target the same users, share trade channels and are complementary. **These goods are similar to a low degree.**

70. **Class 19.** *Ducting; ducting systems; flexible hose; flexible ducting, ducting (non-electrical) made from insulating materials; cavity trunking; non-metallic ceiling roses; conduit systems; conduits; non-metallic struts and frame work comprised of non-metallic struts; boxes; power poles; parts and fittings for the aforesaid goods.*

71. Class 19 covers “*Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; asphalt, pitch, tar and bitumen; transportable buildings, not of metal; monuments, not of metal*”. Whilst the contested specification in class 6 includes the term *metallic trunking systems for electrical cables* which tells me that ducting and trunking made of metal can be used for electrical installations, I have no idea whether the class 19 would cover ducting and trunking for electrical installations. Further, the contested specification in this class qualifies ‘ducting’ as non-electrical and when I have searched the EUIPO TMClass Database for cross-reference, it only brought up four results which confirm that ‘ducting’ or ‘duct’ in class 19 refers to goods which are not for use in electrical installations, i.e. *Ducting installations [non-electric, non-metallic]; Ducts (installations of -) [non-metallic, non-electric]; Non-metal ducts, not for electrical circuitry; Ducting conduit installations (Non-electric -) of non-metallic materials*.

72. Similar considerations apply to the term *conduit systems; conduits*. Collins English dictionary defines conduit as “*a small tunnel, pipe, or channel through which water or electrical wires go*” and the EUIPO TMClass Database only returns results in class 19 which relate to goods intended to be used for drainage, or irrigation or water discharge, i.e. *Concrete conduits, Plastic conduits for drainage, Plastic conduits for irrigation, Clay pipes and conduits, Plastic water conduits for roofs, Non-metallic conduits for water distribution, Non-metallic conduits for water discharge, Ducting conduit installations (Non-electric -) of non-metallic materials*.

73. As regards power poles and non-metallic ceiling roses I reiterate the same comments I made in relation to the same terms which appear in the contested specification in class 6. **I find that all of the contested goods in class 19 are dissimilar.**

74. **Class 20.** *Non-metallic trunking; non-metallic trunking for cables and leads; non-metallic cable trunking systems; non-metallic trunking systems for electrical cables; non-metallic cable management systems and installations (other than electricity); non-metallic trunking channels; non-metallic cavity trunking; non-metallic lighting trunking; non-metallic cable trays; non-metallic ladder racks; non-metallic fasteners; non-metallic cable clips; non-metallic hose clips and clamps; non-metallic cable straps, grips; non-metallic nuts; cable boxes of non-metallic materials; cable couplings and connectors of non-metallic material; non-metallic racks; non-metallic plates, clamps, brackets, bolts covers, end caps, fixings, nuts.*

75. The contested specification in class 20 covers *non-metallic cable management systems and installations (other than electricity)* and *non-metallic trunking systems for electrical cables*. It seems therefore that the specification includes goods which are intended to be used for electrical installation and goods which are not. Unless the term expressly exclude application in electrical installation, I will therefore consider that the goods are suitable for electrical installation. On that basis I consider that *Non-metallic trunking; non-metallic trunking for cables and leads; non-metallic cable trunking systems; non-metallic trunking systems for electrical cables; non-metallic trunking channels; non-metallic cavity trunking; non-metallic lighting trunking; non-metallic cable trays; non-metallic ladder racks; non-metallic cable clips; non-metallic cable straps, grips; non-metallic nuts; cable boxes of non-metallic materials; cable couplings and connectors of non-metallic material; non-metallic racks; non-metallic plates, clamps, brackets, bolts covers, end caps, fixings, nuts* **are similar to a low to medium degree to the opponent's goods.**

76. The remaining *non-metallic cable management systems and installations (other than electricity); non-metallic fasteners* **are dissimilar.**

77. In order for there to be confusion, there must be a degree of similarity between the goods.²⁰ As the following goods are dissimilar, the oppositions under Section 5(2)(b) must fail:

²⁰ See, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

Class 6: *steel framework systems, metal struts and framework comprised of metal struts; power poles; metal ceiling roses.*

Class 17: *Non-metallic flexible pipes; non-metallic fittings, couplings, connectors, seals and joints for flexible pipes and/or hose; non-metallic fittings, couplings, connectors, seals and joints, bends, elbows, tees, washers, adaptors; pvc tapes, adhesive sealants for general industrial use, adhesive tapes (for technical purposes), sealants; parts and fittings for all the aforesaid goods.*

Class 19: *Ducting; ducting systems; flexible hose; flexible ducting, ducting (non-electrical) made from insulating materials; cavity trunking; non-metallic ceiling roses; conduit systems; conduits; non-metallic struts and frame work comprised of non-metallic struts; boxes; power poles; parts and fittings for the aforesaid goods.*

Class 20: *non-metallic cable management systems and installations (other than electricity); non-metallic fasteners*

Average consumer

78. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

79. 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. (as he then was) 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.”

80. The average consumer of the competing goods is a business user, i.e. a building company, or a tradesman. 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, particularly when advice is sought from a sales representative. Even for goods which are not particularly expensive, i.e. parts and fittings, the average consumer might examine the product to ensure that they select the correct type. Hence the average consumer will pay at least a medium degree of attention.

Comparison of marks

81. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

82. 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.

83. The opponent mark is IMO.

84. The applicant's marks are shown below:

(the First Application)



(the Second Application)



85. The opponent's mark consists of the letters 'IMO' which will be perceived by the relevant public as an acronym without any specific meaning.

86. The First Application consists of a series of two composite marks incorporating a number of elements. The first element is a rectangular device presented in blue and grey respectively. To the immediate right of the device are the three capital letters 'IMD' presented in bold in a dark grey colour. The device incorporates a graph white line showing spikes and dips which runs horizontally through the letters 'IMD'. Below these elements, there are the words 'THE NAME BEHIND THE BRANDS' written in capital letters in a significantly smaller size. Both the device and the letters 'IMD' make an equal contribution to the overall impression of the marks. Although I bear in mind the principle that 'words speak louder than devices', this is counterbalanced by the fact that the device is positioned before the letters and beginnings of marks are normally more focused upon. Further, contrary to what the opponent states, I do not

think that the device will be immediately understood as depicting an electrical sign; although I note that the evidence contains an example of use of a similar sign by an electrical company,²¹ that is far from establishing 'common place' use. The phrase 'THE NAME BEHIND THE BRANDS' will also contribute to the overall impression although to a lesser degree due to its smaller size.

87. The same consideration applies to the Second Application, the only difference being that the letter 'imd' are presented in lower case.

88. Visually, the applications and opponent's mark coincide in that they all comprise a three-letter acronym and the first two letters of each acronym 'IM' are identical. Even taking into account that two of the three letters are identical and placed in the same sequence, the last letter is different and the further visual differentiation between the marks will leave an impression on the average consumer. In its submissions in lieu the opponent put forward a number of variations which in my view stretch the boundaries of what would be acceptable as notional and fair use of the earlier mark, for example, I do not accept that notional use of the word mark 'IMO' would cover the following

forms: **IMD** and **IMO**. However, since a word-only mark covers use in all possible fonts and typefaces,²² I do accept that notional a fair use of the earlier word

mark 'IMO' would cover the following form: **IMO** or even, possibly, **IMD**.

89. I also accept that the stylisation of the letters in the First Application slightly increases the degree of similarity between the letter 'D' in the contested mark and the letter 'O' in the opponent's mark marking the two elements 'IMD' and 'IMO' similar, overall, to a medium to high degree:

IMD **IMO**

90. As regards the Second Application, even allowing for the opponent's word-only mark to be presented in a typeface similar to that of the opponent's mark, I find that

²¹ Page 113 of FF1

²² Case T-364/04 *Sadas SA v. OHIM*

the letters 'd' and 'o' in lower case are less similar and that the elements 'imo' and 'imd' in themselves are similar to a medium degree:

imd imo

91. However, when the marks are considered as wholes, the additional differences created by the device, the white line cutting through the letters 'IMD' and the words 'THE NAME BEHIND THE BRANDS' in the contested marks make the marks visually similar overall to a **low degree**.

92. Aurally, the pronunciation of the marks coincides in the sound of the first two letters 'IM/im' present identically in both marks. The pronunciation differs in the sound of the letter 'O' of the earlier mark versus the sound of the letter 'D/d' of the contested marks. In addition to the difference created by the letters 'D/d/O', there might be a further aural difference if the smaller words 'THE NAME BEHIND THE BRANDS' are pronounced, although given the length of the phrase and its descriptive connotations it is more likely that the contested marks will be referred simply as the acronym 'IMD/imd'. Therefore, if the contested marks are pronounced as 'IMD/imd' the marks are aurally similar to a medium degree. If the element 'THE NAME BEHIND THE BRANDS' in the contested marks is articulated the marks are aurally similar to a **very low degree**.

93. Conceptually, neither the acronym 'IMD/imd' nor the acronym 'IMO' has a meaning for the relevant public. Whilst the contested marks contain what the applicant describe as a 'pulse' device, I do not think the device will convey the concept of a pulse because the nature of the goods do not actually support that perception; it is more likely than not in my view that the average consumer will perceive the device as conveying the concept of a graph line. The words 'THE NAME BEHIND THE BRANDS' conveys the concept that the name 'IMD/imd' is the main brand and it is responsible for other brands – although I have said that that concept will be perceived as descriptive of the user of the mark, it is not descriptive in the context of the goods, and so it is distinctive. Overall, **the marks are conceptually dissimilar**.

Distinctive character of earlier mark

94. 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).”

95. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

96. I start with an assessment of the inherent distinctive character of the earlier marks. The earlier marks are word marks consisting of the three letters ‘IMO’. The applicant submitted that since the earlier mark is only three letters long it is of low distinctive character. Although a three-letter word mark is relatively short, the sequence ‘IMO’ is

neither descriptive nor allusive of the goods concerned. It is therefore distinctive to a slightly lower than medium (but not low) degree.

97. The opponent claimed that its mark is particularly distinctive by virtue of intensive use or reputation. For enhanced distinctive to assist the opponent it must be shown that the distinctiveness of the mark has been enhanced in the UK in the context of the registered goods. Although the opponent has filed some revenue figures, it has not provided any breakdown of its total sales, so it is impossible to say how intensive the use has been in relation to the various categories of goods covered by the marks – a factor which is particularly important in my assessment given that the revenue figures are likely to include revenue generated by the sales of goods which are not covered by the registrations. Finally, the annual sales generated in the UK in the period 2015-2019 range between £6.5million and £8.5million; although these figures appear to be significant I have no way of contextualise them given the absence of any information about market share. Hence the evidence does not support the opponent's claim.

Likelihood of confusion

98. 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 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

99. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“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.

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.).
- (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).”

100. I have found the marks to be visually similar to a low degree, aurally similar to a very low or medium degree (depending on whether the words ‘THE NAME BEHIND THE BRANDS’ are pronounced or not) and conceptually neutral insofar as the acronym ‘IMD’ and ‘IMO’ are concerned, although I recognised that the other elements

of the applicant's marks introduce some conceptual differences. I also found that the elements 'IMD' and 'IMO' in themselves are visually similar to a medium to high and a medium degree in the First and the Second Application respectively. As regard the goods which I found to be similar they range from similar to a low degree to identical. I found the average consumer to pay at least a medium degree of attention and the purchase to be mainly a visual one. The earlier mark is distinctive to a slightly lower than medium (but not low) degree.

101. I pause here to say that I have given no weight to the applicant's declared intention with regard to its pending applications, as it makes no difference to the outcome of the oppositions. Further, the evidence filed by Mr Frank does not establish that consumers will understand the acronym 'IMD' as standing for Installations Material Division.

102. The opponent made a number of comments in relation to the likelihood of confusion. It said that the goods concerned are likely to be selected based on functional considerations rather than the brand so that the level of attention to the origin of the goods may be low. I reject the submission. That is not the correct test, and the opponent did not indicate any authority which would support such an approach. The opponent also stated that it has used the registered mark in dark blue and that such use would increase the likelihood of confusion. Even taking into account that the mark 'IMO' could be used in any colour, including a shade of blue similar to that used in the applications, that would not increase the similarity between the marks to any material extent. Finally, the opponent stated that it has used the mark together with other brands, i.e. JAGUAR, and that the strapline 'THE NAME BEHIND THE BRANDS' is perfectly applicable to the opponent's business. However, what the opponent did not say is why consumers are likely to be confused and how confusion could happen.

103. As regards direct confusion, I consider there to be sufficient differences between the opponent's mark and the applicant's marks to avoid them being mistaken as each other.

104. Moving on to indirect confusion, the only way indirect confusion could possibly arise is if the average consumer (who I must assume is aware of the opponent's 'IMO' mark) would, in encountering the applicant's marks, misread 'IMD/imd' for 'IMO' or misremember 'IMO' for 'IMD/imd' and, on the basis of that error or imperfect recollection, conclude that the applicant's marks are variant marks used by the same user of the 'IMO' mark.

105. In marks composed of only three letters not having a meaning, the fact that one of the letters is different may be sufficient to render them not confusingly similar. Even when the difference is in the last letter, the public, in my view, will recognize it, even allowing for a degree of imperfect recollection. This is all of the more so since the contested marks are composite marks and the comparison at issue is not simply between the mark 'IMO' and the mark 'IMD'. The visual difference between the marks means that to envisage indirect confusion the average consumer will need to 1) identify the element 'IMD/imd' as an independent distinctive element of the contested marks; 2) misread or misremember the elements 'IMD/imd' and 'IMO' in the respective marks and 3) put the differences between the marks down to the contested marks being variant marks used by the user of the earlier marks.

106. Although the letter 'D' in the First Application is more similar to an 'O' than a letter 'D' written in standard typeface, it is still sufficiently clear that it is a 'D', not an 'O'. Despite the stylisation, the legibility of the letter 'D' as an 'O' is unrealistic and it is unlikely that the average consumer of the goods at issue will misread 'IMD' for 'IMO', especially given the medium degree of attention that will be paid during the purchase. There are great many acronyms on the market and the public is accustomed to differentiating them so it is also unlikely that the average consumer will misremember the earlier mark and confuse it with the later marks because two of the three letters making up the acronyms in the conflicting marks are the same. Further even if a non-significant number of consumers were to misread or misremember the elements 'IMD' and 'IMO' (a conclusion which I do not accept), it is not simply a case of mixing up the acronyms, as the get-up of the contested marks does not add to the impression that they are a brand extension from the word-mark 'IMO'. Finally, although the opponent states that the concept introduced by the words 'THE NAME BEHIND THE BRANDS' is equally applicable to the opponent, there is no evidence that the opponent has ever

promoted the mark 'IMO' as a brand offering products under other brands and I do not accept that the sporadic evidence that the opponent has marketed some products as JAGUAR driver is sufficient to establish that the brand 'IMO' is associated with that concept. There is no likelihood of confusion.

107. The oppositions based on Section 5(2)(b) fail.

SECTION 5(3)

108. Section 5(3) states:

“(3) A trade mark which-

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

109. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

110. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such

a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

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

111. The relevant date for the assessment under Section 5(3) is the date of the applications, namely 16 August 2019 and 10 March 2020.

Reputation

112. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

113. The Section 5(3) claim is based on the same evidence I have referred to when dealing with the opponent's claim under Section 5(2). As it will be recalled, in the context of Section 5(2) I have found that the evidence filed was sufficient to prove genuine use; however, this does not necessarily mean that the opponent has a reputation in the UK. The test for genuine use and reputation are different tests.

114. In a recent decision (BL-O-730-21) Mr Iain Purvis QC sitting as the Appointed Person reiterated the factors which must be taken into account when assessing claims for reputation:

"Mr. Harbottle says that the Hearing Officer erred in applying too stringent a test to the evidence required to establish a reputation. In particular, he complains that the Hearing Officer ought to have reminded herself of the decision of Arnold J (as he then was) in *Enterprise Holdings Inc. v Europcar* [2015] EWHC 17 and in particular his remark at [120] that the requirement to prove reputation under section 5(3) of the act is

'not a particularly onerous requirement'

30. I disagree that it was incumbent on the Hearing Officer to remind herself of these words, which are little more than a passing comment and were hardly intended to establish a test which can be applied in other cases. Indeed, in *Enterprise* the comment is immediately followed by the words:

'As the Court of Justice explained in General Motors Corp v Yplon SA (C-375/99)'

and the learned Judge then quotes paragraphs [24] to [27] of that decision, which set out the test universally applied by the Courts in this jurisdiction.

31. It is hard to see how any criticism can be made of a Hearing Officer who sets out precisely the same paragraphs as those cited by Arnold J (she quotes them in paragraph 32 of her decision). The key paragraphs here are [26] and [27] in which the Court of Justice say:

"The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark."

"In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

32. Whether one considers that this test is "not particularly onerous" or not, the test is the test and the Hearing Officer plainly applied it."

115. To be relevant reputation must be in the goods and/or services covered by the trade mark registration. The absence of breakdown sales means that it is impossible to establish what proportion of the revenue figure relate to each of the categories of goods covered by the earlier marks. Further, although the opponent claims to have traded for approximately half century there are no turnover figures for the period prior to 2015. There is no indication of market share or marketing expenditures and, aside some brief references to the opponent having its own YouTube Channel and an active LinkedIn page, there is no indication of the mark's exposure in the press or online in the UK. In my view, the opponent has failed to show reputation sufficient to support its claim under Section 5(3).

116. **As such, the claims under Section 5(3) fail.**

SECTION 5(4)(A)

117. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa[...]

b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

118. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

119. I will deal with this claim very briefly. Bearing in my mind my assessment of the comparison of the marks already made, whilst recognising the difference in legal tests between a likelihood of confusion and misrepresentation, the opponent is in no better position with regard to this ground than under Section 5(2)(b). Even if the opponent had established that it had goodwill at the relevant date in respect of some goods claimed which are identical to the contested goods, the visual differences between the marks are sufficient to avoid consumers purchasing the applicant's goods in the mistaken belief that they are provided by the opponent's business, i.e. there will be no misrepresentation. Without misrepresentation there can be no damage.

120. **The oppositions under Section 5(4)(a) also fail.**

OVERALL OUTCOME

121. The oppositions fail in their entirety and the contested applications may proceed to registration.

COSTS

122. The applicant having been successful, is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. I assess this as follows:

Filing two counterstatement and considering two notices of opposition:	£400
Filing evidence and considering the opponent's evidence:	£500
Written submissions:	£300
Total:	£1,200

123. I therefore order IMO Precision Controls Limited to pay City Electrical Factors Limited the sum of £1,200. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of any appeal proceedings.

Dated this 29th day of November 2021

T Perks
For the Registrar,
the Comptroller-General