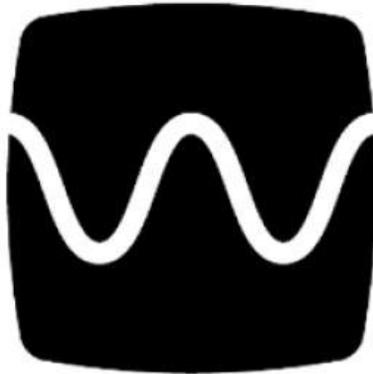


O-054-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2583982
BY
ENMODUS LIMITED
TO REGISTER THE TRADE MARK**



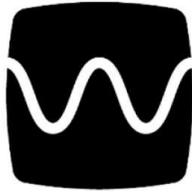
IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO 102438
BY
SOMFY SAS**

Background and pleadings

1. On 7 June 2011, enModus Limited (“the applicant”) applied for the trade mark:



The application was published in the *Trade Marks Journal* on 1 July 2011, following which it was opposed by Somfy SAS (“the opponent”).

2. The following goods are opposed:

Class 9: Apparatus and installations for the measurement, monitoring or control of energy consumption; sensors, meters and controllers for use in energy supply; plugs, sockets, integrated circuit chips and software for use in the measurement, monitoring and control of energy consumption and supply.

3. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) which states:

“(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.”

4. The ground is based upon all the following goods of the opponent’s earlier international registration designating the Community (“the earlier mark”):

0937935



Class 09: *Electric or electronic apparatus and instruments for the control and remote control of operating motors for blinds, screens, curtains, shutters, windows, ventilation hatches, locks, doors, garage doors, gates, barriers and grills; apparatus for lighting; electric or electronic monitoring and alarm apparatus and instruments and their control devices for protection of people, goods and buildings.*

5. The international registration has a French priority date of 22 February 2006 and a designation date of 18 August 2006. The database of the Office for Harmonisation in the Internal Market (“OHIM”) indicates that the period for opposition commenced on 3 September 2007 and that no opposition was received; hence the international registration was protected from 3 December 2007. As the registration had not been protected for five years or more at the date of publication of the application, there is no requirement for proof of use of the earlier international registration (“the earlier mark”) ¹.

6. The opponent states that the marks are similar because the dominant element in its mark is an oscillating white line on a black background and that the application consists of an oscillating white line on a black background. The opponent states that the goods of both parties “are equipment and apparatus for use with electricity and are therefore considered similar.” The opponent claims that the similarities between marks and goods create a likelihood of confusion.

7. The applicant filed a counterstatement in which it denies that the marks and goods are similar (“the suggestion that the goods are similar because they are “equipment and apparatus for use with electricity” does not stand up to any sensible scrutiny”) and denies that there is a likelihood of confusion. The opponent filed evidence. Both sides filed submissions in lieu of a hearing.

Evidence

8. The opponent’s evidence comes from Christopher Lewis, who is a trade mark assistant at Saunders & Dolleymore LLP, the opponent’s professional representatives in these proceedings. Mr Lewis has filed evidence to support the opponent’s claim that the goods in the application could be construed to include goods used to control energy supply in order to control electrical appliances. He exhibits a DVD² which contains a promotional video from the applicant’s website. Mr Lewis states, from the DVD, that:

- the mark is to be used on the applicant’s WATTWAVE technology which is being demonstrated in the video

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

² Exhibit CL1

- the applicant intends the products sold under the mark in the application to be the backbone of modern smart-homes
- the applicant intends to use the mark on products that can control electrical equipment and appliances connected to an electrical circuit
- the applicant's WATTWAVE products are used to remotely control electrical appliances and equipment.

9. Mr Lewis exhibits (at CL2) pages from the applicant's website which he states indicate the type of products the applicant intends to provide under the mark in the application. He highlights the following in his witness statement:

- First page: "We want to make it possible to monitor and control everything in your home; your heating, lighting, electrical appliances, together with security and safety systems...for this we need a new technology. A technology that will work in every corner of every room, every loft and outbuilding, and seamlessly knit together the fabric of your home.

So we invented one – and we called it Wattwave”.

- Second page: "Wattwave is a two way communications technology that utilizes the home powerline to connect every electrical item in your home”.
- Third page states that Wattwave technology will enable

“Home control	Remote switching of appliances
Home safe	Security and occupancy monitoring for maximum protection of your home
Home care	Health and activity monitoring of loved ones”

10. Mr Lewis concludes his evidence by stating that:

“...the mark in the Application is to be used with the Applicant's Wattwave technology. The evidence demonstrates that the Wattwave technology consists of electric or electronic apparatus and instruments for the control and remote control of appliances or equipment connected to an electrical circuit. The evidence also demonstrates that the Applicant intends the Class 9 specification in the Application to cover electric or electronic monitoring and alarm apparatus and their control devices for protection of people, goods and buildings.”

Decision

11. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union („CJEU’): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*

[2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

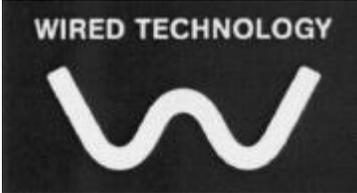
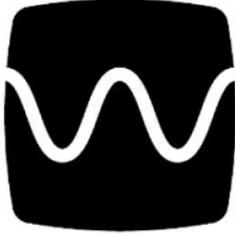
(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of trade marks

12. The marks to be compared are:

Opponent's mark	Applicant's mark
	

13. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. The applicant's mark consists of a white wavy line, which is on a background comprising a black square with rounded edges. The background in the opponent's mark is a plain black rectangle. In both cases the backgrounds are necessary to see the white components of the marks. The opponent's mark consists of two elements, Wired Technology and a white wavy line. Wired Technology appears to be low in distinctive character for the opponent's goods and is smaller within the mark than the opponent's wavy line element. I find that the dominant distinctive element of the opponent's mark is the white wavy line device. The background in the application is slightly rounded at the corner and so is not entirely a plain background necessary for revealing the white elements, as in the opponent's mark; it forms part of the mark as a whole, but it is the wavy

line in the application which is the dominant distinctive element because the eye is drawn to it straightaway.

14. There are points of visual similarity and also difference between the marks. There is some similarity in that the backgrounds are both quadrilaterals; however, the opponent's background is a rectangle and the applicant's is a square with rounded corners. Words are included in the opponent's mark, but there are none in the applicant's mark. The high point of similarity between the marks is the incorporation of white wavy lines. The opponent calls them oscillating lines; the applicant refers to the line in its mark as a sine wave. The opponent's wavy line has straight arms which extend higher than the central curve and which do not reach the outside edges of the black rectangle, whilst the applicant's wavy line has peaks and troughs which are equal in proportion to each other, and the arms reach the outside edges of the black square and have curved tips. In both marks the wavy line has a central peak which is at the centre of the mark as a whole. Taking all these similarities and differences together, the marks share a good level of visual similarity.

15. There are no words to articulate in the application and the device is not reminiscent of a letter W. The marks are not phonetically similar.

16. The applicant submits that the marks are conceptually very different because its mark is a sine wave, which represents alternating electrical current, whilst the opponent's mark expresses the idea of wired technology and a single letter W. The opponent submits that both wavy lines create the impression of a letter W, a submission with which I have disagreed above: the applicant's mark does not look like a W. The opponent goes on to submit that the W devices have a connection with electricity and that they are therefore conceptually similar. W, to my knowledge, does not have a connection with electricity (at least not one which is capable of immediate grasp by the average consumer).

17. The conceptual significance of the opponent's mark is both „wired technology', the meaning of which is apparent immediately, and the device which looks like a W. The evocation of a W may also be made more likely because the first word in the mark also begins with a W but, I think that even without the words, the device looks like a W. The applicant's mark creates a concept, particularly in the context of the goods, of electrical current. The configuration of the wavy line, with its equal peaks and troughs extending across the entire width of the black square with curved corners, is evocative of an old-fashioned screen or monitor showing the monitoring or measurement of continuous and regular electrical current.

18. The nearest that the opponent's mark gets to connotations of electrical current is the word „wired', but I think that in combination with the word „technology', the concept of the opponent's mark, in addition to the letter W, is electrical technology which is wired, rather than pure electrical energy. It follows

that there is only a very low degree of conceptual similarity between the marks. The comparison between the marks gives a disparate set of results: there is a good level of visual similarity, phonetic dissimilarity and a very low degree of conceptual similarity.

Distinctiveness of the earlier mark

19. It is necessary to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion³. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁴. There is no evidence of use, so I have only the inherent position to consider. For the goods covered by the registration, the words can only be said to be low in distinctive character. The plain rectangular background lends no distinctiveness to the overall impression created by the mark. The W device, and the mark as a whole, has an average level of distinctiveness, neither high nor low.

Average consumer and the purchasing process

20. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. This general presumption can, however, change depending on the particular goods in question (see, for example, the decision of the CFI in *Inter-Ikea Systems BV v OHIM* (Case T-112/06⁵). The opponent submits that the average consumer for the goods of both parties is the general public because the goods are available for purchase from DIY stores, builders' merchants, electrical suppliers, home improvement and DIY websites and can be installed without the requirement for any specialist qualifications. The opponent goes on to say that the goods range from very low cost items to moderately expensive and that the level of attention of the average consumer during the purchasing process will be "low to moderate at most". The opponent

³ *Sabel BV v Puma AG* [1998] RPC 199.

⁴ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

⁵ "37 The applicant's arguments are not sufficient, however, to call into question OHIM's assertion that, even when buying an inexpensive item of furniture, the average consumer makes his choice on the basis of a number of functional and aesthetic considerations, in order to ensure that it is in keeping with other furniture already in his possession. While the actual act of purchase may be completed quickly in the case of certain items of furniture, the process of comparison and reflection before the choice is made requires, by definition, a high level of attention. Moreover, where the average consumer does not regularly buy certain goods, as is the situation in the present case, his level of attention when buying those goods must, as a general rule, be taken to be higher than his normal level of attention (see, to that effect, Case T-147/03 *Devinlec v OHIM – TIME ART(QUANTUM)* [2006] ECR II-11, paragraph 63)."

submits that even in relation to the more expensive goods, there would not be a high level of attention as in the example of specialised medical instruments. It concludes that there is, overall, not more than a low to moderate level of attention. The applicant does not address the average consumer for the opponent's goods, but submits that its own goods are highly specialised and sophisticated, bought by a very knowledgeable average consumer with a very high level of attentiveness.

21. The opponent's position appears to be predicated upon the assumption that the general public does not pay more than a moderate attention to its purchases because it is the general public. However, there are many occasions where a particularly expensive or important purchase will engage a high level of attention on the part of the average consumer who is part of the general public. When purchasing the opponent's goods, even if they are bought from a DIY store, these are not regular purchases. They will be subject to research and studying of brochures and instructions before purchase to ensure that the goods do the job and are of a sufficient quality so as not to need the trouble of replacement, at least in the short to medium term. In the case of the applicant's goods, whilst there may be items covered in the specification which the general public can buy, the specification also covers goods which will be used (or at least installed) by specialists. For instance, "Apparatus and installations for the measurement, monitoring or control of energy consumption" could be used in power stations.

22. The purchasing choice will be predominately visual, for example, via the perusal of advertisements, websites and literature, but I do not ignore the potential for aural use of the marks during the purchasing process.

Comparison of goods

23. In its notice of opposition, the opponent claims that the parties' goods are similar, although I note that the opponent's written submissions in lieu of a hearing include the submission that the goods are identical. This was not pleaded, and the applicant's written submissions were framed on the basis of the pleading of similarity. Likewise, the applicant denied in its counterstatement that the goods are similar, but submitted in its written submissions that there is a very low level of similarity. This is a concession. I will therefore take as my starting point that the opponent's position is that the goods are similar, which is what was pleaded, but I cannot go so far as to say there is no similarity because the applicant has conceded that there is a very low degree of similarity, rather than none. The relevance of this is that the level of similarity has a bearing in the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

24. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

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

25. „Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

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

Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

26. If goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the General Court (“GC”) in *Gérard Meric v OHIM*, case T-133/05.

27. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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.”

28. The opponent's evidence is aimed at showing on what goods the applicant intends to use its mark. It bases this on the website which shows what the applicant does and on material within the DVD which shows use of the mark applied for alongside another mark, WATTWAVE, in relation to the control of domestic appliances. I cannot take into account such material because my assessment of the likelihood of confusion must be made on the basis of what has been applied for, not what the applicant is, or is not doing, with its trade mark, which would mean I would have to take a view as to whether the goods it is using the mark on are covered by the specification. My comparison is on the basis of notional and fair use of what is in the statutory application. The respective goods of each party are:

Earlier mark	Application
<i>Electric or electronic apparatus and instruments for the control and remote control of operating motors for blinds, screens, curtains, shutters, windows, ventilation hatches, locks, doors, garage doors, gates, barriers and grills; apparatus for lighting; electric or electronic monitoring and alarm apparatus and instruments and their control devices for protection of people, goods and buildings.</i>	<i>Apparatus and installations for the measurement, monitoring or control of energy consumption; sensors, meters and controllers for use in energy supply; plugs, sockets, integrated circuit chips and software for use in the measurement, monitoring and control of energy consumption and supply.</i>

29. The applicant submits:

“Clearly both sets of goods are electrical items but this cannot automatically make them similar. The argument in the Notice of Opposition that the goods are similar because they are both “for use with electricity” is specious as this would make a food mixer similar to a television. It is much more relevant to consider the uses of the goods, as this will determine the extent to which they may be complementary, intended for the same purpose, or be in competition.”

The opponent submits (in relation to the applicant's goods):

“Apparatus and installations that control electrical appliances and equipment do so by controlling the energy supplied. The term, “Apparatus and installations for the control of energy consumption” therefore covers a large range of goods from the simple light or socket switch, providing an, “on/off” function to the supply of energy, to an electronic device with, “Smart capabilities enabling control of all energy throughout a residence or building.”

30. The opponent's list of goods *Electric or electronic apparatus and instruments for the control and remote control of operating motors for blinds, screens, curtains, shutters, windows, ventilation hatches, locks, doors, garage doors, gates, barriers and grills* is specific in nature and purpose. They control the operation of motors which open and shut, raise and lower blinds, screens, curtains, shutters, windows, ventilation hatches, locks, doors, garage doors, gates, barriers and grills. The nature and purpose of the applicant's goods is that they measure, monitor and control energy consumption and supply. At a very general level, the parties' goods both control; however the purpose of the control differs depending on what is being controlled. The opponent's goods control motors for curtains and doors, and they have cover for security equipment and controllers for such equipment. The purposes of these goods are different to controlling energy consumption. There is some similarity of nature and purpose between controllers which switch an appliance on and off and the control of energy supply: a simple timer switch controls the operation of a lamp by shutting off or allowing the electricity supply to the socket. To be fair to the opponent, I think what it meant by there being similarity because the parties' goods because they are "for use with electricity" is not that the goods use electricity, but that they relate to the supply of electricity as power. There is a reasonable level of similarity between the opponent's goods which control appliances and the applicant's goods which control the supply of electricity; there may be similar channels of trade and the methods of use are that remote timing could be a feature of both parties' goods. There is no similarity between the opponent's goods and the applicant's goods which control the consumption of energy; the latter are concerned with how much electricity is used, rather than controlling supply of it in order for an appliance to operate.

31. It follows that there is not any similarity of nature, purpose or method of use between the opponent's goods and the applicant's goods which measure and monitor energy consumption. They are not in competition with the opponent's controlling goods and they are not complementary. The same applies to the applicant's goods which monitor and measure energy supply. The opponent's *electric or electronic monitoring...apparatus* are qualified as being for the protection of people, goods and buildings. There is no similarity of nature, purpose, method of use and they are not in competition with or a complementary to the applicant's goods for monitoring energy consumption and supply.

32. The opponent has not explained and it is not clear to me what the similarity is between its *apparatus for lighting* and any of the applicant's goods. In conclusion, bearing in mind the change in the applicant's position as regards no similarity and low similarity between the parties' goods, there is a reasonable level of similarity between the opponent's goods and the applicant's goods which control the supply of energy, but there is only a very low degree of similarity between the parties' other goods.

Likelihood of confusion

33. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency. I should guard against dissecting the marks so as to distort the average consumer's perception of them. The average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

34. I have found that the parties' goods will be chosen after careful research and at least a reasonable level of attentiveness will be paid to the purchasing decision. A high level of attention will lessen a likelihood of imperfect recollection⁶, as per the CJEU's judgment in *Picasso v OHIM*, Case C-361/04, [2006] E.T.M.R.29:

"40. Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between marks relating to such goods at the crucial moment when the choice between those goods and marks is made."

35. Goods for regulating energy consumption are likely to be a long-term, highly considered purchase because of the financial implications and the anticipated longevity of the equipment bought. The level of attention during the purchasing process will be relatively high and on a predominantly visual basis. In relation to the applicant's goods, the mark cannot be referenced aurally. The purchasing process will be visual. In this respect, I cannot take into consideration the opponent's submission (based on its evidence of the applicant's promotional video and website) that it will be used alongside the applicant's mark WATTWAVE: this is matter extraneous to the applicant's registered mark and so is not an element which can be considered as part of the global evaluation⁷. It is the visual perception of the marks which is the most important and, consequently, the result of the visual comparison between the marks carries the most weight in the overall appreciation of the likelihood of confusion between them. The earlier mark has an average level of distinctive character, its

⁶ Although this is not always the case, as per the decisions of the GC in *Apple Computer, Inc v OHIM* Case T-328/05 and *Honda Motor Europe Ltd v OHIM* Case T-363/06. However, these decisions can be distinguished from the present case as they concerned marks which were either almost identical or were similar overall, neither of which is the case in the present proceedings.

⁷ *L'Oreal SA v Bellure NV* [2008] RPC 9, Jacob LJ: "The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too – as though it formed part of the registered mark."

distinctiveness being derived chiefly from its visual representation because the words within the mark are low in distinctive character. The marks are visually similar to a good degree.

36. Taking into account the differences between the marks and the level of attention which will be paid to the goods, there is no likelihood that the marks will be confused directly with one another. However, in the case of the goods where there is a reasonable level of similarity, I have considered whether, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the public wrongly to believe that the respective goods come from the same or economically linked undertakings⁸, there is a likelihood of confusion. Although called „indirect confusion’, it is, nevertheless, confusion within the meaning of section 5(2)(b) of the Act. Mr Iain Purvis QC, sitting as the appointed person in *L.A. Sugar Trade Mark* BL O/375/10, explained indirect confusion in the following terms:

“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”*.

37. For the similar goods (i.e. timer controls), which could be lower in cost, bought in DIY shops and not subject to the closest level of scrutiny, the first impression (which will be visual) will be of a similar common dominant and distinctive element, the white wavy line on a black quadrilateral background. The average consumer is likely to conclude, notwithstanding the absence of the words in the applicant’s mark, that the marks are two brands from the same undertaking. There is a likelihood of confusion in relation to the applicant’s apparatus for the control of energy supply.

⁸ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Outcome

38. The application is refused for the goods which are struck through below⁹, but may proceed to registration for the other goods:

Apparatus and installations for the measurement, monitoring or control of energy consumption; sensors and meters ~~and controllers~~ for use in energy supply; plugs, sockets, integrated circuit chips and software for use in the measurement, monitoring and control of energy consumption ~~and supply~~.

Costs

39. Both sides have achieved a measure of success, the applicant achieving the greater share. In offsetting the opponent's limited success, I will award the applicant a contribution towards the cost of its written submissions. I make no award for the opponent's evidence because (i) it was from the applicant's website and therefore the applicant would have been well aware of its content and (ii) the applicant (rightly) dismissed it as irrelevant in a single short paragraph in its submissions.

40. I order Somfy SAS to pay enModus Limited the sum of **£400**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of February 2013

Judi Pike
For the Registrar,
the Comptroller-General

⁹ As per Tribunal Practice Notice 1/2012.