

O/0588/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3812605
IN THE NAME OF ECOSSE MAF CO LTD
TO REGISTER THE FOLLOWING TRADE MARK:

MONOCRYSTAL

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 436823
BY AKTSIONERNOE OBSHCHESTVO "MONOCRYSTAL"

Background and pleadings

1. On 23 July 2022, Ecosse Maf Co Ltd (“the applicant”) applied to register the trade mark **MONOCRYSTAL** in the UK, under number 3812605 (“the applicant’s mark”). Registration is sought for *audio cables* in class 9. Details of the application were published for opposition purposes on 12 August 2022.

2. On 11 October 2022, Aktsionernoe obshchestvo "Monocrystal" (“the opponent”) opposed the applicant’s mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies upon its UK trade mark number 801407244,² which is displayed below.



(“the opponent’s mark”)

3. The opponent’s mark was filed on 24 October 2017 and became registered on 20 November 2018. It stands registered for goods in classes 1 and 6. For the purposes of its claim, the opponent only relies upon some of those in class 6, namely:³

Class 6: Aluminium; iron, unwrought or semi-wrought; brass, unwrought or semi-wrought; copper, unwrought or semi-wrought; common metals, unwrought or semi-wrought; pyrophoric metals; metals in powder form; nickel silver; nickel; tin; gold solder; silver solder; aluminium wire; wire of common metal; wire of common metal alloys, except fuse wire; copper wire, not

¹ I note that the opposition was also originally based upon section 5(3) of the Act. However, this ground was withdrawn by the opponent in its written submissions dated 7 March 2023.

² The opponent’s mark is a comparable trade mark based upon pre-existing International Registration designating the EU number 1407244. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the EU, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

³ I note that, when the proceedings commenced, the opponent’s mark was also registered for goods in class 9. However, by decision dated 3 October 2023, the registration was declared invalid in respect of those goods. Therefore, they may not be relied upon for the purposes of these proceedings.

insulated; soldering wire of metal; silver-plated tin alloys; alloys of common metal; aluminium foil; chromium.

4. The opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the applicant's mark, it is not subject to the use requirements in section 6A of the Act.

5. In its statement of grounds, the opponent contends that the parties' marks and goods are highly similar, resulting in a likelihood of confusion, including the likelihood of association.

6. The applicant filed a counterstatement, denying the ground of opposition.

7. Both parties are professionally represented; the opponent by London IP Limited and the applicant by Cloch Solicitors. Only the opponent filed evidence. No hearing was requested and neither party filed written submissions in lieu of attendance, though I note that the opponent filed written submissions during the evidence rounds. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

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

Evidence and submissions

9. The opponent's evidence is given in the witness statement of Louisa Fielding, dated 6 March 2023, and five annexes (LF1-LF5). Ms Fielding is a Trade Mark Attorney with the opponent's representatives. Her evidence goes to an alleged overlap between the parties' goods.

10. Ms Fielding's statement was accompanied by written submissions dated 7 March 2023.

11. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

Section 5(2)(b) – legislation and case law

12. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

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

13. 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 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

14. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
Class 6: Aluminium; iron, unwrought or semi-wrought; brass, unwrought or semi-wrought; copper, unwrought or semi-wrought; common metals, unwrought or semi-wrought; pyrophoric metals; metals in powder form; nickel silver; nickel; tin; gold solder; silver solder; aluminium wire; wire of common metal; wire of common metal alloys, except fuse wire; copper wire, not insulated; soldering wire of metal; silver-plated tin alloys; alloys of common metal; aluminium foil; chromium.	Class 9: Audio cables.

15. I note that Ms Fielding provides evidence from Wikipedia, as well as Google search results for the terms "copper audio cable" and "silver audio cable" (Annexes LF3-LF5).

However, these documents are of little probative value. This is because, as far as I understand it, Wikipedia is a community-based encyclopaedia that any user can contribute to or edit. This means that the content may be unverified. As for the Google search results, it is my understanding that internet searches use algorithms which become tailored to a user based upon their search history. Search results will also vary over time and are dependent upon who is doing the search.

16. The printouts in Annex LF1 to Ms Fielding's statement suggest that *audio cables* transmit audible signals between an audio source and an output; they contain wires which facilitate the passage of electric current through the cable. Further, they are designed to minimise noise/interference that can impair sound quality. The article contained in Annex LF2 suggests that speaker wire is a common type of audio cable; it is typically made from copper and used to connect a stereo with speakers.

17. On this basis, the opponent argues that its *wire of common metal; wire of common metal alloys; copper wire* are, therefore, identical to the applicant's *audio cables*. I disagree. Although they contain metal wires, the applicant's goods are finished articles for connecting an audio source with an output, not merely metal wires. Other items, such as connectors, also form typical parts of audio cables. In the alternative, the opponent argues that the respective goods are highly similar.

18. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, [...] 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".

19. Furthermore, the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods and services also include an assessment as to their users and channels of trade.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that “complementary” means:

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

21. It is also worth noting that the mere fact that a particular good is used as a part or component of another does not suffice, in itself, to show that the finished goods containing those parts or components are similar; this is because their nature, intended purpose and users may be completely different.⁴

22. The evidence shows that a particular type of audio cable used for speakers consists of, *inter alia*, lengths of unshielded copper wire. Therefore, there is a degree of overlap in nature between the respective goods. However, I bear in mind that audio cables are finished products, whereas metal wires are ordinarily used as parts or components of other goods. Moreover, there is a degree of overlap in intended purpose insofar as the respective goods facilitate the passage of electric current. However, such an overlap is at a very high level of generality. The core purpose of an audio cable is to transmit audio signals so that, for example, music being played by a stereo can be heard through speakers. The goods do not share a method of use; it is unlikely that metal wire would be connected to a speaker in the same way as a finished audio cable would. Users may overlap on a very general level. There is no compelling evidence that metal wires and audio cables reach the market through shared trade channels. In the absence of such evidence, it is my view that the typical channels of trade for the respective goods are different. Metal wire is likely to be found in hardware and DIY stores, whilst audio cables (i.e. the finished goods) will be sold by electronics stores. Even though wires and audio cables both facilitate the passage of electric

⁴ *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61

current, I do not consider there to be any material competition between them; it is unlikely that a consumer would purchase metal wire instead of a finished audio cable to connect their stereo to a speaker, or purchase a finished audio cable to complete a task requiring metal wire. Although metal wire can certainly be regarded as important to the use of an audio cable (as a component), I do not consider the respective goods to be complementary. This is because consumers are unlikely to believe that responsibility for them lies with the same undertaking. Balancing all of the above, I do not consider that the general overlaps in nature, purpose and user are sufficient for the purposes of establishing any overall similarity between the respective goods. They are dissimilar.

23. The opponent argues that its other class 6 goods are also highly similar to the applicant's goods. However, I have considered them and conclude that none puts the opponent in a more favourable position. In fact, they appear to be even further away from audio cables than the goods already compared. The only obvious connection between them is that they may be used as parts or components of audio cables. As outlined above, that is not sufficient for establishing similarity on its own.

24. Some degree of similarity between goods is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.⁵ My findings above mean that the opposition must fail.

Conclusion

25. The opposition under section 5(2)(b) of the Act has been unsuccessful. Subject to any appeal against my decision, the applicant's mark will become registered in the UK.

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Costs

26. As the applicant has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.⁶ The applicant filed a counterstatement but did not file any evidence or written submissions. In the circumstances, I award the applicant the sum of **£300** in respect of considering the opponent's statement and preparing a counterstatement.

27. I order Aktsionernoe obshchestvo "Monocrystal" to pay Ecosse Maf Co Ltd the sum of **£300**. This is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 21st day of June 2024

James Hopkins
For the Registrar

⁶ These proceedings having commenced after 1 July 2016 but before 1 February 2023.