O/0725/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3736256

IN THE NAME OF
BEIJING SEVEN TALENTS TECHNOLOGY CO., LTD

TO REGISTER THE FOLLOWING TRADE MARK:

DEKCO

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 435132
BY SCOLMORE (INTERNATIONAL) LIMITED

Background and pleadings

1. On 23 December 2021, Beijing Seven Talents Technology Co., Ltd. ("the applicant") applied to register the trade mark shown on the front page of this decision in the UK under application number 3736256. The application was published for opposition purposes on 29 April 2022 and registration is sought for the following goods:

> *Class 9: Security cameras; Surveillance cameras; Video cameras; Video surveillance cameras; Webcams; Video surveillance systems; Electric doorbells; Video baby monitors; Baby monitors; Solar panels; Power switches; Electrical outlets; Sensors for determining temperature; Electronic locks.*

2. On 20 July 2022, Scolmore (International) Limited ("the opponent") filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against some goods in the application, namely *power switches* and *electrical outlets.*

3. In respect of the 5(2)(b) claim, the opponent relies on its UK comparable mark "deco". The opponent's mark was applied for on 7 June 2016 at the European Union Intellectual Property Office (EUIPO) and registered on 13 October 2016. Pursuant to the Withdrawal Agreement, the mark was automatically converted to comparable UK trade mark 915514052. The opponent relies upon the following goods:

> *Class 9: Outlet plates, switch plates, socket plates and blank plates (electrical); sockets; plates shaped to receive switches and/or sockets and/or fused connectors; USB charger; fused connection units; satellite, tv, radio, computer, telephone and data sockets/outlets.*

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had completed its registration processes more than five years before the filing date of the contested mark, it is therefore subject to the proof of use provisions contained in section 6A of the Act.

5. 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.

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

7. Both parties are professionally represented in these proceedings, the opponent by Roome Associates Limited and the applicant by Marinos Cleanthous. Whilst the opponent filed evidence and submissions, the applicant did not. Neither party requested a hearing, however, the opponent did file written submissions in lieu. I now make this decision after careful consideration of the papers before me.

8. 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

9. The opponent's evidence was filed in the form of a witness statement dated 5 December 2022 from the company's director, Gary Campbell Mordue, and 6 exhibits. The purpose of the evidence is to demonstrate that the earlier mark has been put to genuine use for the goods on which the opponent relies. 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

10. 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 goods relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested application: 24 December 2016 to 23 December 2021.

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."

11. 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".

12. 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."

13. 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

14. 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]."

Form of the mark

15. Before I move on to assess if the applicant has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*,

EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still".

16. The opponent's registration is for the word mark "deco", however, the majority of the evidence displays the marks as shown below:

(i) 

(ii) 

17. In respect of the first variant, fair and normal use dictates that the word mark "deco" may be used in a range of standard fonts. As for the border surrounding the word, I consider this to be merely a banal surrounding of the registered mark and it does not alter the distinctive character of the mark as registered. I therefore find the first example shown to be an acceptable variant of the opponent's mark.

18. Turning to the second variant, I acknowledge that where a registered mark is used as part of another mark or with additional matter, this may still constitute use of an acceptable variant of the mark as registered, where this element continues to act independently as an indicator of origin.[1] I consider that the additional word and figurative elements do not alter the distinctive character. The word "plus" appears smaller than "deco". It is less distinctive and will merely be perceived as a range of different products sold under the "deco" mark. The figurative element is not particularly distinctive and it serves to reinforce the "plus" wording. I therefore find this to also be an acceptable variant of the applicant's mark.

Use of the mark

19. Mr. Campbell Mordue explains in his witness statement that Scolmore (International) Ltd is a manufacturer of wiring accessories and lighting products.[2] It is claimed that the opponent's mark has been in continuous use since 2006.[3]

20. Turnover figures have been provided for the goods sold under the mark "deco" in the UK for the last five years however, I note it is not stated which goods these figures specifically relate to. Some of the figures provided are dated outside of the

[1] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12
[2] See paragraph 2 of the witness statement of Gary Campbell Mordue
[3] See paragraph 3 of the witness statement of Gary Campbell Mordue

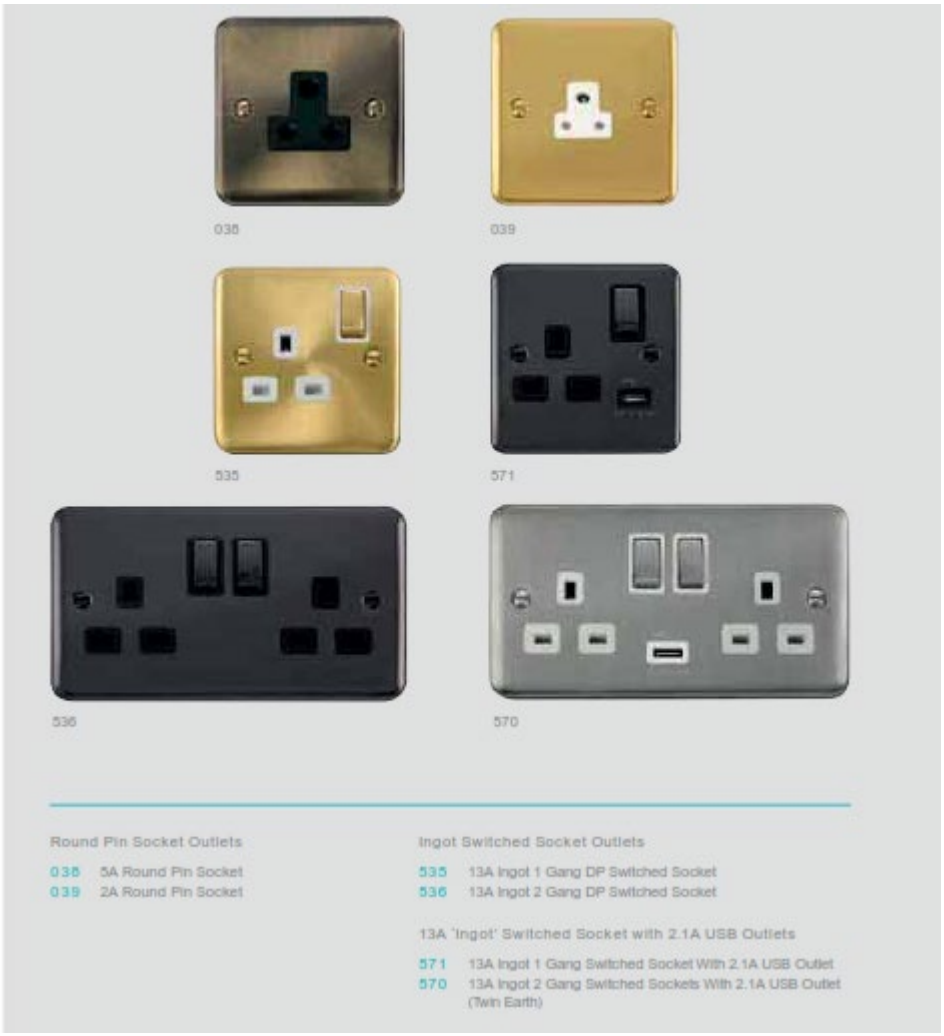
relevant period, so whilst I do not intend to reproduce the table in full here, the total figures from the years 2017 to 2021 are as follows:

Year	Turnover	Average unit price
Jan 2017- Dec 2017	£10,812,595.36	£5.28
Jan 2018- Dec 2018	£11,734,620.39	£5.57
Jan 2019- Dec 2019	£12,103,982.38	£5.98
Jan 2020- Dec 2020	£13,232,436.55	£6.12
Jan 2021- Dec 2021	£16,586,997.30	£6.32

21. Exhibit GCM2 provides invoices of sales made within the UK. Most of the invoices are from within the relevant period. Whilst the earlier mark is not present on the invoices, the opponent has highlighted items on the invoice that originate from the "deco" range. I note the items sold include switches, switch plates with USB and socket outlets. The items highlighted appear to correspond to those listed in the brochures in exhibit GCM3. By way of example, a 2017 invoice highlights the following products:

Product Code	Description	Qty	Unit Price	Total
VPBN140	VPBK NICKEL 1GANG 2WAY 400W DIMMER SWITC	1	10.1136	10.11
VPBN535BK	INGOT 1GANG 13A DP SW SOCKET	1	4.1944	4.19
VPBN536BK	13A 2G INGOT SW SOCKET OUTLET	2	6.3798	12.76
M1999	COLLECTION AFTER 2PM SAME DAY	1	0.0000	0.00

22. The corresponding catalogue from 2017 displays switches next to the "deco" mark, listing products such as "13A Ingot 1 Gang DP Switched Socket":



23. I am therefore satisfied that the invoices display sales made within the UK under the “deco” mark within the relevant period.

24. Brochures and price lists have been included in exhibit GCM3 displaying the “deco” mark alongside goods such as switch plates, however, only one of the examples included (“Wiring Accessories 2017”) is dated within the relevant period. From the evidence, it is unclear how widely these brochures and price lists were circulated within the UK.

25. Exhibit GCM4 includes copies of advertisements and brochures from within the UK promoting goods under the “deco” mark. Whilst I note that none of the examples provided are dated, in the witness statement, Mr. Campbell Mordue has provided a list of the dates, the majority of which are dated within the relevant period. I remind myself that Mr. Campbell Mordue is the director of the opponent’s company and has provided a statement of truth within his witness statement. I therefore have

no reason to dispute his claims regarding the dates of the exhibits provided. I further note that the applicant has also not challenged these claims. The examples given show goods such as outlet plates, outlet plates with built in USB chargers and switch plates being sold under the “deco” mark.

26. Mr. Campbell Mordue further explains that his company also regularly promotes goods sold under the “deco” range at trade shows. Exhibit GCM5 includes photos of the opponent’s stands at various trade shows throughout the UK, the majority of which are said to be dated within the relevant period. Though it is unclear how many people would have attended these events and been exposed to the mark, the opponent’s mark can be clearly seen alongside switch plates, outlet plates, switch plates, fused connection units, sockets and plates shaped to receive switches and/or sockets and/or fused connectors:

27. Advertising figures for promoting goods under the “deco” range within the UK have been provided for within the relevant period and are as follows:

Years	Advertising Spend
Dec 2016- Dec 2017	£11,220.00
Dec 2017- Dec 2018	£2,950.00
Dec 2018- Dec 2019	£16,565.00
Dec 2019- Dec 2020	£9,720.00
Dec 2020- Dec 2021	£3,860.00

Genuine Use

28. Considering the sum of the evidence, including invoices, the turnover and advertising figures between 2017 and up to 2021 and the use of the earlier mark in catalogues, brochures and at trade shows it is my view that the opponent has made use of the mark within the relevant period. The use made by the opponent does not appear to be token, solely for the purpose of preserving the rights conferred by the registration of their mark. Rather, I find the use to be for the purpose of creating and preserving a share of the market within the UK 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 9.

Fair Specification

29. 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."

30. 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."

31. The opponent covers goods in class 9 including *outlet plates, switch plates, socket plates and blank plates (electrical); sockets; plates shaped to receive*

switches and/or sockets and/or fused connectors; USB charger; fused connection units; satellite, tv, radio, computer, telephone and data sockets/outlets. I do not find that the use shown warrants protection for *satellite, tv, radio, computer, telephone and data sockets/outlets* as there is no evidence of these goods being sold within the relevant period. I find that the consumer would consider *Outlet plates, switch plates, socket plates and blank plates (electrical); sockets; plates shaped to receive switches and/or sockets and/or fused connectors; USB charger* and *fused connection units* 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)

32. 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".

33. Section 5A states:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

34. 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

35. In C*anon*, 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".

36. 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.

37. 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".

38. In light of my findings above, the competing goods are as follows:

Opponent's Goods	Opposed Goods
Class 9: Outlet plates, switch plates, socket plates and blank plates (electrical); sockets; plates shaped to receive switches and/or sockets and/or fused connectors; USB charger and fused connection units.	**Class 9:** Power switches; Electrical outlets.

39. Albeit worded differently, I consider *electrical outlets* and *sockets* to be describing the same goods. These terms are therefore identical.

40. I take the term *switch plates* to mean a plate placed in front of an electrical switch for the purpose of protecting electrical wiring and preventing accidental contact with live wires. It is common for a switch to be incorporated into the structure of a *switch plate*, so there is therefore an overlap in terms of nature and method of use with these goods and the applicant's *power switches*. The respective goods would be sold via the same trade channels so it follows that there would be an overlap in users. There may also be a degree of competition as consumers would be faced with the choice of purchasing various types of switches or switch plates during the purchasing process. I consider that there is a complementary relationship between the goods as *power switches* have an important and indispensable relationship with *switch plates* and this is to the extent that consumers would believe that the goods are derived from the same undertakings.[4] Overall, I consider there to be a high degree of similarity between these goods.

The average consumer and the nature of the purchasing act

41. 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

[4] See *Boston Scientific Ltd v OHIM,* Case T-325/06

> "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

42. 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 level of attention to the goods.

43. 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

44. 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."

45. 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.

46. The marks to be compared are as follows:

Opponent's Mark	Applicant's Mark
deco	

47. The opponent's mark consists of the word "deco". The overall impression resides in the mark as a whole.

48. The applicant's mark consists of the word "DEKCO" in a stylised uppercase font. The wording dominates the overall impression with the stylisation playing a secondary role.

Visual comparison

49. The respective marks overlap visually in respect of the first two letters "DE" and the last two letters "CO". A point of difference is created by the letter "K" in the centre of the applicant's mark. Whilst I note the applicant's mark is mildly stylised, the opponent's mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used.[5] For this reason, I do not consider

[5] see *LA Superquimica v EUIPO,* Case T-24/17, paragraph 39

the stylisation of the applicant's mark adds a significant point of difference. Considering these factors, I find there is between a medium and high degree of similarity between the marks.

Aural comparison

50. In their submissions, the opponent argues that the respective marks will be pronounced in the same way and the additional letter "K" in the applicant's mark will not make any difference to the pronunciation. I agree and find that both marks will be pronounced in two syllables as DECK-O. They are therefore aurally identical.

Conceptual comparison

51. 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 GC and the CJEU including *Ruiz Picasso v OHIM*[6]. The assessment must be made from the point of view of the average consumer.

52. The opponent asserts the respective marks will have no conceptual meaning for the relevant public.

53. The applicant claims that "deco" will be perceived as an abbreviation of "art deco" or as the beginning of the word "decoration". They also claim that it could be perceived as the nickname for the footballer Mr. Anderson Luis de Souza.

54. I agree that the applicant's mark will not convey any meaning to the average consumer. In respect of the opponent's mark, I find that even though "deco" is not a dictionary-defined word in the English language, it will most likely be seen as an abbreviation of the word "decoration" or will bring to mind the style of art and architecture known as "art deco". If the opponent's mark is perceived this way, the marks are conceptually dissimilar.

[6] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

Distinctive character of the earlier mark

55. 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 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 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)."

56. 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.

57. I will begin by initially assessing the inherent distinctiveness of the opponent's mark.

58. As previously outlined in the conceptual comparison, the average consumer will acknowledge that "deco" is not a dictionary-defined English word however, it will most likely be perceived as either an abbreviation of "decoration" or it will bring to mind the artistic style of "art deco". I am therefore of the view that the opponent's mark is somewhat allusive to the goods for which it is registered and therefore holds a slightly below medium degree of distinctive character.

59. I will now consider whether the evidence filed by the opponent demonstrates that the distinctiveness of the earlier mark has been enhanced through use. The relevant date for this assessment is the filing date of the contested application, 23 December 2021.

60. In the witness statement of Mr. Campbell Mordue, it is claimed that the opponent's mark has been in continuous use since 2006,[7] however, the earliest piece of evidence provided is a price guide catalogue from 2010[8].

61. Previously in paragraphs 20 of this decision, I outlined the opponent's turnover figures from within the relevant period. Whilst the figures are not insignificant, there is no information for me to gauge how much of the relevant market share the opponent has. Considering the prevalence of the opponent's goods in households and businesses, the relevant sector must be fairly sizeable.

62. Further, I previously outlined in paragraph 27 of this decision the opponent's advertising expenditure. I do not consider these figures to be particularly significant. Whilst I note that it has been evidenced that the mark has been advertised in brochures

[7] See paragraph 3 of the witness statement of Gary Campbell Mordue
[8] See exhibit GCM3

and catalogues[9], it is unclear how widely these were circulated throughout the UK. Similarly, I note that the opponent has attended trade shows throughout the UK, promoting goods with the "deco" mark,[10] however, I am unable to ascertain the number of attendees that would have been at these events and exposed to the mark.

63. While the evidence provided was sufficient to demonstrate genuine use of the opponent's mark, I remind myself that the test for enhanced distinctiveness is considerably more onerous. Taking the above into account, I do not consider that the evidence provided by the opponent is sufficient to show that the distinctiveness of their earlier mark has been enhanced through use.

Likelihood of confusion

64. 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]).

65. 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.

66. Earlier in this decision I concluded that:

- The competing goods are identical or similar to a high degree;

[9] See exhibit GCM4
[10] See exhibit GCM5

- The average consumer will consist of both the general public and professionals, the former demonstrating a medium level of attention and the latter demonstrating at least a medium level of attentiveness during the selection process;

- The purchasing process will be predominantly visual in nature, though aural considerations will not be discounted;

- The opponent's mark holds a slightly below medium degree of distinctive character. This has not been enhanced through the use made of it;

- The opponent's mark is visually similar to the applicant's mark to a medium to high degree;

- The competing marks are aurally identical;

- The opponent's mark is conceptually dissimilar to the applicant's mark.

67. I first note that the respective marks overlap in respect of the first two letters and last two letters with the two points of difference being the presence of the letter K in the middle of the applicant's mark and the stylisation (though I note I found the stylisation to play a secondary role in the mark's overall impression). The fact that I found the goods to be identical or highly similar is also a factor weighing in the opponent's favour. Further, 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[11] and in relation to the goods, I have found that visual aspects will dominate during the purchasing process. Even if I found the marks to be conceptually dissimilar, this does not neutralise the aural identity and visual similarities previously established.[12] With this in mind, I find that the point of difference in the letter K in the applicant's mark may go unnoticed by the average consumer even when paying a medium degree of attentiveness, especially when taking into account its position in

[11] See *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03
[12] See *Nokia Oyj v OHIM,* Case T-460/07

the centre of the mark. I also find that the stylisation of the applicant's mark may be overlooked or misremembered. Considering these factors alongside the interdependency principle, I find that the average consumer is unlikely to recall the differences between the marks and as such, there is a likelihood of direct confusion.

68. I now go on to consider indirect confusion.

69. 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.)

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

71. For a finding of indirect confusion, I would need to conclude that consumers will notice the common "de" and "co" elements and assume that the marks are from the same or related undertakings. I am not convinced that the presence of the letter "k" positioned centrally in the applicant's mark is a signifier of a brand extension or a sub-brand and, as such, I do not see a logical step which would cause consumers to be indirectly confused. Instead, I find the average consumer would put the presence of the common elements down to coincidence rather than an economic connection[13] and consequently, I do not find there to be any likelihood of indirect confusion.

Conclusion

72. The opposition under section 5(2)(b) of the Act has succeeded. Subject to any successful appeal against my decision, the application will be refused in the UK in relation to the opposed goods, namely *power switches* and *electrical outlets.*

73. Subject to the outcome of separate proceedings under opposition number 435130 against the same application, the application will proceed to registration in respect of the following goods:

Security cameras; Surveillance cameras; Video cameras; Video surveillance cameras; Webcams; Video surveillance systems; Electric doorbells; Video baby monitors; Baby monitors; Solar panels; Sensors for determining temperature; Electronic locks.

[13] See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

COSTS

74. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award the opponent the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a statement and considering the other side's statement:	£200
Preparing and filing evidence:	£500
Filing written submissions:	£300

75. I therefore order Beijing Seven Talents Technology Co., Ltd.to pay the sum of £1100 to Scolmore (International) Limited. 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 27th day of July 2023

Catrin Williams
For the Registrar