O/1002/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 4008697

BY FANUM SP. Z. O. O. SP. K.

TO REGISTER THE FOLLOWING TRADE MARK:

FANUM

IN CLASSES 7 & 42

AND

THE OPPOSITION THERETO UNDER NUMBER 447433

BY FANUC CORPORATION

Background and pleadings

1. On 30 January 2024, FANUM sp. z. o. o. sp. k. (“the applicant”) applied to register the trade mark no. 4008697 for the mark ‘FANUM’. It was accepted and published in the Trade Marks Journal on 9 February 2024 in respect of the following goods:

> *Class 7: Material production and processing machines; Numerically controlled machine tools; Machining centres; Cutting tools for machine centres; Hydraulic controls for machines; Pneumatic controls for machines, motors and engines; Electric drives for machine tools; Tools for machine tools; Robots for machine tools; Adapters for machine tools; Drive mechanisms for machine tools; Holding devices for machine tools; Couplings for machines; Robotic mechanisms for conveying; Actuators for mechanisms; Robotic mechanisms for lifting; Agitating mechanisms; Hydraulic controls for machines, motors and engines; Drive mechanisms; System control instruments (Mechanical -); System control instruments (Pneumatic -); Handling machines, automatic [manipulators]; Housings [parts of machines]; Casings for industrial machines; Cowlings [parts of machines]; Feeding machines; Feeders for machines; Guides for machines; Transmissions for machines; Remotely controlled lifting machines; Numerically controlled drilling machines; Transmission control mechanisms; Pneumatic jacks; Compressed air hoists; Industrial pneumatic tools; Air-powered tools; Portable air tools; Lifting tables; Sanding machines; Orbital sanders [machines]; Vibratory grinding machines; Automatic grinding machines; Belt sanding machines; Drill chucks for power drills; Servo-cutters [machines]; Drilling machines; Regulators [parts of machines]; Transferring machines; Precision machine tools; Machine tools for woodworking machines.*
>
> *Class 42: Computer software design; Technical research; Research in the field of materials science; Technical research projects and studies; Research, development, design and upgrading of computer software; Preparation of reports relating to technical research; Product research and development; Expert opinion relating to technology; Engineering research; Engineering project studies; Conducting technical project studies; Design services.*

2. On 9 May 2024, Supreme Imports Limited ("the opponent") opposed the trade mark based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK trade marks:

1. **FANUC**

UK registration number: UK00001182663
Filing date: 1 October 1982
Registration date: 1 October 1982
("*the opponent's earlier '663 registration")*

The following goods are relied on for this opposition:

Class 7: Machine tools; automatic machines for the feeding, handling, receiving and dispensing of work; parts and fittings included in Class 7 for all the aforesaid goods.

2. **FANUC**

UK registration number: UK00002337783
Filing date: 15 July 2003
Registration date: 12 December 2003
("*the opponent's earlier '783 registration")*

The following goods are relied on for this opposition:

Class 7: Electric motors, electric discharge machines, industrial robots, injection molding machines.

Class 9: Numerical controller, programmable controller, computer software.

3. **FANUC**

UK registration number: UK00800948323[1]
Filing date: 11 June 2007
Registration date: 9 December 2008
("*the opponent's earlier '323 registration")*

The following goods are relied on for this opposition:

Class 7: Metalworking machines and tools; food or beverage processing machines and apparatus; pneumatic or hydraulic machines and instruments; machine elements (not for land vehicles).

Class 9: Metal cutting machines (by arc, gas or plasma); laboratory apparatus and instruments; measuring or testing machines and apparatus; power distribution or control machines and apparatus; electronic machines, apparatus.

Class 37: Repair or maintenance of automobiles; repair or maintenance of loading-unloading machines and apparatus; repair or maintenance of electronic machines and apparatus; repair or maintenance of construction machines and apparatus; repair or maintenance of power distribution or control machines and apparatus; repair or maintenance of electric motors; repair or maintenance of laboratory apparatus and instruments; repair or maintenance of measuring and testing machines and instruments; repair or maintenance of metalworking machines and tools; repair or maintenance of integrated circuits manufacturing machines and systems; repair or maintenance of semiconductor manufacturing

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 56 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing International Registration designating the EU. As a result of the opponent's International Registrations being registered as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original priority date.

machines and systems; repair or maintenance of machines and apparatus for processing foods or beverages.

Class 42: designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; Computer software design, computer programming, or maintenance of computer software; technical advice relating to performance, operation of computers, automobiles and other machines that require high levels of personal knowledge, skill or experience of the operators to meet the required accuracy in operating them; providing computer programs.

4. **FANUC-QSSR**

International Registration designating the UK under no.: 1565939
International registration date: 19 October 2020
Date designated for protection in the UK: 19 October 2020
Date protection granted in the UK: 20 April 2021
("*the opponent's earlier '939 registration")*

The following goods are relied on for this opposition:

Class 7: Metalworking machines and tools; loading-unloading machines and apparatus; plastic processing machines; machining centers; injection molding machines; electric discharge machines; metalworking robots; plastic processing robots; food or beverage processing robots; painting robots; welding robots; carrying robots; electronic component manufacturing robots; electronic circuit assembling robots; wrapping robots; packaging robots; industrial robots; machines and apparatus for processing food or beverages; painting machines and apparatus; semiconductor manufacturing machines and systems; electronic component manufacturing devices; packing or wrapping machines and apparatus.

Class 9: Numerical controllers; computer numerical controllers; programmable controllers; measuring or testing machines and instruments; telecommunication machines and apparatus; computer software; computer hardware.

3. By virtue of their earlier filing dates, the opponent's above registrations constitute earlier marks in accordance with section 6 of the Act. As the opponent's earlier '663, '783 and '323 registrations had been registered for more than five years at the filing date of the applicant's mark, they are, in principle, subject to the use provisions set out in section 6A of the Act. The opponent has stated that it has used the marks for all the goods and services relied upon.

4. Under section 5(2)(b), the opponent claims that the respective goods and services are identical or highly similar and that the marks are similar. As such, the opponent submits there will be a likelihood of confusion between the marks, including a likelihood of association.

5. The applicant filed a counterstatement in which they concede that the goods and services are similar or identical, but that the differences in the marks result in no confusion between the marks. The applicant requested the opponent to file proof of use for the opponent's earlier '663, '783 and '323 registrations relied upon.

6. The opponent is represented by Gill Jennings & Every LLP. The applicant is represented by Murgitroyd & Company.

7. 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.

My approach

8. As noted above, the opponent relies on four earlier marks. However, the opponent's earlier '663, '783 and '323 registrations are clearly more similar to the applicant's mark than its earlier '939 registration, as the former do not contain the additional (differing) element "-QSSR" that is present in the latter. Moreover, the goods and services of the opponent's earlier '939 registration do not appear to relate any more closely to the applicant's goods than those of the opponent's other registrations. Accordingly, I will assess the opponent's claim on the basis of its '663, '783 and '323 registrations,

returning to consider the opponent's reliance on its earlier '939 registration only if it becomes necessary to do so.

Evidence

9. The opponent's evidence was filed in the form of a witness statement, dated 24 September 2024. This was filed by Hiroshi Noda, the General Manager of the Research & Development Promotion and Support Division of FANUC Corporation, the opponent. The witness statement introduces seven exhibits labelled HN1 to HN7. The purpose of the evidence is to address the applicant's request for the opponent to show proof of use for their earlier '663, '783 and '323 registrations.

10. The applicant did not file evidence.

11. I do not intend to summarise the evidence filed by the opponent in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Decision

Relevant period

12. The opponent's earlier '663 mark was registered on 1 October 1982, its earlier '783 mark on 12 December 2003 and its earlier '323 mark on 9 December 2008. The contested mark was filed on 30 January 2024. As the earlier marks had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies. It states:

> "(1) This Section applies where–
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

13. I note that the opponent's earlier '939 registration was registered on 19 October 2020, which means it had not been registered for more than five years on the date on which the contested application was filed. This mark is therefore not subject to proof of use.

14. The relevant period for proof of use of the opponent's earlier '663 and '783 marks is from 31 January 2019 to 30 January 2024 in the UK.

15. As the opponent's earlier '323 registration is a comparable mark, paragraph 7 of Part 1, Schedule 2B of the Act is also relevant. It reads:

> "7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (IR), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding IR; and
>
> (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding IR ; and
>
> (b) the references in section 6A to the United Kingdom include the European Union".

16. The relevant period for proof of use of the opponent's earlier '323 registration is therefore from 31 January 2019 to 30 January 2024. Between 31 January 2019 and 31 December 2020, the relevant territory is the EU and then from 1 January 2021 to 30 January 2024, the relevant territory is the UK. I note that the evidence provided by

the opponent focuses on the UK, which was a significant part of the EU during the first part of the relevant period.

PROOF OF USE

Relevant case law

16. In *easyGroup Ltd* v *Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at[36]; Sunrider at [70]; Verein at [13]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and Ferrari at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In Awareness Ltd v Plymouth City Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> ‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported

> evidence as to the nature of that use during the period in question from a person properly qualified to know. […]
>
> 22. […] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal […] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

17. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

18. In the opponent's witness statement, Mr Noda states that the opponent has used the mark continuously since at least 1980 in the UK in respect of their "core products", namely "factory automation machines including industrial robots, computer numerical control (CNC) systems, wire cut electrical discharge machine (EDM) and injection moulding machines". Mr Noda states that the opponent sells products under a variety of sub-bands, but that all its products are sold under the FANUC house brand and are physically branded with the trade mark FANUC. Exhibit HN1 shows an example of the house brand or sub-brand usage on a physical product:

19. Mr Noda also states that the opponent also develops parts and fittings for said machines and systems, as well as associated software and software platforms, technical support and advice, and training services. Mr Noda states that the technical support and advice, and the training services are offered via the FANUC Academy.

20. Exhibit HN2 shows a timeline of the history of the company. I note that it shows that FANUC UK Limited was established in 1980, FANUC Europe Corporation was established in 2012 and FANUC Academy was constructed in 2018.

21. Exhibit HN3 shows 38 invoices dated between 31 January 2019 and 30 January 2024 (the relevant period). The invoices all have the mark “FANUC” in a basic typeface in the top left corner and are issued to 29 different customers across the UK. The invoices show product codes, such as “Oi-TF for Alpha” and “DL21LB5 Robodrill”, which can be cross referenced with the product information leaflets shown in Exhibits HN4 and HN5. I note that the leaflets in Exhibits HN4 and HN5 show the mark FANUC on both the leaflets and the products depicted. In the witness statement, Mr Noda states that some of the leaflets of HN5 are from 2020 and 2021. The leaflets show computer hardware, computer software, drilling machinery, welding robots, cutting machinery, injection moulding machinery and controllers for robots. The leaflets further advertise maintenance services for all of said machinery, and training programs for said cutting machinery. These goods and services all appear to be present on the invoices of HN3.

22. Exhibit HN6 appears to be a printout from a website showing some of the products and services offered by Mr Noda’s company. Mr Noda states that these products and services are available to all FANUC customers worldwide, including in the UK. The

printout shows that customers can use a personalised portal to view technical documents and software. The exhibit further provides information about the maintenance and training services offered by the opponent. The services are only linked to the products that the opponent sells, rather than to machinery maintenance and training at large. I also note that these website printouts are not dated. Although there is a reference to an award won in 2024, it is not possible to confirm that this is from within the relevant period. Mr Noda's witness statement refers to the FANUC Portal and My FANUC being launched in 2023 and 2018 respectively, confirming that these sites were available during the relevant period.

23. In his witness statement, Mr Noda provides the following sales figures for three categories of goods. Although the sales figures are listed in EUR, Mr Noda states that the figures relate to goods bearing the trademark FANUC to UK customers.

	FA products		**ROBOT products:**		**ROBOMACHINE products:**	
	Sales Amount:	Sales Quantity:	Sales Amount:	Sales Quantity:	Sales Amount:	Sales Quantity:
2019	1,645,159	69	37,324,306	418	12,785,617	96
2020	1,031,784	57	21,874,516	300	14,462,465	104
2021	1,128964	62	25,769,687	317	14,442,226	104
2022	1,128,964	73	19,286,564	354	17,859,772	94
2023	2,177,035	102	24,580,169	523	7,597,901	45
2024 (to March)	221,650	12	4,167,959	73	2,544,202	16

24. "ROBOT products" refers to ROBODRILL, ROBOSHOT and ROBOCUT. Mr Noda clarifies that "FA products" refers to "Factory Automation", a subcategory of products that includes Computer Numerical Controls (CNC) for machining centres, Servo Systems which are a control system of mechanical systems, motors and spindles, and

carbon dioxide laser oscillators. These products are shown in the website printout in Exhibit HN7.

25. Exhibit HN7 consists of a printout showing products sold under the FANUC mark, on a website showing the 'FANUC' mark. The printout is dated 16 September 2024, which I note is outside of the relevant period. However, the products shown can be seen on the invoices dated within the relevant period, indicating that they were available to UK customers within the relevant period. The product shown are Factory Automation products, including computer hardware, control systems for mechanical systems, motors, spindles and carbon dioxide laser oscillators. Although it is not stated in Mr Noda's witness statement, it can be inferred that these products are spare parts for the machinery sold by the opponent.

26. The evidence relating to the registered goods is not without its limitations. For example, there are no details as to the amount spent on marketing the goods in the UK, nor is there any reference to the size of the relevant market, or the market share held by the opponent.

27. In relation to the registered services, no sales figures have been provided, and no services appear on the invoices provided. The extent of the services offered is not made clear, and the evidence simply demonstrates that the services were advertised to customers in the UK through catalogues and a website. Whilst it is clear from the evidence that the opponent has advertised their services to the UK market, as I cannot be sure of the extent to which these services were taken up by consumers, and noting there is also no evidence relating to the amount spent on marketing the services overall, I consider that there is not enough evidence to show genuine use of any of the registered services.

28. An assessment of genuine use is a global assessment, which includes looking at the evidence as a whole.[2] The evidence presented demonstrates that goods bearing the opponent's mark were purchased by a number of different consumers across the UK. The invoices show that the sales were geographically widespread in this territory. I have not been made aware of the market share held by the opponent, taking the turnover figures, evidence of sales and the product brochures into consideration, I am

[2] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

satisfied that the opponent has shown genuine use of its mark on a variety of machinery, hardware, software, control systems and spare parts for said machinery.

Fair specification

29. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

30. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved,

are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

33. It is also the case that the purpose or intended use of a product is vital in determining whether goods are a coherent subcategory. In Polfarmex S.A. v EUIPO, Case T-677/19, EU:T:2020:424, the General Court said:

"116. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the

product or service at issue is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services (judgments of 13 February 2007, RESPICUR, T-256/04, EU:T:2007:46, paragraph 29, and of 16 May 2013, Aleris v OHIM – Carefusion 303 (ALARIS), T-353/12, not published, EU:T:2013:257, paragraph 22). In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, August Storck v EUIPO – Chiquita 25 Brands (Fruitfuls), T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited)."

34. Having reviewed the evidence, I am satisfied that the use of the marks has been established for a wide variety of machine tools, which are machines for working with metal, for example by cutting or drilling, as well as injection moulding machines, industrial robots and hydraulic machines. Therefore, I am satisfied that genuine use has been shown for the opponent's goods 'machine tools; automatic machines for the feeding, handling, receiving and dispensing of work; electric discharge machines; industrial robots; injection molding machines; metalworking machines and tools; pneumatic or hydraulic machines and instruments'.

35. I am also satisfied that the use of the marks has been established for control systems and spare parts for said machinery. I am therefore satisfied that genuine use has been shown for the opponent's goods 'electric motors; numerical controller; programmable controller; machine elements (not for land vehicles)'.

36. I am satisfied that the use of the marks has been established for computer software related to said machinery. However, the opponent's specification includes computer software at large, which is a very wide category of goods. I am not convinced that genuine use has been shown for computer software at large, as use has only been shown for computer software relating to the use of the machinery the opponent sells. I am therefore satisfied that genuine use has been shown for 'computer software relating to machine tools' and 'providing computer programs relating to machine tools'.

37. I am satisfied that the use of the marks has been established for electronic machine tools. However, the opponent's specification includes 'electronic machines, apparatus' at large, which is a wide category of goods. I am not convinced that genuine use has been shown for electronic machines at large, as use has only been shown for machine tools. I am therefore satisfied that genuine use has been shown for 'electronic machine tools, apparatus'.

38. I do not consider the opponent to have shown genuine use in relation to the following goods and services:

> Class 7: *Food and beverage processing machines and apparatus.*
>
> Class 9: *Laboratory apparatus and instruments, measuring or testing machines and apparatus; power distribution or control machines and apparatus; metal cutting machines (by arc, gas or plasma).*
>
> Class 37: *Repair or maintenance of automobiles; repair or maintenance of loading-unloading machines and apparatus; repair or maintenance of power distribution or control machines and apparatus; repair or maintenance of laboratory apparatus and instruments; repair or maintenance of measuring and testing machines and instruments; repair or maintenance of integrated circuits manufacturing machines and systems; repair or maintenance of semiconductor manufacturing machines and systems; repair or maintenance of machines and apparatus for processing foods or beverages; repair or maintenance of electronic machines and apparatus; repair or maintenance of construction machines and apparatus; repair or maintenance of electric motors; repair or maintenance of metalworking machines and tools.*
>
> Class 42: *Designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; Computer software design, computer programming, or maintenance of computer software; technical advice relating to the performance and operation of machine tools that require high levels of personal knowledge, skill or experience of the operators to meet the required accuracy in operating them; providing computer programs relating to machine tools.*

39. As such, fair specifications for the first, second and third earlier marks are as follows:

FANUM
(the opponent's earlier '663 registration):

Class 7: Machine tools; automatic machines for the feeding, handling, receiving and dispensing of work; parts and fittings included in Class 7 for all the aforesaid goods.

FANUM
(the opponent's earlier '783 registration):

Class 7: Electric motors; electric discharge machines industrial robots; injection molding machines.

Class 9: Numerical controller; programmable controller; computer software relating to machine tools.

FANUM
(the opponent's earlier '323 registration):

Class 7: Metalworking machines and tools; pneumatic or hydraulic machines and instruments; machine elements (not for land vehicles).

Class 9: Electronic machine tools, apparatus.

Section 5(2)(b)

40. Section 5(2)(b) of the Act is 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".

Section 5A

41. Section 5A of the Act is as follows:

> "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."

The principles

42. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

> <u>The principles</u>

(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 and services

43. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

44. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a. The respective uses of the respective goods or services;

b. The respective users of the respective goods or services;

c. The physical nature of the goods or acts of service;

d. The respective trade channels through which the goods or services reach the market;

e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

45. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

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

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

47. Further, in *Kurt Hesse v OHIM*,[3] 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*,[4] the GC stated that "complementary" means:

"…there is 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."

48. With this in mind, the goods and services for comparison are as follows:

Opponent's goods and services:	**Applicant's contested goods and services:**

[3] Case C-50/15 P
[4] Case T-325/06

The opponent's earlier '663 registration: *Class 7: Machine tools; automatic machines for the feeding, handling, receiving and dispensing of work; parts and fittings included in Class 7 for all the aforesaid goods.*	*Class 7: Material production and processing machines; Numerically controlled machine tools; Machining centres; Cutting tools for machine centres; Hydraulic controls for machines; Pneumatic controls for machines, motors and engines; Electric drives for machine tools; Tools for machine tools; Robots for machine tools; Adapters for machine tools; Drive mechanisms for machine tools; Holding devices for machine tools; Couplings for machines; Robotic mechanisms for conveying; Actuators for mechanisms; Robotic mechanisms for lifting; Agitating mechanisms; Hydraulic controls for machines, motors and engines; Drive mechanisms; System control instruments (Mechanical -); System control instruments (Pneumatic -); Handling machines, automatic [manipulators]; Housings [parts of machines]; Casings for industrial machines; Cowlings [parts of machines]; Feeding machines; Feeders for machines; Guides for machines; Transmissions for machines; Remotely controlled lifting machines; Numerically controlled drilling machines; Transmission control mechanisms; Pneumatic jacks; Compressed air hoists;*
The opponent's earlier '783 registration: *Class 7: Electric motors, electric discharge machines, industrial robots, injection molding machines.*	

Class 9: Numerical controller, programmable controller, computer software relating to machine tools.	*Industrial pneumatic tools; Air-powered tools; Portable air tools; Lifting tables; Sanding machines; Orbital sanders [machines]; Vibratory grinding machines; Automatic grinding machines; Belt sanding machines; Drill chucks for power drills; Servo-cutters [machines]; Drilling machines; Regulators [parts of machines]; Transferring machines; Precision machine tools; Machine tools for woodworking machines.* *Class 42: Computer software design; Technical research; Research in the field of materials science; Technical research projects and studies; Research, development, design and upgrading of computer software; Preparation of reports relating to technical research; Product research and development; Expert opinion relating to technology; Engineering research; Engineering project studies; Conducting technical project studies; Design services.*
The opponent's earlier '323 registration: *Class 7: Metalworking machines and tools; pneumatic or hydraulic machines and instruments; machine elements (not for land vehicles).* *Class 9: Electronic machine tools, apparatus.*	

49. In its counterstatement, the applicant admits that the contested goods and services are identical or similar to the goods and services of the earlier trade mark. I note this admission, but I keep in mind it was made prior to the specification being limited in my assessment of proof of use.

<u>Class 7 goods</u>

Electric drives for machine tools; Drive mechanisms for machine tools; Holding devices for machine tools; Couplings for machines; Robotic mechanisms for

conveying; Actuators for mechanisms; Robotic mechanisms for lifting; Agitating mechanisms; Hydraulic controls for machines, motors and engines; Drive mechanisms; System control instruments (Mechanical -); System control instruments (Pneumatic -); Tools for machine tools; Robots for machine tools; Adapters for machine tools; Housings [parts of machines]; Casings for industrial machines; Cowlings [parts of machines]; Feeders for machines; Guides for machines; Transmissions for machines; Transmission control mechanisms; Drill chucks for power drills; Regulators [parts of machines]; Cutting tools for machine centres; Machine tools for woodworking machines.

50. The above goods are all considered to fall within the scope of the opponent's 'machine elements (not for land vehicles)'. These goods are therefore considered identical according to the principles set out in *Meric*.[5]

Material production and processing machines; Numerically controlled machine tools; Machining centres; Handling machines, automatic [manipulators]; Feeding machines; Remotely controlled lifting machines; Numerically controlled drilling machines; Sanding machines; Orbital sanders [machines]; Vibratory grinding machines; Automatic grinding machines; Belt sanding machines; Servo-cutters [machines]; Drilling machines; Transferring machines; Precision machine tools;

51. I consider that all of the above goods can be used for metalwork. The above goods are therefore considered to fall within the scope of the opponent's 'metalworking machines and tools'. These goods are therefore considered identical according to the principles set out in *Meric*.[6]

Hydraulic controls for machines; Pneumatic controls for machines, motors and engines; Pneumatic jacks; Industrial pneumatic tools; Compressed air hoists; Air-powered tools; Portable air tools; Lifting tables

[5] Case T-133/05
[6] Case T-133/05

52. The above goods are all considered to fall within the scope of the opponent's 'pneumatic or hydraulic machines and instruments'. These goods are therefore considered identical according to the principles set out in *Meric*.[7]

Class 42 services

Computer software design; Research, development, design and upgrading of computer software

53. The above services are most similar to the opponent's 'computer software relating to machine tools'. The above services would include research, development, design and upgrading of computer software relating to machine tools. The purpose of the above goods is to provide tailor-made software, while the purpose of the opponent's goods is to provide a computer with a set of instructions that allow it to perform a specific task. The users will overlap as users of the above services will also use the software it produces. The nature clearly differs, but trade channels overlap as enterprises that sell computer software design, upgrade, research and development will likely also sell the software that is produced to their customers. There may be competition between the goods and services as a consumer could either purchase ready-made software or have the software tailor-made for their requirements. The goods and services are also complementary as computer software is essential for research, development, design and upgrading of computer software, and a consumer is likely to assume that the responsibility for the research, development, design and upgrading of computer software lies with the enterprise that sells the software. Overall, I find the above services to have a medium level of similarity to the opponent's 'computer software relating to machine tools'.

Technical research; Research in the field of materials science; Technical research projects and studies; Preparation of reports relating to technical research; Engineering research; Engineering project studies; Conducting technical project studies; product research and development

54. The above services include technical research and engineering research/studies for machine tools. These services are most similar to the opponent's 'machine tools'.

[7] Case T-133/05

The purpose and nature of the goods and services clearly differ. The users will also differ as consumers of the above services are likely to be manufacturers of machine tools. Trade channels will differ. There will be no competition. Technical and engineering research into machine tools requires the machine tools themselves, and consumers may conclude that the same entity would conduct technical research and sell the machine tools themselves, so there is complementarity between the goods and services. Overall, I find the above services to have a medium similarity to the opponent's 'machine tools'.

Expert opinion relating to technology

55. I consider that machine tools fall under the umbrella of technology. The above services therefore include expert opinion relating to machine tools. These services are most similar to the opponent's 'machine tools'. The purpose and nature clearly differ. The users will overlap as consumers wanting to purchase machine tools may want to obtain expert opinion relating to said tools. Trade channels may overlap where an enterprise selling machine tools may offer expert opinion relating to said tools. There is no competition. Expert opinion relating to machine tools requires the machine tools themselves and consumers are likely to conclude that the same entity would offer the expert opinion and the machine tools themselves. There is therefore complementarity between the goods and service. Overall, I find the above services to have a medium similarity to the opponent's 'machine tools'.

Design services

56. I will compare the above services with the opponent's 'machine tools'. The above services would include design services for machine tools. The purpose and nature of the goods and service clearly differ. The users will overlap as consumers wanting to purchase machine tools may have them designed specifically for their needs. Trade channels may overlap where an enterprise selling machine tools may offer both a tailor-made design service for said tools and technical advice after purchase. There may be competition between the goods and service as consumers could either choose to purchase a ready-made machine tool or to have one designed for them. The design of machine tools requires the machine tools themselves and consumers are likely to conclude that the same entity would offer the design of machine tools and the machine

tools themselves. There is therefore complementarity between the goods and service. Overall, I find the above services to have a medium similarity to the opponent's 'machine tools'.

Comparison of marks

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

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

58. It would be wrong, therefore, to dissect the trade marks artificially, 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.

59. The respective trade marks are shown below:

The opponent's earlier marks	**The applicant's contested mark**
1. **FANUC** *"The opponent's earlier '663 registration"*	**FANUM**

2. **FANUC** *"The opponent's earlier '783 registration"* 3. **FANUC** *"The opponent's earlier '323 registration"*	

60. In its statement of grounds, the opponent submits that the marks are highly visually and aurally similar, with the same intonation and emphasis.

61. In its counterstatement, the applicant accepts that the marks only differ by the final letter, but they deny that marks are visually and aurally highly similar.

Overall impression

62. The opponent's earlier '663, '783 and '323 registrations are word-only marks consisting of the element "FANUC". This is the only element, and is therefore dominant

63. The contested mark comprises the element "FANUM". This is the only element, and therefore is dominant.

Visual comparison

64. The opponent's earlier '663, '783 and '323 marks all consist of the word "FANUC". The first four letters are identical to those of the contested mark. The marks only differ in the final (fifth) letter.

65. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of marks tend to have more visual and aural impact than the ends. I note that this case law is relied upon in the decision (O/338/16) that the opponent references in its written submissions. The court stated:

> "81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced.

As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar."

56. The marks “FANUC” and “FANUM” are relatively short, so the difference will be more obvious to the consumer than the example in the case law. However, the differing letter is still less likely to be noticed by the consumer due to its placement at the end of the mark rather than towards the beginning. Overall, I consider that the marks are visually similar to a high degree.

Aural comparison

66. The opponent’s earlier ‘663, ‘783 and ‘323 marks all consist of the word “FANUC”. This will be pronounced as two syllables: “fah-nuck”.

67. The contested mark consists of the word “FANUM”. This will be pronounced as two syllables: “fah-numb”.

68. The first syllable of all of the marks is identical. The second syllable differs, although it does sound somewhat similar as only the end of the sound differs. I therefore consider that the opponent's earlier '663, '783 and '323 marks are similar to the contested mark to a high degree.

Conceptual comparison

69. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and the CJEU including Ruiz Picasso v OHIM.[8] The assessment must be made from the point of view of the average consumer.

70. The opponent submits that there can be no conceptual comparison made as both marks are invented terms. I agree with this submission. Conceptually, all of the marks are invented words and have no meaning. As neither mark has a meaning that is immediately graspable to the average consumer, the marks are conceptually neutral.

Average consumer and the purchasing act

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

[8] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

72. In its written submissions, the opponent submits that, due to the highly specialised nature of the goods in question, consumers are likely to pay a high degree of attention during the purchasing process. In its counterstatement, the applicant also states that the consumer would pay a high degree of attention, and that they would be a highly skilled professional.

73. I accept with the submissions from both parties. The goods and services in question are highly specialised and will be purchased by skilled professionals procuring machines or services for industrial settings. The goods and services are likely to be purchased infrequently and they are likely to be of a relatively high value.. Taking all of this into account, I consider that the average consumer would pay a high degree of attention during the purchasing process.

74. The goods and services at issue will be purchased through catalogues or online. Advice may be sought from a sales advisor in relation to all of the goods and services, and there is the possibility of word-of-mouth recommendations. Aural considerations will therefore play an important role in the purchasing act. However, I consider that visual considerations will play a larger role as the consumer will see the products in the catalogue or on the website.

Distinctive character of the earlier trade mark

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

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

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

76. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

77. The opponent submits that its mark is highly inherently distinctive. The earlier marks are invented words which have no evident meaning and do not allude to or describe the goods and services at issue. Therefore, I am of the view that the earlier marks are inherently distinctive to a high degree.

78. As the opponent has filed evidence, I will proceed to consider whether the distinctiveness of the earlier marks have been enhanced. The turnover figures in the table provided in Mr Noda's witness statement are significant, although there is no indication as to the market share that the opponent holds. I also note that, although the turnover figures are relatively high, they do not equate to large numbers of items sold by the opponent. There are also no details regarding the amount spent on advertising the goods and services. Overall, I do not consider that the distinctiveness of the earlier marks has been enhanced to a higher degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

79. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be

borne in mind. The first is the interdependency principle, i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods (or services) and vice versa (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

80. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

81. Earlier in this decision, I found the goods and services to range from a medium similarity to identical. I found the marks to have a high visual similarity, and a high level of aural similarity. I found the marks to be conceptually neutral. I found the opponent's earlier registrations to possess a high level of inherent distinctive character for the relevant goods. I identified the average consumer to be a skilled professional paying a high degree of attention. I found that the goods would be selected by both visual and aural means, with visual means dominating the purchasing process.

82. Considering direct confusion, I note the high visual and aural similarity. Whilst I note the differences, being that the fifth letter being "M" in the earlier marks and "C" in the contested mark, as noted above, I consider that this difference being at the end of the marks makes it less obvious to the consumer.[9] Bearing in mind the consumer's imperfect recollection, and notwithstanding the high degree of attention that would be paid, I am satisfied that the average consumer would likely fail to notice or misremember the change of letter at the end of the marks in respect of the similar goods and services.. The average consumer would therefore mistake the parties' marks for each other in respect of the same.

[9] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

83. I therefore find there to be a likelihood of direct confusion between the parties' marks for all of the applicant's goods and services.

Final Remarks

84. The opposition under section 5(2)(b) has been successful in respect of all of the applicant's goods and services. Subject to any successful appeal, the application will be refused in its entirety.

COSTS

85. The opponent has been successful in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £1300 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Preparing and filing the TM7 and statement of grounds and considering the TM8 and counterstatement:	£250
Official fee:	£100
Preparing evidence:	£600
Filing submissions-in-lieu:	£350
Total:	**£1300**

86. I therefore order FANUM sp. z o. o. sp. k. to pay FANUC CORPORATION the sum of £1300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of October 2025

K HARBACH

For the Registrar