

O/1096/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3693638

IN THE NAME OF  
FISHBONE DESIGN  
CO., LTD

TO REGISTER THE FOLLOWING TRADE  
MARK:

**REX Lite**

IN CLASSES 9 & 11

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 430744  
BY SLV GmbH

## **Background and pleadings**

1. On 13 September 2021, FISHBONE DESIGN CO., LTD (the “applicant”) applied to register the trade mark shown on the front page of this decision in the UK. The application, effectively a re-filing of pending European Union trade mark number 018311804, was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union (hereafter referred to as “Article 59”). The EU filing date was 23 September 2020 and so, in accordance with Article 59, the contested application is deemed to have the same filing date as the corresponding pending EU application. The UK application was published for opposition purposes on 3 December 2021 and registration is sought for the following goods:

*Class 9: Electronic interactive whiteboards; Electronic notice boards; Touch panels; Monitors [computer programs]; Downloadable application software; monitors [computer hardware]; fluorescent screens; batteries for lighting; Fire alarms; Signalling panels, luminous or mechanical; intercommunication apparatus; light regulators [dimmers], electric; electrified rails for mounting spot lights; electro-dynamic apparatus for the remote control of signals; control panels [electricity]; padlocks, electronic; theft prevention installations, electric; wearable computers; wearable video display monitors; light-emitting diodes [LED]; Transformers [electricity]; Step-up transformers; Chargers; Plugs, sockets and other contacts [electric connections]; adapter plugs.*

*Class 11: Light-emitting diodes [LED] lighting apparatus; light bulbs; ceiling lights; Decorative lights; sockets for electric lights; Emergency lights; Lighting apparatus and installations; Strings of lights; Projection lamps; Helmet lights; Neon lamps for illumination; lights for vehicles; bicycle lights; motorcycle lights; Ceiling fans; Electric fans; Hydromassage bath apparatus; Ornamental fountains; water heaters; air-conditioning apparatus; radiators, electric; safety lamps.*

2. On 2 February 2022, SLV GmbH (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent

relies on its UK comparable mark AIXLIGHT. The opponent's mark was applied for on 8 February 2006 at the European Union Intellectual Property Office (EUIPO) and registered on 26 January 2007. Pursuant to the Withdrawal Agreement, the mark was automatically converted to comparable UK trade mark 904889507. The opponent relies upon all of the goods for which the earlier mark is registered which are as follows:

*Class 11: Mains-operated lights; Lighting apparatus and installations; head lamps, electric lamps, including lighting rods, decorative lighting apparatus.*

3. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.

4. The opponent submits that there is a likelihood of confusion because the applicant's mark is similar to the opponent's and the respective goods are identical or similar.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its earlier mark.

6. Both parties are professionally represented in these proceedings, the opponent by Baron Warren Redfern and the applicant by Alpha & Omega. Whilst the opponent filed evidence and submissions, the applicant did not. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied 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.

## **EVIDENCE**

8. The opponent's evidence was filed in the form of a witness statement dated 13 June 2022 from the company's Head of legal and Compliance, Corinna Schleipen and includes 4 exhibits in total. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

## **DECISION**

### **Proof of use**

9. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier mark. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the good relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the EU filing date of the contested application: 24 September 2015 to 23 September 2020.

### **Relevant statutory provision:**

#### **Section 6A:**

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5)- (5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be

treated for the purposes of this section as if it were registered only in respect of those goods or services.”

10. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

11. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the UK in the relevant period, and in respect of the goods as registered.

### Relevant case law

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

“114.....The Court of Justice of the European Union (“CJEU”) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and



frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

## **Use of the mark**

14. Ms. Schleipen explains in her witness statement that SLV GmbH is a manufacturer of lamps and lighting installations.<sup>1</sup> It is claimed that the opponent’s mark has been in continuous use since its registration in 2007.<sup>2</sup>

15. Ms. Schleipen goes on to state that each year, the company issues a comprehensive catalogue of more than 800 pages containing the company’s collection of lamps and lighting installations.<sup>3</sup> Exhibit CS1 provides excerpts from the catalogues from the years 2015 up to and including 2021 which show the opponent’s mark accompanied by images and product numbers of lights, fixtures and installations. It is

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<sup>1</sup> See paragraph 2 of the witness statement of Corinna Schleipen

<sup>2</sup> See paragraph 4 of the witness statement of Corinna Schleipen

<sup>3</sup> See paragraph 2- first bullet point of the witness statement of Corinna Schleipen

claimed that the catalogues are printed in an edition of 500,000 pieces and are widely distributed within the European Union and the UK.<sup>4</sup>

16. Exhibit CS3 displays a chart showing the turnover figures for products in the AIXLIGHT family according to years and article numbers. All turnover figures shown in the chart have been made within the European Union. Whilst I do not intend to reproduce the table in full here, the total figures in Euros from the years 2016 to 2021 are as follows:

<b>Year</b>	<b>Total Turnover (Euros)</b>
2016	109,910.07
2017	63,237.80
2018	56,097.65
2019	58,361.54
2020	40,137.71
2021	4,266.63

17. Exhibit CS4 provides sample invoices for products from the Aixlight lamp range from 2017 to 2021. The samples show sales have been made in Austria, Hungary, Germany, Spain and the UK. Although the invoices are in German, the dates, addresses, prices (in Euros) and the "Aixlight" mark can be seen clearly on each invoice.

### **Genuine Use**

18. Considering the sum of the evidence, including the turnover between 2016 and up to the priority date in 2020 and the use of the earlier mark in catalogues and product packaging<sup>5</sup> it is my view that the opponent has made use of the mark within the relevant period. With consideration of the evidence, it is my view particularly with reference to the consistent sales figures and circulation of catalogues over the last five years, the use made by the opponent does not appear to be token, solely for the

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<sup>4</sup> See paragraph 2 of the witness statement of Corinna Schleipen

<sup>5</sup> See exhibit CS2

purpose of preserving the rights conferred by the registration of the opponent's mark. Rather, I find the use to be for the purpose of creating and preserving a share of the market within Europe for the goods for which it is registered. As such, I find that there is genuine use of this mark in relation to the goods protected by the opponent in class 11.

### **Fair Specification**

19. I now need to consider what constitutes a fair specification for the first earlier mark, having regard for the goods upon which genuine use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

20. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

21. The opponent covers goods in class 11 including *Mains-operated lights; Lighting apparatus and installations; head lamps, electric lamps, including lighting rods, decorative lighting apparatus*. Whilst I consider that the use shown by the opponent is in respect of mains operated lights, lighting apparatus and installations, electric lamps and decorative lighting apparatus, I do not find that the use shown warrants protection for head lamps or lighting rods. I find that the consumer would consider *mains operated lights; lighting apparatus and installations; electric lamps*

*and decorative lighting apparatus* to be a fair description of the goods evidenced. I will therefore assess the grounds under section 5(2)(b) based on that specification.

### **Section 5(2)(b)**

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

“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”.

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

### **The principles:**

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

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

## Comparison of Goods

24. In *Canon*, the Court of Justice of the European Union (“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”.

25. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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”.

27. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

28. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

29. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is



to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.

30. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

31. The goods to be compared are as follows:

Opponent’s Goods	Applicant’s Goods
<p><b>Class 11:</b> Mains operated lights; Lighting apparatus and installations; Electric lamps and decorative lighting apparatus.</p>	<p><b>Class 9:</b> Electronic interactive whiteboards; Electronic notice boards; Touch panels; Monitors [computer programs]; Downloadable application software; monitors [computer hardware]; fluorescent screens; batteries for lighting; Fire alarms; Signalling panels, luminous or mechanical; intercommunication apparatus; light regulators [dimmers], electric; electrified rails for mounting spot lights; electro-dynamic apparatus for the remote control of signals; control panels [electricity]; padlocks, electronic; theft prevention installations, electric;</p>

	wearable computers; wearable video display monitors; light-emitting diodes [LED]; Transformers [electricity]; Step-up transformers; Chargers; Plugs, sockets and other contacts [electric connections]; adapter plugs.
	<b>Class 11:</b> Light-emitting diodes [LED] lighting apparatus; light bulbs; ceiling lights; Decorative lights; sockets for electric lights; Emergency lights; Lighting apparatus and installations; Strings of lights; Projection lamps; Helmet lights; Neon lamps for illumination; lights for vehicles; bicycle lights; motorcycle lights; Ceiling fans; Electric fans; Hydromassage bath apparatus; Ornamental fountains; water heaters; air-conditioning apparatus; radiators, electric; safety lamps.

32. The opponent has provided submissions in their statement of grounds on the similarity of the contested goods. Whilst I do not propose to reproduce them all here, I have taken them into consideration when reaching my decision.

33. The opponent's goods include the term '*lighting apparatus*' in Class 11 which, as a broad term, I consider through its ordinary and natural meaning could encompass several goods covered in the applicant's specification in Class 9 such as *electrified rails for mounting spot lights* and *light regulators [dimmers], electric*. I note however, that the opponent in their statement of grounds has pleaded that the respective goods in classes 11 and 9 are similar rather than identical.

34. In *Altecnic Ltd's Trade Mark Application*<sup>6</sup> the Court of Appeal decided that "*the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.*"

35. In addition, in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr

<sup>6</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA)

Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the Omega 1 [2010] EWHC 1211 (Ch) and Omega 2 cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where “*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.*”

36. Whilst the comments made by the late Mr Justice Carr above concerned different circumstances to those which I am considering in these proceedings, it is my view that the term ‘*lighting apparatus*’ may cover goods falling into more than one class. It is my view that I may therefore use the class numbers to aid my interpretation of the respective goods, and to assist in determining the scope of the term lighting apparatus as included in class 11. It appears the opponent is in agreement with this approach, based on its pleading that the goods are similar, not identical. This is how I intend to proceed.

### ***Class 9 Goods***

#### Electrified rails for mounting spot lights; light-emitting diodes [LED]

37. The opponent submits that these goods are all used in conjunction with *lighting apparatus* and therefore the users, uses, points of sale and trade channels are identical. They further state that it would be reasonable for the relevant public to believe that these goods come from the same source, namely a lighting installation equipment company. I agree with the opponent’s points that there would be an overlap in users, purposes and trade channels. I also agree that the respective goods are important to one another to the extent that the relevant public would believe that the goods are derived from the same undertaking, and they therefore share a

complementary relationship. Overall, I find there is a high degree of similarity between these goods.

#### Light regulators [dimmers], electric

38. I consider that *light regulators* would be used to control the brightness of lighting so there is a shared purpose with the opponent's *Lighting apparatus*. Due to the shared purpose, I find there may be an overlap of users and trade channels. Further, there may be a degree of complementarity as the respective goods are important or indispensable for one another to the extent that consumers would think the responsibility for the goods lies with the same undertaking or with economically connected undertakings. I find these goods to be similar to a medium degree.

#### Adapter plugs

39. I find that these goods may be used in conjunction with *lighting apparatus*, and I therefore find there may be an overlap in users and trade channels as they may all be sold in specialist lighting outlets or home improvement stores. I consider however, that the nature and purpose of these goods will differ. Although these goods are used in conjunction with *lighting apparatus*, I do not consider this relationship would be to the extent that consumers will believe that the responsibility of these goods lies with the same undertaking and as such, I do not find there to be a complementary relationship. Overall, I find these goods to have a low degree of similarity.

#### Fluorescent screens

40. Fluorescent screens are transparent screens coated with a phosphor that fluoresces when exposed to x-rays or cathode rays.<sup>7</sup> I find its purpose and physical nature differs from the opponent's goods. Further, I consider fluorescent screens to be specialized equipment and therefore the users and trade channels would differ. I do not find there to be a complementary or competitive relationship between these goods.

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<sup>7</sup> <https://www.collinsdictionary.com/dictionary/english/fluorescent-screen>

Overall, I do not consider there to be any similarity between fluorescent screens and the opponent's goods.

Plugs, sockets and other contacts [electric connections]

41. The above goods may also be used in conjunction with *lighting apparatus*, and I therefore find there may be an overlap in users and trade channels as they may all be sold in specialist lighting outlets or home improvement stores. I consider however, that the nature and purpose of these goods will differ. Although these goods are used in conjunction with *Lighting apparatus*, I do not consider this relationship would be to the extent that consumers will believe that the responsibility of these goods lies with the same undertaking and as such, I do not find there to be a complementary relationship. Overall, I find these goods to have a low degree of similarity.

Downloadable application software

42. The opponent contends in their statement of grounds that *downloadable application software* is often used for the control of lighting installations in business and smart home appliances. Although the nature and purpose of *downloadable application software* differs from *electric lamps*, I do find that consumers with smart lighting equipment would require *downloadable application software* to assist with the function of lighting equipment and there would therefore be an overlap in users. Further, as some *downloadable application software* used to assist with lighting require compatible lights in order to function, I consider that there is some degree of complementarity to the extent that some consumers may believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. I do not consider there to be an overlap of trade channels, nor do I find the goods to share a competitive relationship. Overall, I find the goods similar to a low degree.

Electronic interactive whiteboards; Electronic notice boards; Touch panels; monitors [computer programs]; monitors [computer hardware]; wearable computers; wearable video display monitors

43. In the opponent's submissions, they state that these goods are similar to that of the applicant's as they are all domestic electronic goods which are often sold in the same retailers and are often made by the same electrical goods companies. They claim that while the nature of the respective goods differs, the uses, users, points of sale and trade channels are the same. They go on to claim that the goods are complementary as they all relate to the same kinds of electrical functionality in a commercial or domestic setting and there would be a reasonable expectation on the part of the relevant consumer that all these goods could come from the same source.

44. I disagree with the opponent's submissions that the goods are sold in the same retailers and even if I am wrong, I find that the opponent's goods and applicant's goods would be found in different departments. Further, there is no evidence to suggest that the same electrical goods companies produce the above goods and the goods covered by the opponent's specification. I also consider the nature and purpose of the respective goods differ and while I acknowledge that the above goods all use lighting in order to function, the fact that something is a component of another product does not justify a finding of similarity. I find the opponent's claim of a complementary relationship to be tenuous and I do not consider the respective goods to be important or indispensable to one another to the extent that consumers believe they are derived from the same undertaking. I do not consider there to be any similarity between these goods.

#### Theft prevention installations, electric

45. I consider that *theft prevention installations, electric* in respect of class 9 would include goods such as security alarms, security cameras and security barriers. The nature of these goods therefore differs from *lighting apparatus* however, *lighting apparatus* can be used as a security measure on properties and to that extent, there would be a general overlap in terms of purpose. When *lighting apparatus* is used in the field of theft prevention, I consider there would be an overlap in users and trade channels and there would also be a degree of competition between the goods. I do not consider there to be a complementary relationship between these goods. Overall, I consider there to be a low degree of similarity between these goods.

### Padlocks, electronic

46. These goods differ in terms of nature and purpose compared to *lighting apparatus*. As outlined above, when *lighting apparatus* is used in the field of theft prevention, there would be an overlap in trade channels and users. I find the core purpose and method of use of these goods differ as padlocks are used to prevent unauthorised access to a building or an item whereas lighting apparatus in the field of theft prevention provides illumination to a particular area to deter any criminal activity. I do not consider there to be a complementary relationship between these goods nor do I find there to be any degree of competition. I do not consider there to be any similarity between these goods.

### Signalling panels, luminous or mechanical; electro-dynamic apparatus for the remote control of signals; control panels [electricity]; Transformers [electricity]; Step-up transformers

47. Although these goods differ in terms of nature and purpose compared to *mains operated lights*, they are all used in order to control lighting and therefore I consider the users and trade channels would overlap. Further, there would be a complementary relationship as the respective goods are important to one another to the extent that consumers would believe that the goods are derived from the same undertaking. However, I do not consider that the goods would enjoy a competitive relationship. I find there is a low degree of similarity between these goods.

### Chargers; Batteries for lighting

48. I consider that *chargers* and *batteries for lighting* may be used to supply power to *electric lamps and decorative lighting apparatus*. It is also not uncommon for these goods to be made by the same manufacturer as they would need to be compatible with one another so to that extent I find that they enjoy a complementary relationship. There would also be an overlap in users and trade channels however, I acknowledge that their nature and purpose differ, and I do not consider there to be a competitive relationship between these goods. I find these goods to be similar to a low to medium degree.

### Fire alarms; intercommunication apparatus

49. These goods have a different nature and purpose to the opponent's goods. I note the opponent submits that they are often made by the same electrical goods companies however, there is no evidence to demonstrate this. The opponent also states that the goods would share the same trade channels. Even if this is the case, I find that the goods would be sold in completely different areas and there would be no competitive or complementary relationship between the same. I do not find there to be any similarity between these goods.

### **Class 11 Goods**

#### Lighting apparatus and installations

50. This term appears in both specifications and is self-evidently identical.

#### Light-emitting diodes [LED] lighting apparatus

51. I find that this term in the applicant's specification is encompassed by the opponent's *Lighting apparatus and installations*. On that basis, they are identical in line with *Meric*.

#### Light bulbs

52. I consider *light bulbs* to be a type of *lighting apparatus* and therefore find these terms to be identical.

#### Ceiling lights; Decorative lights; Projection lamps

53. I consider these goods in the applicant's specification to fall within the opponent's term *Mains operated lights*. These goods are therefore identical on the principle outlined in *Meric*.



Emergency lights; Strings of lights; Helmet lights; Neon lamps for illumination; lights for vehicles; bicycle lights; motorcycle lights; safety lamps

54. I find these goods to fall within the opponent's term *electric lamps* and are therefore identical on the principle outlined in *Meric*.

Sockets for electric lights

55. This term relates to a device which mechanically supports and provides electrical connections for a compatible electric lamp. I therefore consider this term to be identical to the applicant's *lighting apparatus* in line with *Meric*.

Ceiling fans; Electric fans; Hydromassage bath apparatus; Ornamental fountains; water heaters; air-conditioning apparatus; radiators, electric

56. In their statement of grounds, the opponent submits that these goods are similar to that of the opponent's as they are domestic electrical goods which are sold in the same wholesalers and retailers as lighting goods and are often made by the same electrical goods companies. Therefore, while the nature of the goods is not the same, the users, points of sale and trade channels are the same. They further state that there is a complementary relationship between the goods as they all relate to electrical functionality in a commercial or domestic setting, and there would be a reasonable expectation on the part of the relevant consumer that all these goods would come from the same source.

57. Whilst I agree that the applicant's goods would be found in the same retailers as the opponent's lighting goods, I find that that these retail outlets would likely be home improvement stores (or their online equivalents) which sell a wide variety of goods and the goods at issue would be found in completely different areas. Although the opponent claims that the applicant's and opponent's goods are often made by the same manufacturers, there is no evidence before me to suggest that this is the case. I also consider that the applicant's goods differ in respect of nature and intended purpose compared to the opponent's goods. I disagree with the opponent's claims that the respective goods share a complementary relationship, I am not convinced that the

respective goods are important or indispensable to one another to the extent that consumers would believe they derive from the same undertaking. Further, I do not find that there would be any degree of competition between the respective goods. Overall, I do not consider these goods to be similar to the opponent's earlier goods.

Light-emitting diode; electronic light emitting diode (LED) signs

58. I consider the above goods to be similar in nature and purpose to the proprietor's *mains operated lights* and *electric lamps* with all of the goods being for the purpose of illumination. I also consider there would be an overlap in trade channels and users however I do not consider there to be a complementary relationship or for the goods to be in competition with one another. Overall, I find these goods to be similar to a high degree.

59. In relation to *Fluorescent screens; Electronic interactive whiteboards; Electronic notice boards; Touch panels; monitors [computer programs]; monitors [computer hardware]; wearable computers; wearable video display monitors; Padlocks, electronic; Fire alarms; intercommunication apparatus; Ceiling fans; Electric fans; Hydromassage bath apparatus; Ornamental fountains; water heaters; air-conditioning apparatus; radiators, electric* which I have found not to be similar, the opposition based on section 5(2)(b) of the Act must fail.

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

60. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

61. The average consumer for the goods in question will be the general public or professionals purchasing on behalf of a business undertaking. The cost of the goods is likely to vary from low to average. In terms of the purchasing process consumers may consider factors such as aesthetics, quality and safety requirements along with compatibility with component parts. I consider that the general public purchasing these goods will pay a medium level of attention and when it comes to the professional consumer, they will also consider these factors, but may also be buying on a larger scale, and will have the added liability of their purchase making a direct impact on their business and as such, I find they will be likely to pay at least an above medium degree of attention to the goods.

62. I find that during the selection process, the goods are likely to be purchased by self-selection from a retail outlet or from an online or catalogue equivalent. I find that the selection process would primarily be visual however, I do not discount that there will be an aural component in the selection of the goods in the form of word-of-mouth recommendations and telephone orders.

### **Comparison of marks**

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

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

64. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

65. The marks to be compared are as follows:

Opponent's Mark	Applicant's Mark
<b>AIXLIGHT</b>	<b>REX Lite</b>

66. The opponent's mark consists of the word AIXLIGHT. The overall impression resides in the mark as a whole.

67. The applicant's mark consists of the word REXLite in a slightly stylised typeface. I note that the letters "REXL" are presented in an upper-case font while the remaining "ite" are presented in lower case. I find the wording itself, in particular the letters "REXL" dominates the overall impression due to its size and positioning at the beginning of the mark. I find that the stylistic aspects make only a minor contribution to the overall impression.

## Visual comparison

68. The respective marks coincide in their use of the letters “XLI” in the centre of the marks. I recognise that due to the stylisation of the applicant’s mark that the letters “XL” are presented in an upper-case font while the “i” is presented in a lower-case font. The entirety of opponent’s mark is presented in an upper-case font however, it seems that through fair and normal use, it would be permitted for their mark to also be presented in the same stylisation of “XLI”. The applicant’s mark differs from the opponents in its use of the letters “RE” at the beginning of the mark which has no counterpart in the opponent’s mark. Further, the opponent’s mark uses the standard English spelling of the word “light” whereas the proprietor uses the spelling “lite”. I find the marks to be visually similar to no more than a medium degree.

## Aural comparison

69. I consider that the applicant’s mark will be pronounced on two syllables as REX-LIGHT. The opponent’s mark will most likely be pronounced in two syllables as AYKS-LIGHT, though I accept that in some cases, a small minority may pronounce the mark as AXE-LIGHT. In both cases, the respective marks coincide in their use of LIGHT at the end of their marks. Although the first syllable of the respective marks differs, there is some similarity in their use of the X sound. Overall, I find the marks to be aurally similar to a medium to high degree.

## Conceptual comparison

70. In respect of the opponent’s mark, I find that the wording “AIX” will be perceived as an invented word with no attributable meaning whereas “LIGHT” will be perceived as the standard dictionary description of an object which produces light, such as an electric lamp<sup>8</sup>.

71. In their counterstatement, the applicant submits that, *‘Rex’ is used to show the side in a court case that is the state, when there is a king. It also has an alternative*

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<sup>8</sup> [Light definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-uk/dictionary/light)

definition, being “a mammal, such as a rabbit or cat, having a genetic mutation that causes the guard hairs to be short or lacking, often resulting in a curly coat”. However, for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court (“GC”) and the CJEU including *Ruiz Picasso v OHIM*<sup>9</sup>. In view of this, I do not consider that the conceptual meanings put forward by the applicant will be immediately recognised by the average consumer and rather the average consumer will simply perceive the word “REX” as a name. I find that the term “LITE” will most likely be considered as a stylised choice of spelling for the word “LIGHT” and will therefore be perceived as the same especially taking into consideration the goods in class 11. I acknowledge however, that in some cases, a small minority may perceive the term “LITE” as an informal term to describe an object as being lighter in size or weight and consider this as a description of some of the goods. Overall, I find the marks to be conceptually similar to a medium degree.

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

72. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

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<sup>9</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

73. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

74. I will begin by initially assessing the inherent distinctiveness of the opponent’s mark.

75. In relation to the registered goods, I am of the view that the opponent’s mark is somewhat allusive due to the use of the word “LIGHT”. As previously outlined, I consider the term “AIX” to have no attributable meaning and is therefore neither descriptive nor allusive of the goods for which it is registered. Consequently, I find the opponent’s mark to be inherently distinctive to a medium degree.

76. I now turn to consider whether the distinctiveness of the opponent’s mark has been enhanced through use. When considering whether the distinctiveness of a trade

mark has been enhanced through use, it is the perception of the UK consumer at the relevant date that is key.

77. In the witness statement of Corinna Schleipen, it is claimed that the opponent's mark has been in continuous use since its registration in 2007,<sup>10</sup> however, the evidence provided shows use from 2015 to April 2021.

78. Previously in paragraph 16 of this decision, I outlined the opponent's turnover figures from 2016 to April 2021. Whilst the figures are not insignificant, the figures reflect sales throughout Europe, and it is therefore unclear as to what proportion of the turnover figures relate to sales in the UK. In addition, from the 19 invoices provided in exhibit CS4, only one invoice is shown relating to sales in the UK whereas the remainder of invoices predominantly relate to sales in Germany. Further, I previously outlined in paragraph 15 of this decision the opponent's claim that the sales catalogues as shown in exhibit CS1 are printed in an edition of 500,000 pieces. Again, however, it is unclear how many catalogues were circulated in the UK.

79. From the evidence provided by the opponent, it would be reasonable to assume that they hold only a minimal amount of the UK market share and in this particular case, I do not consider that the evidence provided by the applicant is sufficient to show that the distinctiveness of their earlier mark has been enhanced through use.

### **Likelihood of confusion**

80. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

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<sup>10</sup> See paragraph 4 of the first witness statement of Corinna Schleipen



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

82. Earlier in my decision, I found the similarity of the respective goods to range from identical to dissimilar. I identified the average consumer to be a member of the general public or professionals purchasing on behalf of a business undertaking and in both cases the goods will be purchased predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process in respect of the general public, and this will be higher in respect of the professional consumer who will pay at least an above medium degree of attention.

83. I found the respective marks to be visually similar to no more than a medium degree, aurally similar to a medium to high degree and conceptually similar to a medium degree. However, I note that the shared concept is weak, as both marks simply convey to the consumer the concept of light in respect of lighting related goods. I also found the earlier mark to have a medium level of inherent distinctive character as a whole in respect of its registered goods however, the distinctiveness of the mark has not been enhanced through the use made of it.

84. I have taken all of the relevant factors into consideration in reaching my decision and bear in mind that the purchasing process is predominantly visual and as a general rule the beginning of marks make more impact than the endings<sup>11</sup>. Considering the marks as a whole, there is a clear difference from the “RE” element at the beginning of the applicant’s mark, which has no counterpart in the opponent’s mark. I find that this difference will not go unnoticed by the average consumer. I do not find that the applicant’s mark will be mistaken for the opponent’s and as such, I do not consider there to be a likelihood of direct confusion.

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<sup>11</sup> See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

85. I now go on to consider indirect confusion.

86. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example.)

87. These examples are not exhaustive but provide helpful focus.

88. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

89. Firstly, I note that this situation is not one that appears to fall into the categories set out in *L.A. Sugar*, however, I remind myself that they were not intended to be exhaustive. Although I found the marks to share a medium to high degree of aural similarity, I am reminded that when making a global assessment, the visual, aural and conceptual aspects of the marks do not always hold the same weight<sup>12</sup> and in this case, I considered that the purchasing process would be predominantly visual. The shared “XLI” element lies in the centre of both marks, and I find that when faced with the mark, consumers will first notice the differences in the first two letters of the respective marks. It is possible that the different choice of spelling “LIGHT” AND “LITE” may be misremembered. However, I do not consider that consumers would perceive these similarities, bearing in mind the visual differences at the start of the mark, as an indication of a brand extension, or an economically linked undertaking. I remind myself that I found the opponent’s mark to have a medium degree of distinctiveness, however, this is on the basis of the ‘AIX’ element which has no direct counterpart in the contested mark. Having carefully considered these points, I am of the view that the applicant’s mark may at best bring to mind the opponent’s mark however, any similarities between the same will be put down to a coincidence rather than an economic connection. I am not satisfied that this gives rise to a likelihood of indirect confusion, and as such, the application for invalidity under section 5(2)(b) must fail.

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<sup>12</sup> See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

## **Conclusion**

90. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal against my decision, the application will proceed in the UK for the full range of goods applied for.

## **COSTS**

91. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, and considering that the applicant has not filed anything further than beyond the counterstatement and has not commented on the opponent's evidence, I award the applicant the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Considering the other side's evidence:	£200

92. I therefore order SLV GmbH to pay the sum of £400 to FISHBONE DESIGN CO., LTD. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 13<sup>th</sup> day of December 2022**

**Catrin Williams**  
**For the Registrar**