

O-341-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2643970
BY FROST EV SYSTEMS LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 & 42:**

WiCAN

AND

**OPPOSITION THERETO (NO. 400273)
BY PARKER HANNIFIN MANUFACTURING SWEDEN AB**

The background and the pleadings

1) Trade mark application 2643970 was filed by Frost EV Systems Ltd (“the applicant”) on 8 November 2012. The mark consists of the word: **WiCAN**. It was published in the Trade Marks Journal on 15 February 2013 in respect of:

Class 9: Electrical and electronic measuring, control, communication and regulating devices; Computer software; Applications for portable communication devices; and programs for electronic data mining, processing, analysis, prediction, control and regulation.

Class 42: Scientific and technological advisory and research services; design and development services of computer hardware and software; industrial analysis, installation, maintenance of computer software, consultancy services.

2) Parker Hannifin Manufacturing Sweden AB (“the opponent”) opposes the registration of the mark. The opponent is the proprietor of the following earlier mark:

Community trade mark (“CTM”) registration 799924

IQAN

Class 9: Electronic control system for controlling and monitoring of machine operations including mobile applications, parts, components and fittings therefore.

Filing date: 16 April 1998

Date of entry in register: 19 October 1999

3) The opponent relies on the above mark as the basis for grounds of opposition under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). It also relies on the use (since 1996) of a sign corresponding to the earlier mark as the basis for a ground of opposition under section 5(4)(a).

4) The applicant filed a counterstatement denying the grounds of opposition. Furthermore, given that the opponent’s earlier mark completed its registration process more than five years before the publication of the applicant’s mark, the applicant put the opponent to proof of use of the registration as per section 6A of the Act. Both sides filed evidence. Neither side requested a hearing. Neither side filed written submissions in lieu of a hearing, but I will take into account the arguments that the parties have made in the various papers before me.

The evidence

For the opponent – Ms Jacqueline McKay

5) Ms McKay is a trade mark attorney at Murgitroyd & Company, the opponent's representatives in this matter. She states that her evidence comes from either publically available information or from the opponent's records.

6) Information about the opponent is given, in short, it specialises in “engineered components and systems, and in motion and control technologies”. It is stated that the opponent's parent company is a world leader in motion and control technologies in various fields. Information about the parent company is provided in Exhibit JM1.

7) The original IQAN product was called **IQAN CAN**; CAN apparently stands for “controller area network”. The original product was developed by a small Swedish company sometime between 1990 and 1995. The first product was launched on the market (which market is not clear) in 1995 and then the product was acquired by a Swedish company called VOAC Hydraulics, who were, in turn, acquired by the opponent in February 1996. IQAN was then integrated into the opponent's product range of system components and electronic control systems for mobile machinery.

8) Ms McKay states that the opponent has been applying the IQAN mark to the above goods for distribution in the UK and further afield since 1996. Exhibit JM2 consists of what Ms McKay describes as “a presentation by the Opponent, explaining examples of its IQAN software products, its IQAN applications for communications devices, and its programs for electronic data mining, processing, analysis and prediction, control and regulation, and other goods...” Ms McKay does not explain the circumstances in which this presentation was created or where/when it was delivered. One of the slides relates to the applicant's products and why they are similar to those of the opponent. Given this, it appears that the presentation may have been created for the purpose of these proceedings, with someone in the opponent company putting together some information for Ms McKay to file with her evidence. It would have been better for Ms McKay to have explained this. It would also have been better for the person who has given this information to have filed evidence themselves as I take the view that this is essentially second hand evidence and constitutes hearsay. The presentation contains a number of slides, the most useful of which sets out what IQAN products actually do. They are used for controlling things such as machinery and fork lifts and the goods themselves range from communication devices, joysticks, system displays and software. The slide relating to the applicant's product shows an extract from some of its publicly material showing that WiCAN is a wireless communication platform to enable communication between a mobile device and a controller area network (CAN). The slides also show that in the 90s there was an IQAN mobile communication system for controller area networks that

operated via a mobile phone. There is nothing in any of the slides about the extent of use.

9) Ms McKay states that the IQAN product range has expanded since 1996. She considers that the IQAN mark has a significant reputation in the UK for motion and control technologies and related engineering services. Exhibit JM3 contains a list of IQAN product codes. There are over 100. In Exhibit JM4 there are “recent and current UK product data sheets”. They are more like product brochures. The IQAN mark features prominently throughout. The goods include software, display modules, control systems (including joysticks), gateways and various parts such as cables for all of this. It is difficult to place any of the brochures to a particular point in time.

10) Ms McKay states that the “UK accounts for 7% of the opponent’s global market for its IQAN products” she does not, though, explain what the figure is or what the global IQAN figures are. Ms McKay does not say in what period this is. Exhibit JM5 contains brochures for the opponent’s IQAN products which are said to be available in the UK. It is difficult to clearly date them, although, I note that one carries a copyright date of 2010-2012 and another 2002-2010. They detail similar goods to that already described.

11) Exhibit JM6 contains a print from the applicant’s website from which Ms McKay notes that the goods enable two way secure wireless communications between a mobile device and a CAN and that one of its functions is “to create bespoke applications for displaying vehicle data and controlling vehicle functions”. Ms McKay refers to her exhibit JM7 which shows a brochure (undated) for IQAN goods which are used in vehicles to control certain functions and provides certain data about the vehicle; it is stated that these are used in the UK.

12) Ms McKay states that IQAN products can be used to control (etc) CAN based hydraulic systems e.g. mobile fork lift systems. IQAN products include software and wireless tools for data processing, measurement control and regulation of such systems. Exhibit JM8 contains the opponent’s “current” leaflet “IQAN Electronic Control Made Easy” which Ms McKay states shows IQAN being used in the UK on a large range of goods (goods which mirror those already described). I note that at the end of this exhibit there is a page headed “Examples of Advertisement Material in the UK”. The page is not mentioned by Ms McKay but it does include the dates of publication for some of the documents she has provided in evidence. The publication date of the brochure in Exhibit JM8 is 2012. Eight other documents are dated, but they are all before the relevant periods except for a “Sales Brochures (Green)” which was published in 2011 and a press release “IQAN-MC3” which was published in 2011. I will come on to the press release shortly, but with regard to the “Green” sales brochure, it is difficult to see which part of the evidence this relates to, none of the brochures are in green, although one is in black and white so it could be this.

13) The final exhibit is JM9 which contains two press releases, the first is from 1999, the second (if the information in JM8 is correct) is from 2011. The latter is about a new hydraulics controller designated IQAN-MC3, no information is given to show what exposure this press release received.

For the applicant – Mr Christian Bunke

14) Mr Bunke describes himself as “agent of the applicant”. He works for an IP company called Basck Ltd. His evidence comes from publically available information and from the records and website of the applicant. He states that the applicant’s WiCAN software product will be sold in the iStore and will run on iPhone and iPad devices. The exhibit to Mr Bunke’s evidence contains prints from the applicant’s website and mirrors that filed by the opponent.

15) Mr Bunke also filed a comprehensive set of written submissions. All the points will be borne in mind. I return to some of them later, but in relation to the opponent’s evidence of use, Mr Bunke makes a number of observations including: that much of what Ms McKay states is mere assertion, the lack of dates on the various documents, that there is a lack of evidence of UK sales, the lack of focus upon the relevant period, the lack of evidence of distribution (of the brochures for example).

Proof of use

16) The use conditions are set out in Section 6A of the Act as follows:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

17) Section 100 is also relevant; it 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.”

18) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

19) The earlier mark is a CTM. Therefore, although in his written submissions Mr Bunke refers to genuine use in the UK, the actual issue relates to genuine use in the EC. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV C-49/11* (“*ONEL*”) the CJEU stated:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the

mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

20) Regarding the territorial scope of the use, the CJEU went on to state:

“52 Some of the interested persons who have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what

territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

Genuine use

21) The relevant period for the proof of use assessment is the five year period ending with the date on which the applicant's mark was published, namely: 16 February 2008 to 15 February 2013. The applicant has made a number of criticisms of the opponent's evidence. I agree that there are a number of flaws. Ms McKay makes a number of assertions that use has been made in the UK since 1996 onwards, but she provides no evidence focused upon the relevant period. There are no turnover figures, there are no advertising figures. There is no specific evidence of advertising. In terms of the relevant period, there is one press release, but it is not known what impact this had and how many people would have encountered it. There are a number of what can be described as brochures, but as observed in my evidence summary, the dates are not clear and even taking into account the information provided in Exhibit JM8, most of the material provided is from before the relevant period. Whilst the "IQAN Electronic Control Made Easy" leaflet appears to have been published in 2012, no information is given as to how many copies of this brochure were produced and to whom and where it was circulated. Again, as I have already said, the only other brochure is the Green sales brochure and it is difficult to see what this relates to, and, furthermore, the same observations made about the preceding brochure applies here. Ms McKay mentions the UK a lot, but whilst use in the UK may constitute genuine use in the EC, it would have been better to have a clearer understanding of the actual geographical spread of use. The company is a Swedish one, but, again, there is little evidence to understand the scale of any use in that Member State. In *Catwalk* BL O/404/13 Mr Hobbs QC, sitting as the Appointed Person stated:

"22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use. As to which see paragraphs [17] to [19] and [24] to [30] of the Decision of Mr. [Daniel] Alexander QC sitting as the Appointed Person in *PLYMOUTH LIFE CENTRE* Trade Mark (BL O-236-13; 28 May 2013)."

22) Deficiencies in individual pieces of evidence can often be overlooked if the fabric of the evidence, considered holistically, supports genuine use. However, in the case before me there seems to be far more holes in the fabric as there is substance. For example, Ms McKay states that the “UK accounts for 7% of the opponent’s global market for its IQAN products” but the question that arises is 7% of what? Whilst there is an earlier claim about the parent company’s global turnover, this is not a figure that relates to IQAN goods alone. The evidence provided in this case illustrates the inherent danger in a trade mark attorney filing evidence on behalf of the company it represents – evidence from the horse’s mouth is always likely to produce a better, more informed set of evidence from which objective assessments may be made. To constitute genuine use it must be “..exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market”, the market in this case is the EC market for the goods concerned. I come to the view that the opponent has failed to establish genuine use. **This means that the opponent’s earlier mark may not be relied upon and, consequently, the grounds of opposition under sections 5(2)(b) and 5(3) must fail.**

23) Despite the above finding, and in case I am found to have been wrong on my proof of use assessment, I will nevertheless consider whether, had genuine use been shown, the grounds of opposition under sections 5(2)(b) and 5(3) would have succeeded or not. When making that assessment, the specification as registered seems to me to represent a fair specification that is not pernickety¹ and takes into account how the relevant public are likely to describe the goods². In coming to this view I have also borne in mind the guidance given by the General Court in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03.

Section 5(2)(b)

24) Section 5(2)(b) of the Act states that:

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

..

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

25) The CJEU has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person,

¹ See *Animal Trade Mark* [2004] FSR 19.

² See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

quoted with approval the following summary of the principles which are established by these cases¹:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

26) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can, of course, vary depending on what is involved.

27) The earlier mark covers goods for a very specific and specialised purpose. They will not be consumed by members of the general public but, instead, by businesses that use machinery. The products are important ones that control the operation of said machines, so issues of function, compatibility and reliability will increase the level of care which will be used when the goods are selected. Therefore, a careful selection process will be adopted. These are the sorts of goods that will be perused in product brochures and on websites so the visual impact of the mark will take on more significance. I will not, though, ignore any aural similarity altogether because the goods may be subject of discussions at meetings etc.

28) The applicant's specification is phrased more broadly and could include goods purchased by the general public. However, where there is likely to be conflict between the goods and services, this will be in areas where the same or similar type of average consumer will be involved; again, a fairly careful approach to selection being adopted.

The competing goods and services

29) When comparing the respective goods and services, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 – "Meric"*) even if there are other goods within the broader term that are not identical. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

30) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

31) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

32) In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory

approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

33) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

34) The earlier mark covers:

Class 9: Electronic control system for controlling and monitoring of machine operations including mobile applications, parts, components and fittings therefore.

35) I will go through the applied for goods and services term by term (grouping them when necessary):

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

Electrical and electronic measuring, control, communication and regulating devices

36) This term covers goods which could potentially be used for controlling machine operations. As such, the goods are either identical or highly similar when the purpose, methods of use, nature etc is considered. The applicant highlights in its submissions that its actual goods of interest are for use with vehicles. This may reduce the similarity (if such a fact were to be recorded in the specification) but I still consider these goods to be reasonably similar as the term vehicles would include vehicles for industrial applications which are not a million miles away from machine operations.

Computer software; Applications for portable communication devices; and programs for electronic data mining, processing, analysis, prediction, control and regulation.

37) The above goods could be used in relation to machine operations and thus very similar to the goods of the earlier mark. Even though the opponent's goods do not specifically mention software, it could clearly form part of the "control system" it is registered for. The purposes specified in the applied for terms either mirror or complement the purposes of the goods of the earlier mark. The goods are highly similar and, as already observed, even in the vehicular field there is still a reasonable degree of similarity.

Scientific and technological advisory and research services; design and development services of computer hardware and software; industrial analysis, installation, maintenance of computer software, consultancy services.

38) The argument here could be that all of these services may be in the field of the control of machine operations. However, all the terms strike me as discrete services offered business to business and are not clearly associated with control of machine operations. Bearing in mind the core of the services applied for, I do not consider the services to be similar to the opponent's goods.

Comparison of marks

39) The competing marks are:

IQAN

and

WiCAN

40) From a visual perspective, both marks end with the letters –AN, and both have an I/i in them (albeit in different positions). However, one mark is shorter than the other, and the beginnings look very different indeed. I come to the view that the differences far outweigh the similarities and the marks are not visually similar to each other. If this is wrong then any similarity is very superficial.

41) From an aural perspective, both marks have a number of potential pronunciations. IQAN could be pronounced as EYE-CAN, EYE-KWAN, I (as in the beginning of IT)-CAN/KWAN. WiCAN may be pronounced as in WHY-CAN or WHI-CAN. Regardless of which pronunciation is adopted, there is a reasonable degree of similarity because there is either a very similar or identical end syllable (depending on exact pronunciation) and a similar initial syllable.

42) Both sides' evidence mentions that CAN stands for CONTROLLER AREA NETWORK. Therefore, in relation to goods which are for use with controller area networks, the specialist consumers involved will regard WiCAN as a made up word but one based on CAN technology. This concept will not be present in the IQAN marks as it will be seen purely as an invented word – although QAN is phonetically similar to CAN, to get the same conceptual message from the mark as a whole requires too great a degree of analysis. This could be said to create a conceptual difference, but given that neither mark has a concept in totality, the position is probably more neutral than that. Both sides' goods could potentially be used in fields which do not involve CAN which means that both marks will be perceived as invented, so, again, the conceptual comparison is neutral.

The distinctiveness of the earlier mark

43) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent perspective, I consider IQAN to be highly distinctive, it makes no allusion to the goods for which it is registered and will be perceived as an invented word. In terms of the use made, this does not advance the opponent's position; as I have already described, the evidence falls short of establishing genuine use, let alone any form of reputation.

Likelihood of confusion

44) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

45) As the applicant points out in its written submissions, and as I have already held, the goods under discussion are to be purchased by specialised and skilled individuals. A careful and considered approach will be adopted. It seems to me that when this is borne in mind the very low (if any) degree of visual similarity will not result in a likelihood of confusion. I have considered that the marks are closer from an aural perspective, but it seems to me that this is not sufficient because the careful selection process that I have described will rely more on visual than aural considerations and even when the marks are being spoken, the visual aspects will almost certainly have already been noted. **There is no likelihood of confusion and the opposition under section 5(2)(b) fails.**

Other grounds of opposition

46) I will deal with these grounds briefly. This is because I do not consider the opponent is in any better position for the following reasons:

- i) In relation to section 5(3), the opponent has not established (for the reasons I have already given) the requisite reputation. In any event, the differences between the marks are, in my view, unlikely to result in the earlier mark being brought to mind.
- ii) In relation to section 5(4)(a), the marks/signs at issue are the same as the comparison already made and, therefore, even if the opponent possessed a goodwill, for similar reason to that already given, there would be no misrepresentation.

47) The grounds under sections 5(3) and 5(4)(a) are hereby dismissed.

Costs

48) The applicant has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side's statement - £300

Considering the opponent's evidence and filing evidence - £500

Written submissions (filed with its evidence) £400

Total - £1200

49) I hereby order Parker Hannifin Manufacturing Sweden AB to pay Frost EV Systems Ltd the sum of £1200 within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of August 2014

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).