

O/871/21

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001430529 BY LYNRED
FOR THE FOLLOWING MARK:**



AS A TRADE MARK IN CLASS 9

AND

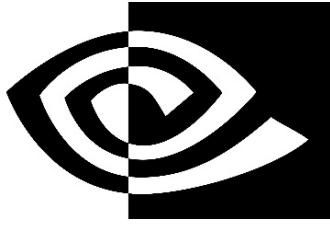
**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 415978
BY NVIDIA CORPORATION**

BACKGROUND

1. LYNRED (“the holder”) is the holder of the international registration shown on the cover page of this decision (“the IR”). The IR was registered on 30 July 2018. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The holder seeks protection for the IR in relation to the following goods:

Class 9: Scientific, optical, optoelectronic, measuring, signaling apparatus and instruments; security surveillance and monitoring apparatus; devices for safety, security, protection and signaling; measuring, detection and monitoring instruments, indicators and controllers; apparatus and instruments for the detection and analysis of human activity not for medical use; sensors; detectors; photosensors; optical detectors and sensors; infrared detectors and sensors; thermal detectors and sensors; heat detectors and sensors; smart sensors and detectors, i.e., which include integrated software and electronic functions; thermostats; infrared imaging retinas not for medical use; software; software for monitoring the environment, access and security of buildings; components, namely, semiconductor or optoelectronic components; electronic apparatus, devices and parts, namely, electronic components, electronic integrated circuits, microprocessors, electronic cards built into optical and optoelectronic apparatus.

2. The request to protect the IR was published on 11 January 2019 and, on 11 April 2019, it was opposed by Nvidia Corporation (“the opponent”). The opposition was initially based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, the opponent failed to file evidence in these proceedings meaning that it was unable to continue with the 5(3) and 5(4)(a) grounds. As a result, the opposition proceeds in respect of the 5(2)(b) ground only.
3. The opponent relies on the following mark:



EUTM: 014519912¹

Filing date 28 August 2015; registration date 31 March 2016

(“the opponent’s mark”)

4. The opponent relies on all goods and services for which its mark is registered and these are set out in the **Annex** to this decision.
5. The opponent claims that as a result of the similarity of the marks and the (at least) high similarity between the parties’ goods, there is a risk of confusion and/or association between the parties’ marks to the extent that the IR should be refused protection in the UK. The holder filed a counterstatement denying the claims made.
6. Neither party has filed evidence. A hearing took place before me on 19 October 2021 by video conference. The opponent was represented by Mr Philip Harris of Lane IP Limited, who have represented the opponent throughout these proceedings. The opponent filed skeleton arguments in advance of the hearing. The holder has been represented by Mathys & Squire LLP but elected not to attend the hearing.
7. 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 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.

¹ Although the UK has left the EU and the EUTM relied upon by the opponent now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application

DECISION

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

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

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

(a) ...

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

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

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

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

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

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

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

11. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than 5 years before the IR was designated for protection in the UK, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services for which its mark is registered.
12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.
- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
 - (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
 - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
 - (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. The holder's goods are set out in **paragraph one** of this decision. The opponent's goods and services are set out in the **Annex** to this decision.

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

“Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. 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.

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

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

17. At the hearing, the opponent gave submissions in respect of the similarity of goods. The opponent submitted that, generally, the terminology of both parties' specifications places them within the *Meric* principle and that the goods in the holder's specification are identical to the goods and services in the opponent's mark's specification. I will not reproduce all of these submissions in full but will, if necessary, refer to them below.
18. "Software" in the holder's specification is, in my view, self-evidently identical with "computer software" in the opponent's specification.
19. "Software for monitoring the environment, access and security of buildings" in the holder's specification falls within the broader category of "computer software" in the opponent's specification. These goods are, therefore, identical under the principle outlined in *Meric*.
20. At the hearing, the opponent submitted that, in general, the range of apparatus and instruments in the holder's specification are all types of computer hardware and that they would, therefore, be identical to the opponent's term, being "computer hardware". In my view, this submission is a very broad one and I do not agree that it applies to all of the remaining goods in the holder's specification. In respect of the following comparison of goods and services, I consider it necessary at this stage to set out that, in my view, "computer hardware" in the opponent's specification covers not only external computer peripherals such as the external casing of a desktop computer, computer monitors, keyboard, mice and storage devices but also internal components such as motherboards, CPUs, graphics cards and RAM. It is a very broad term and in light of the judgment of *Sky v Skykick*,² I do not consider it appropriate to equate the term "computer hardware" to every permutation of its potential functions. Instead, throughout the following comparisons, I will interpret it as covering the goods clearly covered by its literal meaning.
21. I do not consider that "scientific, optical, optoelectronic, measuring, signaling apparatus and instruments" in the holder's specification are types of computer

² [2020] EWHC 990 (Ch)

hardware. Secondly, I note that the opponent suggested that because the holder's goods are likely to include types of computer hardware, they are identical or highly similar to "computer hardware" in the opponent's specification. I have already accepted that computer hardware does cover internal parts of a computer and I am of the view that the holder's term covers goods such as microscopes or digital scales which are both likely to include computer chips and other forms of internal components that may be considered pieces of computer hardware. However, I am reminded of the case of *Les Éditions Albert René v OHIM*³ wherein the GC found that just because a particular good is used as a part, element or component of another does not, in itself, mean that those goods are similar. Aside from the fact the holder's goods may include types of computer hardware as internal components, I see no obvious reasons as to why the goods would overlap in nature, method of use, user or purpose. Further, I do not consider that the goods will be produced by the same undertakings or sold through the same channels meaning that the trade channels are also different. In my view, these goods are dissimilar.

22. Using the same reasoning as discussed at paragraph 21 above, I am of the view that just because "measuring, detection and monitoring instruments, indicators and controllers" and "apparatus and instruments for the detection and analysis of human activity not for medical use" in the holder's specification are goods that are likely to have internal components that may be considered computer hardware, I do not consider there to be any obvious level of similarity between them and any of the goods in the opponent's specification. These goods are, therefore, dissimilar.

23. In my view, "security surveillance and monitoring apparatus" in the holder's specification includes goods such as CCTV equipment such as CCTV cameras. On the basis the "computer hardware" in the opponent's specification can be said to include webcams, I shall give consideration to any similarity between these goods. In my view, there is an overlap in nature between goods such as CCTV cameras and webcams in that they are both camera devices. However, despite both being camera recording devices, their purposes, methods of use and users

³ Case T-336/03

are different. CCTV cameras will be used by business users as part of larger networks for security and monitoring purposes whereas webcams are commonly used by members of the public who plug them into their home computers for the purpose of enabling them to have video calls or record home videos. Further, I do not consider that a provider of a webcam for use with a computer to be the same as the provider of security surveillance and monitoring apparatus. I also find that they will not reach the market via the same distribution channels as the holder's goods are likely to be available through specialist retailers only whereas the opponent's will be available via general retailers. Finally, the goods are not competitive or complementary. In my view, considering all other factors, I do not consider that the overlap in nature is sufficient to warrant a finding of similarity between these goods. I, therefore, find them to be dissimilar.

24. At the hearing, the opponent submitted that the holder's goods that include signalling, being "devices for safety, security, protection and signaling" would fall within the opponent's goods on the basis that the opponent's specification includes "handheld entertainment device, namely, portable digital audio, video and multimedia players, transmitters and receivers for use with text, audio, video, images, still and motion pictures, graphics, computer games, video games, signals, messages, multimedia files, and other digital data, and for accessing global computer and communication networks". While both devices may include the use of signals, I do not consider it is necessarily the case that these goods are identical. In my view, the holder's goods would not, in any way, be interpreted as covering handheld entertainment devices. While I accept that there may be a general overlap in nature in that both goods cover devices that send and receive signals, I consider all other factors to be different. The method of use for these goods are quite clearly different, so too are the users, purposes and trade channels. While there is a general overlap in nature, I do not consider that this is sufficient to warrant a finding that these goods are similar.

25. At the hearing, the opponent submitted that modern entertainment devices contain a great variety of sophisticated technological sensors and that every day consumer products such as mobile phones contain GPS sensors and measuring devices. While I accept that this is in the case, I refer to my comments in paragraph 21

above and find that just because the range of mobile digital devices covered in the opponent's specification may include various types of internal sensors, it does not necessarily mean that these goods are identical or similar to any degree with "sensors", "photosensors", "detectors", "optical detectors and sensors", "infrared detectors and sensors", "thermal detectors and sensors", "heat detectors and sensors" and "infrared imaging retinas not for medical use" in the holder's specification. On the contrary, I consider that these goods all differ in nature, method of use, user, purpose and trade channels. I have also considered whether the holder's goods would be considered different types of computer hardware. While I have no submissions from the holder as to what these goods actually cover, I am of the view that they are not items that would fall within the category of computer hardware. Overall, I consider these goods to be dissimilar with any of the goods or services in the opponent's specification.

26. "Smart sensors and detectors, i.e., which include integrated software and electronic functions" in the holder's specification is a good that includes a type of computer software. While I do not consider these goods to be identical with "computer software" in the opponent's specification on the basis that the holder's goods also include physical devices, there is a level of similarity between them. I have no submissions as to what the holder's goods cover but it is my view that it may cover sensors that are placed in the home which, when triggered, alert the user via computer software that is installed on their mobile device, for example. While there is an overlap in nature and method of use on the basis that they both consist of computer software, any overlap is general on the basis that the holder's goods also include physical devices. I also consider that they overlap in purpose on the basis that the opponent's goods can be used for the same purpose as the integrated software within the holder's term. Further, there is a general overlap in user in that both goods may be used by the same relevant public. Further, I consider there to be an overlap in trade channels on the basis that the goods are both likely to be sold via the same retailers. Overall, I consider the goods to be similar to a medium degree.

27. Without any submissions to the contrary, I am of the view that "thermostats" in the holder's specification are goods used to control the temperature of a certain

location within a building. Again, following on from the reasons given at paragraph 21, the mere fact that these goods may include internal components that are considered types of computer hardware, I do not consider this alone to warrant a finding of similarity between these goods as “computer hardware” or any of the opponent’s goods or services for that matter. The goods have different natures, methods of use, purpose and trade channels. These goods are, therefore, dissimilar.

28. I have no submissions as to what goods the term “components, namely, semiconductor or optoelectronic components” in the holder’s specification covers. It is my understanding that semiconductors are materials that are used to conduct electricity. It is also my understanding that optoelectronic components are used for sourcing, detecting and controlling light. While semiconductors may be used as components within computer chips and on motherboards, I refer to my findings above in that the use of one good as a component in another does not give rise to an automatic level of similarity between them. While I accept that there may be an overlap in nature between these goods and “computer hardware” in the opponent’s specification in that both goods cover different types of electrical components, I am of the view that this is where any similarity ends. The goods are for different purposes in that the holder’s goods are for conductivity or for sourcing, detecting and controlling light whereas the opponent’s are used to run or operate a computer. Further, the goods have different methods of use. I also consider the user base for these goods to be different in that the holder’s goods are, in my view, aimed at specialist consumers such as those who specialise in optoelectronics. Finally, I do not consider there to be any overlap in trade channels and neither do I consider there to be any complementary or competitive relationship between them. Overall, I consider these goods to be dissimilar.

29. “Electronic apparatus, devices and parts, namely, electronic components, electronic integrated circuits, microprocessors, electronic cards built into optical and optoelectronic apparatus” in the holder’s specification are a range of goods that can be said to be different types of computer hardware, albeit for use in optical and optoelectronic apparatus. Even with the limitation that the holder’s goods are to be used in those specific apparatus, I consider that they fall within the broader

category of “computer hardware” in the opponent’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.

30. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail.⁴ For ease of reference, the opposition fails against the following goods in the applicant’s specification:

Class 9: Scientific, optical, optoelectronic, measuring, signaling apparatus and instruments; security surveillance and monitoring apparatus; devices for safety, security, protection and signaling; measuring, detection and monitoring instruments, indicators and controllers; apparatus and instruments for the detection and analysis of human activity not for medical use; sensors; photosensors; detectors; optical detectors and sensors; infrared detectors and sensors; thermal detectors and sensors; heat detectors and sensors; Infrared imaging retinas not for medical use; thermostats; components, namely, semiconductor or optoelectronic components.

The average consumer and the nature of the purchasing act

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

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

32. At the hearing, the opponent submitted that the goods at issue cover a great range of different products, being either ordinary consumer goods or sophisticated products. It further submitted that the average consumer is likely to be members of the public but also accepted that this may extend to professional users. The opponent also submitted that the average consumer would pay an ordinary level of attention. I agree with the opponent in that the average consumer of the goods at issue will be members of the general public and that this would also extend to business users. As for the level of attention paid, I agree with the opponent for the most part in that the average consumer is likely to pay an ordinary, or medium, degree of attention during the selection process. For the majority of goods, the consumer is likely to consider factors such as the reliability and suitability of the goods at issue. As for more sophisticated goods (such as integrated circuits for optical apparatus, for example), I consider the level of attention will extend to a higher than medium degree (but not high). For those goods, the factors already discussed will be considered, albeit to a more heightened degree. Further, for goods such as integrated circuits, for example, the average consumer will also consider factors such as the materials used and the conductivity of the component.

33. As for the selection of the goods, the opponent submits that they are going to be selected in a fairly usual way with visual cues dominating the process. For the most part, the goods will be available via retailers and their online equivalents. Where the goods are selected at a retailer, they will be displayed on shelves and self-selected by a consumer. A similar process will apply to websites where the consumer will select the goods having viewed an image displayed on a website. As for the more sophisticated goods, the process will be very similar with the only difference coming from the fact that the goods are likely to be selected via specialist retailers or their online equivalents. In either situation, I agree with the opponent in that the visual element will pay a primary role in the selection of the goods at issue.

However, I do not discount an aural component still playing a part as a result of word of mouth recommendation or advice from sales assistants.

Distinctive character of the opponent's mark

34. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union ("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)."

35. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent initially claimed enhanced distinctiveness through use but does not maintain that claim as a result of no evidence being filed in these proceedings. Therefore, I only

have the inherent position to consider. I note that at the hearing, the opponent submitted that its mark enjoys a high degree of inherent distinctive character. Further, the opponent gave detailed submissions as to the impression of the opponent's mark. I will not reproduce these here but I note that the main point of these submissions was that the device element, being the only element in the mark, will be seen as an eye.

36. Having considered the submissions and the mark as a whole, I am of the view that the majority of average consumers will see it as a spiral. However, I accept that a significant proportion of average consumers may view the opponent's mark as a graphical representation of an eye. Regardless of whether it is seen as an eye or not, I do not consider the opponent's mark to be particularly remarkable from a trade mark perspective. This is on the basis that average consumers are used to seeing trade marks consisting solely of shapes or stylised representations of recognisable objects (in the case it is seen as an eye). Having said that, I do appreciate that the make-up of the mark, with its spiral and inverted colour scheme, will leave an unusual imprint in the eyes of average consumers. Overall, I consider that the mark enjoys a higher than medium degree of inherent distinctiveness. For the avoidance of doubt, in the event that the mark is seen as an eye, the elevated level of distinctiveness is attributable to the marks stylistic elements and not the fact that the mark consists of an eye.

37. As above, the opponent has argued that its mark will be seen as an eye and it is upon this basis that it aimed its arguments in favour of a likelihood of confusion. While I have found that the majority of average consumers would see it as a spiral, I have found that a significant proportion of average consumers would see it as an eye. As this represents the opponent's best case, I will focus the remainder of this decision on the proportion of consumers that will see an eye. I do not consider this to be a controversial approach as I am reminded of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,⁵ wherein Kitchin LJ concluded that if a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement. While

⁵ [2016] EWCA Civ 41

this case was an infringement case, the principles apply equally to oppositions under section 5(2) of the Act.

Comparison of marks

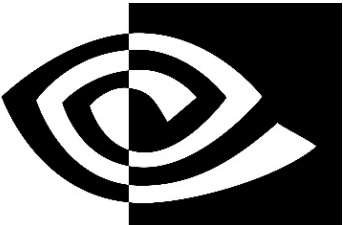

38. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

39. 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.”

40. 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.

41. The respective trade marks are shown below:

The opponent's mark	The IR
	

42. I have detailed submissions from the opponent in respect of the comparison of the marks. However, I will not reproduce these in full here but have taken them into consideration in making the following comparisons and will, if necessary, refer to them below.

Overall Impression

The IR

43. The IR consists of a device and word element. The device will be seen as a stylised eye. It is presented in red and white, with the white part of the eye sitting on a blue background. The word element, that sits below the device, is the word 'ULIS' in a standard blue typeface. The opponent submits that the device element of the IR plays an independent role within the IR given its size and placement in the mark. While noted, it cannot be said that it is any more dominant or distinctive than the invented word 'ULIS'. I make this finding on the basis that 'ULIS' due to its lack of meaning must be said to be distinctive in its own right. Further, even though it takes up less space in the mark than the device, it cannot be said to be *de minimis* or negligible and, therefore, plays a significant role in the IR as its sole verbal element. Consequently, I find that both elements make a roughly equal contribution to the overall impression of the IR.

The opponent's mark

44. The opponent's mark consists of a device element only. There are no other elements that contribute to the overall impression of the mark, which lies in the device itself.

Visual Comparison

45. While both marks consist of a depiction of an eye, it does not necessarily mean that they are considered similar. I make this finding on the basis that the depictions of the eye in each mark are, stylistically, very different and I note that just because two marks may share representations of the same thing, it does not automatically

result in a finding of visual similarity between them.⁶ Another significant point of difference between the marks is the presence of 'ULIS' in the IR. In my view, the only point of visual similarity between the marks is that they share a device element that consist of a contrasting and inverted colour scheme. Even then, I note that while the opponent's mark is registered in black and white, meaning that it can be used in any colour, I do not consider that this extends to use of contrived colour splits like the one present in the IR. Taking all of this into account, I am of the view that the marks are similar to a low degree.

Aural Comparison

46. The opponent submits that the device elements in both marks will be mentally verbalised by the consumer as the word 'EYE'. I disagree that this would be the case and, in any event, I do not consider that the mental impression described would translate to the mark being verbally pronounced as the word 'eye'. Therefore, as the device is the only element in the opponent's mark, it contains no aural component. Given that the IR does, I find that regardless of how 'ULIS' is pronounced, the marks are aurally dissimilar.

Conceptual Comparison

47. In my view, the concept of both marks will be dominated by the fact they consist of an eye, albeit different depictions. Having said that, and despite the fact the word 'ULIS' in the IR will be seen as a made-up or foreign language word, it still acts as a point of conceptual difference between the marks. Overall, I consider the marks are conceptually similar to a higher than medium degree.

Likelihood of confusion

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

⁶ *The Royal Academy of Arts V Errea Sport S.P.A.* (BL O-010-16)

exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

49. I have found the goods to be identical or similar to a medium degree. I have found the average consumer to be both members of the public and business users. I have found that the average consumer will select the goods and/or services through primarily visual means (although I do not discount an aural component). I have concluded that the average consumer will mostly pay a medium degree of attention during the purchasing process but for some goods, this will extend to a higher than medium (but not high) degree. I have found that the opponent's mark enjoys a higher than medium degree of inherent distinctive character but that the elevated distinctiveness is attributed to the stylisation of the mark, not the fact it represents an eye. I have found that the marks are visually similar to a low degree, aurally dissimilar and conceptually similar to a higher than medium degree.

50. I have detailed submissions from the opponent in respect of likelihood of confusion. I will not reproduce those in full but will, where necessary, refer to them below. For the avoidance of doubt, I have considered the submissions carefully in reaching the following conclusion.

51. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that the average consumer will mistake one mark for the other. I make this finding on the basis that there is only a low

degree of visual similarity between them and the fact that they are aurally dissimilar. While the submissions of the opponent in respect of direct confusion are noted, I do not consider that the average consumer would overlook the presence of the word element in the IR and the stylistically different depictions of an eye in both marks. Even taking into account the higher than medium degree of inherent distinctiveness of the opponent's mark, I do not consider this will result in a finding of direct confusion. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks, even on those goods that I have found to be identical.

52. It now falls to me to consider whether there is a likelihood of indirect confusion. Indirect confusion involves recognition by the average consumer of the differences between the marks. In the present case, I see no plausible basis for an average consumer, having recognised the differences in the marks, to believe that the IR is another brand of the owner of the opponent's mark, or vice versa.⁷ There is no obvious rationale for the differences between the marks in that they do not appear to be indicators of a brand extension or sub-brand of the same or economically linked undertaking. The opponent submitted that the differences between the marks would be seen as a logical development and one that the consumer would expect to see. While noted, I see no basis as to why this would be the case. I do not consider that the differences in the device elements would be overlooked or misremembered so that when the word element was noticed, it would not be viewed as a logical development but instead, indicative of a different mark of a different undertaking. Additionally, I do not consider that the differences in the marks will be seen as consistent with a logical re-branding of one another. For example, an average consumer would not consider it logical for an undertaking with a mark that consists of a clear representation of an eye (such as the one in the IR) and a word element to significantly redesign their mark by removing the word and altering presentation of the device element to the point where it had little resemblance to the previous design used. Instead, I am of the view that the average consumer would consider the shared use of an eye to be merely coincidental. As for the shared use of an inverted and contrasting colour scheme,

⁷ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

I see no reason why the average consumer would consider that shared element to be an indicator of the marks coming from the same or economically linked undertakings and would instead attribute no meaning to this save as viewing it as a stylistic embellishment in each mark. Consequently, I find that there is no likelihood of indirect confusion, even on those goods that I have found to be identical.

53. Even if I were to consider the fact that the device element in the IR plays an independent and distinct role within the IR, I still do not consider that a likelihood of confusion would arise. In *Whyte and Mackay Ltd v Origin Wine UK Ltd*⁸ and *Another* wherein Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*.⁹ The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

⁸ [2015] EWHC 1271 (Ch)

⁹ Case C-120/04

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

54. I note that confusion is not an automatic result of the shared element having an independent distinctive role. I have borne in mind the guidance set out in *Duebros Limited v Heirer Cenovis GmbH*¹⁰ wherein Mr James Mellor QC set out that a finding of indirect confusion should not be made merely because the two marks share a common element. It is still a whole mark comparison that must be made. On this point, I also refer to paragraph 21 of *Whyte and Mackay* (cited above) wherein it was set out that even where an element of a composite mark that is similar to the earlier mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. Firstly, I do not consider the elements are similar to enough of a degree that they would be mistaken for one another. Secondly, even if the device element in the IR could be said to be distinctive in its own right, when considering the global assessment and taking into account that the marks consist of significantly different graphically depictions of eyes, I do not consider that the average consumer would be confused. In my view, in the event that the device element of the IR is viewed independently, any resulting increase in similarity between the marks would be very slight and I do not consider that it would be sufficient to overcome the findings that I have made above in

¹⁰ BL O/547/17

respect of both direct and indirect confusion. Consequently, even in the event that the device element in the IR plays an independent distinctive role, I find that there is no likelihood of indirect confusion, even on those goods that I have found to be identical.

CONCLUSION

55. The opposition fails in its entirety and the IR can proceed to be granted protection in the UK for all goods.

COSTS

56. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£200** as a contribution towards its costs. The sum is calculated as follows:

Considering the opponent's statement / preparing counterstatement:	£200
Total	£200

57. I therefore order Nvidia Corporation to pay LYNRED the sum of £200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of November 2021

A COOPER
For the Registrar

ANNEX

Class 9

Computer hardware; computer hardware, namely, integrated circuits, semiconductors and chipsets; computer software for the display of digital media; handheld entertainment device, namely, portable digital audio, video and multimedia players, transmitters and receivers for use with text, audio, video, images, still and motion pictures, graphics, computer games, video games, signals, messages, multimedia files, and other digital data, and for accessing global computer and communication networks; mobile entertainment device, namely, portable digital audio, video and multimedia players, transmitters and receivers for use with text, audio, video, images, still and motion pictures, graphics, computer games, video games, signals, messages, multimedia files, and other digital data, and for accessing global computer and communication networks; computer software for management, storage and network management of digital media, and enhancement of graphical and video display; electronic game streaming devices; high performance computer hardware with specialized features for enhanced game playing ability; electronic, computer, interactive and video game software; mobile digital computing devices, namely, portable digital audio, video and multimedia players, transmitters and receivers for use with text, audio, video, images, still and motion pictures, graphics, computer games, video games, signals, messages, multimedia files, and other digital data, and for accessing global computer and communication networks; hand held electronic devices, namely, portable digital audio, video and multimedia players, transmitters and receivers for use with text, audio, video, images, still and motion pictures, graphics, computer games, video games, signals, messages, multimedia files, and other digital data, and for accessing global computer and communication networks; electronic publications recorded on computer media, in the nature of books, manuals, magazines e-zines and newsletters featuring information regarding electronic game devices and electronic games; software used for gaming and the storage of electronic data; computer game software; electronic game software; video game software; audio and video receivers; digital audio and video players; electronic display screens; flat panel display screens; LCD display screens; computer, video and touch screen monitors; computer screens; projection screens; video screens; integrated circuits; graphics processing units (GPUs); computer servers; digital media servers; network

servers; digital media streaming devices; computer software for enhancing computer performance, for operation of integrated circuits, semiconductors, computer chipsets and micro-processors, and for gaming purposes; computer graphics software; downloadable computer graphics; downloadable computer graphics software development tools for advanced graphics processing, for managing and implementing virtual desktop infrastructures, for virtual desktops and applications, and for virtualization technology software; computer hardware and computer software for professional designers, engineers, and scientists for advanced graphics processing and visual computing; computer hardware and computer software for professional designers, engineers, and scientists for advanced graphics processing and visual computing sold as an integral component of computers; integrated circuit components for graphics and video systems, namely, multimedia accelerators, graphic accelerators and peripheral units; and computer software for operating and managing the said integrated circuit components; computer software.

Class 28

Hand-held units for playing electronic, computer, interactive, and video games; electronic game machines other than those adapted for use with an external display screen or monitor for receipt, storage and transmission of text, graphics and multimedia content; gaming devices; mobile gaming devices; toys, games and playthings; electronic gaming machines for use with an external display screen or monitor; handheld entertainment devices; mobile entertainment devices; mobile digital computing devices for playing digital games; hand held electronic devices for playing digital games; hand held electronic devices, namely, for use with computer games and video games; amusement machines, automatic and coin-operated; arcade video game machines; controllers for game consoles; apparatus for games; portable games with liquid crystal displays; video game machines; virtual reality headsets adapted for use in playing augmented reality video game; bags specially adapted for handheld video games and video game consoles; computer game joysticks; computer gaming consoles for recreational game playing; electronic game equipment with a watch function; electronic games other than those adapted for use with television receivers only; face plates for video game consoles for use with external monitors; fitted covers specially adapted to protect video game consoles for use with an external display screen or monitor; fitted plastic films known as skins for

covering and protecting electronic game playing apparatus, namely, video game consoles and hand-held video game units; floor-standing units for playing electronic games other than in conjunction with a television or computer; game controllers for computer games; game controllers in the nature of keyboards for computer games; games adapted for use with television receivers; gaming headsets adapted for use in playing video games; hand held joy stick units for playing video games; handheld game consoles; hand-held electronic games adapted for use with television receivers only; hand-held games with liquid crystal displays; hand-held units for playing electronic games for use with external display screen or monitor; home video game machines; LCD game machines; player-operated electronic controllers for electronic video game machines; portable games with liquid crystal displays; protective carrying cases specially adapted for handheld video games; protective carrying cases specially adapted for video game consoles for use with an external display screen or monitor; protective covers specially adapted for electronic game playing apparatus, namely, video game consoles and hand-held video game units; stand alone video game machine; stands for electronic game playing apparatus, namely, video game consoles and hand-held video game units; tabletop units for playing electronic games other than in conjunction with a television or computer; video game consoles; video game consoles for use with an external display screen or monitor; video game interactive hand held remote controls for playing electronic games; video game interactive remote control units; video game joysticks; video game machines; video game machines for use with external display screen or monitor; video game machines for use with televisions; video gaming consoles for playing computer games; video output game machines for use with external display screen or monitor; video output game machines for use with televisions; virtual reality headsets and helmets adapted for use in playing video games.

Class 42

Technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; troubleshooting in the nature of diagnosing problems with consumer electronics; platform as a service (PAAS) featuring computer software platforms for downloading, storing, viewing, playing and interacting with digital content, computer and video games and computer software applications; consulting services in the field of gaming technology and graphics

software; computer programming services for customers that enable the customers' digital and handheld devices to download and utilize games and entertainment related content; software as a service, namely, providing a customer service software platform to enable interaction between customers and service representatives to resolve product issues; providing temporary use of non-downloadable computer software for enhancing computer performance, for operation of integrated circuits, semiconductors, computer chipsets and micro-processors, and for gaming purposes; providing temporary use of non-downloadable computer software for computer graphics; providing temporary use of non-downloadable electronic game software; platform as a service (PaaS) featuring computer software platforms for electronic gaming and graphic design; providing virtual computer systems and virtual computer environments through cloud computing; providing cloud computing services featuring software for use in application development for entertainment, social, financial, business collaborative, gaming, and integration of private and public cloud computing environments; providing of cloud computing featuring software used to host, manage, develop and maintain applications, software and websites for managing and implementing virtual desktop infrastructures, for virtual desktops and applications, for virtualization technology software, and remote management and delivery services of real-time data to computers, handheld computers, and mobile electronic devices; computer services, namely cloud hosting provider services; providing virtual computer systems, graphics processing units (GPUs), and virtual computer environments through cloud computing; design of computer hardware, software and peripherals for others.