

O/0223/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003594077  
BY ENTTEC LTD TO REGISTER THE FOLLOWING TRADE MARK:

**ENTTEC**

IN CLASSES 9 AND 11

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 425703

BY SLV GMBH

AND IN THE MATTER OF REGISTRATION NO. UK00908493736  
IN THE NAME OF SLV GMBH FOR THE FOLLOWING TRADE MARK:

**N-tic**

IN CLASS 11

AND AN APPLICATION FOR REVOCATION THERETO

UNDER NO. 504718

BY ENTTEC LTD

## **BACKGROUND AND PLEADINGS**

1. On 11 February 2021, ENTTEC Ltd (“EL”) applied to register the trade mark ENTTEC (no. 3594077) in the UK. The application was published for opposition purposes on 23 April 2021 and registration is sought for the following goods:

Class 9      Light dimmers; Light emitting diodes (LEDs); Lighting control apparatus; Stage lighting controls; Remote control apparatus for controlling lighting; Application software to control lighting; Apparatus and instruments for controlling stage lighting; Control consoles for lighting apparatus and instruments; Computer hardware for the control of lighting; Computer software for the control of lighting; Programmable controls for lighting apparatus and instruments; Sound activated control apparatus for lighting installations; Audio-sensitive controls for lighting apparatus and instruments; Lighting control software for use in commercial and industrial facilities; Computer software for the remote control of electric lighting apparatus; Software for the control of stage lighting apparatus and instruments; Ethernet controllers.

Class 11     Apparatus and installations for lighting; Apparatus for lighting; Lighting; Light bars; LED [light-emitting diode] lighting fixtures; Commercial lighting fixtures; Electrical lighting fixtures; Industrial lighting fixtures; LED lighting fixtures.

2. On 22 July 2021, the application was opposed by SLV GmbH (“SLV”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). SLV relies upon the following trade mark:

N-tic

UKTM no. 908493736<sup>1</sup>

Filing date 17 August 2009; registration date 6 January 2010

Relying on all goods for which the mark is registered, namely:

Class 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

3. SLV claims that there is a likelihood of confusion because the trade marks are similar and the goods are identical or similar.

4. EL filed a counterstatement denying the claims made and putting SLV to proof of use of the earlier mark.

5. On 25 March 2022, EL filed an application seeking to revoke the earlier mark on the grounds of non-use. Under sections 46(1)(a) of the Act, EL claims non-use in the five-year period following the date on which the mark was registered i.e. 7 January 2010 to 6 January 2015. EL requests an effective date of revocation of 7 January 2015. Under section 46(1)(b) of the Act, EL claims non-use for the following three periods:

- a. 24 March 2017 to 23 March 2022, with an effective date of revocation of 24 March 2022;
- b. 24 March 2013 to 23 March 2018, with an effective date of revocation of 24 March 2018; and
- c. 24 March 2015 to 23 March 2020, with an effective date of revocation of 24 March 2020.

---

<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of SLV's EUTM no. 8493736 being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

6. SLV filed a counterstatement defending the earlier mark in respect of “apparatus for lighting” only.

7. SLV is represented by Baron Warren Redferne and EL is represented by Founders Law Limited.

8. Only SLV filed evidence. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

9. SLV filed evidence in the form of the witness statements of Corinna Schleipen dated 7 January 2022, 26 January 2022 and 7 July 2022. Ms Schleipen is the Head of Legal and Compliance for SLV and her statements are accompanied by 4, 2 and 5 exhibits respectively.

10. SLV filed written submissions dated 31 January 2022.

11. Both parties filed written submissions in lieu dated 13 December 2022.

12. I have taken the evidence and submissions into account in reaching this decision.

## **RELEVANCE OF EU LAW**

13. 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 upon 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.

## **DECISION**

### **Proof of Use**

14. SLV is required to prove use of its mark in order to defend the revocation action brought against it. As its mark had been registered for more than 5 years at the date of the application against which the opposition is brought, it must also prove use for the purposes of the opposition pursuant to section 6A of the Act.

15. Section 46 of the Act is relevant to the revocation proceedings which states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that

paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

16. Section 6A of the Act is relevant to the proof of use in the opposition, which states as follows:

“(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), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5)-(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.”

17. As the earlier mark is a comparable mark, SLV can rely upon use of the mark in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day (i.e. 31 December 2020) pursuant to paragraphs 7 and 8 of Part 1, Schedule 2A of the Act.

18. Section 100 is also relevant, which reads:

“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.”

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

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung 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].”

20. 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 market for the goods or services protected by the mark” is not, therefore, genuine use.

21. The relevant periods for the purposes of the revocation are:

a) 7 January 2010 to 6 January 2015 (“the first relevant period”);

- b) 24 March 2017 to 23 March 2022 (“the second relevant period”);
- c) 24 March 2013 to 23 March 2018 (“the third relevant period”); and
- d) 24 March 2015 to 23 March 2020 (“the fourth relevant period”).

22. The relevant period for the opposition is the five-year period ending with the date of the application in issue i.e. 12 February 2016 to 11 February 2021 (“the fifth relevant period”).

23. I have reviewed SLV’s evidence and, in particular, I note the following:

- a) Catalogues from 2016, 2017, 2018 and 2019 show N-tic spot lights, outdoor up-lights and downlights offered for sale;<sup>2</sup>
- b) Ms Schleipen gives evidence that these catalogues were distributed throughout the EU, including the UK, with 500,000 copies being produced;
- c) I note that 10,000 catalogues were printed for the UK market in 2018 and 2019, 11,400 were printed in 2020 and 5,500 were printed in 2021.<sup>3</sup>
- d) The following is provided as sales figures for N-tic lights in the European Union and the UK:<sup>4</sup>

	Netto I	Netto IV
<b>Fiscal year</b>	EUR	EUR
Cal. Year, 4 Special Periods 2017	163,675.15	160,184.79
Cal. Year, 4 Special Periods 2018	130,285.65	128,473.00
Cal. Year, 4 Special Periods 2019	87,939.99	85,036.47
Cal. Year, 4 Special Periods 2020	7,123.89	6,753.47
Cal. Year, 4 Special Periods 2021	95.00	84.68

<sup>2</sup> Exhibit CS1 to 7 January statement and CS1 to 26 January statement

<sup>3</sup> Exhibit CS2 to 7 January statement

<sup>4</sup> Exhibit CS3 to 7 January statement

- e) Sales invoices for N-tic products dated between 2017 and 2021 have been provided.<sup>5</sup> They are in German, but it is possible to identify that they are addressed to recipients in Spain and Germany. Only those dated prior to IP Completion Day will be relevant.

24. By virtue of section 41(3) of the Act, I need only consider the more recent relevant periods. There has clearly been use of the mark as registered in catalogues and invoices. Clearly, the opponent's evidence is thin. However, the sales figures are clearly not insignificant. There have been attempts to create a market for the goods in both the UK and the EU, with brochures distributed. I note that EL takes issue with the fact that the circulation figures for the brochures have not been independently verified, however, this point was not raised until written submissions in lieu, depriving SLV of an opportunity to answer the criticism. In any event, I see no reason to doubt the narrative evidence given by Ms Schleipen. The evidence of use must be viewed in the round. Taking the evidence as a whole into account, I am satisfied that SLV has demonstrated genuine use in relation to *spot lights, down-lights* and *up-lights* during the second and fifth relevant periods.

25. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods 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.”

---

<sup>5</sup> Exhibit CS4 to 7 January statement and Exhibit CS5 to 7 July statement

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. The earlier mark is registered for *Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes*. However, SLV has only defended its registration for “apparatus for lighting”. As there is use in relation to different types of lighting, I am satisfied that that is a fair specification for the use shown.

### **The Opposition**

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

“5(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 of association with the earlier trade mark.”

29. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

30. By virtue of its earlier filing date, the trade mark upon which SLV relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

31. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 goods**

32. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 11</u> Apparatus for lighting	<u>Class 9</u> Light dimmers; Light emitting diodes (LEDs); Lighting control apparatus; Stage lighting controls; Remote control apparatus for controlling lighting; Application software to control lighting;

	<p>Apparatus and instruments for controlling stage lighting; Control consoles for lighting apparatus and instruments; Computer hardware for the control of lighting; Computer software for the control of lighting; Programmable controls for lighting apparatus and instruments; Sound activated control apparatus for lighting installations; Audio-sensitive controls for lighting apparatus and instruments; Lighting control software for use in commercial and industrial facilities; Computer software for the remote control of electric lighting apparatus; Software for the control of stage lighting apparatus and instruments; Ethernet controllers.</p> <p><u>Class 11</u></p> <p>Apparatus and installations for lighting; Apparatus for lighting; Lighting; Light bars; LED [light-emitting diode] lighting fixtures; Commercial lighting fixtures; Electrical lighting fixtures; Industrial lighting fixtures; LED lighting fixtures.</p>
--	---

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

“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.”

34. 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 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.

35. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 for 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.”

### Class 9

36. With the exception of *ethernet controllers* in EL’s specification, the goods in this class are all intended to be used with lighting apparatus. They are likely to be sold through the same trade channels as the lighting. The goods will clearly differ in nature, method of use and purpose. However, the user will overlap and the goods will be complementary. Taking all of this into account, I consider there to be a medium degree of similarity between the goods.

37. *Ethernet controllers* are not for use with lighting. Consequently, I do not consider that the same complementarity applies. There may be some overlap in trade channels to the extent that both could be sold through some general suppliers, but this would be at a very superficial level. Taking all of this into account, I consider the goods to be dissimilar.

### Class 11

38. EL accepts that *apparatus and installations for lighting* and *apparatus for lighting* in its specification are identical to SLV’s goods. However, it denies that the remaining class 11 goods are identical to SLV’s goods, submitting that they are similar to a low degree. In my view, all of EL’s class 11 goods are identical on the principle outlined in *Meric to apparatus for lighting* in SLV’s specification.

### **The average consumer and the nature of the purchasing act**

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective 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.”

40. The average consumer for the goods will be members of the general public or professional users. The goods will vary in cost, but are unlikely to be particularly expensive. The goods are likely to be reasonably infrequent purchases. The consumer is likely to consider factors such as durability, aesthetics, reliability and safety. Taking all of this into account, I consider that a medium degree of attention will be paid during the purchasing process.

41. In relation to the purchasing process, SLV submits:

“These goods are typically selected by the general public from physical retail establishments and websites after viewing information on displays, in catalogues or on the internet, or following an inspection of the premises’ frontage on the high street. In the circumstances, visual considerations will be important. However, it is very important not to discount phonetic considerations in the form of word of mouth recommendations, discussions with sales assistants or telephone enquiries.

[...] For the goods which are more specific to professional users [...] such goods are still typically selected from websites, and from physical stores, so in all cases the visual consideration is important. However, the phonetic consideration is very relevant as professional users may wish to engage in discussions with sales representatives prior to purchase, and word of mouth is important.”

For the reasons given by SLV, I consider that the purchasing process will be predominantly visual, although I do not discount an aural component.

### **Comparison of trade marks**

42. 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 the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. 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.”

43. 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.

44. The respective trade marks are shown below:

<b>SLV's mark</b>	<b>EL's mark</b>
N-tic	ENTTEC

45. SLV's mark consists of the letters N-tic, separated with a hyphen. There are no other elements to contribute to the overall impression of the mark which lies in the combination of these elements. EL's mark consists of the invented word ENTTEC. There are no other elements to contribute to the overall impression which lies in the word itself.

46. Visually, the marks coincide in that they both contain a letter N, T and C. However, SLV's mark begins with the letter N, followed by a hyphen and the letters TIC (in lower case). In EL's mark, the letters N and T are preceded by the letter E and followed by the letters TEC. The visual difference, in my view, is quite significant. Consequently, I consider there to be only a low degree of visual similarity between the marks.

47. Aurally, SLV's mark is likely to be pronounced ENN-TIK. EL's mark is likely to be pronounced ENN-TEC. Clearly, as SLV submits, there is some overlap in the way the marks are likely to be pronounced. In my view, they are aurally similar to between a medium and high degree.

48. EL submits that its mark is an abbreviation of the words 'Entertainment Technology'. However, I do not consider that that meaning will be identified by the average consumer. In my view, conceptually, both marks are likely to be viewed as invented words with no obvious meaning. Consequently, the conceptual position will be neutral.

### **Distinctive character of the earlier mark**

49. 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).”

50. 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

51. I have summarised SLV’s evidence of use above. In my view, it is clearly insufficient to establish enhanced distinctiveness. The sales figures have not been broken down to show the UK market only and, in any event, would not show use on the scale required to establish enhanced distinctiveness through use. I have no information about advertising and promotional expenditure and I have no information about how geographically widespread use in the UK has been. Consequently, I have only the inherent position to consider. SLV’s mark consists of the word N-tic. It is an invented word with no obvious meaning. Consequently, I consider it to be inherently distinctive to a high degree.

### **Likelihood of confusion**

52. 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 down to the responsible undertaking 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between the trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

53. I have found as follows:

- a) The goods vary from being identical to similar to a low degree (except where I have found them to be dissimilar).
- b) The average consumer for the goods is a member of the general public or a professional user who will pay a medium degree of attention.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The marks are visually similar to a low degree and aurally similar to between a medium and high degree. The conceptual position is neutral.
- e) SLV's mark is inherently highly distinctive.

54. I bear in mind that the earlier mark is highly distinctive, that some of the goods are identical and that there is between a medium and high degree of aural similarity between the marks. I also bear in mind that there will be no conceptual hook with either mark to assist the average consumer in distinguishing between them. These are, clearly, all factors in favour of SLV. However, the purchasing process for the goods

will be predominantly visual and there is only a low degree of visual similarity. Even where there are aural aspects to the purchase, the average consumer will still encounter the mark visually (such as on product packaging) prior to purchase. In my view, this prevents there from being direct confusion, particularly where the average consumer will be paying a medium degree of attention, even when used on identical goods.

55. Having found there to be no likelihood of direct confusion, I can see no reason why the average consumer would conclude that these marks originate from the same undertaking. They are not obvious extensions or developments of the other. Consequently, I do not consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

56. UKTM no. 908493736 will remain registered for those goods in respect of which the application for revocation was defended, namely:

Class 11      Apparatus for lighting

57. UKTM no. 908493736 will be revoked for those goods in relation to which the proceedings were undefended, namely:

Class 11      Apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

58. The effective date of revocation is 7 January 2015.

59. The opposition against application no. 3594077 is dismissed in its entirety.

## **COSTS**

60. SLV has succeeded in the revocation. EL has succeeded in the opposition. Consequently, they have enjoyed a roughly equal degree of success and each should bear their own costs.

**Dated this 1<sup>st</sup> day of March 2023**

**S WILSON**

**For the Registrar**