

O/736/22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 917900544

IN THE NAME OF
FISHBONE DESIGN
CO., LTD

IN RESPECT OF THE FOLLOWING TRADE
MARK:

REX Lite

IN CLASSES 9 & 11

AND

THE APPLICATION FOR INVALIDITY THEREOF
UNDER NO. 503748
BY SLV GmbH

Background and pleadings

1. On 14 May 2018, FISHBONE DESIGN CO., LTD (the “proprietor”) applied to register the trade mark shown on the front page of this decision for the following goods in classes 9 and 11:

Class 9: Starters for fluorescent lights; luminance meter; photoelectric detector; switch, namely, change-over switches, Automatic switchboards, Cut-out switches, Differential switches, photoelectric switch, Electric circuit switches, Electric current switches, Electric flasher switches, Electric light switches, High frequency switches, High-frequency switching power supplies, Electronic motor switches for switching off motors, Electronic proximity sensors and switches, Electronic touch sensitive switches, Light switches, Light sensors and switches for light systems, Power switches; automatic switching apparatus; Temperature switches; thin film switches; photoelectric sensor; lighting ballasts; rotating signal lights; outlet, namely, Covers for electric outlets, Electrical outlets, Modular telephone outlet, Multi-outlet socket blocks, Movable sockets; plug, namely, Electrical plugs and sockets, Electrical plug device enabling connection and disconnection of power and/or control cables, Plug adaptors, Plug connectors, Plug-in connectors, Round plug connectors, Safety contact plugs, Adapter plugs; light-emitting diode; electronic light emitting diode (LED) signs; sensor, namely, Electric sensors, Electronic data relays for sensors, Electronic proximity sensors and switches, Industrial calibration sensors, Light sensors and switches for light systems, Photoelectric sensors, Pressure sensors, Proximity sensors, Temperature sensors, Timing sensors; power supply; power adapter; wire connector, namely, Cable connectors, Connectors for electronic circuits, Electrical and electronic connectors, Electrical header connectors, Electrical power connectors, Plug connectors, Plug-in connectors, Insulated electrical connectors, Power connectors, Round plug connectors, Threaded cable connectors of metal; computer software; computer programs [downloadable software]; computer software applications, downloadable; computer software platforms, recorded or downloadable.

Class 11: Flashlights; fluorescent lamps; incandescent lamps; ceiling lamps; safety lamps for underwater and underground use; projector lamps; projection lamps; lights for vehicles; art lamps; brake lights for vehicles; table lamps; searchlights; halogen lamps; illumination apparatus, namely, flashlights for illumination purposes, lights for illuminating stairs, doors, and other portions of buildings, lights for use in illuminating signs and displays; illuminating lamps; decorative lamps; electric lamps; spot lamps; wall lamps; electric light decorative strings; light bulbs, namely, led light bulbs and electric light bulbs; sockets for electric lights; fluorescent lamp tubes; lamp shades; neon lamps; fog lamps; ceiling lights; embedded ceiling downlight, namely, recessed ceiling lights; spotlights; linear ceiling lights, namely, electric ceiling track lighting units; lighting tubes.

2. The application was registered at the European Union Intellectual Property Office (EUIPO) on 19 December 2018. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the contested mark being registered as a EUTM at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, and the original filing date remains.

3. On 7 April 2021, SLV GmbH (the “applicant”) applied to have the contested mark declared invalid pursuant Section 47 of the Trade Marks Act 1994. The applicant relies on its UK comparable mark AIXLIGHT under section 5(2)(b). The applicant’s mark was applied for on 8 February 2006 at the European Union Intellectual Property Office (EUIPO) and registered on 26 January 2007. Pursuant to the Withdrawal Agreement, the mark was automatically converted to comparable UK trade mark 904889507. The applicant relies upon all of the goods for which the earlier mark is registered which are as follows:

Class 11: Mains-operated lights; Lighting apparatus and installations; head lamps, electric lamps, including lighting rods, decorative lighting apparatus.

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.

5. The applicant submits that there is a likelihood of confusion because the proprietor's registration is similar to the applicant's and the respective goods are identical or similar.

6. The Tribunal served the Form TM26(I) on 14 April 2021 on the proprietor's representatives, CABINET CHAILLOT. In accordance with Rule 41(6) of the Trade Mark Rules 2008 ("the Rules"), the proprietor was informed that it had two months from the date of the letter in which to file its Form TM8 and counterstatement. The deadline for filing the Form TM8 and counterstatement was given in these letters, that being 14 June 2021, as well as the consequences of failing to do so.

7. As no defence had been filed within the prescribed period, within the letter dated 1 July 2021, the Registry also informed the proprietor that it shall be treated as not opposing the application for a declaration of invalidity and the registration would be declared invalid in its entirety.

8. On 7 July 2021, a Form TM33 was filed, appointing Alpha and Omega as the new representatives for the proprietor. The new representatives responded and filed a witness statement dated 22 July 2021 in the name of Michael Brown. To summarise, the reasons provided by Mr Brown for the late filing of a defence were due to "a delay in communications surrounding the filing of the TM26(I)" between the proprietor's previous agents in this case and the corresponding EUIPO case.

9. The Registry issued a preliminary view to the parties on 21 October 2021 to allow the late filing of the TM8 and counterstatement. No hearing was requested from either party and consequently, the proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use in respect of its earlier mark.

10. The applicant is represented by Baron Warren Redfern whereas the proprietor is represented by Alpha & Omega. Whilst the applicant filed evidence, the proprietor did not. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

11. 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

12. The applicant's evidence was filed in the form of two witness statements dated 11 January 2022 and 26 January 2022 respectively from the company's Head of legal and Compliance, Corinna Schleipen and included 4 exhibits in total. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

13. Section 5(2) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. The relevant legislation is as follows:

14. Section 47 states:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

15. As the earlier mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

17. 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.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives 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.

Proof of use

18. I will begin by assessing whether there has been genuine use of the earlier mark.

19. Section 100 of the Act states that:

“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.”

20. Pursuant to section 47(2B) of the Act, there are two relevant periods for assessing whether genuine use has been made of the earlier mark. The first is the 5-year period ending with the filing date of the proprietor’s mark, so this will be 15 May 2013 to 14 May 2018. The second is the 5-year period ending with the filing date of the TM26(I) form by the applicant. This will therefore be 8 April 2016 to 7 April 2021.

Relevant case law

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

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

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

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the

goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

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

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

Sunrider at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

22. An assessment of genuine use is a global assessment, which includes looking at the evidential picture, not whether each individual piece of evidence shows use by itself.¹

23. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

Use of the mark

24. In her first witness statement, Ms. Schleipen explains that SLV GmbH is a manufacturer of lamps and lighting installations.²

¹ See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

² See paragraph 2 of the first witness statement of Corinna Schleipen

25. It is further explained that each year, the company issues a comprehensive catalogue of more than 800 pages containing the company's collection of lamps and lighting installations.³ Exhibit CS1 provides excerpts from the catalogues from the years 2015 up to and including 2021 which show the applicant's mark accompanied by images and product numbers of lights, fixtures and installations. It is claimed in the witness statement that the catalogues are printed in an edition of 500,000 pieces and are widely distributed within the European Union and the UK.⁴

26. Exhibit CS3 displays a chart showing the turnover figures for products in the AIXLIGHT family according to years and article numbers. All turnover figures shown in the chart have been made within the European Union. Whilst I do not intend to reproduce the table in full here, the total figures in Euros from the years 2016 to 2021 are as follows:

Year	Total Turnover (Euros)
2016	109,910.07
2017	63,237.80
2018	56,097.65
2019	58,361.54
2020	40,137.71
2021	4,266.63

27. The second witness statement of Ms. Schleipen dated 26 January 2022 provides sample invoices for products from the Aixlight lamp range from 2017 to 2021.⁵ The samples show sales have been made in Austria, Hungary, Germany, Spain and the UK. Although the invoices are in German, the dates, addresses, prices (in Euros) and the "Aixlight" mark can be seen clearly on each invoice.

³ See paragraph 2- first bullet point of the first witness statement of Corinna Schleipen

⁴ See paragraph 2 of the first witness statement of Corinna Schleipen

⁵ See exhibit CS4

Genuine Use

28. Considering the sum of the evidence, including the turnover between 2016 and up to the application date in 2021 and the use of the earlier mark in catalogues and product packaging⁶ it is my view that the applicant has made use of the mark within both relevant periods. Again, with consideration of the evidence, it is my view particularly with reference to the consistent sales figures and circulation of catalogues over the last five years, the use made by the applicant does not appear to be token, solely for the purpose of preserving the rights conferred by the registration of the applicant's mark. Rather, I find the use to be for the purpose of creating and preserving a share of the market within Europe for the goods for which it is registered. As such, I find that there is genuine use of this mark in relation to the goods protected by the applicant in class 11.

Fair Specification

29. I now need to consider what constitutes a fair specification for the first earlier mark, having regard for the services upon which genuine use has been shown. 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.”

30. 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:

⁶ See exhibit CS2

“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.”

31. The applicant covers goods in class 11 including *Mains-operated lights; Lighting apparatus and installations; head lamps, electric lamps, including lighting rods, decorative lighting apparatus*. Whilst I consider that the use shown by the opponent is in respect of mains operated lights, lighting apparatus and installations, electric lamps and decorative lighting apparatus, I do not find that the use shown warrants protection for head lamps or lighting rods. I find that the consumer would consider *mains operated lights; lighting apparatus and installations; electric lamps and decorative lighting apparatus* to be a fair description of the goods evidenced. I will therefore assess the grounds under section 5(2)(b) based on that specification.

Comparison of Goods

32. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

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

d) 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;

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

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

35. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

36. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the*

Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the 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”.

37. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

38. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

39. The goods to be compared are as follows:

Applicant's Goods	Proprietor's Goods
<p>Class 11: Mains operated lights; Lighting apparatus and installations; Electric lamps and decorative lighting apparatus.</p>	<p>Class 9: Starters for fluorescent lights; luminance meter; photoelectric detector; switch, namely, change-over switches, Automatic switchboards, Cut-out switches, Differential switches, photoelectric switch, Electric circuit switches, Electric current switches, Electric flasher switches, Electric light switches, High frequency switches, High-frequency switching power supplies, Electronic motor switches for switching off motors, Electronic proximity sensors and switches, Electronic touch sensitive switches, Light switches, Light sensors and switches for light systems, Power switches; automatic switching apparatus; Temperature switches; thin film switches; photoelectric sensor; lighting ballasts; rotating signal lights; outlet, namely, Covers for electric outlets, Electrical outlets, Modular telephone outlet, Multi-outlet socket blocks, Movable sockets; plug, namely, Electrical plugs and sockets, Electrical plug device enabling connection and disconnection of power and/or control cables, Plug adaptors, Plug connectors, Plug-in connectors, Round plug connectors, Safety contact plugs, Adapter plugs; light-emitting diode; electronic light emitting diode (LED) signs; sensor, namely, Electric sensors, Electronic data relays for sensors, Electronic proximity sensors and switches, Industrial calibration sensors, Light sensors and switches for light systems, Photoelectric sensors, Pressure sensors, Proximity sensors, Temperature sensors, Timing sensors; power supply; power adapter; wire connector, namely, Cable connectors, Connectors for electronic circuits, Electrical and electronic connectors, Electrical header connectors, Electrical power connectors, Plug connectors,</p>

	Plug-in connectors, Insulated electrical connectors, Power connectors, Round plug connectors, Threaded cable connectors of metal; computer software; computer programs [downloadable software]; computer software applications, downloadable; computer software platforms, recorded or downloadable.
	Class 11: flashlights; fluorescent lamps; incandescent lamps; ceiling lamps; safety lamps for underwater and underground use; projector lamps; projection lamps; lights for vehicles; art lamps; brake lights for vehicles; table lamps; searchlights; halogen lamps; illumination apparatus, namely, flashlights for illumination purposes, lights for illuminating stairs, doors, and other portions of buildings, lights for use in illuminating signs and displays; illuminating lamps; decorative lamps; electric lamps; spot lamps; wall lamps; electric light decorative strings; light bulbs, namely, led light bulbs and electric light bulbs; sockets for electric lights; fluorescent lamp tubes; lamp shades; neon lamps; fog lamps; ceiling lights; embedded ceiling downlight, namely, recessed ceiling lights; spotlights; linear ceiling lights, namely, electric ceiling track lighting units; lighting tubes.

40. The applicant has provided submissions in their statement of grounds on the similarity of the contested goods. Whilst I do not propose to reproduce them all here, I have taken them into consideration when reaching my decision.

41. The applicant's goods include the term '*lighting apparatus*' in Class 11 which, as a broad term, I consider through its ordinary and natural meaning could encompass several goods covered in the proprietor's specification in Class 9 such as *Starters for fluorescent lights* and *Lighting ballasts*. I note however, that the applicant in their statement of grounds has pleaded that the respective goods in classes 11 and 9 are similar rather than identical.

42. In *Altecnic Ltd's Trade Mark Application*⁷ the Court of Appeal decided that “*the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.*”

43. In addition, in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where “*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.*”

44. Whilst the comments made by the late Mr Justice Carr above concerned different circumstances to those which I am considering in these proceedings, it is my view that the term ‘*lighting apparatus*’ may cover goods falling into more than one class. It is my view that I may therefore use the class numbers to aid my interpretation of the respective goods, and to assist in determining the scope of the term lighting apparatus as included in class 11. It appears the applicant is in agreement with this approach, based on its pleading that the goods are similar, not identical. This is how I intend to proceed.

Fluorescent lamps; incandescent lamps; ceiling lamps; projector lamps; projection lamps; art lamps; table lamps; searchlights; halogen lamps; illuminating lamps; decorative lamps; electric lamps; spot lamps; wall lamps; electric light decorative strings; light bulbs, namely, led light bulbs and electric light bulbs; fluorescent lamp

⁷ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA)

tubes; neon lamps; ceiling lights; embedded ceiling downlight, namely, recessed ceiling lights; spotlights; linear ceiling lights, namely, electric ceiling track lighting units; lighting tubes

45. I consider these goods in the proprietor's specification to fall within the applicant's term *Mains operated lights*. These goods are therefore identical on the principle outlined in *Meric*.

Flashlights; safety lamps for underwater and underground use; lights for vehicles; brake lights for vehicles; fog lamps

46. I find these goods to fall within the applicant's term *Electric lamps* and are therefore identical on the principle outlined in *Meric*.

Illumination apparatus, namely, flashlights for illumination purposes, lights for illuminating stairs, doors, and other portions of buildings, lights for use in illuminating signs and displays

47. These goods appear to fall within the applicant's term *Electric lamps and decorative lighting apparatus*, and I find they are identical in line with *Meric*.

Sockets for electric lights

48. I find this term relates to a device which mechanically supports and provides electrical connections for a compatible electric lamp. I therefore consider this term to be identical to the applicant's *Lighting apparatus* in line with *Meric*.

Lamp shades

49. This term falls within the scope of the applicant's *decorative lighting apparatus* and is therefore identical in line with *Meric*.

Starters for fluorescent lights; Lighting ballasts

These goods are used to help ignite fluorescent lights and regulate the voltage and current of lamps. I therefore consider their intended purpose to be similar to that of *lighting apparatus* which will cover goods such as filaments for electric lamps and magnesium filaments for lighting. I also find that there would be an overlap in users and trade channels. Overall, I consider these goods to be similar to a high degree.

Rotating signal lights

50. Rotating signal lights are lights which emit light in a 360° range to provide warnings of hazardous conditions. I find that their nature is similar to that of *electric lamps*. Further, the broad intended purpose to emit light will be shared. There may be an overlap in users with both electric lights and rotating signal lights being purchased by users including professionals for use on roadside construction sites, by way of example, and there may also be a degree of competition between the respective goods as consumers may be faced with the choice of purchasing electric lamps or rotating signal lights for use as hazard warnings. Further, there may be an overlap in trade channels however, I do not consider the goods to enjoy a complementary relationship. Overall, I find there is a high degree of similarity between these goods.

Light-emitting diode; electronic light emitting diode (LED) signs

51. I consider the above goods to be similar in nature and purpose to the proprietor's *mains operated lights* and *electric lamps* with all of the goods being for the purpose of illumination. I also consider there would be an overlap in trade channels and users however I do not consider there to be a complementary relationship or for the goods to be in competition with one another. Overall, I find these goods to be similar to a high degree.

Switch, namely, Electric light switches; Light switches, Light sensors and switches for light systems; Electric flasher switches, Power switches, Automatic switching apparatus, Electric circuit switches, Electric current switches, Electric flasher switches,

Electronic proximity sensors and switches, Electronic touch sensitive switches, Temperature switches, Photoelectric switch, Differential switches, Change-over switches, Cut-out switches, High frequency switches, High-frequency switching power supplies, Thin film switches

52. I find that the above goods are all switches which may all be used to control the function of lighting and therefore have a shared purpose to goods falling within the applicant's *Lighting apparatus* such as lighting panels which are used to control electric lighting systems. As these goods are used to control the power of electrical lighting, I find there may be an overlap of users and trade channels. Further, there may be a degree of complementarity as the respective goods are important or indispensable for one another to the extent that consumers would think the responsibility for the goods lies with the same undertaking or with economically connected undertakings. I find these goods to be similar to a medium degree.

Electronic motor switches for switching off motors

53. I consider that the above goods are that of a specialist nature to be used in conjunction with motors. I therefore find their nature and purpose to differ from the proprietor's goods. Although these goods may also be purchased from a specialist outlet, I do not consider there to be any competition or a complementary relationship between the contested goods. Overall, I find these goods to be dissimilar.

Wire connector, namely, Cable connectors, Connectors for electronic circuits, Electrical and electronic connectors, Electrical header connectors, Electrical power connectors, Plug connectors, Plug-in connectors, Insulated electrical connectors, Power connectors, Round plug connectors, Threaded cable connectors of metal

54. The above goods are all connectors which are used to create a secure connection between wires and can also create a link between a device and its power source. I therefore consider that the above goods may be used in conjunction with lighting and enjoy a shared purpose to *Lighting apparatus* which may include goods such as lighting tracks and lighting armatures which are both used to connect a series

of lights. Due to this shared purpose, I also consider the goods may overlap in respect of users and trade channels. I find these goods to be similar to a medium degree.

Luminance meter

55. Luminance meters are used for measuring the intensity of a light source. Their nature and purpose therefore differ from *mains operated lights*. Although a light source is required for the use of a luminance meter, I do not consider the relationship between luminance meters and the applicant's goods to be to the extent that customers may think that the responsibility for those goods lies with the same undertaking. I also acknowledge that a luminance meter may be used to measure the intensity of a natural light source and therefore a mains operated light is not always required for its use. As luminance meters are used in conjunction with light sources, I find there would be some overlap in users and trade channels. I find there is a low degree of similarity between these goods.

Sensor, namely, Electric sensors, Timing sensors, Proximity sensors, Electronic proximity sensors and switches

56. I consider that sensors of this nature may be used for turning lighting on and off and may encompass home security lighting used in gardens or lighting sensors used in offices and classrooms. As these goods assist the function of lighting, I consider their purpose overlaps with *Lighting apparatus* and there may also be an overlap in users and trade channels. Further, there may also be a degree of complementarity to the extent that consumers believe that the responsibility for the goods lies with the same or economically shared undertakings. Overall, I find these goods to be similar to a medium degree.

Electronic data relays for sensors, Industrial calibration sensors, Pressure sensors, Temperature sensors

57. These goods all relate to devices which determine if there is a presence of a particular entity or function or to sense different physical properties. I consider that they are mostly specialised goods predominantly used in industrial or manufacturing settings. I consider that their physical nature and uses differ from that of *mains*

operated lights. Further, I do not consider there to be an overlap of users or trade channels. Overall, I find these goods to be dissimilar.

Photoelectric detector; Photoelectric sensors

58. Photoelectric detectors and sensors use light to detect objects in their field of view and are used predominantly in industrial or manufacturing environments, their nature and purpose therefore differs from *mains operated lights*. Although they emit light in order to function, I am conscious that if something is a component of another product, this does not justify the finding of similarity. I do not find a complementary relationship between the goods, nor do I find there to be a competitive relationship. Further, I do not consider there to be an overlap of users or trade channels. I consider these goods to be dissimilar.

Outlet, namely, Covers for electric outlets, Electrical outlets; Multi-outlet socket blocks, Movable sockets; Plug, namely, Electrical plugs and sockets, Electrical plug device enabling connection and disconnection of power and/or control cables, Plug adaptors, Plug connectors, Plug-in connectors, Round plug connectors, Safety contact plugs, Adapter plugs; power supply; power adapter

59. These are all goods which may be used in conjunction with *Lighting apparatus* and I therefore find there may be an overlap in users and trade channels as they may all be sold in specialist lighting outlets or home improvement stores. I consider however, that the nature and purpose of these goods will differ. Although these goods are used in conjunction with *Lighting apparatus*, I do not consider this relationship would be to the extent that consumers will believe that the responsibility of these goods lies with the same undertaking and as such, I do not find there to be a complementary relationship. Overall, I find these goods to have a low degree of similarity.

Automatic switchboards; Modular telephone outlet

60. These goods both relate to the use of telephones and therefore I find their nature, purpose, users and trade channels differ. Further, I do not find that these goods

enjoy a competitive or complementary relationship with the applicant's goods. Overall, I find these goods to be dissimilar.

Computer software; computer programs [downloadable software]; Computer software applications, downloadable; computer software platforms, recorded or downloadable

61. The applicant contends in their statement of grounds that the above goods are often used for the control of lighting installations in business and smart home appliances. Although the nature and purpose of these goods differ from *electric lamps*, I do find that consumers with smart lighting equipment would require *computer software applications* to assist with the function of lighting equipment and there would therefore be an overlap in users. Further, as some *computer software applications* used to assist with lighting require compatible lights in order to function, I consider that there is some degree of complementarity to the extent that some consumers may believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. I do not consider there to be an overlap of trade channels, nor do I find the goods to share a competitive relationship. Overall, I find the goods similar to a low degree.

62. In relation to *Electronic data relays for sensors, Industrial calibration sensors, Pressure sensors, Temperature sensors, Photoelectric detector; Photoelectric sensors, Electronic motor switches for switching off motors, Automatic switchboards; Modular telephone outlet* which I have found not to be similar, there can be no likelihood of confusion and the opposition to those goods fails.

The average consumer and the nature of the purchasing act

63. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services 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.”

64. The average consumer for the goods in question will be the general public or professionals purchasing on behalf of a business undertaking. The cost of the goods is likely to vary from low to average. In terms of the purchasing process consumers may consider factors such as aesthetics, quality and safety requirements along with compatibility with component parts. I consider that the general public purchasing these goods will pay a medium level of attention and when it comes to the professional consumer, they will also consider these factors, but may also be buying on a larger scale, and will have the added liability of their purchase making a direct impact on their business and as such, I find they will be likely to pay at least an above medium degree of attention to the goods.

65. I find that during the selection process, the goods are likely to be purchased by self-selection from a retail outlet or from an online or catalogue equivalent. I find that the selection process would primarily be visual however, I do not discount that there will be an aural component in the selection of the goods in the form of word-of-mouth recommendations and telephone orders.

Comparison of marks

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

components. The Court of Justice of the European Union 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 relevant 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.”

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

68. The marks to be compared are as follows:

Applicant's Mark	Proprietor's Mark
AIXLIGHT	REX Lite

69. The applicant's mark consists of the word AIXLIGHT. The overall impression resides in the mark as a whole.

70. The proprietor's mark consists of the word REXLite in a slightly stylised typeface. I note that the letters "REXL" are presented in an upper-case font while the remaining "ite" are presented in lower case. I find the wording itself, in particular the letters "REXL" dominates the overall impression due to its size and positioning at the beginning of the mark. I find that the stylistic aspects make only a minor contribution to the overall impression.

Visual comparison

71. The respective marks coincide in their use of the letters “XLI” in the centre of the marks. I recognise that due to the stylisation of the proprietor’s mark that the letters “XL” are presented in an upper-case font while the “i” is presented in a lower-case font. The entirety of applicant’s mark is presented in an upper-case font however, it seems that through fair and normal use, it would be permitted for their mark to also be presented in the same stylisation of “XLI”. The proprietor’s mark differs from the applicants in its use of the letters “RE” at the beginning of the mark which has no counterpart in the applicant’s mark. Further, the applicant’s mark uses the standard English spelling of the word “light” whereas the proprietor uses the spelling “lite”. I find the marks to be visually similar to no more than a medium degree.

Aural comparison

72. I consider that the proprietor’s mark will be pronounced on two syllables as REX-LIGHT. The applicant’s mark will most likely be pronounced in two syllables as AY-X-LIGHT, though I accept that in some cases, a small minority may pronounce the mark as AXE-LIGHT. In both cases, the respective marks coincide in their use of LIGHT at the end of their marks. Although the first syllable of the respective marks differ, there is some similarity in their use of the X sound. Overall, I find the marks to be aurally similar to a medium to high degree.

Conceptual comparison

73. In respect of the applicant’s mark, I find that the wording “AIX” will be perceived as an invented word with no attributable meaning whereas “LIGHT” will be perceived as the standard dictionary description of an object which produces light, such as an electric lamp⁸. I consider that “REX” in the proprietor’s mark will likely be perceived as a name. I find that the term “LITE” will most likely be considered as a stylised choice of spelling for the word “LIGHT” and will therefore be perceived as the same especially taking into consideration the goods in class 11. I acknowledge however, that in some cases, a small minority may perceive the term “LITE” as an informal term

⁸ [Light definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-english/dictionary/light)

to describe an object as being lighter in size or weight and consider this as a description of some of the goods. Overall, I find the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier mark

74. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

75. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

76. I will begin by initially assessing the inherent distinctiveness of the applicant’s mark.

77. In relation to the registered goods, I am of the view that the applicant’s mark is somewhat allusive due to the use of the word “LIGHT”. As previously outlined, I consider the term “AIX” to have no attributable meaning and is therefore neither descriptive nor allusive of the goods for which it is registered. Consequently, I find the applicant’s mark to be inherently distinctive to a medium degree.

78. I now turn to consider whether the distinctiveness of the applicant’s mark has been enhanced through use. When considering whether the distinctiveness of a trade mark has been enhanced through use, it is the perception of the UK consumer that is key.

79. In the first witness statement of Corinna Schleipen, it is claimed that the applicant’s mark has been in continuous use since its registration in 2007⁹, however, the evidence provided shows use from 2015 to April 2021.

80. Previously in paragraph 24 of this decision, I outlined the applicant’s turnover figures from 2016 to April 2021. Whilst the figures are certainly not insignificant, the figures reflect sales throughout Europe, and it is therefore unclear as to what proportion of the turnover figures relate to sales in the UK. In addition, from the 19 invoices provided in exhibit CS4, only one invoice is shown relating to sales in the UK

⁹ See paragraph 4 of the first witness statement of Corinna Schleipen

whereas the remainder of invoices predominantly relate to sales in Germany. Further, I previously outlined in paragraph 23 of this decision the applicant's claim that the sales catalogues as shown in exhibit CS1 are printed in an edition of 500,000 pieces. Again, however, it is unclear how many catalogues were circulated in the UK.

81. From the evidence provided by the applicant, it would be reasonable to assume that they hold only a minimal amount of the UK market share and in this particular case, I do not consider that the evidence provided by the applicant is sufficient to show that the distinctiveness of their earlier mark has been enhanced through use.

Likelihood of confusion

82. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

83. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

84. Earlier in my decision, I found the similarity of the respective goods to range from identical to dissimilar. I identified the average consumer to be a member of the general public or professionals purchasing on behalf of a business undertaking and in both cases the goods will be purchased predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process in respect of the general public, and this will be higher in respect of the professional consumer who will pay at least a medium degree of attention.

85. I found the respective marks to be visually similar to no more than a medium, aurally similar to a medium to high degree and conceptually similar to a medium degree. However, I note that the shared concept is weak, as both marks simply convey to the consumer the concept of light in respect of lighting related goods. I also found the earlier mark to have a medium level of inherent distinctive character as a whole in respect of its registered goods however, the distinctiveness of the mark has not been enhanced through the use made of it.

86. I have taken all of the relevant factors into consideration in reaching my decision and bear in mind that the purchasing process is predominantly visual and as a general rule the beginning of marks make more impact than the endings¹⁰. Considering the marks as a whole, there is a clear difference from the “RE” element at the beginning of the proprietor’s mark, which has no counterpart in the applicant’s mark. I find that this difference will not go unnoticed by the average consumer. I do not find that the proprietor’s mark will be mistaken for the applicant’s and as such, I do not consider there to be a likelihood of direct confusion.

87. I now go on to consider indirect confusion.

88. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

¹⁰ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example.)

89. These examples are not exhaustive but provide helpful focus.

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

91. Firstly, I note that this situation is not one that appears to fall into the categories set out in *L.A. Sugar*, however, I remind myself that they were not intended to be exhaustive. Although I found the marks to share a medium to high degree of aural similarity, I am reminded that when making a global assessment, the visual, aural and conceptual aspects of the marks do not always hold the same weight¹¹ and in this

¹¹ See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

case, I considered that the purchasing process would be predominantly visual. The shared “XLI” element lies in the centre of both marks and I find that when faced with the mark, consumers will first notice the differences in the first two letters of the respective marks. It is possible that the different choice of spelling “LIGHT” AND “LITE” may be misremembered. However, I do not consider that consumers would perceive these similarities, bearing in mind the visual differences at the start of the mark, as an indication of a brand extension, or an economically linked undertaking. I remind myself that I found the applicant’s mark to have a medium degree of distinctiveness, however, this is on the basis of the ‘AIX’ element which has no direct counterpart in the contested mark. Having carefully considered these points, I am of the view that the proprietor’s mark may at best bring to mind the applicant’s mark however, any similarities between the same will be put down to a coincidence rather than an economic connection. I am not satisfied that this gives rise to a likelihood of indirect confusion, and as such, the application for invalidity under section 5(2)(b) must fail.

Conclusion

92. The application for invalidation under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal against my decision, the contested mark will remain on the register.

COSTS

93. The proprietor has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 2 of 2016. Using that TPN as a guide, and considering that the proprietor has not filed anything further than beyond the counterstatement and has not commented on the applicant’s evidence, I award the proprietor the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement:	£200
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Considering the other side's evidence: £200

94. I therefore order SLV GmbH to pay the sum of £400 to FISHBONE DESIGN CO., LTD. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of August 2022

Catrin Williams
For the Registrar