**O/0868/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3734167**

**IN THE NAME OF**

**CONNEXION DEVELOPMENTS LTD**

**TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:**


**AND**


**(SERIES OF TWO)**

**IN CLASS 7, 9, 11 & 17**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 434252 BY**

**GEMÜ GEBR. MULLER APPARATEBAU GMBH & CO. KOMMANDITGESELLSCHAFT**

## Background and pleadings

1. On 17 December 2021, Connexion Developments Ltd ("the applicant") applied to register the series of trade marks shown on the cover page of this decision in the UK ("the application"). The application was published for opposition purposes on 15 April 2022 and registration is sought for the following goods:

> Class 7: Valves as machine components; mechanical valves; piston valves; air-actuated valves; non-return valves; coaxial valves; dust-collecting pulse valves; foot strainer valves; air control valves; float valves; pedal valves; pressure control valves; valve timers; drain valves; breaker valves; valve diaphragms; air filters for mechanical purposes; filters for machines; air cleaners; parts and fittings for all the aforesaid goods.
>
> Class 9: Solenoid valves; electromagnetic coils; electrical connectors; panic buttons; electrical push button panels and switches; electric timers; armatures; electrical components; parts and fittings for all the aforesaid goods.
>
> Class 11: Filters for industrial and household use; air cleaning filters and air filter elements; air purifier filters; air conditioning apparatus; industrial air filter machines; air filters for use as dust arrestants and extractors in industrial processes; solenoid controls for automatically-operating valves; ball valves; water regulating valves; parts and fittings for all the aforesaid goods.
>
> Class17: Non-metallic tubing; pipe and tube connectors and couplings (non-metallic); parts and fittings for all the aforesaid goods.

2. On 15 June 2022, GEMÜ Gebr. Müller Apparatebau GmbH & Co. Kommanditgesellschaft ("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 all goods in the application.

3. The opponent relies upon the following trade marks:

| | Mark: | Reg no. | Filing date | Reg. date | Priority date |
|---|---|---|---|---|---|
| 1 |  | 917546169 | 01/12/2017 | 17/05/2018 | N/A |
| 2 |  | 801468260 | 07/08/2018 | 25/10/2019 | 13/07/2018 |
| 3 |  | 801295503[1] | 01/12/2015 | 16/09/2016 | 03/06/2015 |

4. The opponent's marks are all comparable marks. The first earlier mark is based on the opponent's EU mark and the second and third marks are based on the opponent's earlier International Registrations designating the EU. On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the Registry created comparable UK trade marks for all rights holders with existing EUTMs and IRs. As a result, at the end of the Implementation Period on 31 December 2020, comparable UK trade marks were automatically created. The comparable trade marks shown above are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law and retain their original filing dates.

5. The goods relied upon by the opponent are set out in paragraphs 30 and 43 of this decision.

6. By virtue of their earlier filing dates, the above registrations constitute as earlier marks within the meaning of section 6 of the Act. The first and second earlier marks completed their respective registration processes less than five years before the filing date of the application and are therefore not subject to proof of use pursuant to section 6A of the Act. The third earlier mark had completed its registration process more than five years before the filing date of the applicant, it is therefore subject to the proof of use provisions contained in section 6A of the Act.

7. The opponent submits that there is a likelihood of confusion because the marks in the application are similar to the opponent's and the respective goods are identical or similar.

[1] This mark is currently subject to revocation proceedings.

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

9. The opponent is represented by Stevens & Bolton LLP and the applicant by Stevens Hewlett & Perkins. Whilst the opponent filed evidence and submissions, the applicant did not. Neither party requested a hearing, however, both parties filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

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

11. The opponent's evidence was filed in the form of the witness statement of Marcus Ripsam dated 5 December 2022, which is accompanied by 14 exhibits, being those labelled MR1 to MR14. Mr Ripsam is the Chief Operating Officer of Inevvo Solutions GmbH & Co. KG., an affiliated company of the opponent. 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.

**Preliminary issue**

12. In their submissions in lieu, the applicant challenges the fact that the opponent's evidence is from Inevvo Solutions. They claim that there is no explanation or evidence as to what the affiliation is between the two companies or how Innevo Solutions are involved in business with the opponent. As such, they claim that the evidence provided fails to show that the use being offered as evidence is made by the

opponent with their express consent because the nature of the relationship between the parties is unexplained.[2]

13. I reject this argument on the basis that the relationship between the opponent's company and Inevvo solutions is explained in paragraph 20 of their submissions stating, "Insofar as UK 801295503 has been used by Inevvo solutions GmbH & Co KG, such use was as an affiliated company of the Opponent and with its authority." As per section 6A(3)(a) of the Act (which is reproduced below), use with consent of the opponent is acceptable as a condition of use.

**DECISION**

**Proof of use**

14. The applicant has requested proof of use in these proceedings in respect of the opponent's third 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 application: 18 December 2016 to 17 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

[2] See paragraph 14 of the applicant's submissions in lieu.

(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."

15. 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".

16. 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."

17. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

**Relevant case law**

18. 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 CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.
>
> 115. The principles established by these cases may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

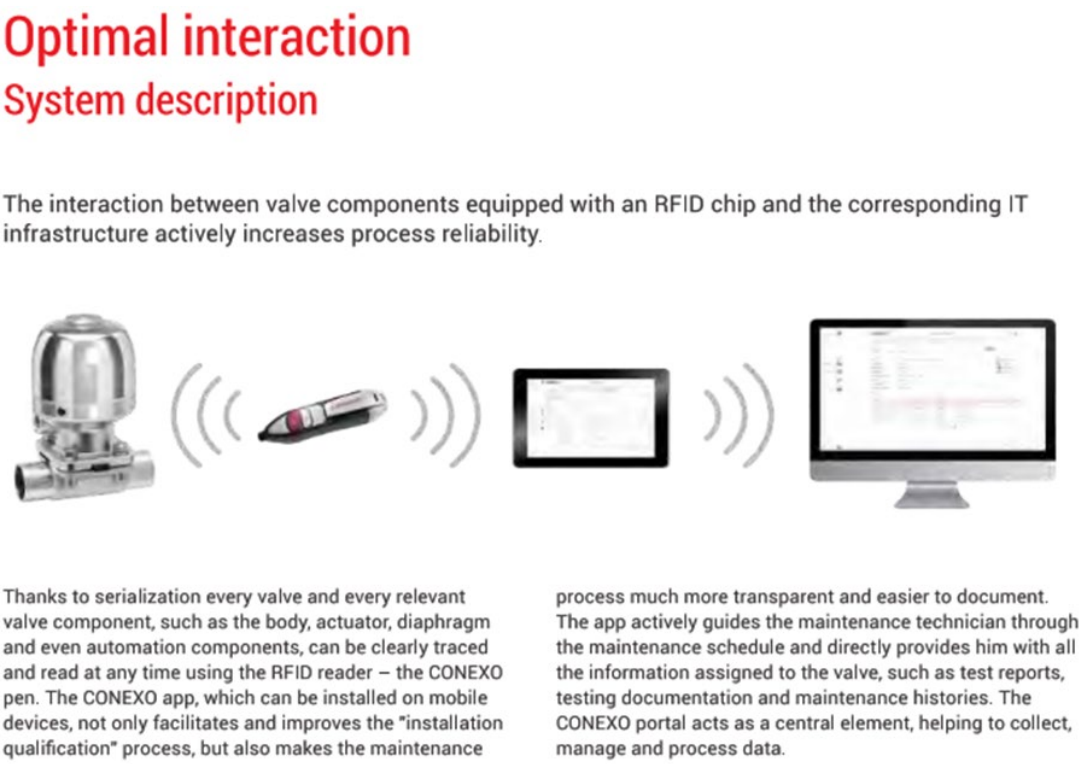
(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

**Use of the mark**

19. Mr. Ripsam explains in his witness statement that in 2015, GEMU developed its CONEXO system which allows for the electronic unique identification of valves and components through the use of Radio Frequency Identification (“RFID”) chips and QR codes and supports documentation management and paperless maintenance. It is further explained that the CONEXO system uses GEMU’s CONEXO tags, which can be read using the electronic CONEXO pen which then feeds data to the CONEXO

software products via an app, portal and online system. The CONEXO system itself can be purchased with or retrofitted to GEMU's products and can also be used in conjunction with third party components and systems.[3]

20. By way of example, the CONEXO brochure provided in exhibit MR8 outlines how the CONEXO system works:




21. Sales figures from various countries across the EU such as France, UK, Austria, Germany, Spain and Poland (amongst others) have been provided for GEMU components such as valves and actuators which are equipped with a CONEXO RFID chip. These figures range from 2017 to 2022 but given that use in the EU is only relevant up until 31 December 2020, I have only re-produced those relevant to the present assessment below.

| **Year** | **Total (€)** |
|---|---|
| 2017 | 1,408,228 |
| 2018 | 7,281,094 |

[3] See paragraphs 8, 9 & 10 of the witness statement of Mr. Ripsam

| | |
|---|---|
| 2019 | 8,132,262 |
| 2020 | 2,512,897 |
| **Total:** | **19,334,481** |

22. As for the UK only figures, these cover sales of €5,994 for 2021 (with the 2022 figures being outside the relevant period). Given that the end of the relevant period is 17 December 2021, I will proceed on the basis that the entirety of the 2021 figures fall before that. This is due to the fact that the conclusion of the relevant period is in such close proximity to the end of that year.

23. I acknowledge that the figures shown above are specifically for GEMU components, however, the components themselves are fitted with a CONEXO RFID chip. From this, I find it reasonable to consider that users purchasing these GEMU components, do so with the intention of using them with the CONEXO system.

24. Mr. Ripsam claims that exhibit MR2 shows examples of how the mark has been used on the opponent's products and services however many of the examples are undated brochures and articles simply explaining how the CONEXO system works. Pages 17 to 23 of exhibit MR2 show parts such as valves and gauges labelled with CONEXO labels and tags however, the photos are undated and no further information about these images is provided.

25. From the articles dated within the relevant period in exhibit MR2, I note the following:

- In 2018, GEMU was an exhibitor at the ACHEMA trade fair in Frankfurt. The fair was attended by approximately 145,000 visitors and reference is made to the CONEXO system.
- The CONEXO Lite app was launched on 20th September 2019 and made available via the Apple store and Google Playstore.
- Several articles have been provided in German however they are dated within the relevant period and clearly refer to the CONEXO mark, RFID chips and QR codes which make up part of the CONEXO system.

26. The evidence sets out that the CONEXO Lite app has been available since 2019 and it enables users to identify components of the CONEXO system. The number of CONEXO Lite users is shown in exhibit MR4 however, there are shortcomings with this evidence. The number of users shown for the Android app includes users from all countries/regions so it is unclear how many users would include those from within the relevant territory. In terms of the iOS users, the time period given is from 1 October 2018 to 1 December 2022 so it is unclear how many users would have installed the app within the relevant period. I also note that the number of UK users is not provided. I accept that the number of users from within the EU such as users from Germany and France would be relevant, however, this would only be acceptable up to 31 December 2020.

27. Mr. Ripsam claims that since 2016, the opponent has spent over €500,000 in promotion and advertising of the CONEXO products and services. [4] Promotional materials from 2016 and 2017 are provided in exhibit MR6 which portray the mark CONEXO and describe CONEXO as "electronic identification and paperless maintenance".

28. In addition to the promotional materials, it is claimed that a large number of CONEXO brochures have been issued during the relevant period at events in the EU and the UK.[5] A spreadsheet is provided in exhibit MR12 showing the numbers and record of issued CONEXO brochures throughout the EU and the UK for the years 2016 to 2021. I note that 50,000 copies were issued in 2018 and 25,000 copies in 2019 for the PPMA Exhibition in Birmingham.

**Genuine Use**

29. Considering the sum of the evidence including the turnover and advertising figures between 2017 and 2021 and the use of the earlier mark on websites, in 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

[4] See paragraph 27 of the witness statement of Mr. Ripsam.
[5] See paragraph 36 of the witness statement of Mr. Ripsam

be token, solely for the purpose of preserving the rights conferred by the registration of their mark. Further, even if this level of use could be said to be low (on this point, I note that I have nothing to suggest the size of the market for the opponent's goods across the EU at large), I remind myself that use need not be quantitively significant for it to be deemed genuine. Bearing all of this in mind, I am content to conclude that the opponent has used its mark in the UK and across the EU during the relevant period. That being said, I do not consider that the opponent has demonstrated use for all goods and services for which its mark is registered and I will now consider a fair specification in respect of the above.

**Fair Specification**

30. I now need to consider what constitutes a fair specification for the third earlier mark, having regard for the goods upon which genuine use has been shown. I remind myself that the goods and services of the third earlier mark are as follows:

> Class 7: Mechanical, pneumatic or hydraulic control elements and controls for valves; actuators for valves [machine parts]; control mechanisms for machines, engines and motors, namely drives of metal or plastic [operated manually or externally controlled]; pneumatic or hydraulic operated switches, valve diaphragms for actuating industrial plants [parts of machines]; valves, clack valves, diaphragms and taps of plastic and/or metal as machine parts for hydraulic and pneumatic media, included in this class; electric, pneumatic and hydraulic actuators for valves, namely electromagnetically, pneumatically or hydraulically operated cylinders; machines and installations composed thereof suitable for use in clean rooms for manufacturing of medical equipment, for manufacturing of data carries, for display manufacturing, automobile manufacturing, micro-engineering, semi-conductor manufacturing and solar manufacturing, for manufacturing in the pharmaceutical industry, in the medical technology and for manufacturing in the food and packaging technology; all above-mentioned goods exclusively provided with one or more electronic data memories.

Class 9: Measuring, detecting and monitoring instruments, indicators and controllers for gases and liquids; fittings for measuring technology and control engineering provided with one or more electronic data memories; apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves; flowmeters, flow controllers; pressure measuring apparatus and pressure regulating apparatus for hydraulic and pneumatic installations and electromagnetically operated relay valves; electric and electronic control and regulating apparatus, in particular for valves and for the installation in plants, for example manufacturing plants for the production of data carriers, manufacturing plants for the display or automobile industry, in micro-technology, in the semi-conductor, solar or pharmaceutical industry or in the medical technology, in the food or packaging technology; switches; none of the aforementioned products being or relating to computer software or hardware in the field of smart metering of energy, smart grids or energy management.

Class 42: Scientific and technological services and research and design services relating thereto; industrial analysis and research services; design of software; all aforementioned services in the field of measurement technology, drive technology, control and regulation technology for valves, including field bus technology and industrial communications; none of the aforementioned services relating to tracking and monitoring energy usage, and energy management.

31. I do not find that the use shown warrants protection for the goods in class 7 or the services in class 42 as there is no evidence of these goods and services being sold within the relevant period. Whilst I accept that the evidence shows images of valves, gauges and diaphragms, it is clear from the evidence that these goods are sold under the mark 'GEMU' and customers are afforded the option of having these items fitted with an RFID chip or a tag under the mark CONEXO for the purposes of monitoring and paperless maintenance.

32. As for the class 9 goods, there are more goods for which no use has been shown. However, I note that the opponent's specification includes "*measuring,*

*detecting and monitoring instruments, indicators and controllers for gases and liquids"* at large. I consider that the goods shown in the evidence can be said to fall within this category of goods. However, this is a fairly broad term that goes beyond the use shown. While it is not the purpose of a fair specification assessment to limit the opponent's goods to the narrowest possible terms, I remind myself that the question to ask when considered a fair specification assessment is, how would the average consumer fairly describe the goods in relation to which the mark has been used.[6] In the present case, I find that the average consumer would fairly describe the use shown in evidence as "*fittings for measuring technology and control engineering provided with one or more electronic data memories* and *apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves"*. I consider this to be a fair description of the goods evidenced and, therefore, for the purposes of a fair specification, limit the opponent's third mark to this term only.

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

33. 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".

34. 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."

[6] See *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

35. 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.

**My approach**

36. The opponent has relied upon three earlier marks under this ground of opposition. I am of the view that the goods within the specification of the first and third earlier marks represent the opponent's strongest case. In the event that I find a likelihood of confusion in respect of the first and third marks, any finding of confusion in respect of the remaining mark does not further the opponent's case. On the contrary, if I find no likelihood of confusion for the first and third marks, it follows that the same finding will apply to the remaining mark. I will, therefore, focus my assessment under the 5(2)(b) ground on the opponent's first and third marks only. If required, I will address this point further when considering any final remarks at the conclusion of this decision.

**Comparison of Goods**

37. 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".

38. 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.

39. 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".

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

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

41. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13*:*

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

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

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

| Opponent's Goods | Applicant's Goods |
|---|---|
| Mark 1<br>**9:** Electronic data memories, Electronic data processing systems and programs and software for the monitoring, inventorying and maintenance of parts and components of installations; Virtual reality hardware; Virtual reality software; All the aforesaid goods in the field of measuring, drive, control and regulating technology; None of the aforesaid goods consisting of or relating to computer software or hardware in the field of smart metering, smart grids or energy management; none of the aforementioned goods in the field of electronic control for the light regulation and thermoregulation in buildings or for the electronic regulation and access control of blinds, curtains, shutters, doors, gates, patio awnings, pergolas, rolling shutters, doors, garage doors and gates.<br><br>Mark 3<br>**9:** Fittings for measuring technology and control engineering provided with one or more electronic data memories; apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves; none of the aforementioned products being or relating to computer | **7:** Valves as machine components; mechanical valves; piston valves; air-actuated valves; non-return valves; coaxial valves; dust-collecting pulse valves; foot strainer valves; air control valves; float valves; pedal valves; pressure control valves; valve timers; drain valves; breaker valves; valve diaphragms; air filters for mechanical purposes; filters for machines; air cleaners; parts and fittings for all the aforesaid goods.<br><br>**9:** Solenoid valves; electromagnetic coils; electrical connectors; panic buttons; electrical push button panels and switches; electric timers; armatures; electrical components; parts and fittings for all the aforesaid goods.<br><br>**11:** Filters for industrial and household use; air cleaning filters and air filter elements; air purifier filters; air conditioning apparatus; industrial air filter machines; air filters for use as dust arrestants and extractors in industrial processes; solenoid controls for automatically-operating valves; ball valves; water regulating valves; parts and fittings for all the aforesaid goods.<br><br>**17:** Non-metallic tubing; pipe and tube connectors and couplings (non-metallic); |

| | |
|---|---|
| software or hardware in the field of smart metering of energy, smart grids or energy management. | parts and fittings for all the aforesaid goods. |

*Class 7*

Valves as machine components; mechanical valves; piston valves; air-actuated valves; non-return valves; coaxial valves; dust-collecting pulse valves; foot strainer valves; air control valves; float valves; pedal valves; pressure control valves; valve timers; drain valves; breaker valves; valve diaphragms; parts and fittings for all the aforesaid goods.

43. I compare the above terms to *apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves* which sits in the opponent's third mark's specification. As the opponent's goods are used for monitoring valves there is a clear overlap in terms of user and trade channels. I also consider that the goods would enjoy a complementary relationship. This is where the similarity ends however as the respective goods have a different physical nature, purpose and method of use. I do not consider that the goods would be in any competition. Overall, I find there is a low to medium degree of similarity.

Air filters for mechanical purposes; air cleaners; filters for machines; parts and fittings for all the aforesaid goods

44. To my mind, the above terms are systems or elements used to remove unwanted substances such as dust or dirt. Their nature, purpose and method of use differs from the opponent's *electronic data processing systems and programs and software for the monitoring, inventorying and maintenance of parts and components of installations* which sits in the opponent's first mark's specification. I consider that the above terms could be considered a part of a component of an installation. It therefore follows that the opponent's goods may be used for the monitoring and maintenance of the above goods. There is therefore some overlap in user and trade channels. The goods share a complementary relationship however, they are not in any

competition. Consequently, there is a low to medium degree of similarity between these goods.

*Class 9*

Solenoid valves; parts and fittings for all the aforesaid goods

45. I compare this term to *apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves* from the specification of the opponent's third earlier mark. The goods differ in terms of nature, purpose and method of use. I do not consider there to be any competitive relationship between the same. To the extent that the opponent's goods may be used for the purposes of monitoring the applicant's goods, there may be an overlap in users and trade channels. As the opponent's goods would be used to monitor goods such as solenoid valves, there is an important relationship between the goods and I find this to be to the extent where consumers would believe they are derived from the same undertaking. Consequently, I find there is a low to medium degree of similarity.

Electromagnetic coils; electrical connectors; electrical push button panels and switches; electric timers; armatures; electrical components; parts and fittings for all the aforesaid goods

46. The above terms are all types of electrical components that could be used in various installations. I consider that their nature, purpose and method of use differs from *electronic data processing systems and programs and software for the monitoring, inventorying and maintenance of parts and components of installations* as covered by the opponent's first earlier mark. Insofar as the opponent's term could be used to monitor the above goods, there would be an overlap in users and trade channels as well as a complementary relationship. I do not consider the respective goods to share a competitive relationship. I find these goods to have a low to medium degree of similarity.

Panic buttons; parts and fittings for all the aforesaid goods

47. Panic buttons are electronic devices that are activated in order to receive assistance the event of an emergency. The nature, purpose and method of use is different from *electronic data processing systems and programs and software for the monitoring, inventorying and maintenance of parts and components of installations* from the opponent's first earlier mark. I do not consider there to be an overlap in users or trade channels. The goods do not share a competitive or complementary relationship. As such, I consider these goods to be dissimilar.

*Class 11*

Filters for industrial and household use; air cleaning filters and air filter elements; air purifier filters; air conditioning apparatus; industrial air filter machines; air filters for use as dust arrestants and extractors in industrial processes; parts and fittings for the aforesaid goods

48. I consider the above terms to be different types of installations relating to filtering and air filtering. These terms differ in terms of nature, purpose and method of use to *electronic data processing systems and programs and software for the monitoring, inventorying and maintenance of parts and components of installations* which sits in the opponent's first mark's specification. The opponent's goods may be used to monitor the applicant's goods and as such, I consider there would be an overlap in users and a broad overlap in trade channels. There may be a complementary relationship between the goods as the applicant's goods are important to the opponent's to the extent where users would believe that the responsibility for them lies with the same undertaking. There is no competition between the goods. Overall, I find there to be a low to medium degree of similarity between these goods.

Solenoid controls for automatically-operating valves; ball valves; water regulating valves; parts and fittings for the aforesaid goods

49. I compare this term to *apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves* which sits in the specification of the opponent's third earlier mark. The goods differ in terms of nature, purpose and method of use. I do not consider there to be any competitive relationship

between the same. To the extent that the opponent's goods may be used for the purposes of monitoring the applicant's goods, there may be an overlap in users and trade channels. As the opponent's goods would be used to monitor goods such as solenoid valves, there is an important relationship between the goods and I find this to be to the extent where consumers would believe they are derived from the same undertaking. Consequently, I find there is a low to medium degree of similarity.

*Class 17*

Non-metallic tubing; pipe and tube connectors and couplings (non-metallic); parts and fittings for the aforesaid goods

50. The above goods have a different nature, purpose and method of use compared to *electronic data processing systems and programs and software for the monitoring, inventorying and maintenance of parts and components of installations* which sits in the opponent's specification for its first earlier mark. Nonetheless, I find that the applicant's goods may be considered parts or components of installations. In view of this, the opponent's data processing systems could be used to monitor the applicant's goods so it follows that there would be an overlap in users and possibly an overlap in trade channels. I consider that the goods would enjoy a complementary relationship however, there is no competitive relationship. Overall, I consider these goods to have a low degree of similarity.

51. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against the goods of the application that I have found to be dissimilar[7], namely *panic buttons.*

[7] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, paragraph 49

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

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

53. The goods in questions are predominantly of a technical nature and I therefore find that the average consumer will primarily be industry professionals. I accept however that the general public will be users of some of the goods such as various valves and filters for household use. 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 at least a medium level of attention. 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 a higher level of attention to the goods.

54. I find that during the selection process, the goods are likely to be purchased by self-selection from a retail outlet (be that general or specialist) 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**

55. 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 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 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."

56. 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.

57. The marks to be compared are as follows:

| Opponent's Marks | The application |
|---|---|
| Mark 1<br>CONEXO | Connexion |

| | |
|---|---|
| Mark 3<br>CONEXO | Connexion |

58. The opponent's marks consist of the word "CONEXO" in an italicised upper-case font. In each of the marks the middle prong of the letter E is conjoined to the letter X and three curved lines emanate from the top right-hand corner of the letter O. Each of the marks differ in colour, the first mark is bright red whereas the third mark is burgundy. For each of these marks, the dominant and distinctive element is the wording "CONEXO". The stylistic features and colour, whilst not negligible, play a secondary role.

59. The application is a series of two marks, each containing the word "Connexion" in a standard black font. Both marks also include a circular arrow device to the left of the lettering. This device is red in the first mark whereas it is grey in the second. However, nothing turns on this difference so I shall refer to these marks in the singular. I acknowledge that the device element sits to the left of the mark, a position which will catch the eye first given the fact that the English-speaking public reads from left to right. Nonetheless, I consider that the consumers eyes will also be drawn to the wording so I consider that the overall impression lies in a combination of these elements.

**Visual comparison**

60. The respective marks overlap in respect of the first three letters being CON. I note that both marks also include the letters EX in a central position within the word. There are, however, several differences. The opponent's marks are presented in an uppercase italicised font whereas the applicant's mark is presented in a fairly standard lowercase font. The opponent's marks are six letters in length whereas the applicant's mark is nine letters in length creating a noticeably longer mark. There are also stylistic differences such as the circular arrow device in the applicant's marks which is not present in either of the opponent's marks. The stylisation of the letters EX in the

opponent's mark does not come into play in the applicant's mark and I note the three curved lines at the end of the opponent's marks have no counterpart in the applicant's mark. Considering the marks as a whole, I find there is a low degree of similarity between both the opponent's earlier marks and the applicant's mark.

**Aural comparison**

61. Both of the opponent's earlier marks will be pronounced in three syllables as CON-EKS-O whereas the applicant's marks will be pronounced in three syllables as CON-EK-SHUN. In my view they are aurally similar to a high degree.

**Conceptual comparison**

62. 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*[8]. The assessment must be made from the point of view of the average consumer.

63. The opponent asserts the respective marks have a high degree of conceptual similarity as both call to mind the idea of connection and/or connectivity and that both marks use the letter "X" in a non-traditional way. They further submit that the figurative elements of the respective marks both call to mind the idea of connectivity.

64. I find that even though "Connexion" is not a dictionary-defined word in the English language, it will most likely be seen as a fanciful misspelling of the word "connection" and will bring to mind the idea of something that connects or joins. The figurative arrow device will also reinforce this idea. In respect of the opponent's marks, I find that consumers will perceive the "CONEX" element of the earlier marks as relating to connectivity, even though it is not a dictionary defined word in the English language. The figurative device will also reinforce this idea. That being said, the additional letter 'O' means that the link to the word 'connection' is direct meaning that

[8] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

it acts as a point of conceptual difference, albeit a slight one. Consequently, I find there is a high degree of conceptual similarity between the marks.

**Distinctive character of the earlier mark**

65. 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)."

66. 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. I will begin by initially assessing the inherent distinctiveness of the opponent's earlier marks.

67. As previously outlined in the conceptual comparison, the average consumer will acknowledge that "CONEXO" is not a dictionary-defined English word however, the term itself will bring to mind the idea of connectivity. I am therefore of the view that the opponent's mark is somewhat allusive to the goods for which it is registered. This element in itself therefore holds a slightly below medium degree of distinctive character. The mark itself is presented in a stylised form which adds marginally to the level of distinctiveness of the marks overall. Overall, I consider both earlier marks to have a medium degree of distinctive character.

68. I will now consider whether the evidence filed by the opponent demonstrates that the distinctiveness of the opponent's marks has been enhanced through use. The almost identity between the opponent's marks means that the evidence of use, while filed in support of the third mark, can be said to also apply to the first mark. The relevant date for this assessment is the filing date of the contested application, 17 December 2021.

69. In the witness statement of Mr. Ripsam, it is claimed that CONEXO was launched in 2015 and has since been promoted by the opponent across the UK.[9]

70. Previously in paragraph 20 of this decision, I outlined the opponent's turnover figures from within the relevant period. As the test for enhanced distinctiveness relates to the perception of the UK consumer, the figures are not wholly relevant here. Based on the evidence, I have calculated that the UK turnover during the relevant period stood at €263,980. There is no information for me to gauge how big the UK market is

[9] See paragraph 26 of the witness statement of Mr. Ripsam

for the goods at issue and, therefore, I am unable to determine how much of the relevant market share the opponent has. Given the low level of turnover over a five year period, this is likely to be low.

71. Further, I previously outlined in paragraphs 28 and 29 of this decision the opponent's advertising expenditure and circulation of CONEXO brochures at trade fares in the UK. I do not consider these figures to be particularly significant. I note that the opponent has attended trade shows within the UK, promoting the CONEXO system however, I am unable to ascertain the number of attendees that would have been at these events and exposed to the mark.

72. While the evidence provided was sufficient to demonstrate genuine use of the opponent's third 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 either mark has been enhanced through use.

**Likelihood of confusion**

73. 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]).

74. 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.

75. Earlier in this decision I concluded that the parties' goods are similar to a low to medium degree. I have found the marks to be visually similar to a low degree and

aurally and conceptually similar to a high degree. I considered that both earlier marks possess a medium degree of inherent distinctive character. I have found that the average consumer of the goods will be either industry professionals or members of the general public. I found that the general public would pay at least a medium level of attention during the purchasing process whereas industry professionals would pay a higher (but not high) level of attention. In respect of both consumer groups, I found that the goods would predominantly be selected by visual means though I do not discount an aural element to the purchase.

76. The only elements shared between the respective marks are the letters "CON" at the beginning of the word and the letters "EX" positioned centrally in the words. Although I considered that this renders the marks conceptually similar to a high degree, I found earlier in my decision that visual considerations would dominate the purchasing process. There is a clear difference in the marks when taking into account their overall impressions and in this case, I find that these differences will not go unnoticed. I do not find that the opponent's marks will be mistaken for the applicant's marks. I also remind myself that I found the competing goods to be similar to a low to medium degree which, when taking into account the interdependency principle, points away from confusion. As such, I do not consider there to be any likelihood of direct confusion between both the opponent's first and third earlier marks and the applicant's mark.

77. I now go on to consider indirect confusion.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.)

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

79. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

80. For a finding of indirect confusion, I would need to conclude that consumers, upon noticing the common "CON" and "EX" elements, would consider that the differences between the marks are logical indicators consistent with them originating

from the same or related undertakings. Firstly, I do not consider that the shared elements of the marks are so strikingly distinctive that the average consumer would believe that only one undertaking would use them in a trade mark. On the contrary, I find the average consumer would put the presence of the common elements (being a link to the word 'connection') down to coincidence rather than an economic connection.[10] Further, I am not convinced that the differences in the marks would be seen as signifiers 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. Consequently, I do not find there to be any likelihood of indirect confusion.

**Final remarks**

81. I have found there to be no likelihood of confusion in respect of the opponent's first and third marks. This assessment represented the opponent's best case and I do not consider it necessary to return to consider the 5(2)(b) ground in respect of the opponent's second mark. That being said, I will set out briefly that the opponent's second mark does not offer a greater degree of similarity in respect of the goods comparison I made above and, as such, any assessment of confusion based on that mark would ultimately fail for the same reasons set out above.

**Conclusion**

82. The opposition has failed. Subject to any successful appeal against my decision, the application will proceed to registration.

**COSTS**

83. The applicant 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 applicant the sum of £1,000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

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

| | |
|---|---|
| Considering notice of opposition and preparing a counterstatement: | £200 |
| Considering the other side's evidence: | £500 |
| Filing written submissions: | £300 |

84. I therefore order GEMÜ Gebr. Müller Apparatebau GmbH & Co. Kommanditgesellschaft to pay the sum of £1,000 to Connexion Developments Ltd. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 14th day of September 2023**

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