

**O/285/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003280013**

**BY R. HAMILTON & CO. LIMITED**

**TO REGISTER THE TRADE MARK:**

**VERVE**

**IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 412342 BY**

**ARLEC AUSTRALIA PTY LTD**

## BACKGROUND AND PLEADINGS

1. On 2 January 2018, R. Hamilton & Co. Limited (“the applicant”) applied to register the trade mark **VERVE** in the UK. The application was published for opposition purposes on 2 February 2018. On 30 April 2018, the applicant requested an amendment to its specification (which was accepted) and the application now relates to the following goods:

Class 9      Electrical connectors; electric wires and electric cables; switches; dimmer switches; dimmer switch units and modules; rheostats; resistors; fuses; electric plugs; electric sockets; telephone sockets; television sockets; circuit breaker apparatus and earthing apparatus; residual current detectors; electric alarms; thermostats; transformers; electrical distribution equipment; speakers and speaker systems; parts and fittings for all the aforesaid goods.

2. The application is opposed by Arlec Australia Pty Ltd (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3149189 for the following mark:



VERVE  
*design*

3. The opponent’s mark has a filing date of 11 February 2016 and a registration date of 17 November 2017. The opponent relies upon all of the goods for which the earlier mark is registered:

Class 11      Lighting products, including Christmas lights (other than candles), cord pendants (light fittings), decorative lights, table lights, floor lights, downlights, electric light bulbs, electric light fittings, electric lights, electric lights for festive decorations, fittings for wall lights (other than switches), flange light fittings, fluorescent light bulbs, fluorescent lights, garden lights, light assemblies, light fittings, light hanging apparatus,

light reflectors, light shades, light-emitting diode (LED) lighting apparatus, lighting apparatus utilising light emitting diodes (LEDs), lights for wall mounting, night lights (other than candles), opaque casings for lights, plastic louvres being light fittings, shades for light sources, spotlights, strings of coloured lights, strobe lights, torches, under cabinet lights, wall lights; parts and accessories for the aforesaid goods included in this class.

4. The opponent's Form TM7 only initially opposed "electrical and electronic control and monitoring apparatus and instruments; electrical and electronic apparatus, all for the control of lighting; electrical connectors; dimmer switches; dimmer switch units and modules in class 9" in the applicant's specification. The opponent subsequently sought to amend its TM7 to broaden the scope of its opposition. This request was accepted by the Tribunal and the application is now opposed in full. The opponent argues that the respective goods are identical or similar and the marks are similar.

5. In addition to its opposition under section 5(2)(b), the opponent originally sought to rely on section 5(3) of the Act, but subsequently withdrew this ground of opposition.

6. The applicant filed a counterstatement denying the claims made.

7. The opponent is represented by D Young & Co Ltd and the applicant is represented by Stratagem IPM. Although the applicant's Form TM8 was originally filed by Page Hargrave, I understand that the latter has been acquired by the former and that there has been no change of legal representative for the applicant. The opponent filed written submissions during the evidence rounds dated 19 September 2018. The applicant filed written submissions during the evidence rounds dated 14 November 2018. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **DECISION**

8. Section 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.”

9. 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.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade 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, therefore, rely upon all of the goods it has identified.

## Section 5(2)(b) – case law

11. 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:

(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 greater 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

12. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 11</u> Lighting products, including Christmas lights (other than candles), cord pendants (light fittings), decorative lights, table lights, floor lights, downlights, electric light bulbs, electric light fittings, electric lights, electric lights for festive decorations, fittings for wall lights (other	<u>Class 9</u> Electrical connectors; electric wires and electric cables; switches; dimmer switches; dimmer switch units and modules; rheostats; resistors; fuses; electric plugs; electric sockets; telephone sockets; television sockets; circuit breaker apparatus and earthing

<p>than switches), flange light fittings, fluorescent light bulbs, fluorescent lights, garden lights, light assemblies, light fittings, light hanging apparatus, light reflectors, light shades, light-emitting diode (LED) lighting apparatus, lighting apparatus utilising light emitting diodes (LEDs), lights for wall mounting, night lights (other than candles), opaque casings for lights, plastic louvres being light fittings, shades for light sources, spotlights, strings of coloured lights, strobe lights, torches, under cabinet lights, wall lights; parts and accessories for the aforesaid goods included in this class.</p>	<p>apparatus; residual current detectors; electric alarms; thermostats; transformers; electrical distribution equipment; speakers and speaker systems; parts and fittings for all the aforesaid goods.</p>
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13. 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 (“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.”

14. 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.

15. 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.”

16. 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.”

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 for 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.”

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

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

19. 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.”

20. I have submissions from both parties on the similarity of the goods and, whilst I do not propose to reproduce those here, I have taken them into consideration in reaching my decision. I note that the opponent’s specification includes “parts and accessories for the aforesaid goods included in this class”. Many of the applicant’s goods would be considered parts and/or accessories for the opponent’s goods, however, they are in class 9 and not class 11. The use of the wording “included in this class” in the opponent’s specification, therefore, prevents the applicant’s goods from falling within this term and being considered identical on the principle outlined in *Meric*.

Electrical connectors; electric wires and electric cables; fuses; electric plugs; resistors; circuit breaker apparatus and earthing apparatus; residual current detectors

21. I recognise that these are all goods which could form part of the opponent’s “lighting products”. This is the term upon which the opponent focused its submissions. However, the fact that something is a component of another product does not justify a finding of similarity<sup>1</sup>. The nature of these goods is different. They will differ in user as the applicant’s goods will be targeted at manufacturers of lighting products and tradespeople and the opponent’s goods will be targeted at members of the general public. Their uses and methods of use are different. I consider the greater degree of similarity is with the opponent’s “parts and accessories for the aforesaid goods included in this class”. As noted above, these goods cannot be considered identical, but they will overlap in use and user. They will be available through the same trade

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<sup>1</sup> *Les Editions Albert Rene v OHIM*, Case T-336/03

channels. However, I recognise that there may be differences in nature and method of use. I consider the goods to be similar to a medium degree.

Switches; dimmer switches; dimmer switch units and modules; electric sockets

22. These are all goods which may be used in conjunction with “lighting products” in the opponent’s specification. There may be overlap in trade channels as they may all be sold by specialist lighting outlets or home improvement stores. The users may overlap. The uses will differ as the opponent’s goods are intended to give light to a particular area whereas the applicant’s goods are intended to control the power supply to electrical items. The method of use will also differ. I consider these goods to be similar to a moderate degree.

23. I consider that these goods also share some similarity with “parts and accessories for the aforesaid goods included in this class” in the opponent’s specification. There will be overlap in user in that they may both be purchased by tradespeople. They will have the same use in that both will assist in the proper functioning of lighting products, although I recognise that more specific uses may differ. They may be available through the same trade channels. The nature and method of use may differ. I consider these goods to be similar to a medium degree.

Rheostats

24. In its written submissions, the opponent states “we understand that [rheostats] are used to control electrical current by varying the resistance”. The applicant has provided no alternative explanation as to what these goods are, and I see no reason to depart from the opponent’s interpretation of this. Whilst I recognise that these may be used as part of lighting products, this is not sufficient for a finding of similarity for the same reasons set out above. Again, I consider the stronger argument for similarity lies in the opponent’s “parts and accessories for the aforesaid goods included in this class”. The goods will overlap in user as they may all be used by tradespeople or manufacturers of lighting products. They may share a common use in terms of ensuring the proper functioning of lighting products, although I recognise that their specific uses will differ.

They will be available through the same trade channels. There may be differences in nature and method of use. I consider these goods to be similar to a medium degree.

### Transformers

25. In respect of these goods, the opponent states that this includes light transformers, “which are specifically designed to work with lighting”. The opponent goes on to state that “light transformers allow voltage to be transformed down to levels that are suitable for household lighting, and may come in the form of dimmer switches”. I accept that there may be some overlap in trade channels with “lighting products” as they may be sold through the same specialist lighting outlets or home improvement stores. The users may overlap. The uses will differ as one is intended to give light to a particular area and the other is intended to control voltage levels. I consider these goods to be similar to a moderate degree.

26. I consider that these goods also share some similarity with “parts and accessories for the aforesaid goods included in this class” in the opponent’s specification. There will be overlap in user in that they may both be purchased by tradespeople. They will have the same use in that both will assist in the proper functioning of lighting products, although I recognise that more specific uses may differ. They may be available through the same trade channels. The nature and method of use may differ. I consider these goods to be similar to a medium degree.

### Telephone sockets; television sockets

27. In respect of these goods the opponent states “telephone sockets and television sockets are also available in a variety of finishes and would be purchased together with the Opponent’s lighting products in order to ensure they complement the lighting products and the style of the room”. This is not the meaning of complementary explained in the case law and I do not consider that these goods are either complementary or competitive. They may overlap in user with “lighting products” as they may both be purchased by members of the general public. Whilst I recognise that both may be available from home improvement stores, they are likely to be sold in entirely different aisles as the applicant’s goods are unrelated to lighting. However, I

do not consider that this is sufficient for a finding of similarity. The goods differ in nature, intended purpose and method of use. I consider these goods to be dissimilar.

28. I recognise that there may be some overlap in user and trade channels with “parts and accessories for the aforesaid goods included in this class” in the opponent’s specification. They may both be used by tradespeople. However, they differ in uses, method of use and nature. I recognise that the goods may be sold through the same trade channels, but they will be in entirely separate areas as the applicant’s goods are unrelated to lighting. I consider these goods to be dissimilar. If I am wrong in this finding, then they will be similar to only a low degree. I can see no further point of similarity which would put the opponent in a stronger position.

#### Electrical distribution equipment

29. In respect of “electrical distribution equipment” in the applicant’s specification, the opponent states “this equipment can be essential in order to provide power to enable the functioning of the Opponent’s “lighting products””. No explanation is provided by the applicant as to what is meant by this term. In my view, this term will cover equipment involved in the distribution of electricity to users. The nature and use of the goods will be different. They will differ in intended use and method of use. These are specialist goods that you would not expect to be sold through the same trade channels as more generic household items. I do not consider these goods to be complementary or in competition. The user will differ as the user of “lighting products” in the opponent’s specification will be members of the general public, whereas the user of “electrical distribution equipment” will be professionals involved in the electrical distribution process. I consider these goods to be dissimilar. I consider that the same points apply to “parts and accessories for the aforesaid goods included in this class” in the opponent’s specification, with the exception that there may be overlap in user with both being used by tradespeople. This alone is insufficient to find similarity. The goods are dissimilar. I can see no further point of similarity with the opponent’s goods that would put the opponent in a stronger position.

### Electric alarms

30. In respect of these goods the opponent states “Electric alarms often contain lights, in particular LED lights, which are covered by the Opponent’s Goods”. In my view, this is far from sufficient to justify a finding of similarity with “lighting products” or “light-emitting diode (LED) lighting apparatus” in the opponent’s specification. The goods may overlap in user on a superficial level. However, they have different intended purposes and methods of use. The trade channels will be different as LEDs may be purchased from home improvement or DIY stores, whereas alarms are likely to be purchased from specialist outlets. They are neither complementary nor competitive. I consider these goods to be dissimilar. I can see no further point of similarity with the opponent’s goods which would put the opponent in a stronger position.

### Thermostats

31. In respect of these goods the opponent states “Digital thermostats contain a backlit display in the form of an LED light, which is covered by the Opponent’s Goods. Many thermostats also contain a coloured light at the top of the display to indicate power”. Again, in my view, this is insufficient to justify a finding of similarity. The users of these goods may overlap with “lighting products” and “light-emitting diode (LED) lighting apparatus” in that they may be purchased by members of the general public. However, the intended purpose will differ in that the applicant’s goods are intended to control temperature and the opponent’s goods are intended to give light to a particular area. The trade channels are likely to differ in that the applicant’s goods will be purchased from providers of heating installations, whereas the opponent’s will be purchased from DIY or lighting stores. The method of use will differ. The fact that thermostats may contain LEDs or lighting more generally is insufficient to find complementarity within the meaning of the case law. The goods are not in competition. I consider these goods to be dissimilar. I can see no further point of similarity with the opponent’s goods which would put the opponent in a stronger position.

### Speakers and speaker systems

32. The opponent puts forward similar arguments in respect of “Speakers and speaker systems” in the applicant’s specification. These goods differ in purpose to the opponent’s “lighting products” and “light-emitting diode (LED) lighting apparatus” in that one is intended to produce sound whereas the others produce light. The method of use and trade channels will differ. The user will overlap in that they may all be purchased by members of the public. The goods are not in competition with each other. The fact that speakers may contain LEDs or lighting more generally is not sufficient for a finding of complementarity. I consider these goods to be dissimilar. I can see no further point of similarity with the opponent’s goods that would put the opponent in a stronger position.

### Parts and fittings for all the aforesaid

33. “Parts and fittings for all the aforesaid” in the applicant’s specification will overlap in nature with “parts and accessories for the aforesaid goods included in this class” in the opponent’s specification. The users and trade channels may overlap. The intended purpose may also be similar. I consider these goods to be similar to at least a medium degree.

34. As some degree of similarity between the goods is required for there to be a likelihood of confusion<sup>2</sup>, the opposition must fail in respect of the following goods in the applicant’s specification:

Class 9 Telephone sockets; television sockets; electric alarms; thermostats; electrical distribution equipment; speakers and speaker systems.

### **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

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<sup>2</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

manner in which the 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 states:

“18) The relevant public of the Contested Goods is the general public and the professional public. The Contested Goods are high quality, expensive, sophisticated products, which are only available in specialist electrical stores, to architects and to property developers. The Contested Goods are not sold in DIY stores. Given the high cost and quality of the Contested Goods, it is submitted that the consumer will exercise a higher degree of care and will buy the goods only after careful consideration. The degree of attention is therefore high in respect of the goods.”

37. In its written submissions, the opponent states:

“21. The Applicant states at paragraph 18 of its submissions that the Contested Goods are high quality, expensive, sophisticated products, which are only available in specialist electrical stores, to architects and property developers, and are not sold in DIY stores. The Applicant submits that the degree of attention in respect of the goods is high. The Opponent disputes the Applicant’s assertions.



22. As noted in the Opponent's submissions dated 19 September 2018, on following the links from the Applicant's website to their distributors, the Contested Goods are available to the general public. Further, the general public can access the Applicant's websites.

23. Indeed the Contested Goods are widely available from DIY stores such as B&Q, Wickes and Homebase (all of which have an adjoined lighting the electrics section). Indeed a search of the B&Q online website ([www.diy.com](http://www.diy.com)) shows that not only are the Contested Goods readily available, they are in many cases very cheap and can be purchased for as little as £1.

24. The Contested Goods are clearly not only available to architects and property developers. Even if architects and property developers were buying the products on behalf of the general public, for example for a renovation project, the general public would be involved in choosing the specific product. As set out above, many of the Contested Goods, including switches, dimmer switches and sockets, are available in a variety of finishes and the general public would want to ensure that the product would complement their lighting products and style of the room.

25. For convenience, and as certain goods require aesthetic consideration together, the relevant consumer is therefore likely to purchase the Contested Goods and the Opponent's Goods from a single outlet. The relevant public would therefore expect the goods containing the same or highly similar trade mark to be part of the same range and originate from the same manufacturer.

26. The Opponent reiterates that the relevant consumer is considered to be the general public, interior designers, electricians and professional decorators. Given the broad range of consumers, these all need to be taken into account, in particular, the general public who are DIY enthusiasts. The degree of attention of the relevant public is average."

38. The parties' submissions seem to have focused on the actual goods supplied by the parties. The assessment that I must undertake is a notional assessment of the

goods covered by the terms in the parties' respective specifications, not just the actual goods sold by the parties. In this context, I consider that the average consumer for the goods will be manufacturers of lighting products, tradespeople and members of the general public. The price of the goods is likely to vary from low (such as electrical wiring) to average (such as lighting products). A number of factors is likely to be taken into account in purchasing the goods, such as aesthetics, quality and safety requirements. I accept that, in relation to the more specialist goods, members of the general public undertaking DIY are likely to pay a higher degree of attention than professionals, as they will be less familiar with the goods in issue. However, I consider that at least an average degree of attention will be paid for both categories of average consumer.

39. The goods are most likely to be purchased by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Visual considerations will dominate the selection process for the goods. However, I do not discount that there will also be an aural component to the purchase of the goods given that advice may be sought from a sales assistant or orders may be placed by telephone.


### **Comparison of the 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
	VERVE

43. I have lengthy submissions from the parties on the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them into account in reaching my decision.

44. The applicant's mark consists of the word VERVE in uppercase font. There are no other elements to contribute to the overall impression which lies in the word itself. The opponent's mark consists of the word VERVE in large slightly stylised lowercase font with the word DESIGN in a smaller, more stylised font beneath it. The word VERVE plays a greater role in the overall impression, with the word DESIGN playing a lesser role.

45. Visually, the marks coincide in the presence of the word VERVE in both marks. This is the only element of the applicant's mark and it is the element of the opponent's mark which has a greater role in the overall impression. The stylisation of the word VERVE in the opponent's mark is minimal and, as notional and fair use of the applicant's mark would allow use in any standard typeface, I do not consider that this is a significant point of difference. The main point of difference between the marks is the presence of the word DESIGN in the opponent's mark, although as noted above, the presentation of this word in a smaller font presented beneath the word VERVE

means that it plays a lesser role in the overall impression. I consider the marks to be visually similar to a high degree.

46. Aurally, the word VERVE will be pronounced identically in both marks. The only point of aural difference between the marks will be the presence of the word DESIGN, although as this is in smaller font beneath the word VERVE there may be some average consumers who would not pronounce this word in the opponent's mark. For those average consumers, the marks will be aurally identical. For the average consumers who do pronounce the word DESIGN in the opponent's mark, the marks will be aurally similar to a medium degree.

47. Conceptually, the word VERVE will be given its ordinary dictionary meaning in both marks. The word DESIGN in the opponent's mark will be given its ordinary dictionary meaning and will be the only point of conceptual difference between the marks. The word design may be seen as a reference to particular aesthetic qualities in respect of some of the goods. I consider the marks to be conceptually similar to a high degree.

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

48. 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).”

49. 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.

50. The opponent submits that its mark has a high degree of inherent distinctiveness as it has no meaning in relation to the goods for which the mark is registered. The applicant disputes this and states that the word VERVE has a normal degree of distinctiveness.

51. As the opponent has filed no evidence to show that its mark has acquired enhanced distinctiveness through use, I have only the inherent position to consider. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The word VERVE is an ordinary dictionary word. I accept that it is neither descriptive nor allusive for the goods in issue. The word DESIGN in the opponent's mark may be seen as alluding to the goods in issue being designer, although this will apply only to those goods which may be purchased for aesthetic reasons (such as lighting products). I do not consider that the stylisation in the mark adds a great deal to its distinctive character. Overall, I consider the opponent's mark to be inherently distinctive to at least a medium degree.

### **Likelihood of confusion**

52. 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.

53. I have found the parties' marks to be visually and conceptually similar to a high degree. I have found the marks to be aurally identical for those consumers who do not pronounce the word DESIGN in the opponent's mark and aurally similar to a medium degree for those who do. I have identified the average consumer to be a member of the general public, a tradesperson or a manufacturer of lighting products, who will pay at least an average degree of attention during the purchasing process. I consider that the goods will be selected primarily by visual means (although I do not discount an aural component). I have found the parties' goods to be similar to at least a medium degree (except for those goods which I have found to be dissimilar). I have found the opponent's mark to have at least a medium degree of inherent distinctive character.

54. Bearing in mind the principle of imperfect recollection, I consider that the presence of the word VERVE in both marks is likely to lead average consumers to mistakenly recall one mark as the other. I consider that the presence of the word DESIGN in the opponent's mark is likely to be forgotten or overlooked when the average consumer is recalling the mark. I consider that the high degree of similarity between the marks will lead to confusion notwithstanding that at least an average degree of attention will be paid during the purchasing process. I consider there to be a likelihood of direct confusion in respect of those goods which are similar to at least a medium degree.

55. In the event that I am wrong in my finding that there is a likelihood of direct confusion, I will go on to 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. If the average consumer recalls the presence of the word DESIGN in the opponent’s mark then I consider that they are likely to view the marks as two different signs used by the same or economically linked undertakings. The word DESIGN may be seen as a reference to a particular range of products. Given that the opponent’s mark has at least a medium degree of inherent distinctive character, I consider that the presence of the word VERVE in another mark for goods which are similar to at least a medium degree will lead to a likelihood of indirect confusion.

## **CONCLUSION**

57. The opposition has succeeded in relation to the following goods for which the application is refused:

Class 9      Electrical connectors; electric wires and electric cables; switches; dimmer switches; dimmer switch units and modules; rheostats; resistors; fuses; electric plugs; electric sockets; circuit breaker apparatus and

earthing apparatus; residual current detectors; transformers; parts and fittings for all the aforesaid goods.

58. The opposition has been unsuccessful in relation to the following goods for which the application will proceed to registration:

Class 9 Telephone sockets; television sockets; electric alarms; thermostats; electrical distribution equipment; speakers and speaker systems.

59. The opponent has achieved the greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. However, I have taken the fact that the opponent has only been partially successful into account in calculating the costs awarded. In the circumstances, I award the opponent the sum of **£800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
Preparing two sets of written submissions and considering the applicant's submissions	£500
Official fee	£100
<b>Total</b>	<b>£800</b>

60. I therefore order R. Hamilton & Co. Limited to pay Arlec Australia Pty Ltd the sum of £800. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 24 May 2019**

**S WILSON**  
**For the Registrar**