

O/697/22

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION 1576093
IN THE NAME OF IMIN TECHNOLOGY PTE. LTD.**

The word "imin" is rendered in a bold, lowercase, sans-serif typeface. The letters are thick and black, with a clean, modern aesthetic. The 'i' and 'n' have rounded terminals, while the 'm' is composed of two vertical stems and a central hump. The overall appearance is that of a strong, minimalist brand mark.

AS A TRADE MARK IN CLASS 9

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425706
BY INIM ELECTRONICS S.R.L.**

BACKGROUND AND PLEADINGS

1. IMIN TECHNOLOGY PTE. LTD. (“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 December 2020 and, 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 to the Madrid Agreement. The holder seeks protection for the following goods:

Class 9: *Apparatus for recording; mobile phone sets; mobile phones having large keys and numbers that assist users having impaired vision or dexterity; tablet computers; downloadable applications for use with mobile devices; radio frequency adapters; electronic data processing machines; optical data storage labels (bar codes); computers; computer software; calculating machines; cash registers; magnetic data carriers; data processing equipment; computer hardware; disk drives for computers; encoded magnetic cards; encoded identification bracelets, magnetic; encoded key cards; magnetic data media; magnetic encoders; magnetic tape units for computers; magnets; measures; measuring devices, electric; mobile telephones; modems; optical apparatus and instruments; optical character readers; optical data media; optical discs; projection apparatus; USB flash drives; video recorders.*

2. The request was published for opposition purposes on 23 April 2021 and, on 22 July 2021, it was opposed by INIM ELECTRONICS S.R.L. (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition was directed at all of the goods in the IR’s specification. The opponent relies on the following trade marks:

INIM

EUTM: 6085997¹

Filing date 10 July 2007; date of entry in register 26 May 2008

Relying on some of the goods, namely:

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent enjoy protection in the UK as comparable trade marks, the EUTMs remains the relevant right in these proceedings. That is because the request for designation in the UK was made 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.

Class 9: *Electrical and electronic, active and passive security systems, namely against intrusion systems, fire detection systems, fire suppression systems, access and presences control systems, surveillance and video surveillance systems, systems for transmission of information, data, voice, video, systems for the management of data and information.*

("the first earlier mark")



EUTM: 017928916

Filing date 11 July 2018; date of entry in register 27 December 2018.

Relying on all of the goods and services, being those set out in full in the **Annex** to this decision.

("the second earlier mark")

3. The opponent submits that there is a likelihood of confusion because the marks are similar and the respective goods and services are either identical or similar. The holder filed a defence and counterstatement denying the claims made and put the opponent to proof of use for the first earlier mark.

4. The opponent is represented by Reddie & Grose LLP; the holder is represented by Bayer & Norton Business consultant. No hearing was requested. The opponent filed evidence in chief and they were accompanied by written submissions. Neither party filed written submissions in lieu of a hearing. This decision is taken following a careful reading of all the papers.

5. 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.

Evidence

6. The opponent's evidence in chief was in the form of a witness statement of Elisabetta Saini dated 17 February 2022. Ms Saini is the CEO and Vice President of the opponent, positions she has held since October 2015. Ms Saini's statement is accompanied by 8 exhibits.

7. I do not propose to summarise the evidence or the submissions in full at this stage. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

Proof of use

8. 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. Given their filing dates, the opponent's earlier marks qualify as earlier trade marks under the above provisions. The first earlier mark completed its registration process more than five years before the designation date of the IR. As I have set out above, the holder put the opponent to proof of use for the first earlier mark meaning that it is subject to proof of use pursuant to section 6A of the Act. The second earlier mark had not completed its registration process more than five years before the designation date of the IR. The use conditions do not, therefore, apply to this mark

and the opponent can rely on all goods and services for which its second earlier mark is registered.

10. The relevant statutory provisions are as follows:

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

6A-(1) This section applies where –

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

(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 mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes–

(a) use of a trade mark includes use in a form (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) - (5A) [Repealed]

(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.”

11. Section 100 of the Act is also relevant, which reads:

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

12. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bundersvereinigung 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 Merken 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].”

13. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the date that the IR was designated for protection in the UK i.e. 31 December 2015 to 30 December 2020.

14. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.²

Form of the Mark

15. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

² *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

16. The opponent's first earlier mark is a word only mark consisting of the word 'inim'. Where the opponent has used its mark as registered, that will clearly be use on which the opponent can rely. In addition, the opponent has used its mark in the following ways:



(Example 1)



(Example 2)



Evolving Security

(Example 3)

17. I note that whilst standard typeface has been used, the conjoining of the letters used is somewhat unusual. Despite this, I am of the view that the use of the word 'inim' in the above examples is in line with notional fair use of the mark as registered. As per

the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. All of the above examples are use of the word “inim” and whilst they are stylised, they are in line with notional and fair use of the first earlier mark. I consider that the ‘inim’ element will be perceived independently and continue to be viewed as indicative of the origin of the goods at issue. As a result, and in accordance with *Colloseum*, I consider the marks shown are examples of use of the opponent’s mark as registered.

Genuine use

18. The opponent’s evidence consists of the witness statement of Elisabetta Saini dated 17 February 2022 and 8 exhibits.

19. The opponent has provided details of the registered mark, invoices, a catalogue, magazine articles, turnover figures, certificates and images of the opponent’s products. I note the following in regard to the evidence:

- a. Annual turnover figures in the UK for the opponent’s registered goods amounting to €43,441.12 (2016), €37,318.24 (2017), €32,679.33 (2018), €54,919.03 (2019) and €26,215.15 (2020).³
- b. Invoices dated between 10 November 2015 and 3 January 2019 for rental of space at the 2016, 2017, 2018 and 2019 International Fire & Safety Exhibition Conference (“IFSEC”) trade fair, certification to build a stand and delivery documents for materials to build a stand. All of these documents are dated within the relevant period. ⁴
- c. Samples of invoices dated between 27 April 2016 and 23 April 2020 relating to the sale of goods under the INIM mark in the UK within the relevant period. ⁵
- d. Extracts of the index pages from the opponent’s catalogue. The opponent states that these catalogues or similar catalogues were

³ The witness statement of Elisabetta Saini, paragraph 15

⁴ Exhibit 2 of the witness statement of Elisabetta Saini

⁵ Exhibit 6 of the witness statement of Elisabetta Saini

distributed at IFSEC fairs from 2016 onwards. The extracts display the opponent's mark. The catalogue is undated.⁶

- e. A copy of issue 8, volume 11 of Construction Industry News, which the opponent states is dated August 2013 and therefore, outside of the relevant period. The article mentions 'Inim electronics' and the opponent's mark is present.⁷

20. As set out above, the opponent has provided evidence regarding its turnover. Of this, I note that between 2016 and 2020 the following value of products were sold in the UK for a total of €434,572.87 over the same period. The opponent has not provided a breakdown as to what products are included in the turnover figures. All of the invoices provided are dated during the relevant period. Some of the opponent's invoices have been provided in English; however, some are provided in Italian and no translations have been provided. I am of the view that some of the content of the untranslated invoices is self-evident and does not necessarily require translation. For example, the information regarding sales figures, the address and some of the products are identifiable. However, it is not clear from the invoices themselves what all of the goods sold via these invoices are and whether they bear the opponent's mark or not. Having reviewed the evidence and cross referencing the invoices to the catalogue, I can identify that some of the goods covered by the remaining invoices show the sale of conventional detection control panels and detectors and accessories.

21. Although I do not have evidence or submissions from the parties to assist me on the matter of the size of the UK market for the goods concerned, I believe the market to be substantial, numbering in millions of pounds per annum. In my view, when compared against the size of the relevant market, these figures are low.

22. The opponent submits that its catalogues show the range of goods that are sold by the opponent. The catalogues provide an indication of the range of products the opponent sells and when cross referenced with the invoices it provides an indication of some of the goods that have been sold. For those goods that cannot be specifically identified following cross referencing it is clear, bearing in mind Ms Saini's witness

⁶ Exhibit 3 of the witness statement of Elisabetta Saini

⁷ Exhibit 4 of the witness statement of Elisabetta Saini

statement, that the goods sold relate to a wide range of intrusion detection, home automation, fire detection and emergency lighting products/systems and related services. I note that the opponent has stated in her witness statement that the catalogues were distributed at fairs from 2016 onwards. However, the opponent has provided no indication as to the number of attendees at the fairs or further information about the audience who attended the events, such as whether they are members of the general public or tradespeople. As a result, I do not consider that the catalogues are evidence of marketing or advertising but they do assist in providing an indication of the goods sold.

23. I note that the invoices provided by the opponent demonstrate the purchase of space for a stand at the IFSEC fair, which it is submitted is a fair about safety. The invoices are dated from 10 November 2015 to 16 June 2018. I note that the former falls outside the relevant period. The invoices are for purchases from two customers in the UK, one based in Kent and the other in London. The invoices were for the purchase of space for a stand at the 2016, 2017, 2018 and 2019 IFSEC fair and of the materials used to build the stand. I note that no further information has been provided by the opponent such as how many people were in attendance, for example. As a result, I do not consider that this evidence is of much assistance to the proprietor in respect of advertising or marketing. However, it does demonstrate an effort by the opponent to create a market share and the expenditure of £ 66,032.10 (by my own calculation) during the relevant period is indicative of advertising expenditure. Finally, in relation to advertising and marketing, I note that the opponent has provided evidence of a copy of the Construction Industry News, which the opponent states is dated August 2013 and therefore, outside of the relevant period.

24. Whilst I recognise that there are clear deficiencies with the opponent's evidence; there is limited evidence in relation to the distribution of marketing and advertising evidence. However, as noted above genuine use requires a global assessment of the evidence as a whole. The evidence has demonstrated an annual turnover of €434,572.87 from 2016 to 2020. In my view, the figures are not quantitatively significant, however, they demonstrate more than token use, therefore, the figures constitute a genuine attempt to create a market share for the goods under the opponent's mark. The sales are not simply attributable to a one-off sale but, instead,

the proprietors have demonstrated a consistent and repeated pattern of sales throughout the relevant period. Taking the above into consideration, I am of the view that the opponent has attempted to create and maintain a market for their goods under their mark. Therefore, I am satisfied that the opponent has demonstrated genuine use of the mark during its relevant period in the UK.

Fair specification

25. I must now consider whether, or the extent to which, the evidence shows use of the opponent's registration in relation to the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

26. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows: “iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

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

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

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

27. I have set out above that the turnover figures are not specifically broken down into the opponent's goods. Therefore, I am required to consider the evidence as a whole and compare what is shown within it to the opponent's specification. It would be unfair for me to simply accept the turnover figures provided are for any or all of the goods for which the opponent's mark is registered. Any use that I am able to identify will be determined by cross referencing the turnover figures with the evidence that has been provided. As mentioned above, the catalogue evidence provided gives an indication of the range of products the opponent sells and in cross referencing the catalogues to the invoices it is evident that there have been sales in relation to conventional detection control panels, detectors and accessories. Further, I note that Ms Saini in her witness statement states that the catalogues display the range of goods produced and sold by inim within the sectors of intrusion detection, home

automation, fire detection and emergency lighting products/systems and related goods which the company provides. I note that Ms Saini states in her witness statement that the opponent also provides services. Therefore, in my view, it is likely that some of the sales figures provided are associated with those services. The figures associated with services will fall outside of the scope of the first earlier mark. However, in my view, that is not a big matter of concern given the broad range of goods that are sold by the opponent. The witness statement of Ms Saini is accompanied by a statement of truth, this statement of truth alongside a lack of challenge in relation to this statement from the applicant leads me to conclude that the turnover figures provided are attributable to some of the goods in the opponent's specification. I consider the use shown to be broad enough to allow the opponent to rely on its current specification. Therefore, I consider a fair specification of the mark to be as follows:

Class 9: *Electrical and electronic, active and passive security systems, namely against intrusion systems, fire detection systems, fire suppression systems, access and presences control systems, surveillance and video surveillance systems, systems for transmission of information, data, voice, video, systems for the management of data and information.*

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

28. 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.”

29. 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 impression created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of the goods and services

30. Further to what I have said about the fair specification above, the opponent's specification for the first earlier mark is the following:

Class 9: *Electrical and electronic, active and passive security systems, namely against intrusion systems, fire detection systems, access and presences control systems, surveillance and video surveillance systems, systems for transmission of information, data, voice, video, systems for the management of data and information.*

31. The specification for the second earlier mark can be found in the **Annex** to this decision. The holder's goods can be found in paragraph 1. I note that there is some overlap between the opponent's marks' specifications. Where appropriate, I will deal with the opponent's identical terms and the terms that are the same but worded slightly differently together.

32. 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 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”.

33. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

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

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

35. 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 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”.

36. I note that the holder submits in its counterstatement that the parties work within different industries with the opponent working in the field of advanced connectivity, specialising in active security systems for the industrial world, and the holder working in the field of intelligent business, specialising in goods and services related to intelligent commercial solutions. Further, I note that the holder submits that the intended users are entirely different and that this will eliminate any concerns of confusion amongst the average consumers. Whilst noted this does not assist the holder. This is because I must consider notional and fair use of the parties’ mark across all segments of the markets for the goods and services for which it is registered. This means that a particular segment of the market in which the parties have so far chosen to trade does not deprive other parties’ mark of the normal level of protection afforded to every registered trade mark. Consequently, I must include consideration of the likelihood of confusion if both parties decide to target the same segment of the market. Therefore, the fact that the parties currently target different market segments is irrelevant where the goods and services at issue are fundamentally the same.

37. “Computers” appear in the holder’s specification and the opponent’s second earlier mark’s specification and are self-evidently identical.

38. “*Tablet computers*” in the holder’s specification falls within the broader category of “*computers*” in the opponent’s second earlier mark’s specification. Therefore, I find the goods to be identical on the principle outlined in *Meric*.

39. In my view, “*computer hardware*”, “*disc drives for computers*”, “*magnetic tape units for computers*”, and “*optical apparatus and instruments*” in the holder’s specification are similar to “*computers and structural parts therefor*” in the opponent’s second earlier mark’s specification. I am reminded that just because one good is a part or component of another this is not sufficient to warrant a finding of similarity on its own.⁸ In my view, the goods overlap in trade channels to the extent that some specialist retailers may sell the holder’s goods alongside computers. There is also a general overlap in users to the extent that those purchasing computers may also purchase the holder’s goods for use in computers. The goods differ in purpose, nature and method of use as the holder’s goods are component parts of computers and are not the finished article. The goods are not in competition; however, I find the goods to be complementary. This is on the basis that the holder’s goods are dependent on computers to function. Therefore the goods are important/indispensable to one another leading the average consumer to believe that they are provided by the same undertaking⁹. Bearing the above in mind, I find the goods to be similar to a medium degree.

40. “*Modems*” in the holder’s specification is similar to “*computers and structural parts therefor*” in the opponent’s second earlier mark’s specification. In the absence of any submissions or evidence to the contrary, it is my view that the term modems is inclusive of the internal and external modems. Similarly to the comparison above in paragraph 39, the goods overlap in trade channels and users. However, the goods differ in nature, purpose and method of use. The goods are not in competition, however, they are complementary. This is on the basis that internal modems require computers to function. Therefore the goods are important/indispensable to one another leading the average consumer to believe that they are provided by the same undertaking. Bearing the above in mind, I find the goods to be similar to a medium degree.

⁸ *Les Editions Albert Rene v OHIM*, Case T-336/03

⁹ *Boston Scientific Ltd v OHIM*, (Case T-325/06)

41. *“Apparatus for recording”* and *“video recorders”* in the holder’s specification are similar to *“surveillance and video surveillance systems”* in the opponent’s specifications. The holder’s goods can be used as an instrument in security systems. I am reminded that the mere fact that the goods may be composed of several components, which may belong to the holder’s specification does not establish an automatic similarity between the finished products and their parts. In my view, the goods are likely to be produced by the same or related undertaking and share the same end user and distribution/trade channels. However, in my view, the goods differ in nature, and method of use. Further, in my view, the goods differ in purpose as the purpose of the opponent’s goods is to record images with the overall intention of monitoring safety whereas the purpose of the holder’s goods is to record images. In my view, it is beyond the ordinary meaning of the holder’s goods for the goods to be used for security purposes. The goods are not in competition. However, in the context of a video surveillance system, the video recorder/recording apparatus will be important/indispensable to one another leading the average consumer to believe that they are provided by the same undertaking. In consideration of the above, I find the goods to be similar to a medium degree.

42. *“Encoded magnetic cards”, “encoded identification bracelets, magnetic”, “magnetic encoders”* and *“encoded key cards”* in the holder’s specification are similar to *“access control and presence detection systems”* in the opponent’s specifications. In the absence of any submissions or evidence to the contrary, it is my view that the opponent’s good is a series of devices that are used to control access amongst visitors and employees within a facility. I note the fact that the goods are used as part of other goods does not establish an automatic similarity between the goods. In my view, these systems can be controlled via staff and keys or be electronic. In modern systems to gain access to a restricted location, an individual can validate their authorisation via key cards, fobs or badges etc. Bearing this in mind, it is my view that the goods will be produced by the same or related undertaking, coincide in users and share the same distribution/ trade channels. The goods will differ in nature, method of use and purpose as the opponent’s goods are systems put in place to restrict access whereas the holder’s goods are encoded to allow access to the restricted locations. It is not my

view that the goods are in competition nor are they complementary. Therefore, I find the goods to be similar to a low degree.

43. “*Computer software*” in the holder’s specification is similar to “*computers*” in the opponent’s second earlier mark’s specification. Computer software is often integral to computers and therefore, often shares the same trade channels with the opponent’s goods. Whilst the goods differ in nature, purpose and method of use, they share end users and trade channels. The goods are not in competition and they are not complementary. Therefore, I find the goods to be similar to a low degree.

44. In the absence of any evidence or submissions to the contrary, it is my view that “*electronic data processing machines*” in the holder’s specification are machines that are used for automatic data processes. It is also my view that “*data processing equipment*” in the holder’s specification are electronic goods that collect and manipulate data to create meaningful information. In my view, data processing equipment can cover a type of computer hardware such as an external peripheral device to a computer. In my view, the holder’s goods are similar to “*computers*” in the opponent’s second earlier mark’s specification. These goods may overlap in purpose, as they are all used to receive data and process it into a particular format. They may also overlap in users to the extent that those purchasing computers may also purchase the holder’s goods. However, the goods differ in the method of use and nature. The goods are not in competition, nor are they complementary. Taking all this into account, I find the goods to be similar to a medium degree.

45. I compared “*magnetic data carriers*”, “*magnetic data media*” and “*optical data media*” in the holder’s specification to the closest clash that I could identify in the opponent’s mark, being “*surveillance and video surveillance systems*”. The goods share a superficial overlap in users. However, the goods differ in nature, method of use and purpose. The goods also differ in trade channels as although providers that make surveillance and video surveillance may use the holder’s goods as components for their goods they will not make their own components nor will the goods be purchased together. The goods are not in competition nor are they complementary. Therefore, I find the goods to be dissimilar.

46. I compared *“Measuring devices, electric”* and *“measures”* in the holder’s specification to the closest clash that I could identify in the opponent’s specifications *“fire detection systems”*. I note that the opponent did not particularise its position in respect of the goods and services or make submissions as to why they consider the goods and services to be similar. If parties fail to do this, they run the risk that the tribunal will find no similarity unless it is obvious. I was unable to find any obvious similarity between the goods and services. Therefore, I find the goods and services to be dissimilar.

47. *“Downloadable applications for use with mobile devices”* in the holder’s specification and *“surveillance and video surveillance systems”* in the opponent’s specifications are similar. Downloadable applications for use with mobile devices is a very broad term, that can be inclusive of applications used for surveillance. In recent times video doorbells have increased in popularity; they are often used with downloadable applications on mobile devices so that the user can surveil their property via a live video feed to their mobile device. These systems differ from a more traditional video surveillance system as, in video doorbell systems, the camera is integrated into a doorbell and placed on the user’s front door whereas the more traditional video surveillance systems are on a larger scale and provide increased coverage of an entire property, be that commercial or residential, as security cameras may be placed anywhere the user wishes to monitor. Without any submissions or evidence to the contrary, it is not my understanding that more traditional video surveillance systems are viewed on mobile devices, rather it is my view that they are monitored in a control room. Taking this into account and in the absence of any evidence or submissions to the contrary, it is my view that there is a superficial overlap in users between the goods. Further, the goods may coincide in purpose, as they may both be used to surveil a property. Despite this, it is likely to be a surficial or limited overlap. I find that the goods differ in nature, trade channels and method of use. It is not my view that the goods are complementary or in competition. Therefore, I find the goods to be similar to a very low degree.

48. *“Projector apparatus”* in the holder’s specification and *“[...] video transmission systems”* in the opponent’s specifications are similar. The holder’s goods are used as part of the opponent’s goods to transmit images. The goods share some overlap in

nature and purpose, as the parties' goods are both a means to transmit an image. However, the goods differ in the method of use, as the holder's goods are solely the image transmission whereas the opponent's goods are part of a larger network to transmit videos. I note that the mere fact that the opponent's goods can be composed of a component, which may belong to the holder's specification, does not establish an automatic similarity between the finished product and its parts. The goods are not in competition. In my view, the goods are not complementary, as although projector apparatus may be used as part of a video transmission system, the goods are not important and/or indispensable to one another on the basis that a video transmissions system may use devices such as DVD players or rely on other broadcast signals. Based on the factors above, I find the goods to be similar to a medium degree.

49. I compared "*optical data storage labels (bar codes)*" in the holder's specification with the closest clash that I could identify in the opponent's specifications, being "*data transmission systems*" and I was unable to find any similarity between the goods. I note that no submissions or evidence that have been provided to assist me in determining whether or not they are similar. In the absence of such and given that the terms are very technical and there is no indication of the context of how they will be used, it is my view, that the goods differ in nature, purpose and method of use. There may be a very superficial overlap in trade channels as the companies that create data transmission systems may also create barcodes to be used with the system; however, as mentioned above, there is no evidence to suggest that this is the case or whether this practice is common within the industry. The goods are not in competition nor are they complementary. In my view, the superficial overlap in trade channels is insufficient to substantiate similarity. Therefore, I find the goods to be dissimilar.

50. In the absence of any submissions or evidence to the contrary, it is my view that "*optical character readers*" in the holder's specification can either be software or hardware that enables computers to read pictures of text. Further, it is my view that "*USB flash drives*" in the holder's specification is a device for data storage. In my view, the average consumer is most likely to associate the terms optical character readers and USB flash drives as a reference to computer hardware. Applying this interpretation, it is my view that these goods will overlap with "*computers*" in the opponent's second earlier mark's specification. In my view, the goods overlap in trade

channels to the extent that some specialist retailers may sell the holder's goods alongside computers. There is also a general overlap in users to the extent that those purchasing computers may also purchase the holder's goods for use alongside computers. The goods differ in purpose, nature and method of use. The goods are not in competition, however, I find the goods to be complementary. This is on the basis that the holder's goods are dependent on computers to function. Therefore the goods are important/indispensable to one another leading the average consumer to believe that they are provided by the same undertaking.¹⁰ Bearing the above in mind, I find the goods to be similar to a medium degree.

51. In my view "*optical discs*" in the holder's specification are an electronic data storage medium. They are used in disc drives. I compared the holder's goods with the closest I could identify "*computers and structural parts therefor*" in the opponent's second earlier mark's specification. Whilst there may be a very general overlap in user, it is my view that the goods do not share trade channels, method of use, purpose or nature. Further, there is no competition between the goods. In relation to complementarity, previously optical discs were important/indispensable to computers to install software etc and the goods would have been provided by the same undertaking. However, following technological advances in relation to computers the complementary relationship between these goods no longer exists; downloads now provide the software needed by computers for them to function. Bearing all the above in mind, it is my view that a very general overlap in users is insufficient to substantiate similarity. I find the goods to be dissimilar.

52. I am unable to find any obvious similarity between "*mobile phone sets*", "*mobile phones having large keys and numbers that assist users having impaired vision or dexterity*", "*mobile telephones*", "*calculating machines*", "*magnets*", "*radio frequency adapters*" and "*cash registers*" in the holder's specification and any of the opponent's goods or services. Therefore, I find these goods to be dissimilar.

53. As some degree of similarity between the goods is necessary to engage the test for the likelihood of confusion, my findings above mean that the opposition aimed

¹⁰ *Boston Scientific Ltd v OHIM*, (Case T-325/06)

against those goods I have found to be dissimilar will fail.¹¹ For ease of reference, the opposition fails against the following goods in the holder's specification:

Class 9: *Mobile phone sets; mobile phones having large keys and numbers that assist users having impaired vision or dexterity; mobile telephones; calculating machines; magnets; radio frequency adapters; cash registers; optical data storage labels (bar codes); measuring devices, electric; measures; optical discs; magnetic data carriers; magnetic data media; optical data media.*

The average consumer and the purchasing process

54. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

55. The average consumer for the goods at issue will be members of the general public and business users. The goods at issue are likely to be purchased visually from the retail shops (or their online equivalents), catalogues, websites or the premises of a specialist. I do not discount aural considerations in the form of, for example, advice received from a sales assistant or word-of-mouth recommendations.



56. The cost of the goods will vary from low to expensive, goods such as encoded magnetic keys will be of low value whereas surveillance and video surveillance

¹¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

systems will be expensive for business users. Generally speaking, the average consumer will pay a medium degree of attention during the purchasing process for the goods at issue. However, for some goods in the parties' specifications, the level of attention will vary from low (for goods such as encoded magnetic keys) to high (for goods that pertain to security for a user's business or home).

Comparison of the marks

57. The respective trade marks are shown below:

	<p data-bbox="810 696 911 741">INIM</p> <p data-bbox="810 775 1139 813">("the first earlier mark")</p>  <p data-bbox="810 1093 1190 1131">("the second earlier mark")</p>
The IR	The opponent's marks

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

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

60. The first earlier mark is a word mark that consists of the text 'inim'. There are no other elements that contribute to the overall impression of the mark. The second earlier mark is a composite mark, containing a word and figurative element. The text 'inim' is presented in a standard but conjoined typeface and appears in dark blue. Above the mark, three dots appearing in various shades of blue form an arch between the tittles in the mark. I consider that the text 'inim' plays a greater role in the overall impression of the mark, with the figurative element playing a much lesser role. I also find that the use of colour in the mark will play a role, albeit a minimal one.

61. As for the IR, it is a slightly stylised word mark that consists of the text 'imin'. Despite the typeface on the IR being stylised, it is still a standard typeface. I consider the text 'imin' to have a dominant impact on the overall impression of the mark, with the stylisation playing a negligible role.

62. Visually, the text in all of the marks are identical in length. All of the marks share the same four letters 'I-N-I-M' but differ in the order that they are presented, being 'inim', in relation to the opponent's earlier marks, and 'imin, in relation to the holder's mark. Further, I note that the second earlier mark also differs from the holder's mark due to the presence of the figurative element that connects the tittles in the mark. Whilst I note that the differences between the marks will be heightened by the brevity of the marks,¹² the letters 'N' and 'M', which are switched within the marks, have a similar visual formation characterised by the angular up and down structure of those letters. I note that the first earlier mark is a word-only mark; fair and notional use of the mark enables the first earlier mark to be used in the same/similar typeface of the IR.¹³ Further, the mark is able to be used in upper/ lower case or a combination of the two and still be in line with notional and fair use of the mark. Bearing this in mind, I find the

¹² *Case T-562/14 Yoo Holdings v OHMI* EU: T:2015: 363.

¹³ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

first earlier mark to have a higher than medium degree of visual similarity to the IR. I find that the second earlier mark is similar to a medium degree.

63. The opponent's marks will be pronounced identically and I will, therefore, assess them together. The applicant submits in its counterstatement that the opponent's marks will be pronounced as 'I-N-I-M' and the IR will be pronounced as 'I-MIN'. I disagree with the applicant, in my view, aurally, the opponent's marks will be pronounced as IN-IM and the IR will be pronounced as IM-IN. Both parties' marks have two syllables. As mentioned above in the visual comparison, I note that the differences between the marks will be heightened by the brevity of the marks, however, I note that 'N' and 'M' share a similar phonetic pronunciation and it can be difficult to distinguish the pronunciation from an 'N' and an 'M'. Taking this into account, I find the opponent's marks to be aurally similar to a high degree to the IR.

64. In relation to the second earlier mark, I do not consider that the figurative element in the mark will convey any conceptual message to the average consumer. Instead, it will be seen as a decorative element only. As a result, the opponent's marks carry the same concept. This leaves the conceptual comparison as being between the word elements of both parties' marks.

65. I note that the holder submits that the average consumer will see 'imin' as a combination of 'I' and 'min' – which I am of the view they are suggesting is a reference to the abbreviation of the word minute. Further, I note that the holder submits that the opponent's marks will not be seen by the average consumer as an English word. In my view, both the words 'imin' and 'inim' will be viewed by the average consumer as words that will be perceived as made up or invented words that will not convey any obvious conceptual meaning. As a result, the conceptual position is neutral.

The distinctive character of the opponent's marks

66. 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 1-2779, 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).”

67. 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 or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

68. The opponent has pleaded that its marks have acquired enhanced distinctive character through use as it has operated since 2018 worldwide and is recognised by the public as a badge of origin. I have considered the evidence in support of a claim of enhanced distinctiveness and do not consider the evidence is sufficient to demonstrate such a claim in regard to the opponent’s marks in the UK. Enhanced distinctiveness must be established in relation to the UK market because the test for confusion will be assessed by reference to the average consumer who is a member of the UK general public. Whilst I note the annual turnover figures for the UK market, no evidence of the market share of the opponent’s marks have been provided. I also note that use of the marks demonstrated is not intensive. Further, I note that no evidence has been provided indicating the proportion of the relevant class of people who identify the goods as originating from the opponent’s undertaking. I also note that evidence of the opponent attending conferences/events for advertising/marketing and

evidence of expenditure associated with this has been provided by the opponent. However, limited information on the scope of advertising and marketing has been provided. Despite this, the opponent's evidence does not point to its marks having acquired enhanced distinctiveness in the UK through use. I have, therefore, only the inherent position to consider.

69. The opponent submits that the marks are inherently distinctive but does not comment on the degree of distinctiveness it assigns to the mark. The opponent's first earlier mark consists of the text 'INIM' presented in the upper case. The opponent's second earlier mark consists of the text 'inim' presented in lower case with the figurative element of three dots that form an arch between the tittles in the mark. 'inim' will be seen as an invented term with no allusive or descriptive qualities. In my view, 'inim' is the dominant and distinctive element of the marks. While the figurative element in the second earlier mark will contribute to the distinctiveness of the mark to a small degree, I do not consider that it will increase its distinctiveness beyond the level created by the text itself. Bearing the above in mind, I find the opponent's marks to have a high degree of inherent distinctive character.

Likelihood of confusion

70. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods at issue and the nature of the purchasing process. In doing so, I must be mindful 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.

71. I have found the marks to vary in visual similarity from a medium to a higher than medium degree. I have found the marks to be aurally similar to a high degree and conceptually neutral. I have found the opponent's mark to be inherently distinctive to a high degree. I have found the average consumer to be a member of the general public or business user, who will purchase the goods at issue via a visual means (although I do not discount an aural component). I have concluded that the average consumer's degree of attention will vary from low to high when selecting the goods at issue. I have found the goods to vary in similarity from similar to a very low degree to identical. I note that there are some goods that are not subject to a likelihood of confusion under the first earlier mark. The remaining goods are addressed by the second earlier mark.

72. Taking the above factors into account, I consider that the differences between the IR and the first earlier mark are insufficient to avoid confusion, particularly when the principle of imperfect recollection is considered. I consider it likely that the marks will be misremembered or mistakenly recalled as each other. This is particularly the case given that the parties' marks are identical in length, they share the first and third letters and the letters 'N' and 'M' which are presented in a different order share a similar visual formation and have a highly similar pronunciation. Further, I note that, particularly in relation to the opponent's first earlier mark, it is a word only mark and as mentioned in paragraph 62 it can be used in line with fair and notional use. Therefore, the first earlier mark can be used in the same/similar font to the IR, as the font used by the IR is not particularly stylised. Bearing all of the above in mind, it is my view, that the average consumer will misremember/mistakenly recall the marks even where a high degree of attention is applied. Consequently, I consider there to be a likelihood of direct confusion. However, for those goods that I have found to be similar to a very low degree, I do not consider that the similarities between the marks will offset the very low similarity of the goods. Therefore, my finding of direct confusion does not extend to those goods. I note that this finding only applies to those goods that I have found to be similar to the first earlier mark.

73. I will now consider the second earlier mark separately as some goods that will not be found to have a likelihood of confusion in respect of the first earlier mark

because they are dissimilar. Despite this, these goods are addressed under the specification for the second earlier mark. In relation to the second earlier mark, it is my view that the average consumer will overlook the figurative element over the titles in the mark and the differences between the text. Consequently, the conclusion that I have reached above in paragraph 72, in relation to the likelihood of direct confusion, will also apply in relation to the second earlier mark.

Conclusion

74. The opposition has succeeded for the following goods which will be refused:

Class 9: *Apparatus for recording; tablet computers; electronic data processing machines; computers; computer software; data processing equipment; computer hardware; disk drives for computers; encoded magnetic cards; encoded identification bracelets, magnetic; encoded key cards; magnetic encoders; magnetic tape units for computers; modems; optical apparatus and instruments; projection apparatus; USB flash drives; video recorders; optical character readers; downloadable applications for use with mobile devices.*

75. The opposition has failed in relation to the following goods which will proceed to registration:

Class 9: *Mobile phone sets; mobile phones having large keys and numbers that assist users having impaired vision or dexterity; mobile telephones; calculating machines; magnets; radio frequency adapters; cash registers; optical data storage labels (bar codes); measuring devices, electric; measures; magnetic data carriers; magnetic data media; optical data media; optical discs.*

Costs

73. In my view, both parties have enjoyed an approximately equal degree of success in these proceedings. As a result, I do not consider it appropriate to make an award of costs in the favour of either party.

Dated this 18th day of August 2022

A Klass

**For the registrar,
the Comptroller-General**

Annex

Class 9: *Active and passive electric and electronic security systems, including anti-intrusion systems; Fire detection systems; Fire suppression systems; Access control and presence detection systems; Electricity generation and management systems; Surveillance and video surveillance systems; Information, data, voice and video transmission systems; Data and information processing systems; Computers and structural parts therefor.*

Class 37: *Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including anti-intrusion systems; Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including fire detection systems; Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including fire suppression systems; Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including access control and presence detection systems; Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including electricity generation and management systems, construction, installation, repair and maintenance of active and passive electric and electronic security systems, including surveillance and video surveillance systems; Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including information, data, voice and video transmission systems; Construction, installation, repair and maintenance of active and passive electric and electronic security systems, including data and information processing systems, computers and structural parts therefor.*

Class 42: *Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including anti-intrusion systems; Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including fire detection systems; Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including fire suppression systems; Consultancy, design and development of products and programs for active and*

passive electric and electronic security systems, including access control and presence detection systems; Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including electricity generation and management systems; Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including surveillance and video surveillance systems; Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including information, data, voice and video transmission systems; Consultancy, design and development of products and programs for active and passive electric and electronic security systems, including data and information processing systems, computers and structural parts therefor.

Class 45: *Surveillance, data collection, monitoring and control centres relating to security systems; Surveillance, data collection, monitoring and control centres relating to anti-intrusion systems; Surveillance, data collection, monitoring and control centres relating to fire detection systems; Surveillance, data collection, monitoring and control centres relating to fire suppression systems; Surveillance, data collection, monitoring and control centres relating to access control and presence detection systems; Surveillance, data collection, monitoring and control centres relating to electricity generation and management systems; Surveillance, data collection, monitoring and control centres relating to surveillance and video surveillance systems.*