

**O/588/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003236781 BY  
BURN CABLE MANAGEMENT SYSTEMS LIMITED  
TO REGISTER:**

**SIMPLEX**

**AS A TRADE MARK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600000711 BY  
SIMPLEX CONDUIT SYSTEMS LIMITED**

## **BACKGROUND AND PLEADINGS**

1. On 12 June 2017, Burn Cable Management Systems Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 23 June 2017.

2. The application was opposed under the fast track opposition procedure by Simplex Conduit Systems Limited (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier UK Trade Mark registration no. 3000708 for the following mark:



3. The opponent’s mark has an application date of 5 April 2013 and registration date of 27 September 2013.

4. The following goods are relied upon in this opposition:

Class 9                      Electrical conduits and conduit fittings included in Class 9.

5. The opponent argues that the respective goods are identical or similar and that the marks are similar.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. By a letter dated 19 December 2017, the opponent sought leave to file evidence relating to the similarity of the goods in issue.

8. A Case Management Conference took place on 18 January 2018, before Mr C J Bowen, to determine whether the opponent would be granted leave to file evidence. The applicant was represented by Mr Jamie Muir Wood of counsel and the opponent was represented by Mr Timothy Blower of IP-Active.com Ltd. It was determined that the opponent would be permitted to file evidence on the alleged similarity of the goods in issue pursuant to paragraph 7(iii) of Tribunal Practice Note (“TPN”) 2 of 2013. The opponent submitted evidence in the form of the witness statement of Mr Timothy John Blower dated 16 March 2018, accompanied by 8 exhibits.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. The applicant filed written submissions in lieu of a hearing. No written submissions were filed by the opponent.

## **DECISION**

10. Sections 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

13. In its Counterstatement, the applicant requested that the opponent prove its use of the earlier mark. However, as the earlier mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

### **Section 5(2)(b) – case law**

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 to mind the earlier mark, is not sufficient;

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

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

### **Comparison of goods**

15. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 9</u> Electrical conduits and conduit fittings included in class 9.	<u>Class 9</u> Electric cables, namely electric fireproof cables and electric mineral insulating cables for protecting buildings from fire.

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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.”

17. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU

in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. 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 language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

19. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

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

21. 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.”

22. As noted above, the opponent has provided evidence on the alleged similarity of the goods in the form of the witness statement of Mr Blower, with eight exhibits. The evidence provided by Mr Blower can be summarised as follows:

a) Exhibit 1 – this is an extract from British Standard BS EN 61386-1:2008 entitled ‘Conduit systems for cable management – Part 1: General requirements’. This provides definitions of conduits and conduit systems. It also confirms that the purpose of conduits is to “provide mechanical and, where required, electrical protection of the insulated conductors and cables contained therein”.

b) Exhibit 2 – this consists of an extract from three trade suppliers. The first is an extract from the trade catalogue of Deta Products dated 2017. This confirms that Deta sells both cables and conduits in their trade catalogue. The second is an undated extract from the website of RS Components. This appears to show that when the ‘Cable Conduit, Trunking & Routing’ tab is selected, customers are directed to a landing page entitled ‘Cables & Wires’. This appears to offer for sale “an extensive range of cables” and “other cable protection products”. The third is an undated extract from the website of Screwfix which shows cable

and cable management offered for sale. The opponent states that the picture used as an example of cable management includes an image of a length of conduit.

c) Exhibit 3 – this is an extract from the Cleveland Cable Company website which is dated 2017. This displays a number of cables for sale including fireproof cables. The description of the fireproof cable states that it is “fire resistant to IEC 60331-21 and BS6387, CWZ when tested in steel conduit”. The opponent states that this demonstrates that in some circumstances the use of conduit with cables will be necessary in order to meet certain standards (such as fire resistance standards).

d) Exhibit 4 – this is an extract from the website of the Institute of Engineering and Technology which discusses instances in which firefighters have died as a result of cable entanglement. It explains that regulations have been introduced “requiring cables in escape routes to be adequately supported against their premature collapse in the event of a fire”. The opponent argues that as conduits “provide the highest degree of support and protection” people will use conduits in order to comply with the regulations.

e) Exhibit 5 – this is an extract from the rotheyburn.com website. The page displays the mark “BURN” (registration no. 3125199) which is a separate mark owned by the applicant. The website offers for sale various types of conduits and conduit accessories. At paragraph 7 of his witness statement, Mr Blower states:

“The present application, with its declaration of “intent to use”, provides evidence that the Applicant intends to offer electric cables to the market. In conjunction with Exhibit TJB 5, this provides evidence that conduit and cable are offered (or intended to be offered) by the same manufacturer and distributor.”

f) Exhibit 6 – this is an extract from the product catalogue of Burn Cable Management System which the opponent states is the catalogue provided by

the applicant. This provides an explanation of the use of a conduit system which supports the definitions provided in Exhibit 1.

g) Exhibit 7 - this is an extract from Decision O/258/12 in which the similarity of “insulated electric wire; insulated electric cables; conduit, trunking and channelling, all for electrical wiring installations” and “grommets made of plastic”. Whilst I note the finding in this case, the goods at issue were different and this is, therefore, of limited use to the opponent.

h) Exhibit 8 – this is an extract from Decision O/251/14 in which the similarity of “apparatus for conducting, switching, transforming, accumulating, regulating or controlling electricity” and “cable glands for use with electrical apparatus; electrical cable gland packs; all the aforesaid goods being intended for use by professional electricians in the field of electrical installation”. Whilst I note the finding in the case, the goods at issue were different and this is, therefore, of limited use to the opponent.

23. The Oxford English Dictionary defines a conduit as:

“A tube or trough for receiving and protecting electrical wires; a length or stretch of this. <sup>1</sup>”

24. The Oxford English Dictionary defines a cable as:

“A strong thick rope, originally hemp or other fibre, now also of strands of iron wire. <sup>2</sup>”

25. It is clear from these definitions that the nature of the goods in issue are different. Their specific purposes differ because a conduit is used to protect electrical wires or cables where as a cable is, of course, the conductor itself which is the subject of that protection. Further, in this case, the applicant’s goods are specifically fireproof cables.

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<sup>1</sup> <http://www.oed.com/view/Entry/38645?rskey=n0IRIm&result=1#eid>

<sup>2</sup> <http://www.oed.com/view/Entry/25760?rskey=MbN50X&result=1#eid>

Notwithstanding the fact that the applicant's specification specifically relates to fireproof cables, the goods do share a more general purpose which is to aid in the safe transmission of electricity.

26. The users of the goods in issue will, in my view, be the same. The user of these goods is most likely to be a tradesperson specialising in electrical works (although there may also be members of the public carrying out DIY works who would also use the goods). Tradespeople will, of course, have need of both electrical cables and conduit. The applicant's specification is, of course, specific to fireproof electrical cables but I do not consider that this will alter the user of such goods.

27. With regard to the trade channels through which the goods will be made available for purchase, the opponent has provided Exhibit 2 and Exhibit 5 in support of the contention that the goods will be available from the same trade channels. In respect of Exhibit 2, the applicant submits as follows:

“36. The Opponent has provided one example of a supplier who sells both cables and conduits, namely Deta Products in exhibit TJB2. It is to be noted that this does not show a supplier of specialist fireproof cables but merely a generic cable supplier. Furthermore, this is a single supplier: three pages of a trade catalogue do not show that suppliers generally supply both fireproof cables and conduits.

37. The Opponent has also provided excerpts from websites operated by RS Components and Screwfix, also contained in TJB2. Both RS Components and Screwfix stock a wide range of products from a wide range of suppliers. This evidence shows that, rather than listing cables and conduits in the same sub-category, they are separated from each other. Accordingly, it is submitted that the average consumer would search one category or the other and not necessarily both to find either cables or conduits.”

28. I agree with the applicant that the Deta Catalogue extract at Exhibit 2 does not appear to list fireproof electrical cables as one of the types of cable available for purchase. It does, of course, sell other types of cable and conduits. The RS

Components website extract does state that it offers for sale “specialist cables” but there is no evidence provided as to whether fireproof cables are included in this. Again, the Screwfix website appears to offer for sale both cables and conduits, but as I have only been provide with the landing page and not examples of the goods actually sold, it is not clear from the evidence whether fireproof cables are sold on the website.

29. With regard to Exhibit 5, the applicant states:

“38. The Opponent draws a false conclusion between the Application and TJB5. Whilst TJB5 shows the Applicant offering conduits and conduit accessories, it shows it doing so under the brand ‘ROTHLEY BURN’ and ‘BURN’. The Application, as the Registrar will be well aware, is for the Sign, which is markedly different from either ‘ROTHLEY BURN’ or ‘BURN’. What this, in fact, demonstrates, is that the Applicant intends to market its fireproof cables under a brand entirely different from the brand under which it markets its conduits and conduit accessories”.

30. I agree with the applicant. All this demonstrates is that the applicant owns (or has applied for) two separate trade marks which relate to different goods and under which different goods are sold. This is not evidence of cables and conduits being provided by the same manufacturer and distributor because, by their very nature, the differing marks under which these products are sold (or are to be sold) distinguishes them as having different trade origins.

31. Whilst the opponent’s evidence does, therefore, demonstrate that cables and conduits are sold through the same trade channels it does not definitively prove that fireproof cables will be sold through the same trade channels as conduits. I agree with the applicant that there will be more generic suppliers who may offer for sale conduits and general electrical cable but will not provide more specialist fireproof cable. However, there will be more specialised suppliers who sell fireproof cable and also offer conduit for sale. I am therefore satisfied that, notwithstanding the deficiencies in the opponent’s evidence in this regard, that there will be a degree of overlap between the trade channels for the goods in issue.

32. The opponent's view is that the goods in issue are complementary. Mr Blower states at paragraph 3 of his witness statement that Exhibit 1 demonstrates that cables are "indispensable to the purpose and method of use of conduits". The opponent also relies upon Exhibit 3 which it alleges shows that in some cases the use of conduits will be "necessary" in order to meet fire resistance standards and Exhibit 4 which confirms that new regulations require additional support to be given to cables along escape routes and the opponent submits that this may require the use of conduits. In this regard, the applicant argues as follows:

"It is accepted that conduits are used to carry cables. Whilst TJB1 shows that conduits are used to carry cables and certain other exhibits, namely TJB3 and TJB4 show that conduits may be required in certain circumstances, the evidence does not show that fireproof cables (as against cables per se) must be fitted in conduits. It is submitted, in fact, that, contrary to the submissions made by the Opponent, which are unsupported by any evidence, the purpose of using fireproof cabling may be to avoid needing to use conduits, rather than leading to an assumption that conduits will also need to be employed." (original emphasis)

33. I accept the applicant's submission that there may be some instances in which conduits will not be used with fireproof cables. However, the opponent's evidence does demonstrate that there will be circumstances in which use of conduits is required for fireproof cabling. In any event, the applicant's submission that the fireproof nature of the cables may make it less likely that a conduit will be used is based on the premise that the conduit is being used only for its fireproof qualities. Conduit may be used to protect cabling from any number of external factors, not just fire (such as impact or moisture). With regard to these other external factors, I see no reason why fireproof cabling would require conduits any less than other types of cabling. In my view, there is a close connection between the opponent's goods and the applicant's goods so that the consumer may think that they were provided by the same undertaking. I therefore consider these goods to be complementary.

34. Taking into account the fact that the goods share a common general purpose, the users of the goods will be the same (mainly tradespeople specialising in electrical works), the trade channels for the goods will overlap (such as specialist electrical retailers) and the goods are complementary, I consider that they are similar to a medium degree.

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

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

36. In its written submissions, the applicant argues as follows:

“21. It is submitted that the average consumer of both the Opposed Goods and the Registered Goods is either a professional electrician or builder or a member of the public undertaking do-it-yourself works. In either case, it is submitted that the average consumer will be more concerned with reviews and price than with the brand of the goods, since neither the Mark not [sic] the Sign has inherent distinctive character.

22. In those circumstances, it is submitted that the average consumer will give low to ordinary regard to the branding of any goods, if any.”

37. I have no substantive submissions from the opponent on the identity of the average consumer or the purchasing process for the goods in issue, other than that the opponent states that the users for the goods would be “electricians or electrical installers”.

38. The goods in issue are specialist electrical products. I agree with the applicant that the average consumer in these proceedings will therefore be a specialist tradesperson (such as an electrician) or a member of the public undertaking DIY work. The frequency of purchases of this nature will vary as they would be infrequent purchases for a member of the public undertaking DIY work, whereas they are likely to be fairly frequent purchases for an electrician who is using the goods in the course of his trade. The cost of the goods will vary depending on the type of goods being purchased (from basic conduits which would be of lower cost to specialist fireproof cabling which would be of higher cost). Both specialists and members of the public are likely to give a fair amount of considered to the purchase of the goods to ensure that they meet their specific requirements for the task that they are undertaking (for example, ensuring that the conduits are the correct size and material). A member of the public who is not used to making purchases of this nature may pay a slightly higher degree of attention when purchasing goods of this nature. I consider that the average consumer will pay at least an average degree of attention during the selection process for the goods in issue.

39. The average consumer is likely to purchase the goods by self-selection from a specialist retail outlet or from their website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of goods, given that advice may be sought from sales assistants or representatives and that orders may be placed by telephone.




## Comparison of trade marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The 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.”

41. 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.

42. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	SIMPLEX

43. In its written submissions, the applicant states as follows:

“It is accepted that the Mark and the Sign have a high degree of aural and conceptual similarity. It is submitted, however, that the visual similarity is lower,

on the basis of the decorative elements and shading contained in the Mark and the absence of such decoration and shading in the Sign.”

44. In its Notice of Opposition, the opponent states as follows:

“The Applicant mark consists of the work mark SIMPLEX. The Opponent mark comprises the word SIMPLEX in a stylised form, with the distinctive and dominant component being the word SIMPLEX. Thus the marks are similar.”

45. I agree with the parties that there is undoubtedly a degree of similarity between the marks. The applicant’s mark consists of the word “SIMPLEX” presented in capital letters. There are no other elements to contribute to the overall impression, which is contained in the word itself. The opponent’s mark also consists of the word “SIMPLEX” in capital letters but this is presented in a stylised white font, with the “S” being larger than the other letters and with the word underlined by an extension to the letter “X”. The word is presented on a black background. I consider that the word “SIMPLEX” dominates the overall impression of the mark and the underlining and background do not detract from the dominance of the word itself. They play a lesser role in the overall impression of the mark.

46. There is an obvious point of visual similarity between the trade marks, as both contain the word “SIMPLEX”. There is also some difference between the trade marks because of the stylisation of the earlier mark and its presentation on a black background. Bearing in mind my assessment of the overall impression, I consider that there is a high degree of visual similarity between the marks.

47. Both marks are likely to be pronounced as written (“SIM-PLEX”). As such, I consider the marks to be aurally identical.

48. Conceptually, both marks appear to be an invented word made from the ordinary word “SIMPLE” with the suffix “-X”. I do not think that the average consumer would attribute any particular meaning to the suffix “-X”. I am therefore of the view that the average consumer would perceive both marks as alluding to the simplicity of the products to which the mark relates or the simplicity of their function. I do not consider

that the stylisation of the earlier mark or its presentation on a background differentiates conceptually from the applicant's mark. I therefore consider that the marks are, to the extent that they are allusive, conceptually identical.

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

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

50. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

51. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. I have no submissions from the opponent on the distinctiveness of its mark. In its written submissions, the applicant states as follows:

“26. It is, however, also submitted that neither the Mark nor the Sign has a particularly high degree of inherent distinctiveness. This is because the Mark contains and the Sign consists of the word ‘*simplex*’, which is very close to the word ‘*simple*’ and is therefore liable to be viewed by members of the public as indicating a straightforward product or a basic level product, when compared with other products. In those circumstances, the average consumer is not liable to regard either the Mark or the Sign as having a high level of distinctive character.

27. If any part of the Mark is distinctive, it is the shading, the slight tapering of the font and the bold white stripe running along its base. It is submitted that the average consumer is more likely to focus on these elements than on the word contained within the Mark.”

52. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The mark is an invented word which is made up of a combination of the ordinary dictionary word “SIMPLE” with the suffix “-X” in stylised font and presented on a black background. Although it is an invented word, it is allusive in that it suggests that the goods to which the mark relates are simple in some way (such as their function). I do not consider that the stylisation of the mark makes a material difference to its distinctiveness. I find that the earlier mark has a medium degree of inherent distinctive character.

### **Likelihood of confusion**

53. 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 and services 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 services 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 he has retained in his mind.

54. I have found the parties' marks to be visually similar to a high degree and aurally and conceptually identical. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be either a specialist tradesperson (such as an electrician) or a member of the general public undertaking DIY works. I consider that they will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the average consumer will pay at least an average degree of attention when purchasing the goods. I have found the parties goods' to be similar to a medium degree. Bearing in mind all of these factors, and taking into account the principle of imperfect recollection, I am satisfied that the similarities between the marks will lead to a likelihood of direct confusion between them i.e. the average consumer will mistake one mark for another.

55. In the event that I am wrong in my finding that there is a likelihood of direct confusion, I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

56. As noted above, the marks are not visually identical. However, the word “SIMPLEX” present in both marks will convey an identical conceptual message and will make the marks aurally identical. Bearing in mind my conclusions summarised in paragraph 54 above, I consider that even if the average consumer recognises the visual differences between the marks (and therefore does not mistake one mark for the other), I consider that there will be an expectation on the part of the average consumer that the goods at issue come from the same or economically linked undertakings. There is, therefore, a likelihood of indirect confusion.

## **CONCLUSION**

57. The opposition has been successful and the application is refused.

## **COSTS**

58. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by TPN 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Filing a notice of opposition	£200
Filing evidence	£200

Opposition fee £100

**TOTAL: £500**

59. I order Burn Cable Management Systems Limited to pay Simplex Conduit Systems Limited the sum of £500. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the determination of this case if any appeal against this decision is unsuccessful.

**Dated this day 24th of September 2018**

**S WILSON**

**For the Registrar**