

**O-369-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3178137 BY OPTRONICS LIMITED TO  
REGISTER THE FOLLOWING TRADE MARK**



**IN CLASSES 6, 9 AND 17**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408150  
BY OSRAM GMBH**

## BACKGROUND AND PLEADINGS

1) Optronics Limited (hereafter “the applicant”) applied to register trade mark no. 3178137, the relevant details of which are:



Filing date: 3 August 2016

Publication date: 28 October 2016

**Class 6:** *Cable ties, cable clips; cable trays and cable management bars; identity plates; brackets, screws, nuts, bolts, wall plugs; grommets, plaster board fixings; cable trunking of metal, connectors; fasteners of metal for trunking; junction boxes for trunking; trunking of metal for cables, networking cables, communication cables; cable boxes of metal, cable clips of metal, cable couplings, cable drums, cable ducts, cable joints, cable junction sleeves, cable straps, cable supports, cable ties, cable trays, cable trunking, clips, covers of metal for use in cable channels, downpoles of metal for the accessing of cables, downpoles of metal for the distribution of cables, flexible ducting of metal, hinges, metal cable-clamps, racking for supporting cables, tension members, trunking; parts and fittings for all the aforesaid goods.*

**Class 9:** *Wires; electrical connectors; electrical testing equipment; cables; networking cables; communication cables; glass fibre cables; synthetic glass fibre cables; networking patches; patchcords; data cables, ethernet cables; patch panels; convertors; electric convertors; signal convertors; multiplexers, waveguide division multiplexers; electrical splitters; microscopes; cabinets and enclosures for electrical equipment; splicing apparatus for glass fibres and synthetic glass fibres; protective gloves; cable test and measurement kits; computer software; cable connectors, splice connectors; **all of the aforesaid***

**goods other than for use in operating devices for lighting apparatus;**  
*parts and fittings for all the aforesaid goods.*

**Class 17:** *Packing, stopping and insulating materials; flexible pipes; insulating materials; spacers and plastic cables for use with wire, cables, networking cables, communication cables, glass fibre cables, synthetic glass fibre cables; parts and fittings for all the aforesaid goods.*

2) OSRAM GmbH (hereafter “the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods set out above and is on the basis of the following earlier trade mark:

Mark and relevant dates	Goods
European Union Trade Mark (EUTM) no. 1499284  OPTOTRONIC  Filing date: 9 February 2000 Publication date: 18 December 2000 Date completed registration procedure: 18 May 2001	<p><b>Class 9:</b> <i>Operating devices for lighting apparatus, in particular fluorescent lamp ballasts; parts of the aforesaid goods.</i></p> <p><b>Class 11:</b> <i>Apparatus for lighting and parts therefor.</i></p>

3) This is an earlier mark within the meaning of section 6(1) of the Act and the opponent claims that it is visually and aurally very similar to the applicant’s mark that is in respect of identical or similar goods thus leading to a likelihood of confusion. The earlier mark completed its registration procedures more than five years before the publication of the application. As a consequence, the earlier mark is subject to the proof of use provisions set out in section 6A of the Act.

4) The applicant filed a counterstatement denying the claims made. It also requests that the opponent provides proof of use. Following the filing of the opposition, the applicant also amended its Class 9 specification by the addition of the term shown in

bold in the specification reproduced in paragraph 1, above. It also claimed that its mark had been in use since 2011 and it is not aware of a single incident of confusion between the respective marks and this indicates that there is no likelihood of confusion.

5) Both sides filed evidence and written submissions. I will summarise the evidence to the extent that it is considered necessary and I will keep the submissions in mind.

6) A Hearing took place on 25 April 2016 with the opponent represented by Martin Krause for Haseltine Lake LLP and the applicant by Charlotte Blythe of Counsel, instructed by Howes Percival LLP.

### **Opponent's Evidence**

7) This takes the form of two witness statements, the first by Giovanni Scilla, Global Strategy Director Smart OEM Systems for OSRAM SpA, a subsidiary of the opponent. The second witness statement is by Heather Orr, trade mark agent employed by the opponent's representative in these proceedings, Haseltine Lake LLP.

8) Mr Scilla provides evidence of the opponent's use of its mark that can be summarised as follows:

- The earlier mark has been used by the opponent for many years in relation to LED power supplies and controls and their parts. To support this statement, Mr Scilla provides:
  - a 2009 technical guide for OPTOTRONIC products at Exhibit GS1. The earlier mark appears prominently throughout;
  - The opponent's LED product brochure from 2012 containing the full range of OPTOTRONIC branded control gear and dimmers that were available at that time. Mr Scilla draws attention to page 7 of the exhibit that shows parts used with OPTOTRONIC control gear and dimmers and these have product codes beginning with "OT" which signifies OPTOTRONIC;

- Exhibit GS3 consists of a product leaflet for a cable clamp identified as an “OT Cable Clamp A-Style TL”;
- Some OPTOTRONIC devices are programmable via a software suite (Exhibit 2, page 19);
- OPTOTRONIC products have been widely marketed throughout the EU including at trade fairs and by direct communications (an example of each are provided at Exhibits GS7 and GS8 where an Optotronic driver and a control system, and an indoor constant current LED power supply, respectively, are mentioned);
- Digital marketing materials in the form of brochures, app guides, posters and videos are available from the opponent’s website [www.osram.com](http://www.osram.com) targeted at English speaking consumers including in the UK and Ireland and the website [www.osram.de](http://www.osram.de) targeting consumers in Germany. OPTOTRONIC constant current LED drives are mentioned in a detailed list of products shown at Exhibit GS9. Downloads of marketing materials from these two websites number 28,000 (20% estimated as originating from English speaking parts of the EU) and 18,000 respectively;
- EU sales figures for OPTOTRONIC products for the period 2012 to 2016 are provided at the confidential Exhibit GS10. The figures are broken down to show sales in France, Germany, Italy, Netherlands, Spain, Sweden and the UK and divided into sales of indoor control gear (on/off), indoor control gear (dimmable), outdoor control gear, cable clamps and the programming interface for OPTOTRONIC via Tuner4TRONIC software. These figures total multi-millions of Euros each year.

9) Ms Orr provides the following information sourced from the Internet:

- Exhibit HO1: A definition of a “driver circuit” obtained from Wikipedia. It explains that “in electronics, a driver is an electrical circuit or other electrical component” and is usually used to control components or devices in a circuit;

- Exhibit HO2: Extracts from a number of third party websites showing aluminium profile and “PC covers” for strip lighting, an LED driver enclosure box and other parts for LED strip lighting,

### **Applicant’s Evidence**

10) This takes the form of a witness statement by Paul Adrian Hussein, director of FibreFab Limited, a trading subsidiary of the applicant. Mr Hussein makes a number of criticisms of the opponent’s evidence that I will not detail here, but I will keep in mind.

11) Mr Hussein states that his company and its predecessor in business have sold wires and cabling by reference to the applicant’s mark since at least 1979, when the predecessor in business changed its name to “Optronics Limited”. An extract from the Companies House register, at Exhibit PH2, shows the change of name took place on 31 December 1979. Mr Hussein also provides evidence of the applicant’s marks over the years since 2002 when the applied for mark was developed. At Exhibit PH4, Mr Hussain provides representations of various OPTRONICS logos created by the applicant together with promotional material. All the various logos include the word OPTRONICS in the same font as in the applied for mark, but none show its device element. Advertising and coverage in trade publications are also provided, many of which are difficult to read because of the small size of the font in the reproductions. The stylised word OPTRONICS is visible on many of these exhibits but not in combination with the device present in the challenged mark.

12) Mr Hussain also asserts that since 2009, the applicant has 3000 separate customers that have purchased a cumulative total of over £95 million worth of OPTRONICS goods on a worldwide basis and over £82 million in the UK.

### **Opponent’s evidence-in-reply**

13) This consists of a further witness statement by Ms Orr. The purpose of this was to provide a full copy of the document provided at earlier Exhibit GS1 that was inadvertently omitted.

## DECISION

### Proof of Use

14) The proof of use provisions are set out at Section 6A of the Act:

“Raising of relative grounds in opposition proceedings in case of non-use

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), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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) Section 100 of the Act states that:

“100. 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.”

16) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La*

*Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

17) The relevant period in which the opponent must demonstrate use is between 29 October 2011 and 28 October 2016.

18) In its written submissions, the opponent asserts that its evidence demonstrates use in respect of “drivers/power supplies/control gear and dimmers for use with LED lighting systems” and also “parts of operating systems”. On this basis, it proposed that the protected goods should be categorised as:

*“Operating devices for lighting apparatus; parts of the aforesaid goods”*

19) At the hearing, Ms Blythe stated that for the purposes of the hearing, the applicant accepts that genuine use has been made, within the relevant period, in respect of “drivers/power supplies/control gear and dimmers for use with LED lighting systems”. However, it is submitted that no use has been shown in respect of any other goods.

20) Ms Blythe referred to the following guidance set out in *Maier v Asos plc* [2015] FSR 20:

“64 Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65 It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

21) Ms Blythe submitted that when applying this guidance, the opponent's suggested specification is too broad and suggests that the correct specification should be:

*"Drivers, power supplies, control gears and dimmers for use with LED lighting systems"*

22) I keep in mind the guidance in *Asos v Maier* together with the following comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

23) Further, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation (that applies equally to partial proof of use, as in the current case) as follows.

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

24) Having regard for all this guidance and, in particular, that fair protection is achieved by identifying the particular categories of goods to which the goods used belong and how the average consumer would fairly describe the goods, I consider that the opponent's suggestion to limit its specification to "*Operating devices for lighting apparatus; parts of the aforesaid goods*" appropriately reflects its use. I find that Ms Blythe's suggestion (at paragraph 19, above) that limited the specification to the specific goods for which use is shown, rather than the sub-category of the goods, is overly restrictive.

25) In summary, I will consider the merits of the grounds based upon section 5(2)(b), based upon the opponent being able to rely on the following specification of goods: “*Operating devices for lighting apparatus; parts of the aforesaid goods*”

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

26) 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”.

### ***Comparison of goods and services***

27) In the judgment of the Court of Justice of the European Union (“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”.

28) 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 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.

29) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“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 für 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”.

30) As a general point, Ms Blythe submitted that if, as I have, I found that following my considerations regarding proof of use, the opponent may rely upon the broad Class 9 specification then its specification is vague, broad and unclear. Ms Blythe relied upon the following guidance of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

31) I find the opponent's specification neither vague or unclear, as claimed by Ms Blythe. It has been confined to a sub-group of goods, the description of which will be readily understood by the average consumer. Further, whilst I accept the sub-group is broader than a list of specific goods, by its very nature, the sub-group is not overly broad. Therefore, I dismiss Ms Blythe assertions, but I will keep Jacob J's guidance in mind.

32) The respective goods are:

Goods for which the opponent has demonstrated genuine use	Applicant's goods
<p><i>Operating devices for lighting apparatus; parts of the aforesaid goods</i></p>	<p><b>Class 6:</b> <i>Cable ties, cable clips; cable trays and cable management bars; identity plates; brackets, screws, nuts, bolts, wall plugs; grommets, plaster board fixings; cable trunking of metal, connectors; fasteners of metal for trunking; junction boxes for trunking; trunking of metal for cables, networking cables, communication cables; cable boxes of metal, cable clips of metal, cable couplings, cable drums, cable ducts, cable joints, cable junction sleeves, cable straps, cable supports, cable ties, cable trays, cable trunking, clips, covers of metal for use in cable channels, downpoles of metal for the accessing of cables, downpoles of metal for the distribution of cables, flexible ducting of metal, hinges, metal cable-clamps, racking for supporting cables, tension members, trunking; parts and fittings for all the aforesaid goods.</i></p> <p><b>Class 9:</b> <i>Wires; electrical connectors; electrical testing equipment; cables; networking cables; communication cables; glass fibre cables; synthetic glass fibre cables; networking patches; patchcords; data cables, ethernet cables; patch panels; convertors; electric convertors; signal convertors; multiplexers, waveguide division multiplexers; electrical splitters; microscopes; cabinets and enclosures for electrical equipment; splicing apparatus for glass fibres and synthetic glass fibres; protective gloves; cable test and</i></p>

	<p><i>measurement kits; computer software; cable connectors, splice connectors; all of the aforesaid goods other than for use in operating devices for lighting apparatus; parts and fittings for all the aforesaid goods.</i></p> <p><b>Class 17:</b> <i>Packing, stopping and insulating materials; flexible pipes; insulating materials; spacers and plastic cables for use with wire, cables, networking cables, communication cables, glass fibre cables, synthetic glass fibre cables; parts and fittings for all the aforesaid goods.</i></p>
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### **Class 6**

33) The applicant submits that there is no similarity between the opponent's goods and any of its Class 6 goods. The opponent submitted that there is similarity and Mr Krause grouped the applicant's goods when making his submissions. I will consider the issue using the same groups.

*Cable ties, cable clips;... cable clips of metal,... connectors;...cable ties,... cable couplings, ... cable joints,... cable straps, ...clips, ... metal cable-clamps,*

34) Mr Krause submitted that Ms Orr's first witness statement illustrates that there are many metal, non-electrical/electronic products that are adapted for use with LED lighting installations, including clips, fixings and tensioners. Ms Blythe submitted that the conclusion should be reached that there is no similarity. I keep these submissions in mind when conducting my analysis based upon the case law I have identified.

35) The applicant's goods are different in nature and intended purpose to the opponent's goods, with the former being in the form of clips, ties, couplings, joints, straps and clamps and the latter are devices for operating lights. As a result, their methods of use are also different, with the former being used to secure and connect cables, whilst the latter is used to operate or control. In light of these differences, I also conclude they are not in competition. In respect of trade channels, there may be some overlap. I note Ms Blythe's submission that the applicant's goods are standard

electronic components. Certainly, the applicant's terms include such standard goods, but they also include goods specifically adapted for use with, or as replacement parts and fittings for the opponent's goods. Therefore, where such goods are adapted for use with installations of lighting and the terms include goods used specifically for connecting operating devices for lighting apparatus there are shared trading channels.

36) Finally, in *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice for the European Union ("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".

37) 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.

38) With this guidance in mind, I note that, when taking “the core of the possible meanings attributable to the rather general phrase” as advised in *Avnet*, the applicant’s terms include goods that are specifically adapted for use with operating devices for such lighting. Such a finding is self-evident but, in addition, I note that Ms Orr has provided some limited evidence that this is indeed the case (see Exhibit HO2). Consequently, in such circumstances, the average consumer will assume that the terms cover specific parts for lighting and operating devices for lighting and that the responsibility for those goods lies with the same undertaking. Therefore, I conclude there is some complementarity.

39) Taking all of the above into account, I conclude that the similarity between the respective goods is of a low level.

*Cable trays and cable management bars;... cable trunking of metal,... junction boxes for trunking; trunking of metal for cables, networking cables, communication cables; cable boxes of metal, cable drums, cable ducts, cable junction sleeves, cable supports, cable trays, cable trunking, covers of metal for use in cable channels, downpoles of metal for the accessing of cables, downpoles of metal for the distribution of cables, flexible ducting of metal,... racking for supporting cables.....trunking*

40) Mr Krause submitted that all these goods are essentially devices for attaching cables to devices or to one another. I would add that these goods also include items used in routing cables. The same considerations apply as with the previous group because these terms also include goods that are specifically adapted to be used with operating devices for lighting. As a consequence, these goods share a low level of similarity to the opponent’s goods.

*...brackets, screws, nuts, bolts, wall plugs; grommets, plaster board fixings; fasteners of metal for trunking; ...hinges*

41) These goods are further removed from the opponent's goods because they have general application and are not likely to be specifically adapted for use with operating devices of the kind covered by the opponent's specification. Therefore, the overlap of trade channels will not exist and the complementarity connection is not likely to exist. I conclude that the similarity with the opponent's goods is very low.

#### *Tension members*

42) Mr Krause identified these goods as a different group, but I understand his submission to be similar as in respect of the previous groupings, namely that this term includes goods adapted for use with lighting installations. I agree. As a result, there may be overlap of trade channels. However, in terms of nature, intended purpose and method of use, there is no similarity with the opponent's goods. Further, merely because the applicant's term includes goods adapted for use with lighting and because the opponent's operating devices are also adapted for use with the same, it does not follow that the respective goods are in competition or complementary. However, insofar as lighting manufacturers may also produce and sell tensioners and operating devices for the same, I find that there may be some overlap of trade channels. Taking all of this into account, the similarity is no more than low.

#### *Identity plates*

43) It is not obvious to me that there is any similarity between these and the opponent's goods. Mr Krause submitted such goods can be attached to operating devices to identify their specification and manufacturing information leading to the respective goods being complementary. I disagree that they are complementary. The respective goods are neither indispensable to each other, nor important for the use of the other and, consequently, do not meet the requirements of complementarity set out in *Boston Scientific*. I find that there is no similarity.

*Parts and fittings for all the aforesaid goods*

44) Mr Krause made no specific submissions on this term. Such goods are slightly further removed from the opponent's goods by being parts of the other goods listed in the applicant's specification. I conclude that if there is any similarity, it is only very low.

### **Class 9**

*Convertors; electric convertors; signal convertors;... other than for use in operating devices for lighting*

45) The applicant concedes that these goods are similar to the opponent's goods. Mr Krause contended that converters are power supply regulators because they include controllers and therefore they are operating devices and are identical. I disagree. They are clearly not identical because of the exclusion that eliminates goods used in operating devices. However, as the applicant has done, I accept they are similar. I would place this similarity as being reasonably high in light of the respective goods having the same nature, intended purpose and methods of use.

*Wires;... cables; networking cables; communication cables; glass fibre cables; synthetic glass fibre cables;... data cables, ethernet cables;... electrical splitters... other than for use in operating devices for lighting*

46) Mr Krause submitted that wires, cables and splitters are identical to the opponent's goods. Once again, I do not agree because the placement of the exclusion within the applicant's specification ensures that this not the case. Nevertheless, wires, cables and electrical splitters share the same nature, purpose and method of use as the same goods covered by the opponent's *parts of the aforesaid goods* (for operating devices for lighting apparatus) and therefore, I conclude they share a reasonably high level of similarity.

47) In respect of the other goods in this grouping, they are all for use in connecting computer networks and have no obvious similarity to parts of operating devices for lighting apparatus. I find that the respective goods share no, or very low similarity.

*Cabinets and enclosures for electrical equipment*

48) The same rationale applies to these goods and I find that they are reasonably highly similar to the opponent's *parts of the aforesaid goods*.

*Electrical connectors; cable connectors, splice connectors*

49) The same rationale also applies to these goods and I find that they are reasonably highly similar to the opponent's *parts of the aforesaid goods*.

*Parts and fittings for all the aforesaid goods*

50) Whilst not covered by the exclusion, by virtue of the fact that all the goods to which the parts and fittings relate are subject to the exclusion, then the parts and fittings themselves cannot be identical to any goods in the opponent's specification. That said, following the above rationale, the term includes goods that share the same nature, purpose and method of use to the opponent's *parts* and are, therefore, reasonably highly similar.

*Computer software*

51) Mr Krause submitted that, as demonstrated by the evidence (Exhibit GS6, page 4), there is a particular importance attached to programming of lighting controllers and the requirement for an interface between a programming device with the appropriate software and the controller. Ms Blythe submitted that just because the opponent's goods are programmable, this is not the same as use in respect of software and that the opponent's evidence in respect of software does not show its mark in use on these goods. The evidence shows a dimmer that can be programmed via "Tuner4TRONIC® software". I agree with Ms Blythe that this does not show use of the opponent's mark in respect of software, however, what I must consider is the

level of similarity with the opponent's goods. The applicant's term *computer software* is broad in nature, but it is limited to an extent by the word "computer". The software related to the opponent's goods is not computer software but rather software that appears to be in a lighting control unit. That said, the applicant's term is not limited by way of purpose and, consequently, the term includes computer software for use in controlling lighting. In summary, the respective the opponent's operating devices may be specifically developed to connect to software to control the lighting, but the respective goods are different in nature and methods of use, but there may be overlap in terms of their purpose. This overlap will result in some similarity, but I would put it no more than low.

*... electrical testing equipment;...; networking patches; patchcords; ...patch panels; ...multiplexers, waveguide division multiplexers; ...microscopes;...; splicing apparatus for glass fibres and synthetic glass fibres; protective gloves; cable test and measurement kits;*

52) Mr Krause submitted that the remaining goods are very similar because they can be used either in conjunction with the opponent's goods or together with lighting more generally. I dismiss this submission. The above goods are different in terms of nature, purpose, methods of use and neither are they obviously in competition or in any way complementary to the opponent's goods. I find that there is no similarity.

### **Class 17**

*Packing, stopping and insulating materials; flexible pipes; insulating materials; spacers and plastic cables for use with wire, cables, networking cables, communication cables, glass fibre cables, synthetic glass fibre cables; parts and fittings for all the aforesaid goods.*

53) Mr Krause submitted there is similarity between these goods and those of the opponent, but conceded that the level of similarity is lower than for the goods in Class 6. He submitted that similarity exists because the applicant's goods can all be used in relation to LED products. They differ in terms of nature, purpose and methods of use. Even though, at a very general level, it is conceivable that these

goods could be used in relation to the opponent's goods, I do not consider it normal that these goods would share trade channels. Finally, they are not in competition, and there is nothing before me to suggest that they are complementary in the sense referred to in *Boston Scientific*. I find there is no similarity.

### **Comparison of marks**

54) It is clear from the comments of the CJEU in *Sabel BV v. Puma AG* (particularly paragraph 23), Case C-251/95, 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.”

55) 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.

56) The respective marks are:

Earlier trade mark	Contested trade mark
OPTOTRONIC	

57) The opponent's mark consists of a single word and it follows that this is both its dominant and distinctive element. The applicant's mark consists of the word OPTRONICS in a stylised font, a line underneath the word, a device element at the start of the mark and these three elements being presented in contrast to a black background. The opponent submits that the word element is the more distinctive element of the contested mark. I agree, it is the dominant and distinctive element, but I also recognise that the other elements, in particular the device, cannot be ignored.

58) The opponent's mark consists of a single, ten letter word OPTOTRONIC. It differs from the word element of the applicant's mark because of the addition of the third and fourth letters "TO" and because the word element of the applicant's mark has a letter "S" at the end. In addition, the get-up and device present in the applicant's mark is absent from the opponent's mark. Taking all of this into account, I conclude that the visual similarity is medium.

59) Aurally, the opponent's mark is likely to be perceived as the four syllables OP-TO-TRON-IC. The get-up and device element of the applicant's mark is unlikely to contribute to the mark's aural characteristics and, consequently, is likely to be perceived as consisting of the three syllables OP-TRON-ICS. The respective first syllables are the same as are the third syllable of the opponent's mark and the second syllable of the applicant's mark. The final syllable of both marks is highly similar. The second syllable of the opponent's mark is absent in the applicant's mark. Taking all of this into account, I conclude that the respective marks share a reasonably high level of aural similarity.

60) It is common ground between the parties that both marks contain the element "OPT" that is likely to be perceived as a reference to "optical" and the element "TRONIC" that is likely to be perceived as a reference to "electronics". Neither combination has a direct descriptive meaning, but each mark, when taken as a whole, may be perceived as consisting of, or containing as the dominant element, elements that give some indication of optical electronic components. The additional get-up and device present in the applicant's mark do not impact upon this conceptual

identity. Taking all of this into account, I find that the respective marks share a high level of conceptual similarity.

***Average consumer and the purchasing act***

61) 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

62) 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.”

63) Ms Blyth submitted that the respective goods are not everyday goods used by ordinary members of the public and that the average consumer is a person working in the electronics industry or a person interested in electrical components. It was further submitted that such persons will be deemed to pay a higher than average level of care and attention. I concur with Ms Blythe in respect of the opponent's goods and the majority of the applicant's goods. I also recognise that some of the applicant's goods may have an average consumer that includes less expert persons who may have a less-specialist interest in, for example, DIY house repairs, who may purchase goods such as screws, nuts, wall plugs or even cable ties without having the specialist knowledge required for many of the goods.

64) It would appear that visual considerations are likely to be paramount as the respective goods are likely to be bought online or in store having viewed the goods or their packaging. However, I do not ignore that aural considerations may play a part.

***Distinctive character of the earlier trade mark***

65) 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).”

66) I have acknowledged that the earlier mark will be recognised by the average consumer as a single word consisting of two elements that give some indirect indication of optical electronic components. Such marks are not endowed with the

highest level of inherent distinctive character, and I conclude that it is endowed with a medium level.

67) Sales figures, including for the UK, are provided by the opponent (see confidential Exhibit GS10). For the period 2012 to 2016, turnover in the UK has run into multi-millions of Euros. I conclude that such a level of sales is likely to result in some enhancement to the mark's distinctive character, but the scale of sales is such that this is not likely to be of any significant extent.

68) In summary, I conclude that the opponent's earlier mark has a medium level of inherent distinctive character and that this is enhanced through use, but not to any significant extent.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

69) The following principles are gleaned from the decisions of 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:

(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.

70) 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.

71) I have found that:

- The word OPTRONICS is the dominant and distinctive element in the applicant's marks, but the get-up and device cannot be ignored;
- The word OPTOTRONIC is the only and dominant element of the opponent's mark;
- the opponent's mark shares a medium level of visual similarity, a reasonably high level of aural similarity and a high level of conceptual similarity with the applicant's mark;
- the level of similarity between the respective goods varies from reasonably highly similar to dissimilar;
- the average consumer in respect of the majority of the parties' goods consists of persons working in the electronics industry or persons interested in electrical components. I also recognised that in respect of some of the applicant's goods, less expert persons without expert knowledge may also be part of the average consumer;
- the opponent's mark is endowed with a medium level of inherent distinctive character and is enhanced through use, but not to any significant extent.

72) Mr Krause submitted that the degree of similarity between the marks together with what he claimed is at least a reasonably high level of similarity between the respective goods results in a likelihood of confusion. He further submitted that the get-up and device present in the applicant's mark do not change this. Ms Blythe submitted that there is no likelihood of confusion based upon her assessment of the similarity of the marks and the respective goods being somewhat lower than that submitted by Mr Krause.

73) I have taken the submissions made on behalf of the parties into account together with my findings summarised in paragraph 70, above, and I conclude that the similarity between the marks is such that when the applicant's mark is used in respect of goods that share a medium level of similarity or higher, there is a likelihood of confusion.

74) Therefore, in summary, there is a likelihood of confusion in respect of the following of the applicant's goods:

**Class 9:** *Wires; electrical connectors; ... cables; ... convertors; electric convertors; signal convertors; ... electrical splitters; ... cabinets and enclosures for electrical equipment; .. cable connectors, splice connectors; all of the aforesaid goods other than for use in operating devices for lighting apparatus; parts and fittings for all the aforesaid goods.*

75) I find that there is no likelihood of confusion in respect of all of the goods listed in the applicant's Class 6 and Class 17 specifications and in respect of the following Class 9 goods:

*...; electrical testing equipment; ...; networking cables; communication cables; glass fibre cables; synthetic glass fibre cables; networking patches; patchcords; data cables, ethernet cables; patch panels; ...; multiplexers, waveguide division multiplexers; ...; microscopes; ...; splicing apparatus for glass fibres and synthetic glass fibres; protective gloves; cable test and measurement kits; computer software; ...; all of the aforesaid goods other than for use in operating devices for lighting apparatus; parts and fittings for all the aforesaid goods.*

### **Concurrent Use**

76) Having found that a prima facie likelihood of confusion exists in respect of the applicant's goods identified at paragraph 73, the only factor that can save that part of the application is the existence and effect of concurrent use. Mr Hussain, for the

applicant, has provided evidence in support of its claim that it has traded under the name “optronics” since at least 1994.

77) For a defence of concurrent use to be successful, it is necessary for me to be satisfied that the parties have traded in circumstances that suggest consumers have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin (see to that effect the Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45 and Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18). Mr Justice Carr provided the following summary of the law relating to concurrent use in *Victoria Plum Limited (trading as “Victoria Plumb”) v Victorian Plumbing Limited and others*, [2016] EWHC 2911 (Ch):

“73. The case law to which I have referred establishes the following principles:

- i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.
- ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant's trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone.
- iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill.”

78) For concurrent use to be of assistance to an applicant I must, therefore, be

satisfied that the effect of concurrent trading has been such that the relevant public has shown itself able in fact to distinguish between goods bearing the marks in question i.e. without confusing them as to trade origin. That implies that both parties are targeting an approximately similar, or at least overlapping, audience and that the use by the parties in nature, extent and duration of trade has been sufficient to satisfy me that any apparent capacity for confusion has been adequately tested and found not to exist.

79) In the current case, Exhibit PS4 provides examples of the applicant's OPTRONICS mark in use. Whilst many of the pages contain indistinct text, it can be made out that the applicant's goods are fibre optic cables and installations. At page 26 of the exhibit there is a reference that such goods are for use in telecoms and data centre applications. From a layman's perspective these goods are not obviously for use in respect of lighting apparatus. Taking this into account, I am unable to conclude that the actual use (as opposed to the notional use that I have otherwise considered for the purposes under section 5(2)(b)) has resulted in the respective marks being exposed to the same or overlapping consumer.

80) Having reached this conclusion, it is not surprising that there are no apparent instances of actual confusion, as relied upon by Ms Blythe. Ms Blythe directed me to the following comments of Kitchin L.J. in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220:

"80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has

been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

81) As Kitchen L.J. noted, the reason for the absence of confusion may be that the applicant’s mark has been used only to the extent that the potential for confusion has not been tested. This is my conclusion in the current case. For this reason, I find that the defence of concurrent use and lack of confusion in the marketplace fails to assist the applicant and my prima facie findings regarding the likelihood of confusion (set out in paragraphs 73 and 74, above) are not disturbed.

### **Summary**

82) The opposition is partially successful to the extent set out in paragraphs 74 and 75.

### **Costs**

83) The opponent has been successful in respect of approximately a quarter of the goods in which the opposition related. It is entitled to a contribution towards its costs but I reduce the amount to take account of this partial success. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I award costs as follows:

Preparing statement other considering counterstatement (including statutory fee of £200)	£275
Preparing evidence and considering other side’s evidence	£250
Preparing for, and attending hearing	£250
<b>Total:</b>	<b>£775</b>

84) I order Optronics Limited to pay to Osram GmbH the sum of **£1800**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18th day of June 2018**

**Mark Bryant**

**For the Registrar**

**The Comptroller-General**