O/1222/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003951849
BY LMPG INC.
TO REGISTER THE FOLLOWING TRADE MARK:

OPTIDRIVE

IN CLASSES 9 AND 11

AND

AN OPPOSITION THERETO UNDER NUMBER 445117
BY TRT LIGHTING LTD

Background and Pleadings

1. On 31 August 2023, LMPG Inc. ("the applicant") applied to register in the UK the trade mark shown on the cover page of this decision ("the contested mark"). The application was accepted and published for opposition purposes on 6 October 2023 and registration is sought for goods in classes 9 and 11 listed below. The applied for mark claims a priority date of 28 August 2023.[1]

    Class 9: *Electronic control system for lighting systems; electrical and electronic control apparatus and devices for regulating and controlling lighting in accordance with the digital multiplexing (dmx) protocol; computer software for regulating and controlling lighting, particularly in accordance with the digital multiplexing (dmx) protocol.*

    Class 11: *Electric lighting fixtures; industrial lighting fixtures; led lighting fixtures; LED lighting fixtures for indoor and outdoor lighting applications; lighting fixtures.*

2. On 8 January 2024, TRT Lighting Ltd ("the opponent") fully opposed the application under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Within its Form TM7, the opponent indicated that the opposition is directed against all the applied for goods.

3. The opponent relies upon the following earlier United Kingdom Trade Mark (UKTM) for its opposition:

    OPTIO

    UK trade mark number UK00003279997

[1] Priority is claimed from Canadian Trademark No. 2277719

Application date: 2 January 2018

Registration date: 30 March 2018

The opponent's mark is registered for the following goods in class 11, *lighting*.

4. Given the filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. As it has been registered for five years or more at the priority date of the application, it is subject to the proof of use requirements specified within section 6A of the Act. I observe from the Form TM8 that the applicant requests proof of use of the opponent's earlier goods.

5. Under section 5(2)(b), the opponent claims in its statement of grounds that the marks are similar as they both share the identical prefix "Opti" and that the goods are either identical (class 11) or similar (class 9) and as a result there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier trade mark.[2]

6. The applicant filed a defence and counterstatement in which it denies similarity of the competing marks and the competing goods, further it denies any likelihood of confusion between the respective marks on the part of the relevant public.

7. The applicant is represented by Stobbs; the opponent is represented by Withers & Rogers LLP.

8. Both parties filed evidence during the evidence rounds.

Evidence and submissions

9. The opponent's evidence consists of the witness statement of Craig Muncaster, dated 12 April 2024, together with exhibits CM1 to CM5. Mr Muncaster is the Joint Chief Executive, Group Financial Director and Company Secretary of FW Thorpe PLC, (the opponent's company group) and the purpose of this evidence is to demonstrate proof of use.

[2] Form TM7 Q9

10. The applicant's evidence comprises the witness statement of Peter Timotheatos, Executive Vice-President and CFO of LMPG Inc (the applicant's company), dated 10 June 2024, together with exhibits PT1 to PT21. The purpose of the evidence is to assist with the meanings of the element OPTI and show that this element is in frequent use for lighting goods currently on the market.

11. The applicant requested a hearing which took place before me on 25 September 2025. The opponent chose not to attend but instead filed written submissions in lieu of its attendance; the applicant filed a skeleton argument in advance of the hearing.

12. Whilst the parties' evidence and submissions will not be summarised here, I have taken them all into consideration in reaching my decision and will refer to them below, as and where necessary.

Relevance of EU Law

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Proof of use legislation and case law.

14. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes – (a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and (b) use in the United Kingdom includes affixing

the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being 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, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 W.F. *Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a

subcategory of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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]."

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the

commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> '19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.
>
> […]
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> 22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

16. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the

economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

17. The onus is upon the opponent to prove genuine use of the registered trade mark in the relevant period. The relevant period in which genuine use must be established is the five-year period ending with the date of application or in this case the date of priority of the contested mark. Therefore, the relevant period is 29 August 2018 to 28 August 2023. In making the required assessment I am required to consider all relevant factors, including:

    i) The scale and frequency of the use shown;
    ii) The nature of the use shown;
    iii) The goods and services for which use has been shown;
    iii) The nature of those goods/services and the market(s) for them;
    iv) The geographical extent of the use shown.

Genuine use

18. I note the following from the opponent's evidence:

a) The opponent claims the "Optio" mark has been used in relation to lighting goods since 2018.

b) Approximate annual turnover figures have been provided for the years 2019 to 2024. It is said within the narrative evidence that these relate to sales of Optio brand lighting products. The figures are replicated below:[3]

[3] Witness statement of Craig Muncaster, paragraph 9.

Product Group	Total Revenue
Optio	**389,000**
2019	8,000
2020	142,000
2021	132,000
2022	93,000
2023	13,000
Optio Micro	**1,231,000**
2021	457,000
2022	410,000
2023	310,000
2024	54,000
Optio Midi	**171,000**
2021	1,000
2022	67,000
2023	81,000
2024	20,000
Optio Nano	**352,000**
2022	11,000
2023	322,000
2024	18,000
Grand Total	**2,145,000**

As can be seen from the table, figures are provided for not only the Optio mark solus, but for Optio Micro, Optio Midi and Optio Nano. The 2024 figures fall outside the relevant period and therefore, I cannot take these into account. I acknowledge that the figures deriving from the Optio solus mark amount to £389,000 during the relevant period. Whereas if I were to consider the total turnover for all Optio products including those under Optio Micro, Optio Midi and Optio Nano, even discounting the figures that fall outside of the relevant period, this would amount to over £2 million.

c) Turnover figures are supported with “a small selection of invoices” which show sales of Optio and Optio Micro products, all of which are dated within the relevant period.[4] The quantities of those orders are fairly high ranging between 50 to 200 units. Furthermore, it is possible to identify that the invoices are from the opponent to customers based in Wales and England and even Scotland from the area postcode. During the hearing, Mr Stobbs submitted that the product description length on the invoices prevented the products from being

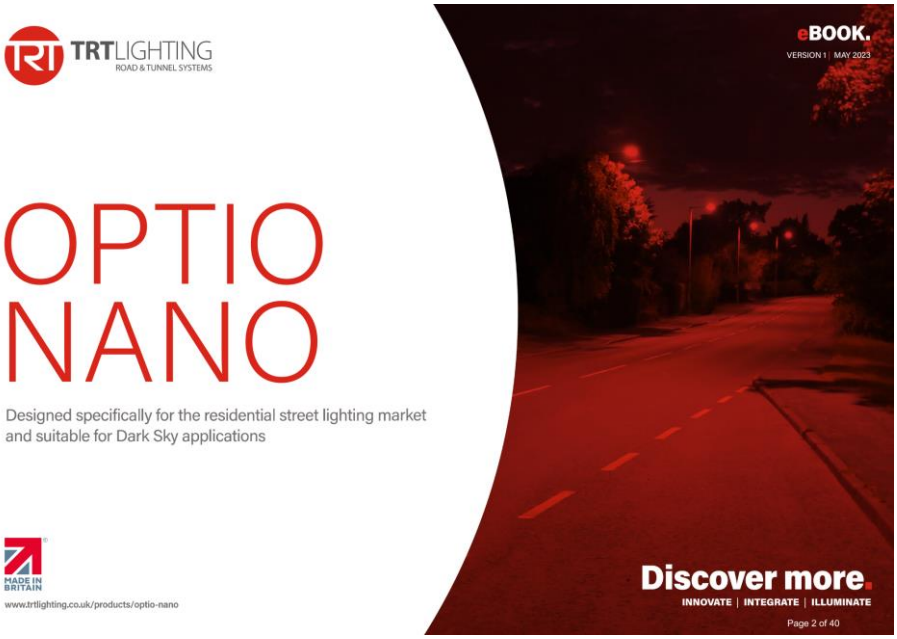
[4] Exhibit CM1.

identified.[5] I disagree, Optio is the first word within the product description and as such I consider it to clearly refer to products under the Optio or Optio Micro marks. Whilst I accept that there are long product descriptions, the word lantern can be clearly identified which coincides with the products shown within the brochures. Mr Stobbs also pointed to an invoice within the evidence which appeared to be an internal invoice, billing the company itself rather than a third party.[6] Whilst the point was not expressly made out at the hearing it is asserted within the skeleton argument at paragraph 12.4.1 that it is unclear what proportion of the turnover figures provided have been generated from internal sales. However, I observe that from the invoices provided, only one relates to evidence of internal use, with the remaining invoices pertaining to external UK customers.[7] In light of no cross examination and without more to suggest that the turnover figures should not be relied upon, I am not prepared to accept that the presence of a single invoice for internal use casts doubt on the overall turnover figures provided.

d) Marketing evidence in the form of brochure or 'e-books' and product specifications within the evidence, dated March 2021 and May 2023, i.e. within the relevant period.[8] Mr Stobbs submitted several times at the hearing that the evidence did not appear to show a range of products under the Optio brand, but Optio Nano products. Having reviewed the evidence, although the different e-books appear to be focusing on different products, either 'Optio Nano' or 'Optio Micro', it is clear from the e-books that they are part of the product range. For example, on the first page following the cover page of both Optio Nano and Optio Micro e-books it says '*TRT are proud to introduce the latest innovation in our product range*.'[9] Further, overleaf within the same e-book it states: '*Adding further choice into our Optio family of streetlights, the new Optio Nano […]*'.[10] However, the e-book entitled Optio Nano, obviously focuses on the Optio Nano

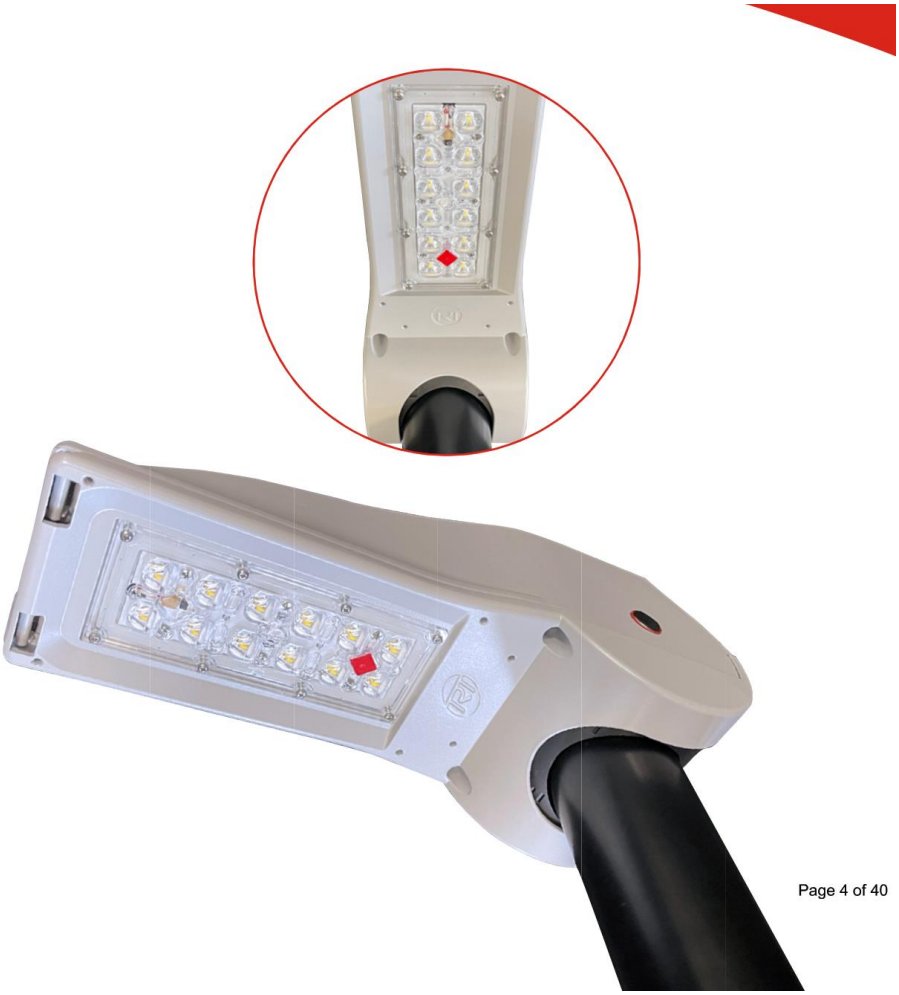
[5] Transcript, page 6.
[6] Exhibit CM page 6 of 14.
[7] The redaction of personal information such as names and addresses was requested by the Tribunal due to the fact that the invoices were addressed to external customers.
[8] Exhibit CM2.
[9] Exhibit CM2, page 3 of 40 and Exhibit CM2, page 25 of 40.
[10] Exhibit CM2, page 4 of 40.

product only, the same way that the e-book entitled Optio Micro focuses on the Optio Micro products only. Furthermore, I note from the evidence that the goods relate specifically to street or road lighting rather than lighting in general and that the products themselves are often referred to as LED lanterns. The cover pages of both e-book states '*Designed specifically for the residential street lighting market'*.[11] Reproduced below:



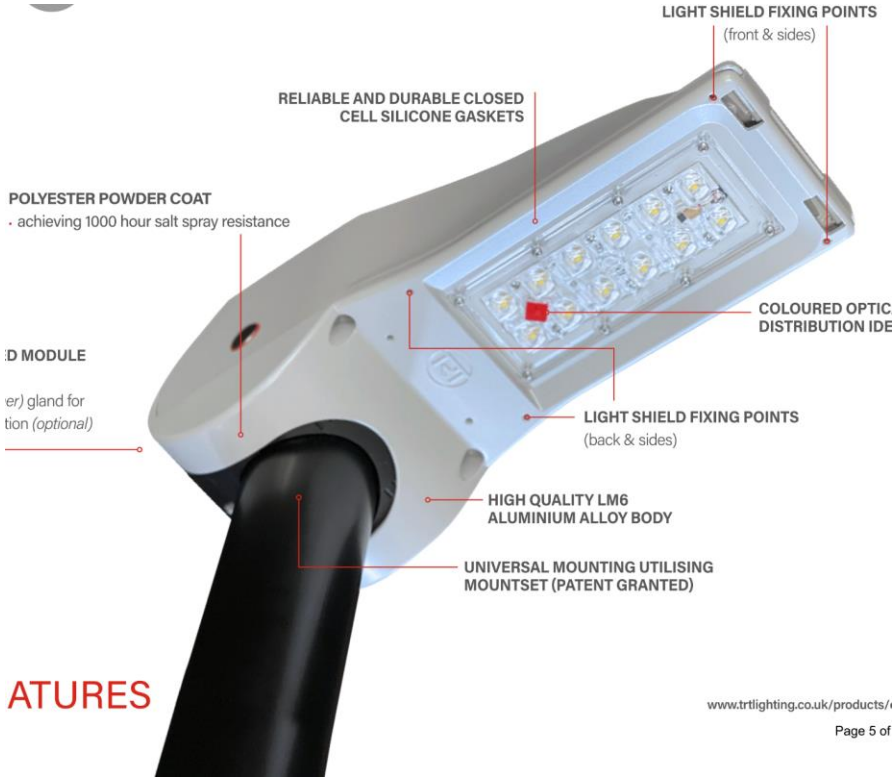
[11] Exhibit CM2, page 2 of 40 and Exhibit CM2, page 24 of 40.

I note in particular the Optio Nano e-book describes the products as follows: '*This LED lantern has been developed to embrace technology and deliver the maximum performance to P Class roads. Special consideration has been given to both capital cost and energy efficiency, the combination of this focus has resulted in the most cost effective streetlighting from TRT to date'*.[12] Whilst the Optio Micro e-book states: '*Designed specifically for residential street lighting applications, the Optio Micro LED lantern has been developed by TRT […]'*.[13] A picture of the goods as displayed in the e-books are replicated below:



Page 4 of 40

[12] Exhibit CM2, page 4 of 40.
[13] Exhibit CM2, page 26 of 40.



e) A case study has been provided,[14] this shows users of the goods as local councils. The evidence also discusses how the products are used. The case study shows that the opponent's Optio Micro lanterns are used as the preferred street lighting by councils to reduce light pollution of the skies and create a dark sky effect that means that the stars could still be visible and would have less of an effect on the ecological environment.

f) Promotional evidence in the form of limited social media evidence from LinkedIn.[15] In his witness statement, Mr Muncaster states that this evidence is dated around April and June 2023.[16] This is supported by the LinkedIn posts which refer to '10mo' or '1y' which I take to mean posted 10 months or 1 year ago, from the date the witness evidence was dated and filed. This shows the promotion of Optio Nano street lighting, to its 1700 followers.[17]

g) Finally, website evidence of Optio branded products which provides information about the products and provides a link for customers to get quotes for the

[14] Exhibit CM3.
[15] Exhibit CM4.
[16] The witness statement of Craig Muncaster, paragraph 13.
[17] Exhibit CM4, page 3 of 3.

products displayed.[18] Using the wayback machine, there is evidence dated, 28 October 2019, 28 December 2019, 3 August 2020, 24 January 2021 and 22 June 2021, all within the relevant period.[19] Many of these extracts refer specifically to the Optio mark and state, '*Optio a residential street light developed by listening to our customers and understanding the challenges they face*'.[20]

Form of the mark

19. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2), which can also be applied to variant use in proof of use cases. He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
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> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
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> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hyphen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This

[18] Exhibit CM5.
[19] Exhibit CM5, pages 8-10 of 10.
[20] Exhibit CM5, pages 9-10 of 10.

suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

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

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

20. Turning to whether all use of the mark is acceptable. At the hearing, Mr Stobbs rejected that the evidence showed genuine use of the mark as registered but rather that the evidence showed use of the mark Optio Nano and Optio Micro. He claimed that the addition of the words Nano and Micro altered the distinctive character of the mark and that even if I considered these additional elements to be non-distinct, they still altered the length and therefore the overall impression of the mark as registered.[21] Addressing this point, I keep in mind that in addition to the above case law, *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the Court of Justice of the European Union ("CJEU") stated that use of a

[21] Transcript, page 9

mark encompasses use of that mark with, or as part of, another mark, so long as it continues to be perceived as indicative of the origin of the goods or services at issue: see paragraphs 32-36.

21. In my view, the average consumer of these goods, upon seeing the sign "Optio Nano", "Optio Micro" or "Optio Midi" would understand the "Nano" "Micro" or "Midi" elements refer to size or units in technology, i.e. nano indicating extreme smallness, being short for nanotechnology, equally micro means extremely small and midi can also be a reference to size. Therefore, I consider these terms to be descriptive of the characteristics of the goods, whereas consumers would perceive "Optio" to be the distinctive part of the sign, that indicates the origin of the goods. Consequently, I find that use of "Optio Nano", Optio Micro" and "Optio Midi" are all use of the earlier mark as registered and any alteration to the mark is acceptable variant use.

Sufficient use

22. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.

23. Despite some shortcomings within the evidence, from the evidential picture overall, I am prepared to accept that the evidence shows that sales made within the relevant period across the UK are on a scale sufficient to show genuine use. UK turnover figures have been provided for Optio branded street lighting products within the relevant period, showing sales of in excess of £2 million which when considering a relatively small market is likely to be a notable figure. These sales are supported by invoice evidence which show the spread of high units of sales across the UK. Further, the case study confirms that the opponent's customers include local councils and I have been provided with marketing and promotional material referring to, and showing, lighting products under the Optio brand. Therefore, it is clear that a genuine attempt has been

made by the opponent to create and maintain a market presence for the goods under this brand.

Fair specification

24. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, which can also be considered when framing a fair specification, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
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> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
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> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.
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> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if

not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

25. In assessing whether, or the extent to which, the evidence shows use of the registered marks in relation to the goods relied upon, I bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods and services for which there has been genuine use, but, rather, the particular categories of goods 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 for the goods and services concerned.[22] In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods shown in evidence; the task is not to describe the use made of the registered marks in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that 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 registrations.[23]

26. In the hearing, Mr Stobbs argued in line with his skeleton argument, that the evidence did not show use of the opponent's broad term lighting and that the goods were mainly referred to within the evidence as street lanterns and as such the specification should be restricted to 'road and street luminaires'.

27. Whilst I accept that the goods are often referred to within the evidence as 'LED lanterns' or 'lanterns', this is in the context of its use as street lighting or road

[22] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10
[23] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

lighting. As such, taking into account the purpose and use of the goods,[24] in my view, consumers would fairly describe the goods as 'street lighting' rather than 'street lanterns' or 'road and street luminaries' which is not a phrase that consumers would realistically use and would have the effect of narrowing the specification too far.

28. Consequently, even at its highest, the use evidence only relates to the "street lighting". Therefore, it follows that a fair specification would be:

Class 11: Street lighting

Section 5(2)(b)

29. Sections 5(2)(b) and 5A of the Act state:

"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.

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

[24] *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, see paragraph 248

Relevant Law

30. 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.

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

31. All relevant factors relating to the goods should be taken into account, which include, inter alia:[25]

    • the physical nature of the goods;

[25] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the "*Treat*" case.

• their intended purpose;

• their method of use / uses;

• who the users of the goods are;

• the trade channels through which the goods reach the market;

• in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

• whether they are in competition with each other (taking into account how those in trade classify the goods, for instance whether market research companies put them in the same or different sectors)

or

• whether they are complementary to each other. Complementary signifying that "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".[26] It is noted that complementarity means that there is an autonomous criterion capable of being the sole basis for the existence of similarity.[27]

32. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the

[26] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13
[27] *Kurt Hesse v OHIM*, Case C-50/15 P, se also *Sanco SA v OHIM*, Case T-249/11

language unnaturally so as to produce a narrow meaning which does not cover the goods in question.[28]

33. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

34. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[29]

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

[28] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
[29] BL O/399/10

35. Further, in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court ("GC") stated that:

> "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."

36. The goods to be compared are shown in the table below:

Opponent's goods	Applicant's goods
	Class 9 Electronic control system for lighting systems; electrical and electronic control apparatus and devices for regulating and controlling lighting in accordance with the digital multiplexing (dmx) protocol; computer software for regulating and controlling lighting, particularly in accordance with the digital multiplexing (dmx) protocol.
Class 11 Street lighting	Class 11 Electric lighting fixtures; industrial lighting fixtures; led lighting fixtures; LED lighting fixtures for indoor and outdoor lighting applications; lighting fixtures.

37. The applicant's applied for goods in class 11, "Electric lighting fixtures; led lighting fixtures; lighting fixtures" are all terms that would fall under the opponent's class 11 term "street lighting" as the applied for goods are not limited

to either indoor or outdoor lighting. Consequently, they are all identical under the *Meric* principle. As at least some of the goods are identical I will proceed on the basis that the contended goods are identical to those covered by the earlier mark. If the opposition fails, even where the goods are identical, then it follows that the opposition will also fail where the goods are only similar.

The average consumer and the nature of the purchasing act

38. As indicated in the caselaw cited above, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[30] 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.[31]

39. I note the opponent's submissions in relation to the average consumer of *street lighting* goods, which are replicated below:

> "*In the event that the Opponent's goods are considered to be limited to "street lighting", such purchases would typically be made by local councils or by owners of private land (such as car parks, industrial estates and retail parks, for example), but such purchasers would not necessarily have any specialist knowledge in relation to street lighting. It is submitted that the level of attention may vary from average to high."*[32]

40. I broadly agree with these submissions and find that due to the specialist nature of the goods at issue, relevant consumers are likely to be predominately councils and owners of private land such as, for example, industrial and retail parks, who typically tend to be business owners.

[30] *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).
[31] *Lloyd Schuhfabrik Meyer*, Case C-342/97.
[32] Opponent's submissions, paragraph 24.

41. The cost of the goods is likely to be fairly high, particularly as they are likely to be purchased in bulk batches rather than single units, and purchases are likely to be infrequent given that once street lighting is in place it is unlikely to be replaced for several years save for malfunction. The selection of the goods would be relatively important for councils and business users as they will wish to ensure that the products meet any regulatory requirements and that the products are efficient, reliable and safe for the public. The technical specification of the goods and compatibility with the network will also be an important factor for consumers to consider. In light of the above, I find that the level of attention paid by councils and business users would be high. The goods are likely to be available through specialist brochures or the internet where the goods will be purchased from a specialist lighting provider after viewing information. In these circumstances, visual considerations would dominate, however, I do not discount aural considerations entirely as it is possible that telephone conversations with sales representatives may be involved.

Distinctive character of the earlier mark

42. In *Lloyd Schuhfabrik Meyer* 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)."

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

44. The earlier mark is a word only mark that consists of an invented word, 'OPTIO'. I do not consider that the relevant consumer will naturally try and break this mark up into the elements "OPTI" and "O", as this would amount to dissection. Therefore, it will be perceived as an invented word that has no overall meaning and no obvious connection with the goods for which it is registered. Accordingly, on this basis, I find that the earlier mark as a whole possesses a high degree of inherent distinctive character.

45. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, I find from the evidence that I have outlined above that the mark has not been used to the scale and extent necessary to give the mark the required exposure for a finding of enhanced distinctiveness.

46. The evidence shows that the earlier mark has been used in the UK since 2018 for street lighting goods and that its turnover figures for the 5-year period between 2018 and 2024 are over £2 million. Whilst I find these figures respectable in relation to genuine use as mentioned above at paragraph 23, I keep in mind that I have no specific details as to the size of the relevant market in the UK nor the UK market share for street lighting held by the opponent to determine exactly how prevalent the mark is or the precise extent of its presence on the relevant UK market. Further, no marketing figures have been provided

and there are no third party articles that promote or recognise the brand. I also observe that the social media evidence showing exposure of the brand is limited. With regard to promotional material such as the 'e-book' or website evidence there is no information regarding the number of internet users which have accessed either the e-book or the online sites, or user location. Taking into account the evidential picture as a whole, on balance, the evidence before me does not support a finding that the distinctiveness of the earlier mark has been enhanced by virtue of its use, or through any marketing, promotional or third party exposure the mark has received.

47. Furthermore, even if it has, it would be unlikely to make a material difference to the outcome of the opponent's claim as I have already found the earlier mark to be inherently highly distinctive.

Comparison of marks

48. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:

> "…it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

50. The marks to be compared are as follows:

The opponent's earlier mark	The applicant's contested mark
OPTIO	**OPTIDRIVE**

51. The opponent's mark is a word only mark that consists of the invented word "OPTIO", as such the overall impression lies in the word itself.

52. The applicant's mark is also an invented word only mark that consists of the single word "OPTIDRIVE", although for reasons that I will address within the conceptual comparison, consumers will identify the elements "OPTI" and "DRIVE". Consequently, the overall impression rests within these elements in equal measure.

Visually

53. The marks coincide in the letters O, P, T and I, found at the beginning of the competing marks, where the attention of consumers is usually directed.[33] However, the marks differ in their respective endings, the addition of the letter "O" in the opponent's mark and the longer addition of the word "DRIVE" in the applicant's mark. This also results in the marks being different in length. Consequently, there is, a medium degree of visual similarity.

Aurally

54. In relation to the aural comparison the opponent states:

[33] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

"Aurally, both marks comprise three syllables, with the first two, 'OP-TI', being identical. Although the third syllables are different, it is submitted that the identical beginnings result in at least a medium degree of aural similarity."[34]

55. In contrast the applicant argues:

"Aurally, both marks begin with the letters O-P-T-I which will be pronounced the same way in each case ("OP-tee"), but again, for the reasons outlined above, this element is not distinctive in the context of the goods. The endings of the marks differ considerably, the Opponent's mark ending with the letter O (which will be pronounced "OH") whereas the Contested Sign ends with the single syllable word DRIVE, which creates a very different sound."[35]

56. I agree with the opponent that the competing marks both comprise three syllables. However, in my view, the average UK consumer would likely pronounce the opponent's mark as OP-TEE-OH whilst the applicant's mark will likely be articulated as OP-TEE-DRIVE. Consequently, the first two syllables are identical, whilst the final syllable differs. As a result, I agree with the opponent that the marks are aurally similar to at least a medium degree.

Conceptually

57. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[36] The assessment must, therefore, be made from the point of view of the average consumer.

58. The opponent states,

"[…] the term OPTIO is the name of a non-commissioned officer rank in the Roman army. However, it is submitted that this meaning is unlikely to be known by the average consumer, and it is far more likely that the Opponent's mark will simply be perceived as an invented term.

[34] Opponent's submissions, paragraph 29.
[35] Applicant's skeleton argument, paragraph 48.
[36] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29.

The Applicant's mark OPTIDRIVE as a whole has no particular meaning, but consumers may naturally perceive within it the two elements 'OPTI-' (a prefix used in a variety of words and conveying different meanings, including "light", "sight" and "best") and '-DRIVE' (which can have multiple meanings as both a verb and a noun, including "the provision of power to make something work or happen / to set or keep something in operation" and "a device for reading/writing/storing digital information"."[37]

59. Mr Stobbs agreed with the opponent's conceptual analysis of "OPTIO" set out above,[38] as do I, i.e. that it will be perceived as an invented word without any meaning.

60. As for the applied for mark, in my view, the ordinary dictionary word "DRIVE" at the end of the mark will clearly be identifiable to consumers. Whilst I acknowledge the applicant's submissions on the meaning of the word "DRIVE" above, in my view, consumers will not immediately grasp the word "DRIVE" as having a meaning in relation to the class 11 lighting goods, instead it is far more likely to be understood in relation to driving a car or vehicle. In relation to electrical goods in class 9 although the word "DRIVE" may refer to a hardware device for storing digital information typically in the context of a hard drive for a computer, this will not be immediately understood by consumers as directly alluding to the goods themselves which are electrical control systems for lighting and the corresponding computer software for such.

61. Due to the fact that consumers will identify the easily recognisable ordinary dictionary word "DRIVE" they will also see the "OPTI" element at the beginning of the applied for mark. The applicant argues that "OPTI" will be understood as meaning light in line with the online source provided by the applicant.[39] However, I observe that this is from a *.com* domain source and does not necessarily show how the element will be understood by UK consumers. More persuasively, at

[37] The Opponent's submissions, paragraphs 30.
[38] Transcript, bottom of page 13 and top of page 14
[39] Exhibit PT1

the hearing Mr Stobbs pointed to paragraph 33 of the opponent's submissions where the opponent states "*although the prefix 'OPTI-' has various meanings including 'light' the Opponent's mark OPTIO is [sic] a whole is an invented term with no relevant meaning in relation to the Opponent's goods, and is of at least normal inherent distinctiveness.*" Whilst I acknowledge that this is in relation to distinctiveness of the earlier mark rather than how the applicant's mark will be perceived, I can see from paragraph 58 above that the opponent accepts that OPTI can be understood as meaning light.

62. Notwithstanding, that both parties agree that at least one meaning of "OPTI" will be understood as light, I observe two points that arise.

63. First, I must assess not whether light is a possible meaning of "OPTI" as accepted by the opponent, but whether the average consumer would understand "OPTI" as referring to light. I have examined the evidence provided by the applicant by way of examples of various lighting products sold under the name "OPTI" offered for sale online,[40] many of which target a UK market. Alongside the fact that the parties both agree that the element "OPTI" can refer to light, I find on balance, there is likely to be a significant proportion of average consumers who identify the letters "OPTI" as referring to light and, equally a significant proportion of average consumers who do not.

64. Second, and more importantly in this case, irrespective of how consumers perceive the letters "OPTI" in the applicant's mark, these letters will not be understood as having the same meaning in the earlier mark, because as noted in paragraph 44 above, the opponent's word mark as a whole, "OPTIO", will be seen as an invented word without any meaning.

65. Therefore, irrespective of how consumers perceive the letters "OPTI" within the applied for mark, the competing marks are conceptually dissimilar. This is because whilst the earlier mark will be understood as having no meaning, consumers will still identify the meaning discussed above in the ordinary dictionary word "DRIVE" in the contested mark. Therefore, given that the

[40] Exhibits PT2 - PT21

contested mark conveys a clear meaning that is absent in the earlier mark, the competing marks must be conceptually dissimilar. Whether "OPTI" will be understood as meaning light, will not change this outcome. If it is understood as meaning light, the marks are still conceptually dissimilar in any event, and if "OPTI" is understood as having no meaning, this will result in the letters being conceptually neutral rather than similar so there will be no impact on the overall finding.

Likelihood of confusion

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

67. I have found the marks to be visually similar to a medium degree, aurally similar to at least a medium degree and conceptually dissimilar irrespective of whether consumers identify "OPTI" within the applied for mark as meaning light. I have found the earlier mark possesses a high degree of inherent distinctive character. I have identified the average consumer to be predominantly councils and owners of private land who will pay a high degree of attention. I have found visual considerations likely to dominate the purchasing act, however, I do not discount

aural considerations entirely. Finally, I find there to be identity for at least some of the goods.

68. In my view, bearing in mind that the relevant consumers will be paying a high degree of attention, the marks would not be misremembered for one another under direct confusion. Although they overlap in the element "OPTI" found at the beginning of the respective marks, a place where the attention of consumers is usually directed,[41] the relevant consumers will notice that the marks differ in their respective endings, particularly given the conceptual difference that arises from the word “DRIVE” within the applied for mark, keeping in mind that the ends of marks may also be impactful.[42] In addition for those consumers that perceived the element “OPTI” as meaning light there will be a further conceptual difference. Consumers will also not overlook the differences in length between the marks. Therefore, taking the above into account, I do not find there to be a likelihood of direct confusion between the marks, even for identical goods as relevant consumers will be paying a high degree of attention when purchasing the goods and are less likely to misrecall the marks for one another.

69. I will now go on to consider indirect confusion. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. Furthermore, it is not sufficient that a mark merely calls to mind another mark:[43] This is mere association not indirect confusion.

70. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, by Iain Purvis Q.C. (as he then was), as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually

[41] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[42] *Bristol Global Co Ltd v EUIPO,* T-194/14
[43] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

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)".

71. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of

direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

72. The opponent submits that there is a likelihood of indirect confusion. It states:

> *"In particular, bearing in mind the principle of imperfect recollection, it is conceivable that consumers encountering the Applicant's mark "OPTIDRIVE" in relation to lighting/lighting control products may assume that it denotes a new sub-brand, or range of the Opponent. This is all the more obvious when it is borne in mind that the Opponent's OPTIO mark is already used in conjunction with various sub-brand, each denoting a different lighting product."*[44]

73. I do not consider that consumers would misremember the "OPTI/OPTIO" elements in the competing marks due to the high attention being paid. That leads me to consider whether, consumers would consider the removal of the letter "O" in the opponent's mark and its replacement with the word "DRIVE" as a logical sub brand in the context of the goods. I can see no good reason why the opponent would separate the letters "OPTI" and "O", as removing the letter "O" would have a crucial impact on the earlier marks level of distinctiveness as an invented word. Thereby it makes no logical sense to remove the letter "O" and replace it with the word "DRIVE" which has no obvious relation to the goods. Whilst I acknowledge that the opponent has referred to the fact that it uses the "OPTIO" mark in conjunction with various sub brands, which I assume to be those referred to in evidence such as "OPTIO NANO", "OPTIO MICRO" and "OPTIO MIDI", a crucial difference is that these all contain the full word "OPTIO" not merely the element "OPTI". Further the words are not conjoined to make an invented word, and the respective second words in these examples are all non-distinctive referring to size. Therefore, I do not find these analogies similar to the competing marks, nor a compelling argument for why consumers would see the applied for mark as a sub brand of the opponent's earlier mark. Instead, the

[44] Opponent's written submissions, paragraph 37.

shared letters “OPTI” will merely be seen as coincidental. Consequently, I do not find that there is a likelihood of indirect confusion between the respective marks even for identical goods.

CONCLUSION

74. The opposition under section 5(2)(b) of the Act has failed. Therefore, subject to any successful appeal against my decision, the application will proceed to registration.

COSTS

75. As the applicant has been successful, it is therefore, entitled to a contribution towards its costs based upon the scale published in Annex A of the Tribunal Practice Notice 1 of 2023.[45] Applying this guidance, I award the applicant the sum of **£1300**, which has been calculated as follows:

Considering a notice of opposition and preparing a counterstatement:	£250
Preparing evidence, considering and commenting on the other sides evidence:	£600
Preparing for, and attending the hearing:	£650
Total:	**£1300**

[45] As the opposition proceedings were commenced after 1 February 2023.

76. I therefore order TRT Lighting Ltd to pay LMPG Inc. the sum of £**1300**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of December 2025

Sarah Wallace
For the Registrar