

BL O/208/20

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF TRADE MARK
APPLICATIONS 3366420 & 3366423**

BY

NEXSTGO COMPANY LIMITED

TO REGISTER THE FOLLOWING TRADE MARKS:

AVITA & AVITA

AND

OPPOSITION THERETO (NOS. 416066 & 416071)

BY

ALV GMBH & CO. KG

Background and pleadings

1. Nexstgo Company Limited (the applicant) applied to register the trade marks:

AVITA and 

in the UK on 11 January 2019. They were accepted and published in the Trade Marks Journal on 18 January 2019, in respect of the following goods:

Class 09: Personal computers; Notebook computers, laptop computers; Tablet computers; Detachable/convertible laptop computers; Computer monitors; All-in-One personal computers; Computer Network Attached Storage (NAS) device; Smart phones; Smart watches; Loudspeakers; Computer peripheral devices; Parts, fittings and accessories for all the aforesaid goods

2. ALV GmbH & Co. KG (the opponent) opposes both trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is based on two earlier European Union Trade Marks (EUTM), namely:

EUTM 18002243, filed on 19 December 2018 and registered on 01 May 2019, for the mark:


Avira

AND:

EUTM 18002248, also filed on 19 December 2018 and registered on 01 May 2019, for the mark:

The opponent's earlier marks are registered in several classes, however, for the purpose of these oppositions, the opponent relies only on a part of the goods covered under the class 09 specification of both earlier EU marks, namely:

Class 09: Software; Mobile apps; Interfaces for computers; Recorded content; Computer software for application and database integration; Communication software; Antivirus software; Computer software for the creation of firewalls; Computer software, recorded; Computer software for authorising access to data bases; Software for network and device security; Computer application software; Downloadable computer security software; Software and applications for mobile devices; Network operating system programs; Computer utility programs [program performs computer maintenance work]; Computer firewall software; Authentication software; Computer programs [downloadable software]; Security software; Programs for smartphones; Programs for computers; Computer software applications, downloadable; Application software for cloud computing services; Cloud computing software; Data processing programs recorded on machine-readable data carriers; Cloud network monitoring software; Computer programs, recorded; Firmware; Data recorded electronically; Computer software for the detection of threats to computer networks.

3. The Opponent claims that the dominant element of the earlier marks relied upon is the word AVIRA. The contested mark AVITA is comprised of that single word. The respective trade marks are therefore visually and aurally highly similar. The Opponent also claims that the marks are conceptually similar as the words AVIRA and AVITA are female names of foreign origin. The Opponent states that the respective goods are complementary and therefore similar, as the hardware specified in the contested marks will utilise the software found in the earlier rights. It is also not uncommon, it claims, for an undertaking to sell both hardware and software. Based on an overall comparison the Opponent claims that there is a likelihood of confusion including a likelihood of association.

4. In its counterstatement, the Applicant denies that there exists a likelihood of confusion and states that as such, the oppositions should be rejected. The Applicant states that the marks differ visually, phonetically and conceptually to a material degree. The Applicant also states that the goods are different in many respects including, but not limited to nature, purpose, methods of use and usual origins. The Applicant claims that manufacturers of computer software are not commonly in the business of also manufacturing and selling products of the kind included within the applicant's specification of goods. The applicant puts the opponent to strict proof regarding its claim that the Applicant's hardware and the earlier software are complementary.
5. The Opponent provided written submissions in which it stated that the earlier marks are inherently distinctive due to the fact that their dominant element is the word 'AVIRA' which has no ordinary English language meaning and no association with the goods covered by the earlier registrations. It also stated that it has been established that in composite marks featuring figurative elements and words, it is the word element that is generally deemed to be the distinctive and dominant element. In this case, the first three letters of the respective marks are identical, being AVI. Furthermore, the marks are identical in 4 out of 5 letters running in the same order, AVI-A.
6. The Applicant did not file any written submissions and neither party filed evidence.
7. A hearing was requested by the Applicant, which came before me on 3 March 2020. The Opponent confirmed that they would not be attending but provided written submissions in lieu.
8. The Applicant was represented at the hearing by Mr Dominic Hughes of counsel, instructed by Mr Mooneapillay of J A Kemp LLP.
9. Throughout the proceedings the Applicant has been represented by J A Kemp LLP and the Opponent has been represented by Freeths LLP.

Decision

Section 5(2)(b) of the Act

10.5(2)(b) of the Act states:

“(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.”

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 and services

12. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

14. In *Boston Scientific*¹, the General Court described goods/services as “complementary” in circumstances where “... *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*”. I also take note that in *Kurt Hesse v OHIM*², the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.

15. The parties’ respective specifications are:

Earlier mark	Application
<p>Class 09: Software; Mobile apps; Interfaces for computers; Recorded content; Computer software for application and database integration; Communication software; Antivirus software; Computer software for the creation of firewalls; Computer software, recorded; Computer software for authorising access to data bases; Software for network and device security; Computer application software; Downloadable computer security software; Software and applications for mobile devices; Network operating system programs; Computer utility programs [program performs computer maintenance work]; Computer firewall software;</p>	<p>Class 09: Personal computers; Notebook computers, laptop computers; Tablet computers; Detachable/convertible laptop computers; Computer monitors; All-in-One personal computers; Computer Network Attached Storage (NAS) device; Smart phones; Smart watches; Loudspeakers; Computer peripheral devices; Parts, fittings and accessories for all the aforesaid goods</p>

¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

² Case C-50/15 P

<p>Authentication software; Computer programs [downloadable software]; Security software; Programs for smartphones; Programs for computers; Computer software applications, downloadable; Application software for cloud computing services; Cloud computing software; Data processing programs recorded on machine-readable data carriers; Cloud network monitoring software; Computer programs, recorded; Firmware; Data recorded electronically; Computer software for the detection of threats to computer networks.</p>	
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16. At the hearing Mr Hughes told me that software can now be found in many day to day products including children’s toys, clocks, fridges and televisions. He referred me to the recent *Skykick*³ decision and stated that it cannot be the case that simply because software may be installed into many products, the term software *per se* should be found to be similar to e.g. a fridge. Mr Hughes accepted however, that computer software and computer hardware were likely to be found similar, but only to a low degree. Regarding the question of computer apps, Mr Hughes told me that the producer of an app may not always be the producer of the goods on which that app would function. Turning to the term ‘interfaces for computers’ which the Opponent has claimed covers items such as computer monitors, peripheral devices and parts and fittings, Mr Hughes referred me to the General Court decision in *AxiCorp Alliance*⁴ where the court recognised that there are some instances where goods and services are so vague that it does not allow for a comparison to be made

³ CJEU Case C-371/18,

⁴ T-279/18 - Alliance Pharmaceuticals v EUIPO - AxiCorp (AXICORP ALLIANCE)

and that where a party has not specified their goods or services with clarity, this is something that they should not benefit from. In this respect, Mr Hughes told me that the term 'interfaces for computers' was vague and imprecise and therefore not sufficiently clear for a comparison to be made.

17. The Applicant's contested goods *Personal computers; Notebook computers, laptop computers; Tablet computers; Detachable/convertible laptop computers; All-in-One personal computers;* are all computer hardware. These goods require computer software to function. The manufacturer of these goods will install an operating software system as a basic requirement, as well as additional firmware which allows various parts of the computer to engage with the other parts. Generally, these goods will also be sold with software such as Windows or Linux pre-installed. The Opponent's earlier '*software*' is a broad term that encompasses the kind of software that will be part of the package provided within those contested goods listed above. These goods may share producer, distribution channels and end-user. It can also be said that these goods are complementary as the contested goods will not operate without the addition of software. These goods are therefore similar to a low to medium degree.

18. The Applicant's *Smart phones; Smart watches,* are watches and telephones that include smart technology and software pre-installed. As such these goods are capable of functionality over and above that expected of a standard watch or phone. This functionality may include e.g. camera and video capability; access to the internet; GPS tracking; health tracking via heart rate monitors and step tracking to measure physical activity. All of these kinds of functionality work through the use of specific software applications. The Opponent's earlier '*Software*' as a broad term, encompasses the software packages and applications that those contested goods would utilise. The Opponent's earlier '*Communication software; Software and applications for mobile devices; Programs for smartphones; Application software for cloud computing services; Cloud computing software*' specifically covers software that may be used by smart phones and smart watches to allow the user of those goods to access the internet or communicate remotely. These goods may share manufacturer, channels of trade and end-user. It can also be said that these goods are complementary as the contested goods will not be fit for purpose without the

inclusion of the appropriate software. These goods are therefore similar to a low degree.

19. The Applicant's *Computer monitors; Computer Network Attached Storage (NAS) device; Computer peripheral devices; Loudspeakers; Parts, fittings and accessories for all the aforesaid goods*; are all goods that may be used in conjunction with hardware, firmware and software. For example, a computer printer is considered to be a computer peripheral. A printer will contain firmware which is in essence a piece of software intended specifically to provide a link between the printer and the computer that wishes to connect with it for the purposes of printing documents. The same is true of Computer monitors; Computer Network Attached Storage (NAS) devices and Loudspeakers that are intended to be used with hardware. These goods require software in order to be able to connect to hardware and function as intended. Goods such as mice and loudspeakers will generally be connected to a piece of hardware e.g. a PC or laptop via a USB port. When connected, the hardware will identify the item that has been connected to it, not simply as a mouse or loudspeaker but, using firmware within the peripheral item, identify a specific model or type of mouse, loudspeaker, keyboard etc. These goods may share end-user and channels of trade. They can also be said to be complementary, as software is essential in ensuring that those contested goods function effectively. Therefore, I find these goods to be similar to the Opponent's goods to a low degree.

20. During my assessment of the similarity of goods, I have taken note of Mr Hughes's comments in respect of the *Skykick* decision and the issue of vague terms, however I find that in the matter at hand, the majority of the applicant's goods are computer hardware and peripherals which, as I have set out above, share a connection to the opponent's software and are at least complementary in nature. In respect of smart phones and smart watches, I have found a clear link between those goods and specific software products covered by the opponent's earlier mark. It could be argued further that, in their nature, smart phones and smart watches can be said to be a part of the computer hardware 'family' in that they provide much of the functionality expected of larger, less mobile hardware items, e.g. access to the internet, communication functionality etc, all of which is possible only because of specific software installed on such devices.

21. In conclusion, I find all of the Applicant's goods to be similar to a low or low to medium degree to the Opponent's '*Software; Communication software; Software and applications for mobile devices; Programs for smartphones; Application software for cloud computing services; Cloud computing software*'.

Average consumer and the purchasing act

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

23. 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.”

24. To my mind, the average consumer of software and computers, including peripherals and parts and fittings thereof; may be both a professional consumer and the general public.

25. Both types of consumer will generally purchase the goods at issue from specialist retail outlets and specialist websites online, although many of the goods can also be purchased from large supermarket chains. The selection of these goods will be largely a visual process, with the average consumer having taken time in the selection of the appropriate product through research online, perusing catalogues

and other printed matter, but also aurally, through discussion with sales assistants and appropriate experts.

26. The Opponent stated in submissions that the average consumer of the goods at issue is deemed to be reasonably well informed, observant and circumspect. It added that the goods at issue cover a wide range of price points and attract an average degree of consumer attention.

27. Mr Hughes on behalf of the Applicant, stated during the hearing that computers prompt a higher than average degree of attention. He told me that often, computers will be listed on home insurance policies as specific items of value. He added that they involve a significant degree of expenditure and last a long time. Mr Hughes also claimed that consumers are more aware of the importance of cybersecurity. He added that it was obviously not the case that computers are the only goods at issue in this matter, however he felt that even peripherals that are going to be used with expensive items like computers would attract a degree of attention during the selection process. Mr Hughes stated that some items, e.g. a harddrive, would be installed or replaced by a professional rather than the average consumer. Therefore, he claimed that the average consumer would be paying a higher than average degree of attention.

28. Having considered the submissions put forward by both parties, I am not persuaded that the level of attention involved in the selection and purchase of the goods at issue would be any higher than average. The goods at issue are not necessarily expensive in today's market. Some years ago, I would agree with Mr Hughes, that a computer or laptop would be an expensive and well thought through purchase, however I find that not to be true today. It is the case for example, that many young people have their own tablet or laptop computer which they take into school and use daily, as a replacement for pen and paper. The goods at issue are everyday items, and I therefore find the level of attention paid by both sets of consumers to be medium.

Comparison of marks

29. 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 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.”

30. 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.

31. The respective trade marks are shown below:

Earlier marks	Contested trade marks
 	 

32. The opponent's marks are comprised of the invented word 'Avira' combined with a figurative element that is made up of a red square, in the centre of which is placed a white line drawing of an umbrella. These elements can be said to be roughly the same size and neither the word nor the figurative element can be said to have any obvious link or association with the goods at issue. During the hearing Mr Hughes suggested that the word 'Avira' contains allusive features when considered within the context of anti-viral software. Having considered this point, I reject that argument and will expand on this issue later in my decision.
33. I find that whilst both elements of the earlier marks are distinctive and are roughly equal in size, it is the case that the eye is naturally drawn to verbal elements in a mark and, as such, I find that the word element 'Avira' in the earlier marks plays a slightly greater role in the overall impression of those marks.
34. The applicant's marks are comprised simply of the invented word 'AVITA'. UK 3366423 being presented in plain script and UK 3366420 in a stylised typeface. I note that in the latter mark, the horizontal section of the two letter 'A's is missing. However, I do not think this will prevent the mark from being identified by the average consumer as the word 'AVITA'. As such the overall impression in those marks lies in their totality.

Visual similarity

35. Visually, the respective marks are similar inasmuch as they share the letters 'AVI-A'. They differ visually in the letter 'T' of the contested marks and the letter 'R' of the earlier marks. They also differ visually in the figurative element present in both earlier marks, and in the stylised typeface of contested mark 3366420, all of which have no counterpart in the other marks. Whilst the figurative element in the earlier marks is presented either above or to the left of the word element 'Avira', it is commonly accepted that a consumer will be drawn to verbal elements in a mark initially.
36. The shared letters 'AVI-A' form a substantial part of the word elements in the marks at issue. The differing letters 'T' and 'R' fall towards the end of the words, in the fourth position within each five-letter word and as such the word elements can be said to be visually very similar. The addition of the figurative elements within the

earlier marks serve to separate the marks visually to some degree, however I have found previously that the word elements of the earlier marks will play a slightly greater role in those marks.

37. The stylisation of the lettering in contested mark 3366420 will not go unnoticed, however it is not so elaborate as to mask the perception of the letters 'A' and 'V' within the mark, or the perception of the word 'AVITA' as a whole.

38. I find therefore, that the earlier marks and the plain word contested mark 'AVIRA' are visually similar to a medium degree. I find that the visual similarity between the earlier marks and the stylised contested mark will be slightly less than medium.

Aural similarity

39. Aurally, the earlier marks will be pronounced as *AH/VY/RAH* or *AH/VEE/RAH*. As noted above, the absence of the horizontal lines in the letter 'A's in the 3366420 contested mark, will not prevent it from being recognised as the word AVITA. Consequently, both contested marks will be pronounced the same i.e. as *AH/VY/TAH* or *AH/VEE/TAH*. The marks share identical beginnings and very similar endings. The differing sounds produced by the letters T and R within these words are fairly minor within the context of the whole and are likely to be largely unnoticed. The marks are considered to be aurally similar to a high degree.

Conceptual similarity

40. The earlier marks are comprised of the word 'Avira', which appears to be an invented term with no meaning in English, combined with a figurative element of an umbrella presented in a red square. The Opponent has claimed that the verbal element is a girl's name and the Applicant has suggested that it has allusive qualities when considered within the context of antiviral software. I have no evidence to support either position. It may be that 'Avira' is a female forename somewhere, but that cannot be said to be commonly the case within the UK. During the hearing, Mr Hughes suggested that 'Avira' alludes to antivirus or antiviral because it begins with the letter A and because the string of letters 'vira' would be perceived as having a link or connection to the words virus or viral. He added that the inclusion in the mark of an umbrella device reinforced a message of protection. I appreciate Mr Hughes's

position in this regard, however, I am not persuaded by the argument. In my opinion, the term 'Avira' will be perceived, as a whole, as an invented or fancy word, or as a foreign word not commonly recognised or understood by the average member of the UK public. The figurative element will be perceived as an umbrella and the meaning of that will be readily understood as being an object used to shelter the user from rain or sun. Neither element in the earlier marks can be said to have any clear link or association with the goods at issue. As such only the device element of the earlier marks conveys any concept i.e. the concept of an umbrella.

41. The contested marks are comprised of the plain word 'AVITA' and a stylised version of that word which will be perceived, regardless of the stylised lettering, as 'AVITA'. The word 'AVITA' has no known meaning in English and will be perceived as an invented or fancy term. For the same reasons as I have set out above, I do not accept the argument that the word 'AVITA' will be perceived as a female forename. Therefore, the contested marks convey no conceptual meaning.

42. As the common elements between the marks carry no concept, the marks cannot be compared conceptually, and the conceptual position is neutral.

Distinctive character of the earlier trade marks

43. 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-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).”

44. The opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character. I must therefore assess the mark purely on its inherent distinctive character.

45. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

46. The earlier marks contain the word ‘Avira’ which can be said to be an invented term that has no meaning in the English language. As such it can be said to enjoy a higher than average degree of inherent distinctive character. I have taken note of the comments made by Mr Hughes regarding his claim that the word ‘Avira’ contains allusive features when used in connection with anti-viral or anti-virus software. I have dismissed this argument previously as I believe that the average consumer will not

dissect the word in the way that Mr Hughes suggested to me during the hearing. The word 'Avira' is short, containing only five letters. The average consumer will not seek to break down such a short term but will instead understand the term as a whole and perceive it as an invented or foreign word.

47. The addition of the distinctive figurative element adds to the distinctive character of the earlier mark but, as it is the distinctiveness of the common element which is key, I shall focus on the distinctiveness of the word 'Avira' for the purposes of my assessment.

Likelihood of Confusion

48. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

49. During the hearing Mr Hughes stated that there is no likelihood of direct confusion as nobody would mistake the earlier marks for the later, or vice-versa, bearing in mind the large figurative element found in both earlier marks. He added that indirect confusion would not occur either, as the average consumer would not naturally assume that the word 'AVITA' was a logical brand extension of 'AVIRA', or vice-versa.

50. In what Mr Hughes has referred to as fact-matching, the Opponent referred to two opposition decisions of the European Union Intellectual Property Office (EUIPO), namely opposition B 859 845 and opposition B 2 250 226, in support of its case. Whilst I have considered these cases, I am not bound by decisions of the EUIPO Opposition Division. This decision is made based on my own assessment of the matters at hand.

51. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises

the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

52. I have already found that:

- the goods are similar to a low to medium degree and to a low degree;
- the marks are visually similar to a medium degree and a slightly less than medium degree; aurally similar to a high degree, and conceptually neutral.
- the average consumer will be a member of the general public or a professional;
- the consumer will pay a medium level of attention when selecting the goods;
- for the goods at issue, the visual and aural assessments will both be important;
- the earlier marks have a higher than average level of inherent distinctiveness.

53. Taking all of the aforesaid into account, I find that direct confusion is likely to occur when these marks are the subject of a primarily aural selection process. The words 'AVITA' and 'Avira' are phonetically highly similar and conceptually neutral. During the purchase process the average consumer is unlikely to enunciate the figurative element in the earlier marks but will instead refer to the word 'Avira'. As I have found previously, the aural impact of the marks during the selection process cannot be discounted and I conclude that an aural selection process would lead to the average consumer mistaking one mark for the other.

54. However, in the event that I am found to be wrong in my finding of direct confusion, I go on to consider the matter in respect of indirect confusion.

55. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

"16. ...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).”

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

57. In considering the likelihood of confusion I take into account the guidance provided in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), where Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

58. Applying the *Medion* case law to the matter before me, I find that the verbal element ‘Avira’ in the earlier marks plays an independent distinctive role in those marks. It is also the case that I have found previously that the element ‘Avira’ plays a slightly greater role in the earlier marks. I find that the average consumer, whilst appreciating the composite figurative nature of the earlier marks as a whole, will also perceive, immediately, the word ‘Avira’ as an element that enjoys independent significance in the marks. As the only verbal element within the Opponent’s marks, I find it likely that the average consumer’s perception will be that of ‘Avira’. That is not to dismiss the equally distinctive figurative element from the global assessment of the marks. The marks must be considered as a whole, however, applying the principles of *Medion*, I

find that the average consumer will appreciate the whole but also appreciate the significant role played by the verbal element 'Avira'.

59. As the average consumer is likely to consider the earlier marks as being 'Avira' marks, I find the differences between the words 'AVITA' and 'Avira' to be visually and aurally quite minimal, such that the average consumer would be confused. I find it likely that direct confusion would occur if the earlier marks were comprised solely of the 'Avira' element. That being the case, I believe that the average consumer will mistake the verbal elements in the marks at issue but, due to addition of the figurative element in the earlier marks, consider the marks to be brand variations coming from the same, or an economically linked, undertaking. I consider this to be the case, notwithstanding the fact that the goods are only similar to a low and low to medium degree.

60. I conclude therefore, that there is a likelihood of indirect confusion.

Conclusion

61. As I have found that there is there is a likelihood of confusion, the oppositions are successful. Subject to appeal, both applications are refused for all of the applied for goods.

Costs

62. The opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016.

63. I award costs to the opponent as follows:

Official opposition fees	£200
Preparing the statements of case and considering the counterstatements	£200
Preparing submissions and submissions in lieu	£500

Total

£900

64. I therefore order Nexstgo Company Limited to pay ALV GmbH & Co. KG the sum of £900. The above sum should 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 2nd day of April 2020

Andrew Feldon

For the Registrar

The Comptroller-General