

O/097/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003421975 BY DWS GROUP
LIMITED TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 1, 6, 9, 10, 37 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418612 BY MG CONTRACTORS ApS

Background and Pleadings

1. On 16 August 2019, DWS Group Limited ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number UK00003421975. The application was published for opposition purposes in the *Trade Marks Journal* on 30 August 2019. Registration is sought in respect of the following goods and services:

Class 1: *Fireproofing preparations; fire extinguishing compositions.*

Class 6: *Turnstiles of metal; building materials of metal; transportable buildings of metal; safes [metal or non-metal]; strongboxes [metal or non-metal]; metal cupboards; metal containers.*

Class 9: *Alarm systems; alarm panels; alarm sensors; alarm installations; fire break glass units; fire detecting apparatus; fire detection apparatus; fire detectors; fire protection apparatus; fire extinguishers; lifesaving apparatus and equipment; security alarms; security alarm systems; keypads for security and fire alarms; control panels for security and fire alarms; security sensors; motion, proximity, fire, heat, smoke, distance, and alarm sensors; smoke detectors; carbon monoxide detectors; first-aid alert alarms; cameras; security cameras; temporary alarms and alarm systems; portable alarms and alarm systems; radios; radio apparatus; radio transmitters; radio transceivers; alarm units and systems with built in radios.*

Class 10: *First aid medical apparatus for sale in kit form; surgical and medical apparatus and instruments, orthopaedic articles.*

Class 37: *Installation, maintenance, servicing, repair and removal of security apparatus; repair of electrical equipment; electrotechnical installations.*

Class 45: *Monitoring of burglar and security alarms; rental and leasing of alarms; surveillance and security services; security consultancy services; responding to and verifying alarms that have been triggered; security services*

for the protection of property and individuals, rental of fire alarms and fire extinguishers.

2. On 2 December 2020, the application was opposed by MG Contractors ApS ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the Applicant's goods and services in classes 1, 6, 9, 10, 37 and 45. The Opponent relies on the following earlier trade mark registration for its section 5(2)(b) ground:

EUTM 018010080¹

Safety Bull

Filing date: 16 Jan 2019; Date registration completed: 29 May 2019

Relying on its registered goods in class 9:

Safety apparatus [for the prevention of accident or injury]; Safety equipment for roofing.

3. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) and its opposition is directed against all of the goods and services of the application.
4. The Applicant filed a defence and counterstatement, denying the grounds.
5. Written submissions have been filed by the Opponent only.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

6. The Opponent is represented by Wynne-Jones IP Limited' the Applicant is represented by Harrison Clark Rickerbys Limited.
7. The only comments from the parties available to me are therefore those within the Opponent's Notice of Opposition and Grounds, the Opponent's written submissions and the Applicant's Defence and Counterstatement.

Preliminary issues

8. The Applicant makes the following comments at paragraphs [6] and [7] of its counterstatement:

The Applicant has used a bull's head motif and the word "BULL", as part of its branding since 2006. The Applicant is proud to be based in Herefordshire and the use of the bull motif is because the Herefordshire Bull is synonymous with this county.

The Opponent has not shown how they use the Registration.

9. The reasoning behind a party's choice of mark is irrelevant to the Tribunal's assessment of whether there is a likelihood of confusion under s5(2)(b) of the Act in this case. I must consider the respective marks 'at face value'; I am unable to take into account the rationale behind a mark's creation or design.
10. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the publication date of the applied-for mark, the opponent may be required to prove use of the earlier mark. In the instant case, Section 6A is not engaged because the registration date of the earlier mark, i.e. 29 May 2019, is less than 5 years prior to the publication date of the applied-for mark, i.e. 16 August 2019. Therefore, the Opponent is entitled to rely upon its mark in respect of the full width of the terms identified in its statement of use.
11. Consequently, the Opponent is not required to provide evidence as to how it uses its mark. My assessment must therefore only consider the 'notional' use of the respective marks.

12. The concept of 'notional use' was addressed in *Compass Publishing BV v Compass Logistics* [2004] R.P.C. 41 per Laddie J.:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market-place but no confusion has been caused, then there cannot exist a likelihood of confusion under Art.9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market-place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

13. In my assessment, I must therefore consider all of the possible circumstances in which the respective marks *might* be used. My assessment must take into account only the specifications as they appear on the registration, in the case of the Opponent; and on the application for registration, in the case of the Applicant.

14. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(b) of the Act and related case law

15. Section 5(2)(b) of the Act states:

“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.”

16. The following principles are derived from the decisions of the Court of Justice of the European Union (“CJEU”)² 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 C120/04; *Shake 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;

² Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of goods and services

17. Similarity of goods and services – Nice Classification

Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

18. I must therefore be mindful of the fact that inclusion within the same class is not enough to guarantee similarity between the goods; and, conversely, the appearance of the respective goods or services in different classes is not a sufficient condition for dissimilarity between those goods or services.

19. I must also bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

“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”.

20. The Tribunal may group goods (or services) together for the purposes of assessment:

Separode Trade Mark BL O-399-10 (AP):

“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.”

21. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

“[23] “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”.

22. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281³, identified the following factors for assessing similarity of the respective goods and services:

- (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.

23. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁴

24. 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 [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

⁴ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

“...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”.

25. In *Sanco SA v OHIM*, Case T-249/11, the General Court 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.”

26. The goods and services to be compared are thus:

Opponent’s mark:

Applied-for mark:

Class 9

Safety apparatus [for the prevention of accident or injury]; Safety equipment for roofing.

Class 1

Fireproofing preparations; fire extinguishing compositions.

Class 6

Turnstiles of metal; building materials of metal; transportable buildings of metal; safes [metal or non-metal]; strongboxes [metal or non-metal]; metal cupboards; metal containers.

Class 9

Alarm systems; alarm panels; alarm sensors; alarm installations; fire break glass units; fire detecting apparatus; fire detection apparatus; fire detectors; fire protection apparatus; fire extinguishers; lifesaving apparatus and equipment; security alarms; security alarm systems; keypads for security and fire alarms; control panels for security and fire alarms; security sensors; motion, proximity, fire, heat, smoke, distance, and alarm sensors; smoke detectors; carbon monoxide detectors; first-aid alert alarms; cameras; security cameras; temporary alarms and alarm systems; portable alarms and alarm systems; radios; radio apparatus; radio transmitters; radio transceivers; alarm units and systems with built in radios.

Class 10

First aid medical apparatus for sale in kit form; surgical and medical

*apparatus and instruments,
orthopaedic articles.*

Class 37

*Installation, maintenance, servicing,
repair and removal of security
apparatus; repair of electrical
equipment; electrotechnical
installations.*

Class 45

*Monitoring of burglar and security
alarms; rental and leasing of alarms;
surveillance and security services;
security consultancy services;
responding to and verifying alarms
that have been triggered; security
services for the protection of property
and individuals, rental of fire alarms
and fire extinguishers.*

27. I will make my comparison with reference to the Applicant's goods and services, all of which have been opposed.

Class 1

Fireproofing preparations; fire extinguishing compositions.

28. The Opponent's class 9 term *Safety apparatus [for the prevention of accident or injury]* covers a vast array of apparatus. Examples include: fire-extinguishing apparatus; breathing apparatus; protective headgear; gauges for detecting and measuring various hazards, to name but a few.

29. *Fireproofing preparations; fire extinguishing compositions*, on the other hand, are *substances* whose function is to prevent or extinguish fires. *Fireproofing preparations* include fireproof coatings which are applied to structures; and flame-retardant granules to absorb flammable liquids after spillages. These goods function to prevent fires from occurring. *Fire extinguishing compositions* are the chemical agents used in fire extinguishers. They function to extinguish fires.
30. Both the Opponent's *Safety apparatus [for the prevention of accident or injury]* and the above class 1 goods have the common aim of preventing harm to the person by accident or injury.
31. I consider that the end-users of *fire extinguishing compositions* will include members of both the general and professional public. Most public places and workplaces will be equipped with fire extinguishers; many members of the general public will have a fire extinguisher in their homes, particularly in kitchen areas or in garages. The users of those fire extinguishers will necessarily be the users of the extinguishing compositions contained within them. However, in my view, *fire extinguishing compositions* would, in the majority of cases, be *purchased* by members of the professional public. When fire extinguishers are purchased, they are usually already filled with the chemical agent needed for them to function. Most purchases of these goods will therefore be made by businesses selling/providing and/or maintaining fire extinguishers. In my view, it would be unusual for a member of the general public to purchase these goods.
32. *Fireproofing preparations* will be used in both residential and business, or other non-domestic, premises. Both the professional and general public would use these. Many users of fire-proof coatings, for instance, would be specialists or the professional public, e.g. providers of services in relation to construction and building maintenance. However, some members of the general public would also purchase these for DIY tasks/home improvement projects. On the other hand, products such as flame-retardant granules to absorb flammable liquids would, in my view, almost always be purchased by specialists i.e. industrial laboratories; companies providing chemical spillage clean-ups; or the Fire Brigade.

33. The Opponent's *Safety apparatus [for the prevention of accident or injury]* would be used largely by the professional public, with a smaller proportion of users from the general public. Purchasers of the respective goods would therefore include both the professional and general public.
34. The physical nature of the goods is very different. The Applicant's goods are substances rather than apparatus. Substances tend to be 'consumables' which deplete with use; they are, by their nature, capable of being divided into smaller quantities; and they will need to be housed in some form of receptacle. Apparatus, on the other hand, refers to items whose integrity subsists through use (though the items, or parts of them, may eventually perish).
35. The Opponent's goods would be purchased via websites and from physical premises. The nature of the Applicant's goods, in my view, is such that, in most cases, they would be purchased via websites. However, given my finding that the Opponent's class 9 specification will include fire extinguishing apparatus, I consider that fire safety-related consumables will likely be sold alongside them. In my view, the Applicant's goods will, in some instances, be purchased by placing an order while visiting a physical shop in which safety apparatus is also on sale. There is therefore an overlap in trade channels.
36. The respective goods will, in many cases, be self-selected to the extent that they are purchased from a website. Where the respective goods are purchased from the same physical premises, whether or not the goods can be self-selected would, in the case of the Opponent's goods, depend on the size of the piece of safety apparatus. Large and unwieldy items would be supplied on request and, depending on how specialised a product, may have to be ordered. The Applicant's goods, in my view, are less likely to be found on a shelf or on display on the shop floor. They are most likely to be supplied on request or ordered, particularly where large quantities are purchased. However, I consider that the availability of the Applicant's goods would nevertheless be displayed visually by way of posters or adverts within the premises, and that these would be displayed in the same section as certain goods under the Opponent's term *Safety apparatus [for the prevention of accident or injury]*.

37. I do not consider the respective goods to be interchangeable. If a consumer were seeking to purchase a *fireproofing preparation* or *fire extinguishing composition*, they would not, in my view, consider an item of fire safety *apparatus* to be an alternative. Consequently, there is no competitive relationship between the respective goods.

38. As noted above, at [31], the Applicant's *fire extinguishing compositions* will include the chemical agents used in fire extinguishers, without which they would not function. Fire extinguishers will fall within the Opponent's *safety apparatus [for the prevention of accident or injury]*. *Fireproofing preparations* include preparations applied to surfaces to render those surfaces fireproof; and substances capable of absorbing flammable liquids or gases due to spillages or leakages. Some of these goods will be complementary to apparatus, used by professionals whose business is to clean chemical spillages, to apply/direct the fireproofing substance to the site of the hazard. I therefore find complementarity between the respective goods.

39. I therefore find that the respective goods are similar to at least a medium degree.

Class 6

Turnstiles of metal; building materials of metal; transportable buildings of metal; safes [metal or non-metal]; strongboxes [metal or non-metal]; metal cupboards; metal containers.

40. *Turnstiles of metal* are mechanical structures which control the physical access of persons or livestock to certain premises or areas. The purpose of these goods is to ensure that any persons or animals in an area, or on a premises, have, in the case of persons, made the necessary payment, or been granted the necessary permission; or, in the case of animals, been authorised to be there.

41. The uses of the Opponent's *safety apparatus [for the prevention of accident or injury]* are different. Although metal turnstiles can have a role to play in safety,

e.g. to limit admission and therefore prevent certain areas from becoming overcrowded, I consider that their primary purpose is to promote commercial or operational efficiency, e.g. corralling cattle; ensuring tickets are purchased or admission fees paid.

42. I consider that the purchasers of metal turnstiles will be the professional public.

43. The nature of the respective goods is similar only to the broad extent that both are apparatus i.e. equipment or machinery for a particular activity or purpose.

44. The Applicant has, at paragraph [12] of its counterstatement, conceded that there is a 'very low' similarity between its goods and services and the Opponent's goods:

The Opponent relies on its class 9 goods but opposes all of the Applicants goods and services. Schedule 1 sets out the Applicant's Opposed Goods and Services and the Opponent's Goods. As can be seen the Applicant's Opposed Goods and Services do not cover 'Safety equipment for roofing' and focus on security products rather than apparatus for safety. The Applicant therefore submits that the Applicant's Opposed Goods and Services are only similar to the Opponent's Goods to a very low degree.

I note, however, that at paragraph [14] of its counterstatement, it states that there is 'low similarity':

The Opponent suggests the interdependence principle should be considered in this Opposition, however the Applicant submits that, as there is low similarity between the Applicant's Opposed Goods and Services and the Opponent's Goods, and very low similarity between the Application and the Registration, this principle has no bearing on this Opposition.

45. I therefore find that there is a low degree of similarity between *Turnstiles of metal and safety apparatus [for the prevention of accident or injury]*.

46. *Building materials of metal* are, self-evidently, materials used in construction; the materials themselves will be incorporated into the structure being built. In my view, there is no overlap in use between these goods and the Opponent's safety apparatus. However, there will be an overlap in *user*; both the professional and general public would use these materials, albeit the greater proportion will be professionals e.g. construction workers.

47. The physical nature of the goods is very different; 'building materials' are 'consumables' to the extent that the materials themselves become part of the

building under construction; whereas safety apparatus comprises discrete items capable of repeated use.

48. In my view, there will be some shared trade channels; both *building materials of metal* and products under the term *safety apparatus [for the prevention of accident or injury]* will be sold in the same retail premises e.g. builders' merchants.

49. The respective goods are not substitutable and not, therefore, in a competitive relationship. There is, however, complementarity because construction workers will use safety apparatus routinely at work; many members of the general public would also use some form of safety equipment while doing certain DIY tasks.

50. As noted above, at [44], the Applicant has conceded that there is a low similarity between its goods and services and the Opponent's goods:

51. **I therefore find that there is no more than a low degree of similarity between *building materials of metal* and *safety apparatus [for the prevention of accident or injury]*.**

52. *Transportable buildings of metal* will include sheds, garages and feedstores, to name but a few. I consider that most of these goods will be used as storage facilities or workspaces. Some will be used to provide shelter for horses or agricultural livestock. The purposes of these goods are vastly different to those of the Opponent's 'safety apparatus'.

53. The users of the respective goods will be the same i.e. members of both the professional and general public.

54. *Transportable buildings of metal* and 'safety apparatus' are different in terms of their physical nature. Pieces of safety apparatus are, generally, likely to be smaller than transportable metal buildings and more likely to be moved around. Although 'transportable' buildings can be moved to the extent that they can be dismantled and reassembled elsewhere, or even moved 'whole' by a lorry, they are intended to remain static for prolonged periods of time.

55. In my view, *transportable buildings of metal* would, in most cases, be sold by specialist companies dealing only with those products; in some cases, both *transportable buildings of metal* and 'safety apparatus' might be purchased from the same retailer e.g. a builders' merchant.
56. I do not consider the respective goods to be either competitive or complementary.
57. As noted above, at [44], the Applicant has conceded that there is a low similarity between its goods and services and the Opponent's goods.
- 58. I therefore find that there is a low level of similarity between *transportable buildings of metal* and *safety apparatus [for the prevention of accident or injury]*.**
59. I group the following of the Applicant's class 6 goods together: *safes [metal or non-metal]*; *strongboxes [metal or non-metal]*. These items are used to keep valuable items and confidential documents secure. While the Opponent's *safety apparatus [for the prevention of accident or injury]* relates to *personal* safety, *safes [metal or non-metal]* and *strongboxes [metal or non-metal]* relate to keeping *property* secure.
60. However, I acknowledge that the Applicant's specification will include 'gun safes' used to keep firearms and ammunition locked away. The principal purpose of a gun cabinet is safety. Consequently, I find that there will be an overlap in purpose between 'safety apparatus' and *some* items included under the terms *safes [metal or non-metal]* and *strongboxes [metal or non-metal]*.
61. I consider that the users of the respective goods will be the same i.e. both the professional and general public. I consider the *nature* of the respective goods to be similar only to the broad extent that both include equipment or machinery for a particular activity or purpose.
62. The respective goods will not, in my view, share the same trade channels. I do not consider there to be any competitive relationship or complementarity between them.

63. I therefore find that there is no more than a low degree of similarity between ***safes [metal or non-metal]; strongboxes [metal or non-metal] and safety apparatus [for the prevention of accident or injury].***

64. I group the following of the Applicant's class 6 goods together: *metal cupboards; metal containers*. Both terms relate to storage receptacles. The purposes of these goods are very different to those of the Opponent's 'safety apparatus'. The Applicant's terms will include shipping containers, storage bins for animal feed, receptacles for human foodstuffs, skips for building waste, to give but a few examples.

65. The users of the respective goods will be the same i.e. members of both the professional and general public.

66. The physical nature of the respective goods is different: many goods included in the term 'safety apparatus' will be machines, of one kind or another, or will function by virtue of moving parts; whereas *metal cupboards* and *metal containers* can fulfil their function as static objects. I consider that waste skips, which fall under the Applicant's term *metal containers* will be purchased from builders' merchants where many goods under the term 'safety apparatus' will also be available for purchase. There is therefore some overlap in trade channels.

67. I do not consider the respective goods to be either competitive or complementary.

68. As noted above, at [44], the Applicant has conceded that there is a low similarity between its goods and services and the Opponent's goods.

69. I therefore find that there is a low degree of similarity between ***metal cupboards; metal containers and safety apparatus [for the prevention of accident or injury].***

Class 9

Alarm systems; alarm panels; alarm sensors; alarm installations; fire break glass units; fire detecting apparatus; fire detection apparatus; fire detectors; fire protection

apparatus; fire extinguishers; lifesaving apparatus and equipment; security alarms; security alarm systems; keypads for security and fire alarms; control panels for security and fire alarms; security sensors; motion, proximity, fire, heat, smoke, distance, and alarm sensors; smoke detectors; carbon monoxide detectors; first-aid alert alarms; cameras; security cameras; temporary alarms and alarm systems; portable alarms and alarm systems; radios; radio apparatus; radio transmitters; radio transceivers; alarm units and systems with built in radios.

70. Applying the *Meric* principle, outlined above at [19], the following terms within the Applicant's class 9 spec are identical: *Alarm systems; alarm panels; alarm sensors; alarm installations; fire break glass units; fire detecting apparatus; fire detection apparatus; fire detectors; fire protection apparatus; fire extinguishers; lifesaving apparatus and equipment; security alarms; security alarm systems; keypads for security and fire alarms; control panels for security and fire alarms; security sensors; motion, proximity, fire, heat, smoke, distance, and alarm sensors; smoke detectors; carbon monoxide detectors; first-aid alert alarms; temporary alarms and alarm systems; portable alarms and alarm systems; alarm units and systems with built in radios*

71. All of the above items are intended to prevent injury or harm to the person. They are therefore included within the Opponent's term *Safety apparatus [for the prevention of accident or injury]*.

72. The Applicant's class 9 goods enumerated above at [70] are therefore identical to *safety apparatus [for the prevention of accident or injury]*.

73. I group the following of the Applicant's class 9 terms together: *cameras; security cameras*. Both terms, self-evidently, relate to cameras. Cameras, in my view, do not have as their primary function 'the prevention of accident or injury'. Consequently, I disagree with the Opponent's submission, at [6.4-6.5] of its written submissions, that these goods are identical with *Safety apparatus [for the prevention of accident or injury]*. I must therefore consider whether the goods are similar, and, if so, to what extent.

74. The purpose of a *camera* is to capture static or moving images. A *security camera* captures images in order to monitor activity in an area or premises for the ultimate purpose of protecting property and/or persons. I find that there is a certain degree of overlap between these goods and the Opponent's *safety apparatus [for the prevention of accident or injury]* to the extent that both *security cameras* and the Opponent's goods are intended to prevent harm.
75. However, the uses of the respective goods also differ in some respects. The Opponent's goods specifically relate to the safety of the *person* by aiming to prevent accident or injury; whereas the Applicant's *security cameras* are aimed at protecting property from theft/damage, or surveilling peopled areas in order to detect and/or prevent crime.
76. I consider that the users of the respective goods will be the same i.e. members of both the professional and general public.
77. I find that there will be a certain degree of overlap between *cameras* and *some* of the goods included in the Opponent's class 9 specification in terms of the physical nature of the goods. E.g. certain pieces of safety apparatus might incorporate cameras or video screens. However, aside from the small number of such specialist items, I do not consider there to be any other great physical similarity between the respective goods.
78. I consider that there will be an overlap in trade channels. It is conceivable that items of 'safety apparatus' could be sold in the same retail outlets as *security cameras*.
79. I do not consider *cameras*, or *security cameras*, to be substitutable for goods included in the term *safety apparatus [for the prevention of accident or injury]*. Consequently, I find that the respective goods are not in a competitive relationship.
80. In my view, there is no complementarity between the respective goods. The average consumer would not consider *cameras*, or *security cameras* to be important or indispensable to *safety apparatus [for the prevention of accident or*

injury]; and nor would it be assumed that the same undertaking would supply both.

81. Consequently, I find that there is a low level of similarity between the Applicant's cameras; security cameras and the Opponent's Safety apparatus [for the prevention of accident or injury].

82. I group the following of the Applicant's class 9 terms together: *radios; radio apparatus; radio transmitters; radio transceivers.*' All of these terms relate to radio apparatus.

83. While the Opponent has submitted, at [6.4] of its written submissions, that 'the goods applied for by the Applicant in class 9 are identical to the Opponent's goods in class 9', it has omitted these particular terms in its list of contested goods at paragraph [6.5] of its submissions. I assume that this has been an oversight on the part of the Opponent because it has indicated in its Statement and Grounds of Opposition that all goods and Services in the Application are being opposed. I must therefore consider whether the goods are similar, and, if so, to what extent.

84. The above terms relate to items whose function is to facilitate communication via the transmission and reception of radio signals. Goods will therefore include: radios for listening to broadcasts (i.e. the 'radios' with which the general public will be most familiar); 'walkie-talkies'; and an array of more specialised equipment. The purpose of these goods is therefore very different from that of the Opponent's *safety apparatus [for the prevention of accident or injury]*.

85. I consider that the users of the respective goods will be the same i.e. members of both the professional and general public.

86. With respect to the physical nature of the goods, radio-related apparatus and 'safety apparatus' are similar only to the broad extent that the respective goods are, or comprise components of, apparatus i.e. equipment or machinery for a particular activity or purpose.

87. I do not consider it likely that these class 9 goods and the Opponent's 'safety apparatus' would share the same trade channels, but it would not be impossible.

88. In my view, the respective goods cannot be said to be substitutable; there is therefore no competitive relationship between them.

89. I do not consider the respective goods to be indispensable to one another; nor do I find that the average consumer would assume that they would be supplied by the same undertaking. Therefore, I do not find complementarity between the respective goods.

90. I therefore find that there is a low level of similarity between the Applicant's class 9 radio-related goods and the Opponent's *Safety apparatus [for the prevention of accident or injury]*.

Class 10

First aid medical apparatus for sale in kit form; surgical and medical apparatus and instruments, orthopaedic articles.

91. The purposes of the respective goods differ to the extent that the Opponent's 'safety apparatus' is intended to *prevent* accident or injury, whereas all of the above class 10 goods are intended to *treat* injuries (or illnesses).

92. The users of *first aid medical apparatus in kit form* will be mainly the professional public e.g. paramedics and first response medical professionals. I do not consider that these particular first aid kits, i.e. those that contain *apparatus*, would be used by members of the general public. My view is reinforced by the fact that class 10, of the Nice classification system, does not include 'medical dressings, for example, plasters, bandages and gauze for dressings'; items that are staple components of the *general* first aid kits used by members of the general public.

93. The users of *surgical and medical apparatus and instruments, orthopaedic articles* will almost always be members of the healthcare professions. However, I

recognise that certain apparatus will be used by patients themselves and/or their carers.

94. I consider the nature of the respective goods to be similar only to the broad extent that the respective specifications involve apparatus i.e. equipment or machinery for a particular activity or purpose.

95. In my view, the respective trade channels will be distinct. Most of the Applicant's class 10 goods will be purchased from suppliers of medical equipment; some items, such as orthopaedic bandages, will also be purchased from pharmacies. Purveyors of these goods will not, in my view, likely supply *safety apparatus [for the prevention of accident or injury]*. I do not consider the respective goods to be either competitive or complementary.

96. As noted above, at [44], the Applicant has conceded that there is a low similarity between its goods and services and the Opponent's goods.

97. I therefore find that there is a low level of similarity between *First aid medical apparatus for sale in kit form; surgical and medical apparatus and instruments, orthopaedic articles and safety apparatus [for the prevention of accident or injury]*.

Class 37

Installation, maintenance, servicing, repair and removal of security apparatus; repair of electrical equipment; electrotechnical installations.

98. The ultimate purpose of services to install, maintain, repair or remove goods is to ensure that the goods work efficiently and safely; or, in the case of removal, to dispense with a broken or dangerous item. The respective purposes of these services and the Opponent's *safety apparatus [for the prevention of accident or injury]* are similar to the extent that both concern safety; albeit the Opponent's goods are *wholly* concerned with safety, whereas, in the case of the above services, safety is one concern among others (e.g. efficiency).

99. I consider that the users of the respective services and goods will be the same i.e. both the professional and general public.

100. Their physical nature will be very different; the services will be received in the form of installation, repair, maintenance etc. carried out by a professional, whereas the Opponent's goods are tangible objects.

101. I find that there will be some overlap in trade channels to the extent that some purveyors of *safety apparatus [for the prevention of accident or injury]* will also provide the above services, perhaps as part of a package when the goods are purchased.

102. I consider the respective goods and services to be in a competitive relationship; a purchaser might deliberate over whether to replace or repair a piece of apparatus.

103. I also find complementarity; all of the above services could be employed in respect of goods falling within the Opponent's term *safety apparatus [for the prevention of accident or injury]* e.g. in a warranty.

104. I therefore find that the level of similarity between the Applicant's class 37 services and the Opponent's *safety apparatus [for the prevention of accident or injury]* is at least medium.

Class 45

Monitoring of burglar and security alarms; rental and leasing of alarms; surveillance and security services; security consultancy services; responding to and verifying alarms that have been triggered; security services for the protection of property and individuals, rental of fire alarms and fire extinguishers.

105. The purpose of these services is the protection of property and persons. There is therefore an overlap in *purpose* with *safety apparatus [for the prevention of accident or injury]*; some of the Opponent's goods will be identical to the *goods provided as part of* some of the Applicant's services e.g. fire extinguishers.

However, the *method* of use will differ; acts of service are provided to the consumer by a professional person; whereas *goods* are tangible objects obtained and used by the purchaser. I find that the users of the respective services and goods will be the same i.e. both the professional and general public.

106. In my view, there will also be overlap in trade channels; the same undertaking might provide both *safety apparatus [for the prevention of accident or injury]* and the option to rent goods within that term. Consequently, there will competition between some of the respective goods and services; e.g. either *purchasing* or *renting* fire alarms will address fire safety in the same way.

107. There will also be complementarity between the respective goods and services to the extent that a provider of services such as rental of fire extinguishers or fire alarms would not be able to offer those services without having the goods 'fire extinguishers' and 'fire alarms'.

108. I therefore find that the level of similarity between the Applicant's class 45 services and the Opponent's *safety apparatus [for the prevention of accident or injury]* is in the medium to high range.

Average consumer and the purchasing act

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

110. In *Hearst Holdings Inc*⁵ Birss J. described the average consumer thus:

⁵ *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).

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

111. The Opponent has submitted the following at paragraph [7.6.3] of its written submissions:

the average consumer will be either a member of the general or professional business public or professional business public only, but the perception to be assessed of those from the general public as they will display a lower degree of attentiveness and will be more prone to be confused;

112. The Applicant has made the following comments at paragraph [13] of its counterstatement:

It is understood that the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind. It is also agreed that the attention of the average consumer is high and that they will pay particular attention to the visual and conceptual aspects of the respective marks and will notice and rely on the differences between these.

113. I consider that the average consumer of the respective goods and services will comprise both the general and professional public. The respective specifications cover goods and services which include both highly specialised products/services only used by experts as well as those used by the general and professional public alike.

114. The goods will, in my view, be purchased either from physical premises or via websites. I consider that more specialised items will be requested orally and, often, will need to be ordered after consultation with the seller to ensure that the item will meet the needs of the purchaser.

115. Where the goods purchased are chemical substances, e.g. *fireproofing preparations*, required in large quantities, these goods would likely be ordered orally either by telephone, or in person at a premises, or via email.
116. I consider that the services would be ordered orally, by telephone or in person at a premises; or via email after viewing information on a website.
117. With the exception of *building materials of metal; transportable buildings of metal; and metal containers*, the respective goods and services would be purchased in relation to safety or security requirements. The average consumer would therefore display prudence when making their purchases. They would consider factors such as the level of safety or security that the good/service provides; whether the good/service is compatible with legal requirements, as well as their individual needs. Many of the goods and services would be purchased only after consultation with professional experts.
118. I find that *building materials of metal; transportable buildings of metal; and metal containers*; would also be purchased with a measure of consideration and caution. The average consumer would consider factors such as strength; durability; the particular type, composition and properties of the metal.
119. Consequently, I find that the respective goods and services will be purchased with a level of attention in the high to very high range. I find this to be the case for both the general and professional purchaser.

Comparison of the marks

Safety Bull	
Opponent's (earlier) mark	Applicant's (contested) mark

120. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C 591/12P, *Bimbo SA v OHIM*, that:

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

121. 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.

122. The Opponent has made the following points in paragraphs [3.14] – [3.28] of its written submissions:

- That the distinctive and dominant element of the earlier mark is 'BULL' [3.14];
- That the respective marks are visually similar to a high degree [3.23];
- That the 'Securing your safety' element of the Applicant's mark is 'of minimal value' in an aural comparison of the marks [3.24]; and
- That the marks are conceptually similar to a high degree [3.28];

123. The Applicant has made the following comments at paragraphs [9] – [11] of its counterstatement:

- That the respective marks are visually dissimilar [9];
- That the bull device and the 'BULL' word element 'are the features a consumer will notice first and remember' [9];
- That the respective marks are aurally dissimilar [10]; and
- That the respective marks are conceptually dissimilar [11].

124. The Opponent's mark comprises two word components, 'Safety Bull', in a plain font, with the first letter of each word in upper case. The overall impression of the mark resides in the two-word mark in its entirety.

125. The Applicant's mark comprises several elements. At the top of the mark is a device depicting a bull, which might be described as being in the style of a 'minimalist' line drawing. The device occupies about a third of the mark. Below the device is the word 'BULL', in a plain font with all letters in upper case. Below the word 'BULL' are the words 'securing your safety', in a stylised font which might be described as 'handwriting', with all letters in lower case. The device and both word elements are rendered in white against a red background. The 'BULL' element is heavily emboldened relative to the device and 'securing your safety' element; and the lettering in 'BULL' is significantly larger than the lettering in 'securing your safety'. The overall impression resides in the entirety of the mark, with the 'BULL' word element having visual dominance over the other elements of the mark.

126. Visual comparison

The fact that the words 'safety' and 'bull' are wholly incorporated into the Applicant's mark is uncontroversial. Whereas in the Opponent's mark, neither 'Safety' nor 'Bull' has visual dominance over the other, the word 'BULL' in the Applicant's mark is the most visually striking element. Although the bull device occupies more of the mark than 'BULL', the minimalist 'sketch-like' style in which the device is presented, compared to the heavily emboldened lettering of 'BULL', causes the eye to be drawn to the 'BULL' element first.

127. The 'securing your safety' element of the Applicant's mark will have a much weaker visual impact due to the small size of the lettering relative to the 'BULL' element directly above it. The heavily emboldened 'BULL' in large upper case lettering, as compared to the small stylised lower case lettering of 'securing your safety', will result in these word elements being perceived visually as two separate units within the mark.

128. Although the device and 'securing your safety' elements will have less visual prominence than 'BULL', the presence of those weaker visual elements will nevertheless be discerned by the eye of the average consumer. The fact that the earlier mark comprises two words, whereas the Applicant's mark contains four words, is a visual difference that will not, in my view, be overlooked. Although the word 'safety' is present in both marks, in my view, it plays a less prominent role in the Applicant's mark. Whereas the 'Safety' element of the Opponent's mark would be articulated as part of the brand name, the 'securing your safety' element, in the Applicant's mark, would likely be perceived as a laudatory statement about the brand, or a strap-line.

129. Consequently, I find that there is a low-medium level of visual similarity between the respective marks.

130. Aural comparison

The Opponent's mark will be articulated as 'safe-tee-bull', with the emphasis on the first syllable. The Applicant's mark, in my view, will be articulated as 'BULL'. I

do not consider that the words 'securing your safety' will be articulated by the average consumer. The *visual* perception of 'BULL' and 'securing your safety' as two separate word elements, with 'BULL' having greater prominence, will, to my mind, mean that, *aurally* speaking, the focus will be on 'BULL'.

131. There is a measure of aural similarity between the respective marks to the extent that the most prominent word element of the Applicant's mark, i.e. 'BULL', is aurally identical to the second word of the Opponent's mark. On the other hand, the difference in the lengths of the respective marks, i.e. the earlier mark's 3 syllables as compared to the contested mark's 1 syllable (if 'securing your safety' is not articulated) will be discerned aurally.

132. I therefore find that, if 'securing your safety' is not articulated, the degree of aural similarity between the marks is no more than medium. If 'securing your safety' is articulated (which is unlikely), the marks will be aurally similar to a low degree.

133. Conceptual comparison

Dealing with the Opponent's mark first, both 'safety' and 'bull' are commonly used English words with which the average consumer will be very familiar. 'Safety' entails protection from harm; 'Bull' refers to an uncastrated male bovine animal. In my view, 'Safety Bull' as a mark for *safety apparatus [for the prevention of accident or injury]* would, for the average consumer, invoke the idea of strong and robust equipment to protect the person from harm. The literal construction of the two words would be the notion of a bull that has protective or safeguarding qualities.

134. The Applicant's mark includes a device and two word elements. The 'BULL' element would be understood to have the meaning underlined above, at [133]; the device depicting a bull, therefore, expresses the same concept. The less prominent word element 'securing your safety', as part of a mark for the goods and services in respect of which registration is sought would be understood as conveying the idea of strong and robust equipment or materials to protect both

persons and property from harm. Both marks therefore contain the concept of safety.

135. Consequently, I find that the level of conceptual similarity between the respective marks is medium-high.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

137. I find that the first word of the earlier mark, i.e. 'Safety', is descriptive of the goods in respect of which the mark is registered. The word 'Bull', on the other hand, neither describes nor alludes to the goods; it is therefore an unusual choice of word to include in a mark to identify a purveyor of safety apparatus. 'Bull' is therefore the distinctive element of the mark. In my view, the pairing of the words with 'Safety' positioned before 'Bull', rather than the other way around e.g. 'Bull Safety', is also rather unexpected. Even though the mark includes the word 'Safety', which is descriptive of the goods being sold under the mark, I consider the *order in which the words appear* to be fairly unusual. I conclude that the earlier mark is inherently distinctive to at least a medium degree.

Likelihood of confusion

138. Confusion can be direct or indirect. Mr Ian Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*⁶. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*⁷, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a 'sub brand', for instance.

139. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [16].

⁶ Case BL O/375/10 at [16].

⁷ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

140. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

141. My comparison of the respective goods and services has determined that:

- There is a **medium degree of similarity** between the Applicant's **class 1** goods and the Opponent's goods;

- There is no **more than a low degree of similarity** between the Applicant's **class 6** goods and the Opponent's goods:

Turnstiles of metal; transportable buildings of metal; metal cupboards; metal containers; building materials of metal; safes [metal or non-metals]; strongboxes [metal or non-metal];

- The following of the Applicant's **class 9** goods are **identical** to the Opponent's goods:

Alarm systems; alarm panels; alarm sensors; alarm installations; fire break glass units; fire detecting apparatus; fire detection apparatus; fire detectors; fire protection apparatus; fire extinguishers; lifesaving apparatus and equipment; security alarms; security alarm systems; keypads for security and fire alarms; control panels for security and fire alarms; security sensors; motion, proximity, fire, heat, smoke, distance, and alarm sensors; smoke detectors; carbon monoxide detectors; first-aid alert alarms; temporary alarms and alarm systems; portable alarms and alarm systems; alarm units and systems with built in radios;

- There is a **low degree of similarity** between the following of the Applicant's **class 9** goods and the Opponent's goods:

cameras; security cameras; radios; radio apparatus; radio transmitters; radio transceivers;

- There is a **low degree of similarity** between the Applicant's **class 10** goods and the Opponent's goods;
- There is **at least a medium degree of similarity** between the Applicant's **class 37** services and the Opponent's goods;
- There is a **medium-high level of similarity** between the Applicant's **class 45** services and the Opponent's goods.

142. My comparison of the marks has determined that:

- There is a low to medium level of visual similarity between the marks;
- There is no more than a medium level of aural similarity between the marks if 'securing your safety' is not articulated; if that element *is* articulated, then aural similarity will be low;
- The level of conceptual similarity between the marks is medium-high.

143. In *New Look Limited v OHIM*⁸ the General Court stated that:

"49. ...it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market..."

⁸ Joined cases T-117/03 to T-119/03 and T-171/03.

144. In *Quelle AG v OHIM*⁹, the General Court held that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs.”

145. Although the above-mentioned GC decision concerns *goods*, I consider the general principle to be apposite to the Applicant's *services* also. The way in which the goods and services are purchased will vary, as noted above at [114]-[116]. However, in each case the visual aspect of the marks will play a more prominent role because the selection of, or decision to purchase, the goods or services will usually be made after visual exposure to the mark either by way of information on a website, or after seeing the products in a shop. Where a purchase is not concluded until the purchaser's needs have been discussed/professional advice sought/recommendation made etc., the purchaser will have encountered the mark on websites, adverts or the shop façade. I consider that the weight to be accorded to the aural similarity of the marks is therefore diminished.

146. I have found that the Opponent's mark is inherently distinctive to at least a medium degree. The CJEU held in *Sabel*¹⁰ that:

“24. The more distinctive the earlier mark, the greater will be the likelihood of confusion.”

147. This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited*¹¹:

⁹ Case T-88/05.

¹⁰ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

¹¹ BL O-075-13.

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

148. In my view, the visual differences between the marks, together with my finding at [145] concerning the weight to be accorded to the visual comparison, are sufficient to rule out the likelihood of direct confusion. I find this to be the case even in respect of the identical goods. As noted above, at [117], the nature of the goods and services is such that the purchaser, professional and general public alike, will display a high level of attention when making their purchase.

149. However, the following observations lead me to conclude that there is a likelihood of *indirect* confusion in respect of all of the goods and services applied for:

- There is similarity, albeit in varying degrees, between *all* of the Applicant's goods and services, and the Opponent's goods.
- The level of conceptual similarity between the marks is medium-high.
- The distinctive element of the earlier mark, i.e. 'Bull', forms the dominant and distinctive element of the Applicant's mark. Both marks also contain the concept of 'safety'. The word element 'securing your safety' has less visual impact by virtue of its smaller lettering in contrast to the heavily emboldened 'BULL' element above it. The 'securing your safety' element is, in my view, likely to be perceived as a laudatory statement about the goods and services, rather than as part of the brand name. Although the word 'safety' is not distinctive in either mark, its presence in the Applicant's

mark, combined with the distinctive word 'BULL', would, in my view, give rise to a likelihood of indirect confusion.

- In *Whyte and Mackay*¹² it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. In the instant case, the Applicant's mark 'Bull' has retained its independent distinctive role leading the average consumer to presume that 'BULL' is related to the brand 'Safety Bull'.
- In my view, the culmination of these factors will result in the average consumer discerning the visual differences between the respective marks but concluding that the marks relate to economically-linked undertakings.
- I find that this is the case in respect of all of the Applicant's goods and services, even though the goods and services will be purchased with a high level of care.

Final Remarks

150. The Opposition has succeeded in full. The Application is refused in its entirety.

COSTS

151. I award the Opponent the sum of **£600** as contribution towards its costs, calculated as follows¹³.

Preparation of statement and consideration of the Applicant's statement:	£200
Official fee for 5(2)(b) only:	£100

¹² *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

¹³ Based upon the scale published in Tribunal Practice Notice 2/2016.

Written Submissions

£300

Total:

£600

152.I therefore order DWS Group Limited to pay to MG Contractors ApS the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of February 2021

Mx N. R. Morris

For the Registrar,

the Comptroller-General