

BL O/0424/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3681159

BY

NGIS CHINA LIMITED

TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:



Oden

The word 'Oden' is written in a bold, grey, sans-serif font. Below the text is a horizontal brushstroke that transitions through a rainbow spectrum of colors: red, orange, yellow, green, cyan, blue, and purple.

Oden

The word 'Oden' is written in a bold, grey, sans-serif font. Below the text is a horizontal grey shadow or brushstroke that tapers at both ends.

AND

OPPOSITION NO. 431578 THERETO

BY

RMI PRESSURE SYSTEMS LIMITED

Background and pleadings

1. On 13 August 2021, NGIS CHINA LIMITED (the “Applicant”) applied to register in the UK the series of two figurative trade marks as shown on the cover of this decision for the following goods and services:

Class 9 *Computer software; Mobile application software; Application software for devices; Computer software platforms; Computer software for application and database integration; Collaboration software platforms [software]; Cloud network monitoring software; Cloud computing software; Environmental control software; Environmental monitoring software; Reporting software; Air analysis apparatus; Map software; Augmented reality software for creating maps.*

Class 42 *IT services; technological services; Design of software; Design and development of computer software; Software development, programming and implementation; Research and development of computer software; Technical data analysis; Research relating to data processing; Design and development of software in the field of mobile applications; Computer software integration; Integration of computer systems and networks; Design and development of computer software architecture; Software as a service [SaaS]; Platform as a Service [PaaS]; Environmental consultancy services; Environmental monitoring services; Environmental assessment services; Environmental hazard assessment; Compilation of environmental information; Compilation of information relating to environmental conditions; Consultancy services relating to environmental planning; Consultancy services relating to research in the field of environmental protection; Sampling for pollution; Environmental testing of noise pollution; Advisory services relating to environmental pollution; Advisory services relating to pollution control; Technical advice relating to pollution damage; Technical consulting in the field of pollution detection; Conducting sampling and analysis services to assess pollution levels*

2. The contested application was accepted and published for opposition purposes in the Trade Marks Journal on 3 December 2021.

3. On 3 March 2022, RMI Pressure Systems Limited (the “Opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is aimed against all of the goods and services of the contested application. For the purposes of this opposition, the Opponent relies upon all of the goods for which the following earlier United Kingdom Trade Mark (UKTM) is registered:

UKTM 3374772

ODIN

Filing date: 12 February 2019

Registration date: 14 June 2019

Class 7 *Pumps, compressors and fans; supports for pumps; hydraulic pump stations; pumps and machines for use in coal mining operations; parts and fittings for the foregoing.*

Class 9 *Software for the control of pump stations; Programmable Logic Controllers (PLCs); software for managing and recording the efficiency of pump stations; software for use in coal mining operations.*

4. Since the filing date of the earlier mark predates that of the contested application, the Opponent’s mark is considered to be an “earlier mark” in accordance with Section 6 of the Act. However, as the mark had not been registered for a period of five years or more before the filing date of the application it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

5. The Opponent submitted that the “lightly stylised” contested marks ‘ODEN’ are visually, aurally and conceptually highly similar to the earlier mark ‘ODIN’. The Opponent also submitted that all of the contested goods and services are either identical or similar to the goods of the earlier mark, whilst making particular reference

to the similarity of the contested *computer software* in Class 9. The Opponent argued that based on a global appreciation of the marks at issue there exists a likelihood of confusion, which would also include a likelihood of association.

6. On 20 April 2022, the Applicant filed a counterstatement. The Applicant submitted that the contested marks contain distinctive elements, only one of which is the word element 'ODEN', with another being the "geometric figures representing a brush stroke". The Applicant further submitted that the geometric figure is arguably the dominant element of each mark. Conversely, the Applicant argued that the earlier mark has no distinctive elements and "is not at all distinctive such that likelihood of confusion is nil". The Applicant referred to the *Whyte and Mackay Limited* case law,¹ and submitted that it provides "if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion." The Applicant argued that when the average consumer looks at the total visual impression of each mark, they would believe that the marks are unrelated as they are "starkly different" from one another.

7. The Applicant provided detailed submissions regarding the goods and services comparison. The full extent of these submissions shall not be included here, but will instead be called upon if they provide assistance whilst conducting my own comparison of the respective goods and services. That having been said, it is worth briefly summarising that the Applicant submitted it is engaged in environmental assessment, surveillance and monitoring, whereas the Opponent is engaged in the business of manufacturing pumps for global coal mining and industrial applications. The Applicant submitted that the contested goods and services are an "On-demand Noise Mapping Day Evening and Night" web-based software platform, with the relevant consumer consisting of planners, engineers, architects and environmental practitioners, including government agencies and institutions, all of whom are sophisticated, attentive and careful. The Applicant submitted that such a consumer is expected to act on the basis of a "careful consideration of the reliability and dependability of the manufacturer and seller of the product", particularly as the

¹ *Whyte and Mackay Limited v Origin Wine UK Limited & Anor* [2015] EWHC 1271 (Ch)

“availment of [its] goods and services ... involves a technical need and the allotment of a sum of money”.

8. On 30 May 2022, the Tribunal issued a preliminary indication which found that the opposition would partly succeed in relation to the contested *computer software; mobile application software; application software for mobile devices* and *computer software platforms* in Class 9. Accordingly, the Tribunal invited the opponent to file a Form TM53 to confirm if it wished to pursue the opposition in respect of those goods and services in relation to which the assessment was deemed too finely balanced for a preliminary indication, and the applicant to file a Form TM53 if it still wished to defend the opposition in relation to those goods and services for which a preliminary indication had indicated there would be a likelihood of confusion. The opponent filed a Form TM53 confirming that it wished to continue with the opposition. The Applicant failed to file its intention, and the Tribunal subsequently informed both parties that the proceedings would continue only in relation to the goods and services not deemed withdrawn (see **Comparison of the goods and services**).

9. On 14 September 2022, the Opponent filed submissions. The Opponent rebutted the Applicant’s submissions that the earlier mark is not inherently distinctive and that there would be no likelihood of confusion. The Opponent argued that the word element ‘ODEN’ in the contested mark is the dominant and distinctive element, and that it is visually, aurally and conceptually similar to the inherently distinctive word ‘ODIN’ in the earlier mark.

10. The Opponent submitted that although the contested mark has already been refused for certain goods in Class 9, there nevertheless remains identity and similarity between the outstanding goods and services at issue. By way of example, the Opponent contended that both the contested *cloud computing software* in Class 9 and contested *software as a services [SaaS]* in class 42 would encompass the *software for use in coal mining operations* of the earlier mark. The Opponent argued the Applicant’s submission that the parties operate in distinct business fields is irrelevant, as the goods and services which must be compared are those presented as filed or registered. In addition, and in any case, the Opponent contended that its coal mining operations require closely monitoring environmental conditions and therefore there is a connection with the contested environmental monitoring services. Further, the

Opponent submitted that its pumps manage the environment using software, which is part of the contested specification.

11. On 13 February 2023, the Opponent filed submissions in lieu of a Hearing. The submissions reflected those previously made during the proceedings, with no new submissions of substance being made.

Decision

12. 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. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b)

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

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

(a) ...

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

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of the goods and services

15. Both parties have made substantial submissions in relation to the goods and services at issue, including arguments as to whether the companies carry out their businesses in similar or different industries. As the Opponent correctly stated, the goods and services to be compared are those which are presented before me. In circumstances where the goods or services have not been specifically particularised or limited, I must consider the most natural meaning of the term and the scope to which it would realistically extend. In conducting my analysis I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity. The competing goods and services are as follows:

Earlier mark	Contested mark
<p><i>Class 7: Pumps, compressors and fans; supports for pumps; hydraulic pump stations; pumps and machines for use in coal mining operations; parts and fittings for the foregoing.</i></p>	
<p><i>Class 9: Software for the control of pump stations; Programmable Logic Controllers (PLCs); software for managing and recording the efficiency of pump stations; software for use in coal mining operations.</i></p>	<p><i>Class 9: Computer software for application and database integration; Collaboration software platforms [software]; Cloud network monitoring software; Cloud computing software; Environmental control software; Environmental monitoring software; Reporting software; Air analysis</i></p>

	<p><i>apparatus; Map software; Augmented reality software for creating maps.</i></p>
	<p><i>Class 42: IT services; technological services; Design of software; Design and development of computer software; Software development, programming and implementation; Research and development of computer software; Technical data analysis; Research relating to data processing; Design and development of software in the field of mobile applications; Computer software integration; Integration of computer systems and networks; Design and development of computer software architecture; Software as a service [SaaS]; Platform as a Service [PaaS]; Environmental consultancy services; Environmental monitoring services; Environmental assessment services; Environmental hazard assessment; Compilation of environmental information; Compilation of information relating to environmental conditions; Consultancy services relating to environmental planning; Consultancy services relating to research in the field of environmental protection; Sampling for pollution; Environmental testing of noise pollution; Advisory services relating to environmental pollution; Advisory services relating to pollution control; Technical advice relating to</i></p>

	<p><i>pollution damage; Technical consulting in the field of pollution detection; Conducting sampling and analysis services to assess pollution levels.</i></p>
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16. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

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

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

19. It has been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. 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”.

Class 9

21. The goods of the earlier mark include *software for use in coal mining operations*. The scope of software “for use in coal mining” is quite broad, and could extend to all

manner of control, monitoring, detection, instruction and management, for example. Coal mining can be an extremely dangerous operation, considering that it involves industrial labour underground. Hazards could include cave-ins, landslides, and methane gas explosions, to name but a few. With this in mind I see value in the Opponent's submission that coal mining operations require closely monitoring environmental conditions, the actual monitoring of which could fall within the broad scope of the earlier mark's *software for use in coal mining operations*. The contested *Environmental control software* and *Environmental monitoring software* also have a broad scope, and could extend to the control and monitoring of all types of environment, both global and localised (i.e., inside of a coal mine). The contested *Environmental control software* and *Environmental monitoring software* are therefore considered to have a similar intended purpose, use and end user to the *software for use in coal mining operations* of the earlier mark. Further, they could be in competition. As such, they are considered to be similar to a high degree.

22. The contested *Air analysis apparatus* is a type of good that could be used in the field of coal mining to detect methane or other hazardous gases, for example. Although apparatus and software have a different nature, the contested *Air analysis apparatus* and the earlier mark's *software for use in coal mining operations* have the same intended purpose, use and end user. Further, they could be in competition. As such, *Air analysis apparatus* is similar to a medium degree.

23. The contested *Map software* and *Augmented reality software for creating maps* are broad categories that could be used to find a location for a coal mine and produce an underground layout of a coal mine, for example. Such is the scope of the earlier mark's category *software for use in coal mining operations* that it could also include software for mapping. The contested *Map software* and *Augmented reality software for creating maps* therefore have the same intended purpose, use and end user as the *software for use in coal mining operations*. Further, they could be in competition. As such, the contested *Map software* and *Augmented reality software for creating maps* are considered to be similar to between a medium and high degree.

24. The remaining contested goods in Class 9 include *Computer software for application and database integration*; *Collaboration software platforms [software]*; *Cloud network monitoring software*; *Cloud computing software*; and *Reporting*

software. It seems to me self-evident based on the most natural and obvious interpretation of the literal meaning of these contested goods that they are types of software with a specific intended purpose which does not extend to, or encompass within its more general category, the coal mining or pump station fields of the earlier mark's Class 9 goods. I further do not find any similarity between the remaining contested goods and the *Programmable Logic Controllers (PLCs)* of the earlier mark, the function of which is to control manufacturing machines as opposed to integrate a database, collaborate a platform, monitor a network or report software.

25. I also do not consider the remaining contested goods in Class 9 to be similar to the goods in Class 7 of the earlier mark. The *Pumps, compressors and fans; supports for pumps; and parts and fittings for the foregoing* in Class 7 are essentially instruments that are used in relation to machines, engines or complex systems, for example, and are quite different to the contested software by way of their respective nature, intended purpose, use, end user, and trade channel. As for the *hydraulic pump stations; and pumps and machines for use in coal mining operations* in Class 7, these goods relate specifically to coal mining and pump stations and are to my mind therefore self-evidently different from software that is specified as relating to the integration of a database, or collaborating of a platform, or monitoring of a network, or reporting.

26. I note the Opponent's submission that the contested *cloud computing software* "simply identifies the nature of the software without limit as to its function" and that the software "would encompass 'cloud computing software for use in coal mining operations' and thus ...represents identical goods..." to the *software for use in coal mining operations* of the earlier mark. I disagree. It seems to me that the Opponent has perhaps inadvertently misinterpreted the meaning of *cloud computing software*. The contested *cloud computing software* is software that enables the use of/facilitates access to cloud computing. The terms 'cloud computing' define the type of software rather than the place where the software is made available. Contrary to the Opponent's submission, the type of software is therefore very much limited as to its function, i.e., in relation to cloud computing. As such, the contested *cloud computing software* has a different intended purpose, use and end user to the software of the earlier mark, which is limited as being used in relation to pump stations and coal mining operations.

Class 42

27. The contested services in Class 42 include *software as a service [SaaS]*. The definition of *Software as a service* or *SaaS* is the provision of software via means of subscription. It is a form of cloud computing, whereby software is hosted on a central server and access to users is provided remotely.² *SaaS* has the same intended purpose, use, end user and (often) producer as tangible software, and may also have the same trade channels. In addition, *SaaS* and tangible software may be in competition. It is worth noting that the contested *software as a service [SaaS]* has not been limited or particularised and is therefore considered to be a general category that would not only include more specific types of software as a service, but would also be highly similar to more specific types of tangible software. The contested *software as a service [SaaS]* is therefore highly similar to all forms of software in Class 9 of the earlier mark.

28. The contested services in Class 42 include *Platform as a Services [PaaS]*. *PaaS* is a category of cloud-computing that allows users to manage the combination of a computing platform with computer applications.³ It is a cloud environment that enables the user to deliver applications.⁴ *Applications* and *software* are essentially synonyms or interchangeable wordings. I therefore consider it to be self-evident that a platform system which enables the management and delivery of *applications* would also enable the management and delivery of *software*. The goods of the earlier mark include software, and it is entirely possible that a user of software would also use a platform system that allows the use of software within a cloud environment. The contested *Platform as a service [PaaS]* is therefore highly similar to the software of the earlier mark insofar as they share intended purposes, uses, end users and trade channels. In addition, they may be in competition.

29. The contested services in Class 42 also include services involved in the design, development, programming, implementation, research and integration of software. These contested services have not been limited or particularised as to the type of software they design, develop or programme etc., and are therefore relatively general

² <https://www.collinsdictionary.com/submission/7719/SaaS>

³ https://en.wikipedia.org/wiki/Platform_as_a_service

⁴ <https://azure.microsoft.com/en-gb/resources/cloud-computing-dictionary/what-is-paas/>

categories. The design, development and programming etc., of software is inextricably linked to the end-product of tangible software. Therefore, the contested *Design of software; Design and development of computer software; Software development, programming and implementation; Research and development of computer software; Design and development of software in the field of mobile applications; Computer software integration; and Design and development of computer software architecture* are all highly similar to the earlier mark's tangible software products. In the alternative, the identified services are at least complementary to the software of the earlier mark, as the design, development and programming etc., of software is either indispensable or important to the tangible software itself, such that the average consumer would believe that they originate from the same or economically linked undertakings.

30. I have found the contested *Environmental control software and Environmental monitoring software* in Class 9 to be similar to a high degree with the *software for use in coal mining operations* of the earlier mark. It appears to me to be logical, therefore, that the contested services which relate to the environment are also likely to be similar to the *software for use in coal mining operations*. For example, if the contested *Environmental monitoring software* is similar to the earlier mark's *software for use in coal mining* on the basis that the contested goods could monitor the environment in a coal mine, then the contested *Environmental monitoring services* are also similar as they have the same intended purpose, use, and end user. They could also be in competition. On this basis, the contested *Environmental consultancy services; Environmental monitoring services; Environmental assessment services; Environmental hazard assessment* are found to be similar to between a medium and high degree.

31. I reiterate that I consider the earlier mark's *software for use in coal mining operations* to be so broad that it could extend to all manner of control, monitoring, detection, instruction and management, etc., in the field of coal mining. In my opinion this would likely relate to all environmental considerations of coal mining operations. I therefore find the following contested services to be similar to between a medium and high degree with the *software for use in coal mining operations* of the earlier mark: *Compilation of environmental information; Compilation of information relating to*

environmental conditions; Consultancy services relating to environmental planning; Consultancy services relating to research in the field of environmental protection.

32. The contested services *Sampling for pollution; Environmental testing of noise pollution; Advisory services relating to environmental pollution; Advisory services relating to pollution control; Technical advice relating to pollution damage; Technical consulting in the field of pollution detection; Conducting sampling and analysis services to assess pollution levels* are concerned specifically with pollution. It is conceivable that coal mining creates pollution, including noise pollution. Therefore, the broad scope of *software for use in coal mining operations* could relate to the pollution considerations of coal mining operations. As such, the contested services *Sampling for pollution; Environmental testing of noise pollution; Advisory services relating to environmental pollution; Advisory services relating to pollution control; Technical advice relating to pollution damage; Technical consulting in the field of pollution detection; Conducting sampling and analysis services to assess pollution levels* could overlap in use and end user, and could also be in competition, resulting in a medium degree of similarity.

33. The contested service *Technical data analysis* is a broad category that could extend to the analysis of coal mining's technical data. It therefore has the same intended purpose, use and end user as the earlier mark's *software for use in coal mining operation*, and further it could be in competition. Subsequently, the contested *Technical data analysis* is similar to a medium degree.

34. The contested *IT services* and *Technological services* are broad categories that would include the more specific services that have been found to be similar to either a medium or high degree with the *software for use in coal mining operation* of the earlier mark. It is therefore logical that the contested *IT services* and *Technological services* are similar also.

35. The remaining contested services in Class 42 are *Research relating to data processing* and *Integration of computer systems and networks*. Such services clearly conduct research and integration in relation to subjects that are not covered by the goods in either Class 7 or 9 of the earlier mark. The goods in Class 7 of the earlier mark are either instruments for use in relation to machines, engines or complex

systems, or are the complex systems themselves (e.g., *hydraulic pump stations*). The goods in Class 9 of the earlier mark either relate to pump stations or coal mining operations, or are used to control manufacturing machines (e.g., *PLCs*). In my opinion, the respective goods have clearly different intended purposes, uses, end users and trade channels to the contested services that conduct data processing research or system/network integration. Further, the goods and services at issue are unlikely to be either complementary or in competition with one another, and are therefore found to be dissimilar.

36. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

37. In relation to those contested goods and services which have been found to be dissimilar there can be no likelihood of confusion. Consequently, I will continue with the assessment only in relation to the following contested goods and services:

Class 9 Environmental control software; Environmental monitoring software; Air analysis apparatus; Map software; Augmented reality software for creating maps.

Class 42 IT services; technological services; Design of software; Design and development of computer software; Software development, programming and implementation; Research and development of computer software; Technical data analysis; Design and development of software in the field of mobile applications; Computer software integration; Design and development of computer software architecture; Software as a service [SaaS];

Platform as a Service [PaaS]; Environmental consultancy services; Environmental monitoring services; Environmental assessment services; Environmental hazard assessment; Compilation of environmental information; Compilation of information relating to environmental conditions; Consultancy services relating to environmental planning; Consultancy services relating to research in the field of environmental protection; Sampling for pollution; Environmental testing of noise pollution; Advisory services relating to environmental pollution; Advisory services relating to pollution control; Technical advice relating to pollution damage; Technical consulting in the field of pollution detection; Conducting sampling and analysis services to assess pollution levels.

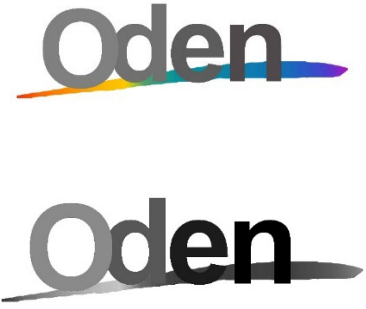
Comparison of marks

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

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

39. 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 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.

40. The respective trade marks are shown below:

Earlier mark	Contested mark
<p>ODIN</p>	

41. The earlier mark consists exclusively of the uppercase word ‘ODIN’, presented in a plain, non-stylised font. In my opinion the word ‘ODIN’ would most likely be recognised by a significant number of consumers as the name of the Norse god of creation, and father of Thor. Alternatively, it may be recognised as a male name that is used predominantly in Nordic countries, or as a seemingly invented term. The overall impression lies exclusively in the perception of word/name ‘ODIN’, which is also where any distinctiveness lies.

42. The contested mark is a series of two marks, each of which consists of the lowercase word element ‘Oden’, and a figurative element of an underlying “brush stroke”. The word ‘Oden’ is presented in different shades of grey in the first mark and a combination of grey and black in the second mark. The word ‘Oden’ has no apparent meaning in any language, and neither party has provided submissions as to a possible meaning during the proceedings. It is therefore likely to be perceived as a seemingly invented word. That having been said, I consider it possible that a certain number of consumers will perceive ‘Oden’ as the name of the Norse god ‘ODIN’. It may be the case that some consumers are aware of the god but are unsure how it is spelt, and would therefore assume that ‘Oden’ is the correct spelling. I also consider it possible that a certain number of consumers may perceive ‘Oden’ as a deliberate misspelling of ‘ODIN’. The figurative “brush stroke” element in the first mark changes colour in accordance with the colour spectrum, from red on the far left to purple on the far right. The figurative element in the second mark is in grey-scale, and changes between

lighter and darker shades of grey intermittently. Whilst the figurative “brush stroke” is certainly noticeable in each mark, it is my opinion that it would most likely be perceived as a decorative flourish. I therefore consider the word element ‘Oden’ to be the more dominant and distinctive element in each of the marks.

Visual similarity

43. The marks are visually similar insofar as they each contain a four-letter word that contains the combination of letters ‘OD-N/Od-n’. The marks differ visually as to the third letter of each respective mark. In addition, each of the contested marks contain a figurative “brush stroke” element, which has no counterpart in the earlier mark. The word elements in each respective mark also use different fonts and casings, although these constitute only minor visual differences. Overall, the marks are considered to be visually similar to between a medium and high degree.

Aural similarity

44. The marks are aurally similar insofar as they each contain two-syllable word elements, and share the first identical sound ‘OD/Od’. The second syllable of each mark contains a different opening vowel, thereby creating a differentiating vocal. However, the sound created by articulating ‘IN’ and ‘en’ is quite similar. In addition, each mark’s second syllables end in the same sound created by the letter ‘N/n’. The figurative element of the contested mark will not be pronounced and therefore has no aural impact. Overall, the marks are considered to be aurally similar to a high degree.

Conceptual similarity

45. The earlier mark contains the concept of the Norse god Odin, which I consider to be the most likely perceived concept. That having been said I accept it as a possibility that a certain number of consumers may be unfamiliar with the god Odin, and may instead perceive the term ‘ODIN’ as either a Nordic male name or a seemingly invented word.

46. The contested marks contain the word ‘Oden’. Neither party has submitted a meaning for the word. In the instances where it is perceived as a seemingly invented term, it must be found to be conceptually dissimilar to the concept of the earlier mark.

47. I have not ruled out the possibility that some consumers may perceive 'Oden' as either a deliberate misspelling of 'ODIN', or (in their mind) as the correct spelling of 'ODIN'. In either of these two scenarios, the contested marks are conceptually highly similar if not identical to the earlier mark, depending on whether the misspelling is perceived to be deliberate or not.

Average consumer and the purchasing act

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

49. 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."

50. Several of the goods at issue have a specific intended purpose, e.g., being for use in relation to hydraulic pump stations, coal mining operations, or controlling the environment. The relevant consumer of such goods will be a person trained in or related to these specific fields and is therefore considered to be a specialist. Whilst several of the goods at issue have not been particularised in regard to their specific intended purpose, they are nevertheless the type of goods which are invariably used for a particular function in a specific field by a specialist. For example, the *Pumps, compressors and fans* in Class 7 and *Programmable Logic Controllers (PLCs)* in Class 9 are not everyday items that are purchased by the average consumer, rather they are

items for use in relation to machines, engines and vehicles etc., and are therefore most likely purchased by a person trained in relation to such equipment.

51. The majority of services at issue (as identified in paragraph 37) are also relatively specialist insofar as they have the particular intended purpose of, for example, designing, developing, programming, implementing and researching software, or testing pollution, or monitoring the environment. Such services are in my view unlikely to be purchased by a consumer without a particular knowledge, understanding, interest or skill in relation to such fields. I therefore consider the relevant consumer of such services to be a specialist with a higher-than-average degree of attention. That having been said, it is worth noting that the contested services also include more “everyday” services such as *Software as a service [SaaS]*, which is essentially online software and applications that users must subscribe to use. Some of the most common types of *SaaS* would include email accounts and music libraries. *SaaS* is therefore an everyday provision insofar as it is used and purchased on a daily basis by the average consumer of the general public, who is not required to pay a heightened degree of attention when purchasing or using such services.

52. Based on the nature of the goods and services at issue, I consider the purchasing process to most likely be visually dominated. Whether the consumer is purchasing software for mapping or is subscribing to software as a service online, for example, the consumer will invariably be examining the visual aspect of the related marks, and would therefore most likely be making a purchase decision based on the visual appearance of the products. I do not entirely dismiss the possibility that the marks may be spoken, for instance, over the telephone or in conversation, and accept that there may also be an aural element to the purchasing process.

Distinctive character of the earlier trade mark

53. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has it filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

54. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

55. The earlier mark consists of a plain word without any additional stylisation or figurative elements, and as such any inherent distinctive character rests exclusively in the meaning of the word ‘ODIN’. The concept of ‘ODIN’ has no apparent relation to the goods and services at issue, whether that be when it is perceived as the name of a Norse god, or as a Nordic male name, or as a seemingly invented term. In the instances when the word ‘ODIN’ is perceived as the Norse god or as a Nordic name it will have a medium degree of distinctive character. In the instances where it is perceived to be an invented term the degree of distinctive character would be higher.

Likelihood of confusion

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

57. 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 (see *Sabel*, C-251/95, para 22). The first is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa (see *Canon*, C-39/97, para 17). Further factors to keep in mind include the distinctive character of the Opponent's trade mark, the nature of the purchasing process, and the average consumer for the goods and services. As regards the average consumer, I must also be alive to the fact that the consumer rarely has the opportunity to make direct comparisons between trade marks, and must instead rely upon the imperfect picture of them that he has retained in his mind.

58. Whilst conducting a global assessment of the likelihood of confusion I must be cogent to the fact that not all aspects of the respective signs will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods or services are marketed, and in which type of store they are made available.⁵ Having conducted a comparison of the marks at issue, I have determined that it is the visual consideration which is of primary importance in the assessment of a likelihood of confusion, due to the purchasing process of the respective goods and services being visually dominated.⁶ With this in mind, it is important to reaffirm that I have found the marks to be visually similar to between a medium and high degree. That having been said, it is also important to reaffirm that I did not rule out the possibility that the marks may be

⁵ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

⁶ *Quelle AG v OHIM*, Case T-88/05

spoken in certain purchasing environments, in which case it is also worth recognising that I found the marks to be aurally similar to a high degree.

59. In *El Corte Inglés*,⁷ the GC noted that the beginning of words tend to make more of a visual and aural impact than the end of words. The marks at issue in these proceedings share the first two letters. The marks also share the last letter which, according to *El Corte Inglés*, acts to reinforce visual similarity. Whilst the sharing of three letters may not appear significant in and of itself, it should be kept in mind that the earlier mark and the word element of the contested marks are only four letters long. In the instances where it is required to conduct a comparison of marks which are relatively short, it has previously been considered that changes within them are more noticeable and substantial than changes in longer marks. I refer to the finding of Mr Iain Purvis QC, acting as the Appointed Person in BL O/277/12:

20 *In considering visual similarity, it was clearly right to take into account the shortness of the marks, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark”.*

60. However, it should be acknowledged that in the same decision Mr Purvis stated “...there could be no basis for laying down some arbitrary rule that ‘short marks differing in only one letter cannot have a high degree of visual similarity’. The right approach as a matter of principle is to consider each case on its own merits.”

61. Mr James Mellor Q.C. (as he then was) also considered the impact of changes in short marks whilst acting as the Appoint Person in BL O/301/20.⁸ He too found that there are no special tests which apply to short marks, and instead indicated that comparisons between even short marks must be conducted according to the approach laid down in the CJEU case law (as cited at paragraph 14).

62. Having considered the findings of Mr Purvis and Mr Mellor, it is my opinion that the marks before me constitute one of those instances whereby the change of one letter does *not* fall into the category of a significant change. Although the third letter of each mark is different, the marks are nevertheless still visually similar to between a medium

⁷ *SA v OHIM*, Cases T-183/02 and T-184/02 paragraphs 81 – 83.

⁸ *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20

and high degree. In addition, I find the change of one vowel from an 'l' to an 'e' to be almost aurally silent in this instance, with the marks being pronounced with a high degree of similarity. It must also not be overlooked that for a certain number of consumers who perceive the Norse god or Nordic male name in both 'ODIN' and 'Oden', the marks will be conceptually identical.

63. I have found the parties' mark to be visually similar to between a medium and high degree, with the visual aspect being the more dominant in the purchasing process. I have also found the marks to be aurally similar to a high degree, and in certain instances conceptually identical. I consider the goods and services at issue to be similar to between a medium and high degree (or in the alternative complementary), and I have identified the relevant consumer of them to include both the average consumer (e.g., *SaaS*) and the specialist consumer (e.g., *software for use in coal mining operations*).

64. Although the level of attention of each type of consumer would invariably change due to the functionality of the specific goods and services, this does not necessarily mean that each type of consumer does not naturally rely upon its own imperfect recollection. It is well-established in case law that the average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind. It is also established in case law that a similar reality afflicts even the more attentive consumer who, despite having a higher level of attention, will not examine the mark before it down to the smallest detail or compare it in minute detail to another mark, as they too rarely have the chance to compare marks directly and must therefore rely upon their own imperfect recollection.⁹

65. Taking into account all of the above factors, including considering that each type of consumer is subject to the impacts of imperfect recollection, I find it entirely possible that upon seeing/hearing the contested marks both types of consumer would mistake them for the earlier mark 'ODIN' that they had seen/heard previously in relation to goods and services that are similar to between a medium and high degree, or complementary. This is because it is my view that the differing letters 'E/l' will be

⁹ *Vetpharma Animal Health v EUIPO Deltavit*, T-146/21, para 121.

mistakenly recalled. I do not consider the decorative “brush stroke” to significantly impact the mind of the consumer to the degree that it would be perceived as an important point of difference, and in the instances where the marks are spoken the “brush stroke” would have no impact at all. Even if the average consumer does recall the “brush stroke” device, it is my view that it will be viewed simply as a decorative device on an alternative mark used by the same or economically linked undertakings. Consequently, there would be a likelihood of indirect confusion.

66. I shall briefly consider the Applicant’s submission that if the only common element between the marks has low distinctiveness, then this would point away from a likelihood of confusion. I acknowledge the principle from *Whyte and Mackay Limited*, however, I disagree that its finding applies to the marks at issue in these proceedings as I do not consider either element ‘ODIN’ or ‘Oden’ to have low distinctiveness in relation to the services at issue.

67. In light of the above, I consider there to be a likelihood of direct confusion in relation to those contested goods services found to be either similar or complementary.

Conclusion

68. The opposition under Section 5(2)(b) is partially successful. Subject to an appeal, the application will be refused for the following contested goods and services:

Class 9 *Environmental control software; Environmental monitoring software; Air analysis apparatus; Map software; Augmented reality software for creating maps.*

Class 42 *IT services; technological services; Design of software; Design and development of computer software; Software development, programming and implementation; Research and development of computer software; Technical data analysis; Design and development of software in the field of mobile applications; Computer software integration; Design and development of computer software architecture; Software as a service [SaaS]; Platform as a Service [PaaS]; Environmental consultancy services; Environmental monitoring services; Environmental assessment services; Environmental hazard*

assessment; Compilation of environmental information; Compilation of information relating to environmental conditions; Consultancy services relating to environmental planning; Consultancy services relating to research in the field of environmental protection; Sampling for pollution; Environmental testing of noise pollution; Advisory services relating to environmental pollution; Advisory services relating to pollution control; Technical advice relating to pollution damage; Technical consulting in the field of pollution detection; Conducting sampling and analysis services to assess pollution levels.

69. Also subject to an appeal, the application will proceed to registration for the contested goods and services found to be dissimilar, namely:

Class 9 *Computer software for application and database integration; Collaboration software platforms [software]; Cloud network monitoring software; Cloud computing software; and Reporting software.*

Class 42 *Research relating to data processing; Integration of computer systems and networks.*

COSTS

70. Although the Opponent has not been wholly successful, it has nevertheless successfully opposed a substantial number of the applied for goods and services. I therefore consider it appropriate to award the Opponent a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Opponent the sum of £800.

Filing a notice of opposition and considering the counterstatement	£400
Preparing submissions	£400
Total	£800

71. I therefore order NGIS CHINA LIMITED to pay RMI Pressure Systems Limited the sum of £800. 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 5th day of May 2023

Dafydd Collins
For the Registrar
The Comptroller-General