

O/0845/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003821349
IN THE NAME OF SHENZHEN FORSAFE SYSTEM TECHNOLOGY CO., LTD
FOR THE FOLLOWING TRADE MARK:

Forsafe

IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 437809
BY CITY ELECTRICAL FACTORS LIMITED

BACKGROUND AND PLEADINGS

1. On 18 August 2022, Shenzhen Forsafe System Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 2 September 2022 and registration is sought for the following goods:

Class 9 Data processing apparatus; computer programs, recorded; interfaces for computers; monitors [computer programs]; integrated circuit cards [smart cards]; computer hardware; black boxes [data recorders]; thin client computers; fog signals, non-explosive; light-emitting electronic pointers; transmitters of electronic signals; transmitting sets [telecommunication]; radios; remote control apparatus; acoustic alarms; alarms; anti-theft warning apparatus; fire alarms; buzzers; smoke detectors; batteries, electric; Facial recognition apparatus; flashing lights [luminous signals]; Transponders; detectors; measuring apparatus; security surveillance robots.

2. On 1 December 2022, the application was partially opposed by City Electrical Factors Limited (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon trade mark no. UK00002047170 for the mark FIRESAFE, which was filed on 2 December 1995 and registered on 25 April 1997. The opposition is directed against only those goods underlined in the preceding paragraph. The opponent relies upon all goods for which the mark is registered, namely:

Class 9 Fire alarms; fire and smoke detection apparatus and installations and parts thereof.

3. The opponent claims that the applicant’s trade mark is highly similar to its own mark and that the goods are identical, resulting in a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its mark.

5. The applicant was originally represented by Revomark and is now represented by Cam Trade Marks & IP Services. The opponent is represented by Marks & Clerk LLP.

6. Only the opponent filed evidence. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

7. The opponent filed evidence in the form of the witness statement of Mark Stephen Jacobs dated 11 April 2023, which is accompanied by 13 exhibits. Mr Jacobs is the Finance Director of the opponent, a position he has held since 3 June 2004.

8. The applicant filed written submissions in lieu dated 17 July 2023.

9. The opponent filed written submissions in lieu dated 18 July 2023.

10. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

RELEVANCE OF EU LAW

11. 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 upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

12. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

13. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. However, for reasons that will become apparent later in this decision, I do not consider that the issue of proof of use will be determinative in these proceedings, and I will conduct my assessment on the basis that the opponent can rely upon the full breadth of its specification.

14. 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:

(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 greater 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

15. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 9</u> Fire alarms; fire and smoke detection apparatus and installations and parts thereof.	<u>Class 9</u> Acoustic alarms; alarms; fire alarms; buzzers; smoke detectors; batteries, electric; detectors.

16. The term "fire alarms" appears identically in the specifications of both marks. Consequently, I will conduct my assessment on the basis that at least some of the goods are identical.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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 (as he then was) 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.”

18. The average consumer for the goods is likely to be a member of the general public or, in the context of fire alarms for commercial premises, a business user. Even where the goods are relatively low cost, given their importance in ensuring the safety of the user, I consider that a higher than average degree of attention will be paid. Where the user is a business user, who will be concerned with the safety of those entering its premises, I consider that a high degree of attention will be paid.

19. The goods are likely to be selected from the shelves of a retail outlet or their online equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of trade marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) 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 relative 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.”

21. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the 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.

22. The parties' respective marks are set out as follows:

Opponent's trade mark	Applicant's trade mark
FIRESAFE	<i>Forsafe</i>

23. The opponent's trade mark consists of the conjoined words FIRESAFE. The overall impression lies in the combination of these elements. The applicant's trade mark consists of the conjoined words FORSAFE, presented in a slightly stylised font. The overall impression of the mark lies in the combination of these words, with the stylisation playing a lesser role.

24. Visually, the marks overlap in that the second word in both is SAFE. They differ in that the first word of each mark is different (FIRE in the opponent's mark and FOR in the applicant's mark). However, I note that both begin with the letter F and contain the letter R, albeit the latter is in different positions. In my view, the marks are visually similar to a medium degree.

25. Aurally, the opponent's mark will be pronounced in the same way as the dictionary words FIRE and SAFE. The applicant's mark will be pronounced in the same way as the dictionary words FOR and SAFE. In my view, they are aurally similar to a slightly higher than medium degree.

26. Conceptually, the opponent accepts that the words FOR and FIRE have different meanings and that the result of this is that the opponent's mark has the conceptual

meaning of “to protect or safeguard from fire” and the applicant’s mark has the conceptual meaning of “safety for you”. I am not convinced about the latter interpretation, it is more likely that the applicant’s mark will be interpreted as meaning “intended for safety”, in my view. However, in either case, the differing words FIRE and FOR create different conceptual messages overall, notwithstanding the common conceptual meaning of the word SAFE. In my view, the marks are conceptually similar to only a low degree.

Distinctive character of the earlier mark

27. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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-2779, 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).”

28. Registered trade marks possess varying degree 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

29. The opponent's mark consist of the conjoined words FIRESAFE. In its written submission in lieu, the applicant pointed to various other trade marks which are registered in class 9 and which include the words FIRESAFE. No evidence has been filed to demonstrate that these marks are actually being used in the marketplace, and so I do not consider that this evidence assists the applicant. However, I agree with the applicant's more general point that, in the context of fire alarms and smoke detection apparatus (and parts for those goods), the words FIRESAFE will be highly allusive. Therefore, I consider the opponent's mark to be inherently distinctive to a low degree.

30. I now turn to consider whether the distinctiveness of the opponent's mark has been enhanced through use. I note the following from the opponent's evidence:

- a) The opponent has been using the FIRESAFE brand since 1994 in relation to fire-related goods such as alarms, sounders and smoke detectors.
- b) The mark has been used on the opponent's website since at least 7 November 2017.¹
- c) It has also been used in brochures since at least 2016/2017.²
- d) Products are sold in packaging displaying the FIRESAFE brand.
- e) In relation to products sold under the FIRESAFE brand, between May 2021 and April 2022 the opponent made sales of over £5million and between May 2022 and August 2022 the opponent made sales of over £2million.

¹ Exhibit MSJ1

² Exhibit MSJ6

- f) A sample of invoices have been provided dated between 7 September 2017 and 20 February 2022.³ These invoices are all addressed to the opponent and appear to be for delivery to various locations from which the opponent operates. They relate to FIRESAFE goods such as batteries, smoke detectors, fire alarm kits and fire panels. I note that the fire alarm kit costs approximately £500 and the fire panels cost between approximately £250 and £450. Smoke detectors cost approximately £45.
- g) The opponent's LinkedIn page has around 26,000 followers, but the FIRESAFE dedicated page has only around 160 followers. Promotional activities have been carried out through social media, but there are limited examples of this which can be dated prior to the relevant date and, in any event, it appears to have had a limited reach in terms of likes and subscribers.⁴
- h) FIRESAFE products have been advertised on a number of occasions between 2018 and 2020 in a publication called Electrical Contracting News, although no information is provided about the reach of this publication.⁵
- i) Examples of other adverts have been provided, although no information is given about the reach these achieved.⁶
- j) The opponent has also promoted its FIRESAFE brand through trade fairs in 2019 and incurred expenditure associated with its promotional catalogues.⁷

31. Whilst I am satisfied that the opponent has been trading under the FIRESAFE brand and its sales figures are not insignificant, I have no information about market share or overall advertising expenditure. Further, I have only been provided with sales figures for 2021/2022 and so have limited information about the extent of use prior to that period. In my view, the evidence is not sufficient to establish that the distinctiveness of the earlier mark has been enhanced through use.

³ Exhibit MSJ8

⁴ Exhibits MSJ9 and MSJ10

⁵ Exhibit MSJ11

⁶ Exhibit MSJ12

⁷ Exhibit MSJ13

Likelihood of confusion

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

33. I have found as follows:

- a) At least some of the goods are identical.
- b) The average consumer is a member of the general public or a business user, who will pay a higher than average degree of attention during the purchasing process (although for business users, the level of attention is likely to be high).
- c) The purchasing process is predominantly visual, although I do not discount an aural component.
- d) The marks are visually similar to a medium degree, aurally similar to a slightly higher than medium degree and conceptually similar to a low degree.
- e) The earlier mark is inherently distinctive to a low degree.

34. The identity of the goods is clearly a factor in favour of the opponent. However, taking all of the above factors into account, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other. This is particularly the case given the only medium degree of visual similarity between the marks and the fact that the average consumer will be paying at least a higher than average degree of attention during the purchasing process. I note that the aural similarity is slightly higher, but the purchasing process will be predominantly visual and the mark is likely to be encountered visually prior to purchase. Further, in my view, the differing first words will be recognised by the consumer as being different dictionary words with different meanings, which will assist in distinguishing one mark from the other. I do not consider there to be a likelihood of direct confusion. As this finding applies where the goods are identical, it will also apply even if they are only similar.

35. Having recognised the differences between the marks, I consider it unlikely that the average consumer will conclude that they originate from the same or economically linked undertakings. The earlier mark is of low inherent distinctiveness, and I consider it more likely that the common use of the word SAFE, in the context of goods aimed at fire safety, is more likely to be viewed as coincidence rather than indicating linked undertakings. The marks are not consistent with a brand extension or variant. Consequently, I do not consider there to be a likelihood of indirect confusion.

36. For the avoidance of doubt, even if I had found there to be some enhancement to the distinctiveness of the earlier mark (which, at best, would take it to an average degree of distinctiveness overall), I would have reached the same conclusion bearing in mind the differences between the marks and the level of attention being paid during the purchasing process.

CONCLUSION

37. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

38. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,150**, calculated as follows:

Considering the Notice of opposition and filing a counterstatement	£250
Considering the opponent's evidence	£550
Written submissions in lieu	£350
Total	£1,150

39. I therefore order City Electrical Factors Limited to pay Shenzhen Forsafe System Technology Co., Ltd the sum of £1,150. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of September 2023

S WILSON

For the Registrar