

IN THE MATTER OF APPLICATION NO. 2338980 IN THE NAME OF METRIX
ELECTRONICS LTD

AND IN THE MATTER OF OPPOSITION NO. 92227 THERETO BY CHAUVIN
ARNOUX

DECISION

Introduction

1. On 26 July 2003 Metrix Electronics Ltd applied to register the following trade mark (“the applicant’s Mark”):



2. The application was in respect of the following goods in Class 9:

Digital multimeters; analogue multimeters; air/humidity testers; airflow testers; oscilloscopes analogue and digital; clamp meters analogue and digital; power meters; panel meters analogue and digital; voltage detectors analogue and digital; thermometers; satellite field strength meters; function generators; frequency counters.
3. The application was subsequently opposed by Chauvin Arnoux on the sole ground that registration of the applicant’s Mark was precluded by section 5(2)(b) of the Trade Marks Act 1994 having regard to the opponent’s earlier

Protected International Trade Mark (UK) No. 797522 MULTIMETRIX (“the opponent’s Mark”) registered in respect of the following goods in Class 9:

Scientific, surveying, electric (including by wireless telegraphy), photographic, cinematographic, optic, weighing, measuring, signalling, monitoring, rescue and teaching apparatus and instruments; coin or token-operated automatic apparatus; speaking machines, cash registers, calculators; fire extinguishers; but not including apparatus, instruments or equipment for providing, maintaining, validating and identifying security features on items nor including optical apparatus, instruments, devices and elements.

4. Both parties filed evidence, but neither asked for a hearing or even made written submissions. In a written decision dated 29 November 2005 (O/310/05) John MacGillivray acting for the Registrar upheld the opposition. The applicant now appeals.

Matters not in issue

5. Most of the evidence filed by both parties in this case is directed to issues other than the ground of opposition relied upon by the opponent. It is therefore necessary to emphasise that the following matters are either not in issue at all upon the parties’ statements of case or are irrelevant to the issue raised by the opponent’s ground of opposition:
 - (1) the respective rights of the parties to the goodwill connected with the trade mark METRIX in the United Kingdom;
 - (2) the validity of the opponent’s Mark having regard to such rights as the applicant may have in the goodwill connected with the trade mark METRIX in the United Kingdom;
 - (3) the validity of the opponent’s Mark having regard to earlier United Kingdom Registered Trade Mark No. 2043960 METRIX ELECTRONICS PLC;

- (4) whether the applicant is rightfully registered as the proprietor of registration No. 2043960.
6. With regard to points (2) and (3) I would emphasise that, as the hearing officer pointed out, the opponent's Mark benefits from a statutory presumption of validity under section 72 of the 1994 Act. It would have been open to the applicant to apply for a declaration of invalidity of the opponent's Mark and to request that that application be heard together with these proceedings, and furthermore to argue that the contentions advanced by the opponent in support of the opposition if correct would equally support the contention that the opponent's Mark was invalid over registration No. 2043960; but it did not do so.

Section 5(2)(b)

7. Section 5(2)(b) provides:

A trade mark shall not be registered if because ... 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 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.

The hearing officer's decision

8. The hearing officer began by directing himself in accordance with the Registrar's standard summary of the jurisprudence of the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881. This summary is very well known and it is unnecessary to repeat it here.

9. Next the hearing officer observed that there was no real evidence of use of the opponent's Mark. Accordingly he proceeded on the basis that it was an unused mark. He went on to point that this was therefore not a case in which one could draw any conclusions as the likelihood of confusion from concurrent use of the marks in issue.
10. So far as the goods covered by the respective specifications were concerned, the hearing officer held that they were identical and/or closely similar.
11. As to the comparison between the respective marks, the hearing officer held as follows:
 52. The mark in suit consists essentially of the words METRIX ELECTRONICS (there is some slight stylisation to the letter e in the words) and the words are imposed upon a "wavy" line. I have no doubt that the dominant, distinctive component of the mark is the word METRIX, which although possibly alluding to the obvious dictionary word METRIC, is nevertheless distinctive. The word ELECTRONICS is, of itself, not distinctive in relation to the goods, while the "wavy" line, although an integral and visually significant component of the mark, is a secondary element in relation to the words.
 53. The opponent's earlier registration consists of the invented word MULTIMETRIX. While the mark comprises one word I believe it would be obvious to the average consumer that the prefix MULTI comprises a well-known combining form and is conjoined to the invented word METRIX.
 54. I turn to a visual and aural comparison of the respective marks. The dominant, distinctive component of the applicant's mark (the word METRIX) is clearly combined within the opponent's earlier registration (the word MULTIMETRIX) and given that the prefix MULTI is an obvious or well known combining form conjoined to the word METRIX, it is my view that the respective marks are as a whole closely similar.
 55. Next, a conceptual comparison of the marks. As both marks contain invented words they do not possess a clearly defined conceptual identity. However, both marks share the distinctive letters METRIX and given the position of these letters in the applicant's mark and their overall impact within the opponent's mark, it seems to me that there is some conceptual similarity overall.
12. As to the average consumer the hearing officer held as follows:

56. In my considerations I must also consider the relevant customer for the goods and services. In these proceedings it seems to me that the relevant customer would be largely businesses users as opposed to the public at large. This is certainly not a bag of sweets case and it seems to me that the goods are likely to be purchased with a good degree of care.

13. The hearing officer expressed his overall conclusion as follows:

57. I now go to a global appreciation of the likelihood of confusion. The respective goods and services are identical and/or closely similar and given the prominence of the letters METRIX in the opponent's MULTIMETRIX mark, the respective marks are visually, aurally and conceptually similar as a whole. Notwithstanding that the customer for the goods and services would be relatively careful and discerning, it is my view that the applicant's mark would capture the distinctiveness of the opponent's trade mark in the market place and that there is a likelihood of confusion to the relevant customer.

58. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

‘Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive’ (*see Sabel*).

59. The opposition under Section 5(2)(b) of the Act is successful.

Standard of review

14. This appeal is a review of the hearing officer's decision. The hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

The appeal

15. The statement of case filed in support of the applicant's appeal by the applicant's trade mark attorneys seeks to revive a number of matters which the hearing officer disregarded and which as I have explained above I consider to be irrelevant to the opponent's ground of opposition.
16. The sole contention advanced by the statement of case that is relevant to that issue is that the respective trade marks are clearly distinguishable because there are differences in presentation and pronunciation. The statement of case does not even attempt to identify an error of principle on part of the hearing officer. Indeed, it concludes by requesting that the case be "reheard and reconsidered". I regret to say that this reveals a misapprehension as to the function of this tribunal.
17. Nevertheless I have considered the hearing officer's reasoning with care. Having done so I am unable to detect any error of principle in his approach. Moreover I consider that the conclusion which he reached was clearly one that was open to him on the facts of the case.

Conclusion

18. The appeal is dismissed.

Costs

19. The hearing officer ordered the applicant to pay the opponent £1,200 as a contribution to its costs below. I will order that the applicant pay the opponent the additional sum of £300 as a contribution to its costs of the appeal.

25 July 2006

RICHARD ARNOLD QC

Peter Rummer of the applicant appeared in person.

Alastair Rawlence of Mewburn Ellis LLP appeared for the opponent.