

O/804/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3345857 BY
YAN-HER LIN
TO REGISTER:**



PILOTFLY

AS A TRADE MARK IN CLASSES 9 & 35

AND

**OPPOSITION THERETO
UNDER NO. 415234 BY
MARCUS OSWALD**

Background & Pleadings

1. **Yan-Her Lin** (“the applicant”), applied to register the (figurative) trade mark shown on the front page of this decision in the United Kingdom on 16 October 2018. It was accepted and published in the Trade Marks Journal on 26 October 2018 in respect of the following goods and services:

Class 9: Stands for photographic apparatus; Tripods for cameras; Camera straps; Cases adapted for cameras; Cases for photographic apparatus; Car video recorders; Fluorescent screens; Lens hoods for cameras; Neon signs; Electronic notice boards; Carrying bags specially adapted for holding or carrying portable computers; Bags adapted for laptops; Instrument to facilitate text-messaging in the nature of a stylus-type device that is attached to the hand for use in conjunction with personal digital assistants; Cell phone battery chargers; Electric cables for the transmission of sounds and images; Electric charging cables; Wireless communication devices for voice, data or image transmission; Optical filters for screens; Keyboards.

Class 35: Advertising on communication media for retail purposes; Goods import-export agencies; Auctioneering provided on the internet; Organization of exhibitions for commercial or advertising purposes; Wholesale ordering services; Online retail store services relating to photographic instruments; Retail store services in the field of photographic instruments; Wholesale services relating to photographic instruments.

2. **Marcus Oswald** (“the opponent”) opposes the application on the basis of Sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The

opponent is the proprietor of EUTM registration number 15378185¹ for the following figurative mark:



3. The mark was filed on 27 April 2016 and registered on 20 October 2016 for various goods and services in Classes 9 and 35 as shown later in this decision. For the purpose of this opposition, the opponent relies on all goods and services as covered by his registration.
4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's earlier mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. The opponent, in his notice of opposition, claims that the contested mark is identical to the earlier mark and the goods listed in the applicant's specification in Class 9 "are identical and/or highly similar" and the services are all identical "because all services of both trademark[s] are connected to wholesale and retail services". Therefore, registration of the contested mark should be refused under Sections 5(1) and 5(2)(a) of the Act.
6. The applicant filed a defence and counterstatement, denying all the grounds of the opposition. The applicant also states that "[...] this [earlier]

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the opposition was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.

registration is subject to cancellation proceedings which are currently in progress at the EUIPO.”

7. I note that the present opposition relies on a mark that is subject to an invalidation application at the EU Intellectual Property Office (EUIPO). In this regard, if my decision is to uphold the opposition, my decision will be provisional only, pending the outcome of the EU proceedings.
8. None of the parties filed evidence. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate throughout this decision. Neither party requested a hearing. Thus, this decision has been taken following a careful consideration of the papers.
9. In these proceedings, the opponent is represented by RDP Roehl Dehm & Partner Rechtsanwälte mbB and the applicant is represented by Roland Wilding.
10. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Decision

Sections 5(1) and (2)(a)

11. Section 5(1) of the Act states:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

12. Section 5(2)(a) of the Act is as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

13. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Trade Marks

- 14. It is a pre-requisite of Sections 5(1) and 5(2)(a) that the marks be identical. I will begin by assessing whether they are identical within the meaning of the case law.
- 15. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, Case C-291/00*, the Court of Justice of the European Union (“CJEU”) held that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”
- 16. The marks to be compared are:

Earlier Mark	Contested Mark
	

- 17. Both the earlier and the contested marks are figurative marks, consisting of the verbal element “PILOTFLY” in a stylised font, and a triangular device appearing inside the letter ‘O’ resembling the ‘play icon’. It is self-evident that these two marks are identical.

Comparison of Goods and Services

18. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

“23. 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 complementary.”

19. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

20. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

22. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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) (IP TRANSLATOR)* [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.”

23. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

25. The competing goods and services to be compared are shown in the following table:

Opponent's Goods & Services	Applicant's Goods & Services
<p>Class 9: Batteries; Batteries, electric; Electric batteries for powering electric vehicles; Camera tripods; Camera flashes; Camera filters; Pouches for photographic apparatus; Slings for cameras; Camera closures; Shutter releases [for cameras]; Camera bipods; Tripods for cameras; Light filters for cameras; Lens filters for cameras; Protective caps for cameras; Viewfinders [for cameras]; Self-timers [for cameras]; Camera mounts; Photographic lenses; Tilting heads [for cameras]; Memory cards for cameras; Camera monopods; Camera covers; Camera casings; Bags designed for cameras and camera tripods; Bags designed for photographic equipment; lens hoods for cameras; Audiovisual apparatus; Lithium ion batteries; Power packs [batteries]; Software; Control segment integration software; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Software programmable microprocessors; Rechargeable batteries; Electric cables; Umbrellas for photographic use</p>	<p>Class 9: Stands for photographic apparatus; Tripods for cameras; Camera straps; Cases adapted for cameras; Cases for photographic apparatus; Car video recorders; Fluorescent screens; Lens hoods for cameras; Neon signs; Electronic notice boards; Carrying bags specially adapted for holding or carrying portable computers; Bags adapted for laptops; Instrument to facilitate text-messaging in the nature of a stylus-type device that is attached to the hand for use in conjunction with personal digital assistants; Cell phone battery chargers; Electric cables for the transmission of sounds and images; Electric charging cables; Wireless communication devices for voice, data or image transmission; Optical filters for screens; Keyboards.</p>
<p>Class 35: Retailing and wholesaling, including via the internet, in relation to batteries; electric batteries; Electric batteries for powering electric vehicles; camera tripods; Camera flashes; Camera filters; Camera drones; Camera cases; Camera straps; Camera shutters; Camera shutter releases; Camera bipods; Tripods for cameras; Light filters for cameras; Lens filters for cameras; Protective caps for cameras; Viewfinders for cameras; Self-timers for cameras; Holders for cameras; Lenses for</p>	<p>Class 35: Advertising on communication media for retail purposes; Goods import-export agencies; Auctioneering provided on the internet; Organization of exhibitions for commercial or advertising purposes; Wholesale ordering services; Online retail store services relating to photographic instruments; Retail store services in the field of photographic</p>

cameras; Swivel heads for cameras; Memory cards for cameras; Monopods for cameras; Covers for cameras; cases for cameras; Bags designed for cameras and camera tripods; Bags designed for photographic equipment; Lens hoods for cameras; audio-visual apparatus; Lithium-ion batteries; Power packs (batteries); Software; Control segment integration software; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, sound, graphics, still images and moving pictures; Software programmable microprocessors; Rechargeable batteries; electric cables; Screens (photography).	instruments; Wholesale services relating to photographic instruments.
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26. The opponent made submissions in relation to the identity and/or similarity of the respective goods and services, which I have considered in this decision. In particular, the opponent submitted that all of his goods and services are identical, also claiming similarity for the following goods:

b. Similar goods	
Opponents goods	Applicants goods
Batteries; Batteries, electric; Electric batteries for powering electric vehicles; Camera tripods; Camera flashes; Camera filters; Pouches for photographic apparatus; Slings for cameras; Camera closures; Shutter releases [for cameras]; Camera bipods; Tripods for cameras; Light filters for cameras; Lens filters for cameras; Protective caps for cameras; Viewfinders [for cameras]; Self-timers [for cameras]; Camera mounts; Photographic lenses; Tilting heads [for cameras]; Memory cards for cameras; Camera monopods; Camera covers; Camera casings; Bags designed for cameras and camera tripods; Bags designed for photographic equipment; lens hoods for cameras; Audio-visual apparatus; Lithium ion batteries; Power packs [batteries]; Software; Control segment integration software; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Software programmable microprocessors; Rechargeable batteries; Electric cables; Umbrellas for photographic use.	Car video recorders; Fluorescent screens, Neon signs; Electronic notice boards; Carrying bags specially adapted for holding or carrying portable computers; Bags adapted for laptops; Instrument to facilitate text-messaging in the nature of a stylus-type device that is attached to the hand for use in conjunction with personal digital assistants; Cell phone battery chargers; Keyboards. Optical filters for screens;

For these similar goods, the opponent also contends that they “are connected to camera or video equipment, so these goods have the same purpose and are supplied through the same channels, so they are highly similar. All goods are equipment for photographs so they are used by the

same people and especially are complementary products. [sic]” As for the identical goods and services, the opponent claims that “the wholesale services [...] includes [sic] exhibitions, auctions or import export, because all this services are part of wholesaling or retailing. [sic]”

27. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

Stands for photographic apparatus; Lens hoods for cameras; Tripods for cameras

28. As there are identical counterparts of the contested terms “*tripods for cameras*” and “*lens hoods for cameras*” in the opponent’s specification, the respective goods will be identical.
29. In relation to the contested term “*stands for photographic apparatus*”, such goods will be encompassed by the broad term of the opponent’s “*camera mounts*” which includes a wide range of items that are used to support or stabilise cameras. Thus, the respective goods will be identical as per the *Meric* principle.

Camera straps

30. The contested term is ostensibly identical to the opponent’s term “*slings for cameras*”, which is an alternative term for the same goods.

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Cases adapted for cameras; Cases for photographic apparatus

31. The contested terms are identically worded or are ostensibly the same as the opponent's terms "*camera covers; camera casings*". Therefore, I find them to be identical on the basis set out in *Meric*.

Car video recorders; Electronic notice boards

32. The contested goods are encompassed by the broad term of the opponent's "*audiovisual apparatus*" as they are all audio-visual devices of some sort. Thus, I find them to be identical in agreement with the *Meric* principle.

Fluorescent screens

33. There is no evidence or submissions to guide me as to the term "*fluorescent screens*". From my experience, such goods might include monitors/displays, such as LCD TVs and computer monitors, lit with fluorescent technologies. In this regard, the opponent's "*audiovisual apparatus*" goods will cover the applicant's goods, which means I find them to be identical as per *Meric*.
34. If I am wrong on that and the term "*fluorescent screens*" is not akin to "*audiovisual apparatus*", the competing terms would certainly cover fluorescent screens such as backdrops which could be used for photography purposes. Whilst the opponent's goods do not cover screens per se, they do cover a range of photographic equipment, and there seems to be a complementary relationship between the goods. Whilst the nature and purpose of the goods would not be the same, the complementarity means that the users and channels of trade are likely to be the same; as such, as a fall-back, I find there to be a low level of similarity.

Electric cables for the transmission of sounds and images; Electric charging cables

35. The contested goods are electric cables that are encompassed by the broad term of the opponent's "*electric cables*", and I find them to be *Merici* identical.

Cell phone battery chargers

36. The contested goods are accessories that recharge the battery of mobile devices. These are similar to the opponent's "*batteries*" and "*rechargeable batteries*" as the batteries are a key component of cell phones (re)charged by the contested goods. Thus, there is a prominent complementary relationship between the goods. Further, the respective goods could be sold through the same trade channels. Therefore, they are similar to a medium degree.

Carrying bags specially adapted for holding or carrying portable computers; Bags adapted for laptops

37. There is some similarity between the contested goods and the opponent's "*bags designed for cameras and camera tripods; bags designed for photographic equipment*". The nature of both will likely be the same and they coincide in the general purpose, as they are bags aiming at carrying or protecting electronic devices. The method of use is the same and there might be an overlap in trade channels as it is usual for such goods to be sold in the same electronics shops. The goods are not complementary or in competition. I find there to be similarity to a medium degree.

Wireless communication devices for voice, data or image transmission

38. The contested goods cover devices that generally facilitate the wireless communication not only of audio but also the transmission of data, including images. Whilst the opponent's goods do not cover such goods

per se, they do cover a range of goods, which might be connected to wireless communication devices in order to facilitate data transfer. As such, there is an overlap in users and trade channels, as the goods will be likely sold in close proximity in electronics stores/retailers. It is likely, in my view, for the existence of a complementary relationship in the sense that some of the applicant's goods may be used in conjunction with the opponent's goods in such a way that the relevant public may believe that the responsibility for the respective goods lies with the same undertaking. I find them to be similar to a medium degree.

Optical filters for screens

39. These are items attached to screens intended to enhance or improve their effects. I identify that the contested goods are similar to the opponent's goods, "*lens filters for cameras*". The respective goods may share some similarity in nature, even though the filter will be applied to different devices. Further, they serve a similar purpose, that of enhancing the visual effects of a given device. The users and trade channels will overlap to an extent with the goods sometimes being sold in the same shops (such as electrical stores), albeit they may be in different areas. However, there is no element of complementarity or competition. I find the respective goods to be similar to a low degree.
40. If I am wrong, I find that there is also similarity between the contested goods and the opponent's "*audiovisual apparatus*". This is because the contested goods are attached to screens, whereas the latter covers the screens to which they are attached. Although they differ in purpose and method of use, they share the same users and trade channels. The respective goods could be used in conjunction with each other, giving rise to a relationship of complementarity between them. The nature of the relationship is one where the average consumer may think the responsibility for those goods lies with the same undertaking. There is no competition. I find a low degree of similarity.

Keyboards; Instrument to facilitate text-messaging in the nature of a stylus-type device that is attached to the hand for use in conjunction with personal digital assistants

41. The contested goods are devices that are used as a component, or peripheral, of another apparatus enabling a typing function. The opponent's "audiovisual apparatus" covers a wide range of products that could be operated by the contested goods, i.e. keyboard or stylus. Against this background, there is a relationship of complementarity between the respective goods, which the relevant users will expect that the responsibility for the respective goods lies with the same undertaking. Although they may share the same users, the method of use will differ as will the nature and purpose. I find them to be similar to at least a low degree.

Neon signs

42. The contested goods are signs illuminated from fluorescent/neon lights. The term "audiovisual apparatus" of the earlier specification covers a wide range of products, including screens and displays. Despite the different nature of the respective goods, there might be an overlap in purpose as both are potentially used to display information, as signage. I accept that although the users may coincide, the trade channels may not. There is no element of complementarity or material competition. I find them to be similar to only a low degree.

43. I now turn to the contested services in Class 35:

Retail store services in the field of photographic instruments; Wholesale services relating to photographic instruments; Online retail store services relating to photographic instruments

44. The contested services are broad terms to include the opponent's "retailing and wholesaling, including via the internet, in relation to [...] camera

tripods; camera flashes; camera filters; camera drones; [...] camera shutters; camera shutter releases; camera bipods; tripods for cameras; light filters for cameras; lens filters for cameras; protective caps for cameras; viewfinders for cameras; self-timers for cameras; holders for cameras; lenses for cameras; swivel heads for cameras; memory cards for cameras; monopods for cameras". These services can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong in this finding, then there will be significant overlap between the users, uses, method of use and trade channels for the services, so that they will be highly similar.

Advertising on communication media for retail purposes

45. The contested services are advertising services for retail purpose, so this term appears to be less like an advertising agency service, but more about the advertising of particular goods and services on communication media such as websites. Such services are similar to the opponent's retailing services, although the contested term may not offer the full retail experience. They share a similar nature and general purpose as they both focus on bringing goods and services to the public's attention. They also coincide in uses and potentially trade channels. The competing services could be also linked with each other, and as a result, there is a complementary relationship between them. The consumers would most likely expect that such services will be provided by the same undertaking. I find that there is a medium degree of similarity between the respective services.

Wholesale ordering services

46. The contested services cover a range of services relating to the support and management of orders in a wholesale environment. For example, such services may involve the issuance of order acknowledgements, invoices, and payment confirmations. These contested services are closely connected with the wholesaling services of the opponent. The nature,

purpose, users, and trade channels coincide. Further, there is a profound degree of complementarity since the contested services can be intrinsic to the opponent's wholesale services creating the expectation to the consumers that they are both offered by the same undertaking. Therefore, I find them to be similar to a medium degree.

Auctioneering provided on the internet

47. The contested services mainly cover online auctioning, where a public sale is taking place with the highest bidder obtaining the auctioned item. There is similarity between the contested services with the opponent's retail and wholesale services as they share the same users and trade channels. This is because both could be offered via online marketplace websites, where users could visit following a search or recommendation. There is also the potential for the same undertaking to offer the respective services, resulting in a certain degree of complementarity. In addition, it is very common for retailers to select traditional or auctioneering marketplaces or even use them interchangeably to sell their products. As a result, there is a degree of competition between the respective services. Therefore, I find them to be similar to a medium degree.

Organization of exhibitions for commercial or advertising purposes

48. Although there is seemingly no direct relationship between the opponent's services and the above contested services, it is common that retailers partake in exhibitions to promote and sell their goods. Thus, the contested services facilitate sales that coincide with the end purpose of the opponent's retailing services. However, there is no overlap in trade channels. The respective services may be deemed complementary but not in competition. I find a low to medium similarity.

Goods import-export agencies

49. The subject matter of the contested services concerns the movement of goods and their commercialisation in markets where customs authorities impose trade tariffs and controls. This could take place after the retail/wholesale process as covered by the opponent's services. However, the former consists of agencies aiming to provide the above services to businesses, whereas the latter is provided to actual end-users of retail or wholesale goods. There is no overlap in purpose and trade channels. There will be some overlap in users, businesses who avail themselves of a wholesale service, wishing to arrange for import/export. Despite these differences between the respective services, they could be complementary. This is because the contested services could facilitate the distribution of goods for wholesaling, creating a complementary relationship between the services. I find them to be similar to a very low degree.
50. For those goods and services that I have found identical to the opponent's, **the opposition succeeds as per Section 5(1) of the Act**, given my earlier finding that the competing marks are also identical. Nevertheless, I will now move to the other considerations for the goods and services which are not identical that need to be considered under Section 5(2)(a) of the Act.

Average Consumer and the Purchasing Act

51. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

52. In relation to the goods at issue in Class 9, they cover a range of items, mainly for electronic devices. The average consumer of the goods will be a member of the general public, but there is also the potential for specialised customers for certain goods, such as certain types of camera equipment/accessories. Such goods can be selected from stores, including specialist ones, brochures, catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment. Such goods range, in my experience, from fairly low, such as chargers, cables, and cases, to those of medium value, such as camera accessories and equipment, and car video recorders. Even for those at the inexpensive end of the scale, the average consumer may examine the product to ensure that they select the correct type, size, material, quality, and aesthetic appearance (of bags and cases). Thus, the average consumer will pay an average degree of attention, heightened slightly for more expensive goods such as car video recorders and notice boards.
53. Further, regarding the retail and wholesale services in Class 35, the selection process will be based on factors such as availability of the desired product range, price, quantity, and quality. Primarily, the average consumer’s encounter with the given services will be on a visual level, such as signage on premises, promotional material, and website use. The process, therefore, will be primarily visual, but word of mouth or

recommendations may also play a role. The degree of attention paid to the selection of a retailer will be average, taking into account commercial considerations.

54. As to the “*advertising on communication media for retail purposes; goods import-export agencies; auctioneering provided on the internet; organization of exhibitions for commercial or advertising purposes; wholesale ordering services*” services in Class 35, the average consumer will mainly be businesses which will select the service provider, based on reviews, cost, and suitability, while they may also consult the service provider before making the final decision. The selection process will be predominantly visual, with the average consumer selecting the retail service following a visual inspection of the shops or website, or promotional material, though I do not discount aural considerations. Given the more specialist nature of the services, I consider that the average consumer will pay a slightly higher than average degree of attention in choosing the service provider.

Distinctive Character of the Earlier Trade Mark

55. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

56. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

57. The opponent has filed no evidence to show any use made of the earlier mark. Therefore, I have only the inherent position to consider. The opponent in his submissions contends that “[t]he sign has not [sic] meaning in context to [sic] the goods and services, so the distinctiveness is average.” I agree with the opponent that the meaning of the verbal element “PILOTFLY” has no real suggestive or allusive significance in relation to the goods and services for which it is registered. The word PILOTFLY is a made-up word consisting of the conjunction of the ordinary dictionary words PILOT and FLY, which together allude to aircraft operators or aviation in general. However, I do not consider that the conjoined word is highly distinctive or fanciful in the same way an invented word might be. Also, the device and the stylisation will add somewhat to the distinctiveness of the mark but not to a significant degree. Consequently, the earlier mark is distinctive to a medium degree.

Likelihood of Confusion

58. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred earlier in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.³ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁴

59. Earlier in this decision I have concluded that:

- The goods and services at issue range from being similar from a very low to a high degree;
- the average consumer of the parties' goods and the retail and wholesale services is a member of the general public and specialised customers. The level of attention paid will be average, heightened slightly for more expensive goods. However, for the set of services in Class 35, which I have identified as being more specialist, the degree of attention will be slightly higher than average. The selection process is predominantly visual without discounting aural considerations;
- the competing marks are identical;
- the earlier mark has a medium degree of distinctiveness.

³ See *Canon Kabushiki Kaisha*, paragraph 17.

⁴ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

60. I will now consider the additional grounds under section 5(2)(a). This is in relation to the rest of the respective goods and services, for which I found that there is similarity as opposed to identity. I will begin by considering the goods/services where I have found a medium or high degree of similarity, including where I have done so as a fall-back. Due to the identity of the marks, which offsets a lesser degree of similarity between the goods and services, and the distinctiveness of the earlier mark being of a medium degree, I consider that the average consumer in this case, will mistakenly believe that the respective goods or services come from the same or economically-linked undertakings. Put simply, the average consumer will not put this all down to a coincidental use of the same mark, they will regard it as an economic connection. There is, therefore, a likelihood of confusion. I extend this finding to cover all goods and services, even those for which I have found only a very low/low degree of similarity for much the same reasons as advanced above. Whilst I have approached this with caution given the lower levels of goods/services similarity, but bearing in mind the interdependency principle of the various factors, I still regard there to be a likelihood of confusion.

Outcome

61. The opposition has been wholly successful on the basis of the earlier word mark, EU registration number 15378185. As mentioned earlier, the mark upon which the opponent's success is based is currently the subject of an invalidation application at the EUIPO. If successful, the earlier mark upon which the success of this opposition relies will not have been validly registered at the date on which the application was filed. **As such, this is a provisional decision, which will be made final only once the proceedings at the EU Intellectual Property Office have ended.** An appeal deadline will be set only after my final decision has been issued.

Costs

62. As this decision is yet to be made final, there will be no award of costs made at this time. Costs will be awarded along with the issuance of the final decision.

Dated this 29th day of October 2021

**Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General**