

O/0995/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3849434
IN THE NAME OF THREE SMITH GROUP LIMITED
TO REGISTER AS A SERIES OF 2 TRADE MARKS**



IN CLASSES 9, 19 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 439434
BY INVENTIO AG**

BACKGROUND AND PLEADINGS

1. On 15 November 2022, THREE SMITH GROUP LIMITED (“the applicant”) applied to register, as a series of two, the trade marks shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 25 November 2022, in respect of goods and services in classes 9, 19, and 42, as listed in the table under paragraph 16 of this decision.

2. The application is opposed by INVENTIO AG (“the opponent”). The opposition was filed on 27 February 2023 and is based upon section 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon its UK designations of the following two International Registrations (“IRs”):



International Registration No.: WO1633619

International Registration date: 10 August 2021

Priority claimed from CH 767544, with a priority date of 9 April 2021

UK Date of Designation: 10 August 2021

Date protection conferred in the UK: 26 May 2022

Protected for goods in classes 9, 10, 11, 17, 19 and 21

Relying on all goods, as listed either in the table under paragraph 16 or in Annex A of this decision.²

(The ‘619 mark); and

¹ The grounds under section 5(3) as originally filed were withdrawn by the opponent in a letter to the Registry dated 11 July 2023. The opponent maintains its opposition under section 5(2)(b) only.

² See paragraph 17 of this decision.



International Registration No.: WO1405956

International Registration date: 14 December 2017

UK Date of Designation: 6 March 2019

Date protection conferred in the UK: 27 June 2019

Protected for goods and services in classes 6, 7, 9, 35, 37, 38, 42 and 45

Relying on all goods and services, as listed either in the table under paragraph 16 or in Annex A of this decision.³

(The '956 mark).

3. The above marks qualify as earlier marks under section 6(1) of the Act. As neither trade mark had been protected for more than five years at the date the application was filed, they are not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that because the marks are similar and the goods and services are similar, there exists a likelihood of confusion on the part of the public, and therefore the application should be refused under section 5(2)(b) of the Act.

5. The applicant filed a counterstatement denying the claims and submits that there is no likelihood of confusion. It requests that the opposition be rejected and requests that the application proceed to registration for all goods and services.

6. Only the applicant elected to file evidence, neither party requested a hearing. Both parties filed written submissions in lieu of a hearing, which will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of the papers on file.

³³ See paragraph 17 of this decision.

7. In these proceedings, the opponent is represented by Kilburn & Strode LLP and the applicant is represented by Appleyard Lees IP LLP.

EVIDENCE

8. The applicant filed evidence in support of its defence of the opposition in the form of the witness statement of Rachel Louise Garrod, a Chartered Trade Mark Attorney of the applicant's representatives. The statement is dated 16 October 2023, and is accompanied by eight exhibits, labelled RLG1 to RLG8. The exhibits comprise screenshots from the following:

- The UKIPO website, giving details of each of the opponent's two earlier marks (RLG1 and RLG2) and the application at issue (RLG3);
- The examination report for the contested application which shows that no earlier marks were raised by the examiner (RLG4);
- The UKIPO website giving details of another of the applicant's (registered) trade marks (RLG5);
- The web pages of "Schindler Ltd (UK)", which provides lifts and escalators as well as the installation, repair, maintenance and servicing of lifts and escalators (RLG6). I note that a similar sign to the opponent's mark is shown directly above the word "Schindler" within this exhibit. I also note that at page 13 of 15 of its written submissions in lieu of a hearing, the applicant submits that this exhibit provides details of the opponent's business. However, I find nothing within the exhibit to show any link between **Schindler Ltd (UK)** and the opponent in these proceedings, being **INVENTIO AG**⁴;

⁴ I note that at paragraph 50 of the opponent's written submissions in lieu, it merely states that the exhibit "claims to consist of the Opponent's website which has no bearing on these proceedings given that their marks are not vulnerable to proof of use", but it neither explicitly admits nor denies any link between the two companies. However, at paragraphs 7 and 20 of the same submissions, the opponent refers to the '619 and '956 marks as "the Schindler Device".

- The website of “A-SAFE” (sales@asafe.co.uk), which provides, inter alia, industrial safety barriers (RLG7). I note that a similar sign to the applicant’s mark is shown alongside and to the left of the word “A-SAFE” within this exhibit. Further, at page 13 of 15 of its written submissions in lieu, the applicant submits that this exhibit provides details of the applicant’s business, although the link between “**A-SAFE**” and the “**THREE SMITH GROUP LIMITED**” has not been demonstrated; and
- A search conducted using Google Lens for similar logos to those of the applicant (RLG8). The applicant submits that the opponent’s logo was not revealed by this search.

9. Although the examiner of the contested application did not raise any earlier rights, this in itself is insufficient for a finding of no likelihood of confusion between the marks. Neither is the examination report binding on me in relation to the decision before me. Further, the lack of results from the Google Lens search of its mark conducted by the applicant does not evidence that the average consumer of the goods and services at issue which are found to be similar to those of the opponent will not find the competing marks to be compared as confusingly similar. As such, exhibit RLG8 carries very little weight.

10. I note that in the written submissions in lieu, the applicant submits that exhibits RLG6 and RLG7 show that the nature of the parties’ respective businesses is extremely different. However, even allowing that the exhibits potentially link the relevant goods and services under each of the marks at hand to the parties, I am mindful that I must make an assessment of the degree of similarity between those goods and services based on how they might fairly be used now or in the future: *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, at [59].

11. I find nothing within the evidence which has any real probative value which will assist me in reaching my decision on the likelihood of confusion between the marks at

hand. Accordingly, I consider it unnecessary to make any further reference to the evidence in my decision.

DECISION

12. 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.

Section 5(2)(b)

13. Section 5(2)(b) is relied on and 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”.

14. Section 5A states:

“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.”

15. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("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 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

16. The goods and services to be compared are:

Applicant's goods and services
<p><u>Class 9</u> <i>Safety, security, protection and signalling devices; alarms and warning equipment; navigation, guidance, tracking, targeting and map making devices; measuring, detecting and monitoring instruments, indicators and controllers; sensors and detectors; distance, speed and dimension measuring instruments; safety monitoring apparatus [electric]; safety alarms [other than for vehicles]; safety apparatus and devices [for the prevention of accident or injury]; communication hubs; personal protective goods, namely protective clothing, high visibility safety clothing, protective gloves, protective footwear, protective headwear, safety helmets, protective bonnets, protective eyewear, protective glasses,</i></p>

protective visors, protective face masks and coverings, safety harnesses, protective gowns and protective screens; personal protective equipment, namely protective clothing, high-visibility safety clothing, protective gloves, protective footwear, protective headwear, safety helmets, protective bonnets, protective eyewear, protective glasses, protective visors, protective face masks and coverings, safety harnesses, protective gowns and protective screens; fire extinguishing apparatus; firefighting apparatus; fire detection apparatus; digital signage; directional signage [luminous or mechanical]; parts, components and fittings for any or all of the aforementioned products.

Class 19

Barriers; barrier systems; barriers for airports; fencing; bollards; pedestrian barriers; traffic barriers; car park barriers; pedestrian and traffic guide devices being barrier systems; pedestrian and traffic protection devices being barrier systems; handrails; access gates; non-metallic protective barriers to prevent damage to racks and shelving systems; parts for barriers, fencing and bollards made of plastic; plastic pipes and tubes; parts and fittings for any or all of the aforementioned products made of plastic; all abovementioned goods not of metal; parts, components and fittings for any or all of the aforementioned products.

Class 42

Scientific and technological services in relation to industrial safety; design, research and development services in relation to industrial safety; design engineering services; safety technology services; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

Opponent's goods and services

The '619 mark:

Class 9

Application software for mobile phones, tablets and computers; application software for mobile phones, tablets and computers in connection with the control of elevators, escalators, moving walkways, turnstiles and access control systems; remote control apparatus and instruments; electronic access control systems for elevators, escalators, moving walkways and turnstiles; control panels for elevators; display screens; digital, electric and electronic measuring, checking, controlling and regulating apparatus (included in this class); motion detectors; cameras; mobile telephones; sensors; smartphones and parts thereof (included in this class); protective films adapted for display screens,

smartphones, tablet computers and for control panels for elevators; plastic adhesive protective films for protecting control panels and touch screens from dirt and damage.

Class 19

Handrails; building materials; scaffolding; mouldings for buildings; balustrades; barriers for pedestrian traffic control; doors, gates, turnstiles and barriers; all the aforesaid goods not of metal.

The '956 mark:

Class 9

Electric and electronic measuring, checking, controlling and regulating (included in this class) apparatus for elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, and corresponding computer programs and software stored in memory; electric and electronic control apparatus for elevators with destination call control; electronic controls and corresponding software for monitoring, controlling and regulating the operation of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, as well as building installations and access control systems; electronic controls and corresponding software for monitoring, controlling and regulating the access for boats, buildings, area surrounded by a fence, restricted areas within buildings and boats, elevators, escalators and moving walkways and other vertical, horizontal and inclined transport installations; electronic controls and corresponding software for monitoring, controlling and regulating the guidance and navigation systems; remote monitoring apparatus for monitoring the operation of elevators, escalators and moving walkways and other vertical, horizontal and inclined transport installations, building installations, systems for access control, guidance and navigation, of locking systems, doors, turnstiles, swing gates, barriers and gates; remote monitoring apparatus for monitoring human activity in elevators, boats, buildings and public facilities, particularly video monitors, electric and electronic apparatus for remote monitoring, cameras, sensors, motion sensors, light barriers and infrared sensors; remote control apparatus for the monitoring of the control for elevators, escalators and moving walkways and other vertical, horizontal and inclined transport installations as well as access to elevators, escalators and moving walkways and other vertical, horizontal and inclined transport installations, and access to buildings, boats, areas surrounded by a fence and restricted areas within buildings and boats; remote monitoring apparatus and corresponding software for the control of light; remote control apparatus and corresponding software for controlling heating, ventilation, air-conditioning and fire alarm installations; control panels; level

indicators; floor boards; car operating panels; TFT, LCD, LED, OLED displays, projection displays and plasma displays; computer screens; television screens; touch screens; electronic bulletin boards; computer screens, touch screens, television screens and projection apparatus for interactions with passengers of elevators, escalators and moving walkways; loudspeakers; LED screens; emergency warning lights; horns; electromagnetic signal transmitters; alarms, namely, fire alarms, break-in alarms, burglary alarms, flood alarms, hazard alarms, motion alarms, alarms for emergency calls, abuse alarms and incident alarms; Computer equipment for receiving, recording, transmitting, processing, converting, sending and reproducing voice, audio and video data, drawings, images and signals in connection with the design, installation, maintenance and repair, renovation and modernization of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, systems for access control, guidance and navigation, locking systems, doors, turnstiles, swing gates, barriers and gates; electronic guidance systems for the orientation of users and flow of users; electronic navigation systems, particularly navigation systems based on GPS, on Bluetooth, on WiFi, on mobile data and on radio-communication; electronic access control systems; radio frequency identification systems and components therefor, particularly antennas, memory chips and RFID card readers, for Bluetooth communication and for near field communication (NFC); radio frequency labels and identification cards (RFID); NFC labels and cards; readers for encoded identification cards, encoded key cards, encoded smart cards and encoded labels; coded identification cards; encoded key cards; encoded smart cards; encoded labels; optical code readers; biometric identification apparatus, particularly of the face, voice, iris, fingerprints and hand; mobile telephones; smartphones; clothing computer systems (Wearables) which, during use, are attached to the user body, namely, smartwatches, glasses, clothing or bracelets; goods of augmented reality and virtual reality, namely, 3D spectacles, headphones, audio speakers, digital spectacles, (head mounted displays, HMD) digital gloves, stereoscopic 3D displays, 3D scanners, 3D cameras and 3D microphones; magnetic, optical and digital storage media; tablets; computers; network routers; wireless routers; modems; interfaces (interface apparatus or interface programs for computers); microprocessors; software for creating and managing a database of voice, audio, video and multimedia files, and data for operating, power and users of elevators, escalators, moving walkways, building installations, access control systems, doors, turnstiles, swing gates, barriers and gates; software and application software for searching, playing, displaying and storing voice, audio, video and multimedia files; software for the production of virtual sound; software and application software for monitoring and controlling elevators, escalators, moving walkways and other vertical and horizontal and inclined

transport installations as well as installations for buildings; software and application software for monitoring and controlling alarm, access control, guidance and navigation systems; software and application software for mobile phones, smart phones, smart watches, fitness monitors and tablets for monitoring and controlling elevators, escalators, moving walkways and other vertical and horizontal and inclined transport installations as well as installations for buildings; software and application software for wireless routers and network routers; software and application software for the connection of mobile telephones, smartphones, smart watches, fitness monitors, computer clothing and tablets to building installations, access control, navigation and guidance systems, doors, turnstiles, swing gates, barriers and gates; software and application software for mobile phones, smart phones, smart watches, fitness monitors and tablets in connection with locating in and out of buildings, parts of buildings, public facilities, elevators, escalators, moving walkways and other vertical and horizontal and inclined transport installations; software and application software for mobile phones, smartphones, smart watches fitness monitors and tablets, for guidance and navigation and in and out of buildings, parts of buildings, public facilities, and to elevators, escalators, moving walkways and other vertical and horizontal and inclined transport installations; electric sensors; frequency converters; electrical transformers; photovoltaic solar modules for electricity generation; electricity storage devices; uninterruptible power supply apparatus (apparatus for Uninterruptible Power); surge protection; power distribution devices; current rectifiers; electric current switches; integrated circuits; printed circuits; electric boards; electric control panels; electric safety devices; integrated safety circuits; electric and electronic locks; radio controlled locks; electronic publications, namely, downloadable magazines, material for teaching, training and practice, installation, repair and modernization instructions, manuals, newsletters, brochures and spare parts lists in the field of elevators, escalators, moving walkways and other vertical and horizontal and inclined transport installations, access control, guidance, navigation and safety systems; jigs mainly of metal (measuring instruments).

Class 42

Research and development in the field of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, access control, navigation and guidance systems, locking systems, doors, turnstiles, swing gates, gates, barriers and gates; research and development in the field of safety engineering; research, monitoring and analysis and monitoring of the traffic flow inside, between and outside buildings; development, design and construction of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, monitoring, access control, guidance

and navigation, locking systems, doors, turnstiles, swing gates, barriers and gates; engineering planning and engineering services in the field of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, surveillance systems, access control, guidance and navigation systems, locking systems, doors, turnstiles, swing gates, barriers and gates; carrying out quality control tests and technical tests; energy audits; computer-aided remote maintenance of software, for monitoring and control of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, security, access control, guidance and navigation systems, locking systems, doors, turnstiles, swing gates, barriers and gates as well as building elements and components as parts thereof; remote monitoring of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, security systems, access control, guidance and navigation systems, locking systems, doors, turnstiles, swing gates, barriers and gates via communication link by means of computer systems for monitoring the operating condition of the aforesaid goods; diagnosis, particularly remote diagnosis relating to a need for maintenance as well as to malfunction of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, security systems, access control, guidance and navigation systems, locking systems, doors, turnstiles, swing gates, barriers and gates via communication link using computer systems for detecting incidents; analysis and evaluation of operating data for elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, security systems, access control, guidance and navigation systems, locking systems, doors, turnstiles, swing gates, barriers and gates; analysis and monitoring of telecommunication signals; programming, development, installation, updating and maintenance of software and application software as well as consulting services relating thereto; design and development of virtual reality and augmented reality software; programming of software for Internet platforms; providing of Internet platforms (software); provision of software via computer networks (in particular the Internet) and telecommunication networks; provision of online and offline software via a computer network or a telecommunication link, relating to the use of education and training material, instructions for installation, repair and modernization; provision of online and offline software tools for building, configuration and design of elevators, escalators and moving walkways; temporary online providing of non-downloadable applications for the use of a cloud computing network and for the access to it; SaaS (Software as a Service); design of voice and data communication interfaces (software) for connections to computer data banks and call centers; provision of online and offline software tools for monitoring human

activity in elevators, boats, buildings and public facilities; provision of software for automatically operating of emergency messages via computer networks and telecommunication networks; computer services, namely, design and programming of software for management of user rights in computer networks; computer security services consisting of the issuance and management of digital keys; design and programming of computer software for the authentication of smart cards and the management of user rights and related applications; software rental.

17. In its notice of opposition, the opponent has indicated that it is relying on all of the goods and services protected under each of its earlier marks. There are goods and services within the specifications which do not appear to have any prospect of success under section 5(2)(b). I note that in the written submissions, the opponent has provided a table comparing the applicant's goods and services against goods in classes 9 and 19 only of the earlier '619 mark, and against goods and services in classes 6, 7, 9, 35, 37, 42 and 45 of the '956 mark, although it does not go as far as to say to what degree it considers them similar at this point. The opponent then proceeds to emphasise the similarities between its goods and services in classes 9, 19 and 42 only of the earlier marks. Taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision,⁵ I note the opponent's written submissions and I will proceed to make my own comparison in relation to the specifications in these classes only, as listed in the table above. For completeness, the goods and services protected under the opponent's remaining classes are listed at Annex A at the end of this decision.

18. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

19. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

⁵ BL O/0911/24, at [32].

“23. 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”.

20. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

21. 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 (“GC”) stated that “complementary” means:

“82. ...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”.

22. For the purposes of considering the issue of similarity of the goods and/or services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.⁶

23. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"12. ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in

⁶ Paragraph 5

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."

24. In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms: *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at [56].

25. As per *Separode*, I will approach the comparison of the goods and services at issue by grouping them collectively in as few groups as I consider logical. Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *YouView* and *Skykick* by comparing what I consider to be the core meaning of the goods or services, without affording them neither a too liberal, nor an artificially narrow, interpretation. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

The contested goods in class 9

Safety, security, protection and signalling devices; alarms and warning equipment; safety monitoring apparatus [electric]; safety alarms [other than for vehicles]; safety apparatus and devices [for the prevention of accident or injury]; fire detection apparatus.

26. I consider that the applicant's above goods either encompass or are encompassed by the opponent's "*alarms, namely, fire alarms, break-in alarms, burglary alarms, flood alarms, hazard alarms, motion alarms, alarms for emergency calls, abuse alarms and incident alarms*" in class 9, as relied on under the earlier '956 mark. As such the goods are identical as per the principle outlined in *Meric*.

Navigation, guidance, tracking, targeting and map making devices.

27. I find the above goods would all be used for the purposes of navigation and as such they encompass/are encompassed by the opponent's "*electronic navigation systems, particularly navigation systems based on GPS, on Bluetooth, on WiFi, on mobile data and on radio-communication*" under the '956 mark, rendering them *Meric* identical.

Measuring, detecting and monitoring instruments, indicators and controllers; sensors and detectors; distance, speed and dimension measuring instruments.

28. I consider these goods to cover/be covered by the opponent's "*digital, electric and electronic measuring, checking, controlling and regulating apparatus (included in this class); motion detectors; sensors*" found in class 9 of the earlier '619 mark. Therefore I find the goods to be identical as per *Meric*.

Digital signage; directional signage [luminous or mechanical].

29. The opponent submits that these goods are similar to the "*display screens*" found under class 9 of the '619 registration. I agree that the applicant's wider terms would include the opponent's display screens, as well as its "*digital, electric and electronic sign ...*", and as such are considered identical as per the principle outlined in *Meric*.

Communication hubs.

30. I consider that a "*communication hub*" would utilise "*software and application software for wireless routers and network routers*" as included in class 9 of the opponent's '956 mark. There will be an overlap in users of the goods which are likely to be sourced from the same channels of trade and I consider the goods to be complementary to the extent that the consumer could reasonably expect them to originate from the same undertakings. Overall, I find the goods similar to a medium degree.

Fire extinguishing apparatus; firefighting apparatus.

31. The opponent submits that these goods are identical or highly similar to the “*electric safety devices*” and “*fire alarms*” covered by the ‘956 mark. I disagree that the goods are identical, and while the opponent’s “*fire alarms*” are used to give warning of a fire, they do not fulfil the purpose of containing a fire, being the fundamental nature of the applicant’s goods. The goods also differ in their method of use. I further consider the opponent’s “*electric safety devices*” to be a particularly broad term which to my mind does not encompass the very specific nature of the opposed goods. However, there will be an overlap in users of “*Fire extinguishing apparatus; firefighting apparatus*” and the opponent’s “*fire alarms*”, and the goods are likely to be sourced through the same channels of trade. I do not consider it likely that the average consumer would automatically expect “*Fire extinguishing apparatus; firefighting apparatus*” and “*fire alarms*” to be provided by the same or economically linked undertakings. I consider the goods to be similar to a low degree.

Personal protective goods, namely protective clothing, high visibility safety clothing, protective gloves, protective footwear, protective headwear, safety helmets, protective bonnets, protective eyewear, protective glasses, protective visors, protective face masks and coverings, safety harnesses, protective gowns and protective screens; personal protective equipment, namely protective clothing, high-visibility safety clothing, protective gloves, protective footwear, protective headwear, safety helmets, protective bonnets, protective eyewear, protective glasses, protective visors, protective face masks and coverings, safety harnesses, protective gowns and protective screens.

32. The opponent submits that the applicant’s goods are all types of safety equipment which are similar to, inter alia, its own “*electric safety devices; integrated safety (circuits)*” in class 9 and “*Safety services for protection of property and persons*” in class 45 of the ‘956 mark.⁷ To my mind, electric safety devices would include the likes of circuit breakers and would not encompass the applicant’s goods, being predominantly protective clothing. I consider the contested goods to be different in

⁷ See paragraph 42 of the opponent’s final (written) submissions dated 8 February 2024.

nature, purpose and method of use to the opponent's "*electric safety devices; integrated safety (circuits)*", and even if there were an overlap in trade channels, I do not consider that the goods would be found in close proximity to each other, or that the consumer would immediately assume them to be provided by the same undertaking. Neither do I consider there to be any similarity with the opponent's "*Safety services for protection of property and persons*", which I construe as including the provision of personal security and, for example, the monitoring of security cameras and alarm systems. In *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.⁸ Pragmatically, the goods and services will have different users, are different in nature, purpose and method of use, with different channels of trade. Neither do I consider them to be either complimentary or in competition. Accordingly, I find the aforementioned goods and services to be dissimilar.

Parts, components and fittings for any or all of the aforementioned products.

33. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

While it is possible that for some goods, different, unrelated undertakings would provide the component parts and the finished article, for the goods which I have found to be similar, I see no reason why the consumer of those goods would not also expect the "*Parts, components and fittings*" to originate from the same source. Accordingly, I find them similar to the same degree as the complete article, as per my earlier findings. Where I have found the goods at hand to be dissimilar, the same reasoning will apply to their "*Parts, components and fittings*".

⁸ At [24].

The contested goods in class 19

Handrails; access gates; all abovementioned goods not of metal.

34. These are self-evidently identical to the opponent's "*Handrails; ... gates...; all the aforesaid goods not of metal*" in class 19 of the '619 mark.

Barriers; barrier systems; barriers for airports; pedestrian barriers; traffic barriers; car park barriers; pedestrian and traffic guide devices being barrier systems; pedestrian and traffic protection devices being barrier systems; non-metallic protective barriers to prevent damage to racks and shelving systems; parts for barriers ... made of plastic; all abovementioned goods not of metal.

35. Both the applicant's and the opponent's specifications (the '619 mark) include the broad term "*barriers*". I consider the above goods to be either self-evidently identical or, where the goods are encompassed by the broader term of the competing specification, *Merici* identical, to the opponent's "*barriers for pedestrian traffic control; ... and barriers; all the aforesaid goods not of metal*" under class 19 of the '619 mark. I further consider that in this instance, it could be reasonable to expect that the parts would originate from the same undertaking as the finished product.

Fencing; bollards; parts for ... fencing and bollards made of plastic.

36. I consider that fencing and bollards serve to separate and delineate areas and so could be classed as a form of barrier and as such could be encompassed by the opponent's broad term "*barriers*", included in the '619 mark. However, I am mindful that as per *YouView*, I should not apply too liberal an interpretation on such broad terms. At a basic level, I consider there to be an overlap in nature, purpose and method of use of the applicant's "*Fencing; bollards*" with the opponent's "*barriers*" and that the goods share channels of trade. I again consider it reasonable that the parts would originate from the same undertaking as the finished product. Overall, I find the goods to be similar to a low to medium degree.

Plastic pipes and tubes; all abovementioned goods not of metal.

37. I acknowledge the opponent's submissions that all of the applicant's goods in class 19 are identical or highly similar to "*barriers; barriers for pedestrian traffic control; building materials*" in class 19 of the '619 registration.⁹ However, while pipes and tubes may be components of barriers, in this instance, and as outlined in *Les Éditions Albert René*, I consider the goods to be different in nature, purpose and method of use and in this instance I do not consider that the average consumer would expect them to be provided by the same undertaking. In relation to the opponent's "*building materials*", I am mindful of the guidance in *YouView* not to apply too liberal an interpretation to the scope of the goods. I do not consider that pipes and tubes would be encompassed by the broad term "*building materials*", which to me would include the likes of bricks, cement, timber and plaster. In my view, plastic pipes and tubes which would be used in the completed building, for example for purposes such as plumbing, and could also include the likes of exterior downpipes. There would be some overlap in users of the goods at issue, and the goods would also share trade channels, although are unlikely to be found in close proximity. The goods are not in competition, neither are they complimentary in a trade mark sense to the extent that the consumer would automatically believe that the applicant's "*Plastic pipes and tubes; ...*" are provided by the same undertaking as the opponent's (non-metallic) building materials. Overall, I find there to be a low degree of similarity between the goods.

Parts and fittings for any or all of the aforementioned products made of plastic; all abovementioned goods not of metal; parts, components and fittings for any or all of the aforementioned products.

38. For the same reasoning given in relation to the parts and fittings of the class 9 goods, I find the above goods in class 19 to be similar to the same degree as the finished article, as per my earlier findings.

⁹ At [44] of the opponent's final submissions.

The contested services in class 42

Scientific and technological services in relation to industrial safety; design, research and development services in relation to industrial safety; safety technology services.

39. The opponent submits that the applicant's services encompass its "research, monitoring and analysis and monitoring of the traffic flow inside, between and outside buildings" included in the class 42 specification of its '956 mark and are therefore identical/highly similar. To my mind, the applicant's services are more akin to the opponent's "research and development in the field of safety engineering" and I consider that the applicant's broad terms would also cover the opponent's services in the field of safety engineering, rendering the services identical as per *Meric*.

Design engineering services.

40. I consider that design services would be the next step following the research and development stages, and as such, research, development and design services in the same field go hand in hand and will often be provided by the same undertakings, although I accept this may not always be the case. There will be an overlap in users who will source the services through the same channels of trade. In my view there is a complementary relationship between the applicant's "Design engineering services" and the opponent's "research and development in the field of safety engineering" of its '956 mark to the extent that it would not be unreasonable to expect the services to be provided by the same, or economically linked undertakings. Overall, I find the services to be similar to a medium degree.

Consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

41. There is likely to be a degree of consultancy, advice and information offered in relation to each of the applicant's services, either prior to those services being procured, or during or post delivery of such services. I therefore find them similar to the same degree as the specific service being provided, as per my earlier findings.

42. Under section 5(2)(b), a degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

43. In relation to the class 9 goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

44. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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, at [26].

45. The applicant submits that in view of the nature of the respective goods and services, which it submits are very specialised, that the consumer will pay a higher degree of attention to the marks and the goods and services in question.¹⁰ The opponent submits that the average consumer will be the public at large which are likely to pay an average level of attention.¹¹

46. In my view, the average consumer for the competing goods will be both the general public and businesses for certain goods, such as for the likes of *alarms and warning equipment*, which could include basic smoke detectors, and *fencing* (such as garden fencing), while the more specialised goods, including *pedestrian and traffic protection devices being barrier systems/barriers for pedestrian traffic control* and the overlapping services in class 42 will be directed towards a professional consumer with a specialist knowledge of the goods and services.

¹⁰ See “C) Relevant Public – level of attention” at page 14 of 15 of the applicant’s written submissions dated 8 February 2024.

¹¹ Paragraph 18 of the opponent’s final written submissions dated 8 February 2024.

47. For the sake of clarity, in the table below I will set out which of the goods under the applicant's mark for which I have found a degree of similarity I consider would reasonably be utilised by both the general public and business consumers, and those goods which will most likely be sourced only by the professional business consumer. I have confined the goods targeted towards the professional consumer to those which would not realistically be purchased by the general public, without, as guided by *YouView*, affording the term either a too liberal, or an artificially narrow, interpretation. I have taken a pragmatic approach although I accept that there may be exceptions to this in certain instances. To reiterate, I consider that all of the services in class 42 are likely to be consumed by businesses only.

Goods consumed by both the general public and businesses
<p><u>Class 9</u></p> <p><i>Safety, security, protection and signalling devices; alarms and warning equipment; navigation, guidance, tracking, targeting and map making devices; measuring, detecting and monitoring instruments, indicators and controllers; sensors and detectors; distance, speed and dimension measuring instruments; safety monitoring apparatus [electric]; safety alarms [other than for vehicles]; safety apparatus and devices [for the prevention of accident or injury]; communication hubs; fire extinguishing apparatus; firefighting apparatus; fire detection apparatus; parts, components and fittings for any or all of the aforementioned products.¹²</i></p>
<p><u>Class 19</u></p> <p><i>Fencing; access gates; parts for ..., fencing ... made of plastic; plastic pipes and tubes; parts and fittings for any or all of the aforementioned products made of plastic; all abovementioned goods not of metal; parts, components and fittings for any or all of the aforementioned products.</i></p>
Goods consumed by the professional business consumer
<p><u>Class 9</u></p> <p><i>Digital signage; directional signage [luminous or mechanical]; parts, components and fittings for any or all of the aforementioned products.</i></p>

¹² I consider the likes of firefighting apparatus to include small fire extinguishers and fire blankets which could realistically be purchased by the general public for household use, while broad terms such as *safety devices* could be in the form of personal alarms.

Class 19



Barriers; barrier systems; barriers for airports; bollards; pedestrian barriers; traffic barriers; car park barriers; pedestrian and traffic guide devices being barrier systems; pedestrian and traffic protection devices being barrier systems; handrails; non-metallic protective barriers to prevent damage to racks and shelving systems; parts for barriers, ... and bollards made of plastic; parts and fittings for any or all of the aforementioned products made of plastic; all abovementioned goods not of metal; parts, components and fittings for any or all of the aforementioned products.

48. The goods such as basic alarms and fencing will be sold through a range of channels including physical premises such as general DIY stores as well as via the internet, with more complex alarm systems provided by specialists in the field, while the highly specialised goods and services are likely to be sourced through dedicated providers, be that from physical premises or via the internet. To my mind, the selection process would be predominantly visual, although aural considerations will play a part, for example, where the consumer receives verbal advice and recommendations from sales representatives.

49. Considerations during the selection of the goods and services will include the suitability of the product for the consumers' individual requirements, as well as cost. I would expect the degree of attention paid by the general public to the selection of the goods to be medium. The requirements of the professional consumer are likely to be more specific and they will want to ensure that they select the most suitable products, which are unlikely to be purchased casually or as a matter of routine. The consequences of not selecting the most appropriate goods or services could be costly, both in terms of the business consumer's reputation and, given the safety aspect for many of the goods and services, the physical risk to the end user. The professional consumer will therefore pay a high degree of attention to the selection of the overlapping goods and services.

Comparison of marks

50. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="204 327 783 398">Identical to both the '619 mark and the '956 mark:</p> 	<p data-bbox="810 327 975 360">Series of 2:</p> 

51. The application has been accepted for registration purposes as a series of two marks under section 41(2) of the Act. As shown above, the first mark in the series is presented in black, while the second mark of the series is presented in the colour yellow. I note that registration of a mark in black and white covers use of the mark in colour.¹³ For convenience, I will from this point refer to the series in the singular, though my comments should be taken as referring equally to both marks in the series, unless expressed otherwise.

Overall impression

52. 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

¹³ See paragraph 5, *Specsavers* [2014] EWCA Civ 1294.

“34.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.”

53. It would be wrong 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.

54. The opponent’s mark consists of a solid, double outlined circular ring or annulus, infilled in an irregular grey-shade, with a solid inverted “V” shape resembling a triangular wedge emanating from the bottom of, but still within, the ring. The overall impression of the mark rests in the mark in its entirety.

55. The applicant’s mark consists of a portion of a double outlined, infilled circular ring which is interrupted by an inverted “V” shape, the bottom of which is positioned beneath the lower segment of the ring and continues upwards into its centre. In spite of the fact that there are no breaks between them, I consider that the device will be seen as two distinct shapes, being a partial triangle in front of a partial circular ring. The overall impression therefore rests in the combination of the two shapes which form the whole as presented.

Visual comparison

56. In the simplest of terms, both marks contain a solid infilled circular ring shape juxtaposed with an inverted “V” shape. However, in the applicant’s mark, the circular ring shape is incomplete and is infilled in a solid block colour, compared to the opponent’s mark where the (complete) ring, which is wider than that of the applicant’s mark, is filled in an inconsistent grey shade, creating a visual disparity. The inverted “V” in the applicant’s mark has no bottom line and starts outside the ring; the inverted “V” in the opponent’s mark forms a solid block which is incorporated within the base

line of the ring, giving rise to a further visual difference between the marks. Overall, I consider the marks to be visually similar to a medium degree.

Aural and conceptual comparisons

57. To my mind, each of the marks would be perceived by the average consumer as an intangible image. Neither mark contains any words or other components which would be articulated by the consumer: *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T- 424/10 at [45 – 47]. Given that the marks as a whole each comprise an abstract shape, neither mark overall has any clearly recognisable concept. This is agreed by both parties in their respective written submissions. Therefore I make no aural or conceptual comparison of the marks.

Distinctive character of the earlier marks

58. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

“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).”

59. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

60. As described previously, I consider the opponent's mark to comprise an abstract image which as a whole is neither strikingly distinctive, nor particularly weak. Overall, I consider the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

61. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of all relevant factors, keeping in mind the interdependency between them, including that a great degree of similarity between the respective trade marks may be offset by a lesser degree of similarity between the respective goods (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer.

62. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

63. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

64. Earlier in this decision, I found the applicant’s goods in classes 9 and 19 to range between identical to dissimilar to the opponent’s goods, while the class 42 services were either identical as per *Meric* or similar to at least a medium degree. I considered there to be two distinct groups of average consumers, being the general public who would pay a medium degree of attention to the selection of the applicable goods, and a professional business consumer who would pay a high degree of attention to the purchase of the relevant goods and services. I found the competing trade marks to

be visually similar to a medium degree, however neither an aural nor a conceptual comparison could be made. I found the earlier mark to be inherently distinctive to a medium degree.

65. I have weighed up each of the competing factors in my decision, not least the visual differences as well as the similarities between the competing marks, alongside the degree of inherent distinctive character of the earlier mark, as identified above, all of which play a part. I bear in mind that in relation to the assessment of the likelihood of confusion, it is the section of the public with the lowest level of attention which must be taken into consideration.¹⁴

66. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that the professional business consumer of the specialist goods and services identified earlier would mistake the applicant's mark for the earlier marks. In my view, given the high degree of attention paid to those goods and services by such consumers, they will notice and recall the visual differences between the marks. I find this even where there is identity between the goods and services at issue. Overall, I do not consider there to be any likelihood of direct confusion for the specialist goods and services for which I found a degree of similarity, which I considered would most likely be procured by the professional consumer, as listed under paragraph 72 of this decision.

67. In relation to the general public as the average consumer of the remaining goods, bearing in mind the medium level of attention paid during the selection process, I consider that while they will recall that each of the mark contain abstract shapes, they will be less certain of the exact form that the marks take. As such there is a likelihood of confusion in relation to the goods listed below at paragraph 71, being items which encompass a broad range of goods likely to be purchased by the general public. I accept that some of these goods will also be purchased by professional consumers and will vary in complexity, however, given the broad nature of some of the terms, I

¹⁴ Case T-247/12, *Argo Group International Holdings Ltd. v OHIM*.

must make my assessment on the lowest level of attention of the basic products attributable to the goods.

68. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

69. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

70. Keeping in mind the global assessment of the competing factors in my decision, it is my view that it is unlikely that the average consumer, being either the professional business consumer or a member of the general public who notices the differences between the competing marks, would assume that there is a connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive, however, while for some consumers sight of one mark may bring to mind the other mark, I do not see anything which would lead the average consumer into believing that one mark is a logical brand extension of the other. I therefore find no likelihood of indirect confusion.

CONCLUSION

71. The opposition under section 5(2)(b) of the Act has been partially successful in relation to the following goods only:

Class 9

Safety, security, protection and signalling devices; alarms and warning equipment; navigation, guidance, tracking, targeting and map making devices; measuring, detecting and monitoring instruments, indicators and controllers; sensors and detectors; distance, speed and dimension measuring instruments; safety monitoring apparatus [electric]; safety alarms [other than for vehicles]; safety apparatus and devices [for the prevention of accident or injury]; communication hubs; fire extinguishing apparatus; firefighting apparatus; fire detection apparatus; parts, components and fittings for any or all of the aforementioned products.

Class 19

Fencing; access gates; parts for ... fencing ... made of plastic; plastic pipes and tubes; parts and fittings for any or all of the aforementioned products made of plastic; all abovementioned goods not of metal; parts, components and fittings for any or all of the aforementioned products.

72. The opposition under section 5(2)(b) of the Act has failed in relation to the remaining goods and services, either because they are selected by professional business consumers or because they have been found to be dissimilar. Subject to any successful appeal, the application by THREE SMITH GROUP LIMITED may proceed to registration in respect of the following goods and services only:

Class 9

Personal protective goods, namely protective clothing, high visibility safety clothing, protective gloves, protective footwear, protective headwear, safety helmets, protective bonnets, protective eyewear, protective glasses, protective visors, protective face masks and coverings, safety harnesses, protective gowns and protective screens; personal protective equipment, namely protective clothing, high-visibility safety clothing, protective gloves, protective footwear, protective headwear, safety helmets, protective bonnets, protective eyewear, protective glasses, protective visors, protective face masks and coverings, safety harnesses, protective gowns and protective screens; digital signage; directional signage [luminous or mechanical]; parts, components and fittings for any or all of the aforementioned products.

Class 19

Barriers; barrier systems; barriers for airports; bollards; pedestrian barriers; traffic barriers; car park barriers; pedestrian and traffic guide devices being barrier systems; pedestrian and traffic protection devices being barrier systems; handrails; non-metallic protective barriers to prevent damage to racks and shelving systems; parts for barriers, ... and bollards made of plastic; parts and fittings for any or all of the aforementioned products made of plastic; all abovementioned goods not of metal; parts, components and fittings for any or all of the aforementioned products

Class 42

Scientific and technological services in relation to industrial safety; design, research and development services in relation to industrial safety; design engineering services; safety technology services; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

COSTS

73. Both parties have enjoyed a share of success in these proceedings. Considering the balance of success is roughly equal, adopting a “rough and ready” approach to the matter, I have concluded that both parties should bear their own costs.

Dated this 16th day of October 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General

Annex A

Goods and services in classes 10, 11, 17 and 21 as protected under the '619 mark

Class 10

Ultraviolet ray lamps for medical purposes; filters for ultraviolet rays for medical purposes; lamps for medical purposes; facial masks for hygienic purposes; sanitary masks for medical purposes; aerosol dispensers for medical purposes.

Class 11

Ultraviolet ray lamps not for medical purposes; germicidal lamps for purifying air; purification lamps with a germicidal effect; air purifiers; air purifying apparatus and machines; gas purification apparatus; disinfectant dispensers for toilets; disinfectant apparatus; sterilizers; air sterilizers; disinfectant apparatus for medical purposes; air-conditioning apparatus and installations; heating installations; apparatus for lighting, heating, steam generating, cooling, drying, ventilation and water supply; electric fans; motion sensitive security lights; light panels; light projectors.

Class 17

Plastic film, other than for wrapping; insulating floor coverings; adhesive protective films made of plastic to protect walls, panels, handrails from dirt and damage.

Class 21

Soap dispensers; soap boxes; soap holders; aerosol dispensers not for medical purposes.

Goods and Services in classes 6, 7, 35, 37, 38 and 45 as registered under the '956 mark

Class 6

Building materials of metal, namely, beams, spacers, intrados, floor plates, wall panels, ceiling boards, railings, bolts, screws, springs, nuts, nails and rivets; spacers

of metal for hoists; scaffolding of metal; support posts of metal; ladders of metal; partitions of metal for lifts, escalators and moving walkways; wall linings of metal for building; frames of metal for building; guide rails of metal; cables of metal; ropes mainly of metal, with or without sleeves, for handling loads; ropes of metal for protection from falling; swing doors, rotating doors, sliding doors, revolving doors, folding doors, fire doors, fire shutters and automatic doors; door frames and door linings, mainly of metal; door fittings, of metal or mainly of metal; door handles of metal or mainly of metal; door axis and door knobs, of metal or mainly of metal; locks of metal; mechanical locks of metal; metal door locks; gates, rolling doors, accordion doors, turnstiles, swing gates and barriers made of metal or mainly of metal; windows of metal; window frames of metal; metal window fittings, mainly of metal; steps of metal; handrails for escalators and moving walkways; key safes; electronic and mechanical key safes; metal locksmith and ironmongery; lift doors of metal or mainly of metal.

Class 7

Elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, components and parts for all the aforementioned goods; elevator car frames of metal; elevator platforms of metal; work and construction platforms of metal; elevator cars of metal; work and construction platforms able to be raised; electric generators; electric motors and parts therefor, excluding for land vehicles; transmissions, other than for land vehicles; hydraulic motors; cables and belts for elevator motors; cables and belts for elevator cars and parachutes; cables and belts for elevator car doors; hydraulic and electric drives other than for land vehicles; drives for elevator car doors, drive belts and drive shafts excluding those for land vehicles; bearings for machines; brakes and brake linings excluding those for land vehicles; brake pads and shoes excluding those for land vehicles; electronic and mechanical safety devices for elevators, escalators and moving walkways and other vertical, horizontal and inclined transport installations; electronic and mechanical safety brakes as safety equipment for lift installations; counterweights for lifts; cable pulleys of metal (machine parts); slip couplings for elevators, escalators and moving walkways; hydraulic, pneumatic and electric door openers and door closers for doors and gates, and components and spare parts therefor, electronic and mechanical door drives; electronic and mechanical gate drives; transmission motors for barrier installations; transmission motors for door drives; transmission motors for gate drives;

electric, hydraulic and pneumatic door closers and components and spare parts therefor; electric, hydraulic and pneumatic closing installations.

Class 35

Gathering, systematization and updating of data in computer databases; data management by computer; input and processing of data for users of monitoring, access control and guidance and navigation systems in computer databases; input and processing of operating data for elevators, escalators, moving walkways and other vertical transport systems, horizontal and inclined transport installations, building installations, monitoring, access control, guidance and navigation systems, locking systems, doors, turnstiles, revolving doors, barriers and gates in computer databases; creation of statistical reports and analysis of relating to operating data for elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, monitoring, access control, navigation and guidance systems, locking systems, doors, turnstiles, swing gates, barriers and gates; administrative processing of orders by telephone or computer; taking orders; invoicing; e-commerce services, namely, provision of information on products through telecommunication networks for advertising and sales purposes; provision of information on goods, purchase, design, specifications rates for elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, access control, navigation and guidance systems as well as consulting services relating thereto for advertising and sales purposes; wholesale and retail of spare parts and components of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, access control, navigation and guidance systems, locking systems, door openers, door closers, doors, turnstiles, revolving doors, barriers and gates (also via the Internet); advertising, marketing and sales promotion; advertising using computer screens, touch screens, television screens, projection apparatus, video projectors and electronic bulletin boards; rental of advertising space; provision of advertising space, and advertising time and advertising media; organization and management of customer loyalty programs; organization of trade fairs and exhibitions for economic or advertising purposes.

Class 37

Provision of construction information; building consultancy; information on the repair, operation of maintenance, servicing and overhaul of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, access control, navigation and guidance systems, locking systems, doors, door openers, door closers, gates, turnstiles, revolving doors and barriers; installation, maintenance, repair and overhaul of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, as well as building elements and components as parts of these installations; works of installation, maintenance, repair and construction for the modernization of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, as well as building elements and components as parts of these installations; partial dismantling of existing elevators, escalators and moving walkways, for the preparation of the modernization thereof; consulting on the installation, maintenance, repair, overhaul and modernization of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations as well as building elements as parts and components as parts of these installations; implementation of measures for preventive maintenance of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, access control systems, locking installations, doors, door openers and door closers, gates, turnstiles, swing gates, barriers and components thereof; consulting on the installation, maintenance, repair, overhaul and modernization of access control, guidance and navigation systems, locking systems, doors, door openers and door closers, gates, turnstiles, swing gates, barriers and gates; installation, maintenance, repair, overhaul and modernization of elevators, escalators, moving walkways, access control, navigation and guidance systems, locking systems, doors, door openers and door closers, gates, turnstiles, swing gates and barriers through remote access with a communication link, particularly via the Internet; installation, maintenance, repair, overhaul and modernization of alarm and monitoring systems as well as consulting related thereto; installation, maintenance and repair of computers and of apparatus for telecommunications.

Class 38

Provision of communication links with data banks; provision of access to platforms and portals on the Internet; provision and transmission of voice, audio, and video data,

messages, texts, drawings, images via analog and digital communication networks, radio networks and wired telecommunication networks; communication services by telephone; paging services by radio or telephone; provision of telecommunications links for hotlines and call centers; electronic exchange of messages by means of online chatrooms, online discussion sites and Internet forums; provision of telecommunication links for data exchange between the central computing apparatus and elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, access control, navigation and guidance systems, locking systems, doors, turnstiles, swing gates, barriers and gates; provision of access to operating data of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, access control, navigation and guidance systems, locking systems, doors, turnstiles, swing gates and gates by means of a communication network; provision of access to data that informs about disorders of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations, building installations, access control, navigation and guidance systems, locking systems, doors, turnstiles, swing gates and gates by means of a communication network; transmission of electronic data and voice signals, and data of all types for the purpose of monitoring, control, maintenance and repair of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations; transmission of signals of alarm apparatus and access control systems; transmission of emergency messages via computer networks and telecommunication networks; transmission of data and signals of navigation and guidance systems for tracking people and objects and the orientation of persons inside and outside buildings; electronic transmission, via computer and telecommunication networks, of messages, notifications, entertainment, images, advertising information, elevator position information and emergency information for users of elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations; electronic transmission, via computer and telecommunication networks, of teaching and training as well as installation, modernization and repair instructions; rental and provision of access time to data in computer databases; rental of telecommunication apparatus.

Class 45

Safety services for protection of property and persons; security monitoring services for the monitoring of buildings, persons and objects; alarm monitoring services; monitoring customers' emergency phone calls and emergency warning devices; consulting in the field of physical security; security services for controlling access to buildings, parts of buildings, public facilities, doors, turnstiles, swing gates, barriers, gates, elevators, escalators, moving walkways and other vertical, horizontal and inclined transport installations; control of systems around a building, systems for access to buildings and systems for building security; opening of security locks for security purposes; opening of security locks for security purposes through a remote access with a communication link, particularly via the Internet; opening of security locks by means of communication link, particularly via the Internet; monitoring of security systems; identity verification services for security purposes; rental of apparatus for monitoring of security and access control systems; granting of licenses for the use of monitoring, access control and navigation systems, including software applications relating thereto; management and licensing of industrial property rights and copyrights.