

O-290-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2209133 AND 2209134
BY WI-FI ALLIANCE
TO REGISTER THE CERTIFICATION MARKS:**



AND

WI-FI

IN CLASS 9

AND

**THE OPPOSITIONS THERETO
UNDER NOS 52854 AND 52855
BY
WILHELM SIHN JR KG**

Trade Marks Act 1994

**In the matter of application nos 2209133 and 2209134
by Wi-Fi Alliance
to register the certification marks:**



**and
WI-FI
in class 9
and the oppositions thereto
under nos 52854 and 52855
by Wilhelm Sihh Jr KG**

BACKGROUND

1) On 21 September 1999 Wireless Ethernet Compatibility Alliance, Inc (now called Wi-Fi Alliance), which I will refer to as Alliance, applied to register the above two certification marks. The certification marks have a priority date of 15 September 1999, from the United States of America. The applications were published for opposition purposes in the "Trade Marks Journal" on 18 April 2001 with the following specification:

computer hardware and peripherals, namely wireless local area networking products

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 18 July 2001 Wilhelm Sihh Jr KG, which I will refer to as Sihh, filed notices of opposition to the applications. Sihh is the owner of United Kingdom trade mark registration no 810576 for the trade mark **WISI**. The application for registration was filed on 10 September 1960 and the registration process was completed on 24 May 1961. The registration has been subject to an action for revocation for non-use action by Alliance. As a result of this action the specification was limited, with effect from 25 May 1966, to the following specification of goods:

apparatus and instruments for receiving, transmitting, amplifying, processing and measuring television signals, apparatus and instruments for receiving, transmitting, amplifying, processing and measuring radio frequency signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes; parts and fittings for the aforesaid goods.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15

June 1957, as revised and amended. Sihh claims that the respective marks are similar and that the respective goods are identical or similar. Consequently, there is a likelihood of confusion and so registration of the certification marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). Sihh seeks the refusal of the applications.

3) Alliance denies that the marks are similar. It states that a certification mark performs a different function from that of a trade mark, which further eliminates the likelihood of confusion. Alliance states that it is a condition of registration of the certification marks that they shall not be used in the United Kingdom or in the Isle of Man without indicating that they are certification marks. It claims that this further eliminates the risk of confusion. Alliance requests the rejection of the oppositions and an award of costs.

4) Both sides filed evidence. The evidence for each case, with the exception of reference numbers, is identical. The issues in these cases are either identical or very similar. These cases should have been consolidated once the proceedings had been joined by Alliance. I will treat the cases as if they had been consolidated and make an appropriate adjustment in costs because of this.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Both sides filed written submissions. Consequently, this decision is made from the evidence and written submissions before me.

EVIDENCE

Evidence of Sihh

6) This consists of a witness statement by Waldemar Leitner. Mr Leitner is a German patent and trade mark attorney. He has a background in physics and has a doctorate in technical sciences. He has acted for Sihh since 1994. He has drafted a number of patent applications in the field of communication technology and high frequency connection technology for Sihh. Mr Leitner states that he has a good background in the technologies involved in wireless networks; in particular in local area, wide area and global area wireless networks. He exhibits at WL1 a copy of brochure entitled 'Signals' which he states has been distributed in the United Kingdom since 1995.

7) Mr Leitner states that in wireless networks there is wireless communication between products ie computers that are incorporated in such a wireless network. He states that a wireless local area network is inevitably connected with the use of antennae as only antennae are capable of receiving and transmitting signals. The wireless signal received by the antenna allocated to a wireless networking product then must be transmitted via radio frequency cables or optical fibres to the product itself in order to establish a connection between the antenna and the wireless networking product. Mr Leitner states that antennae are, therefore, indispensable parts of wireless local area networks; they constitute peripherals of wireless networking products. Exhibited at WK2 is a hard copy

of a CD-ROM catalogue published by Sihm in the year 2000. Mr Leitner states that this catalogue shows that Sihm produces and sells all kinds of antennae, inter alia: FM, VHF, UHF, UHF broadband and VHF-UHF multiband. He states that all of these antennae are radio frequency antennae and can be used to transmit television, video and audio signals. They can also be used to receive and transmit radio frequency signals containing data, messages and information as the information carried by a signal (video, audio or data) does not have a major influence on the technology employed. Mr Leitner states that based upon his technical experience antennae sold by Sihm can be used and are used in local area networks.

8) Mr Leitner states that the wireless signal transmitted and/or received respectively by the antenna must be led from the antenna to the product itself by means of an electrical radio frequency cable or by an optical fibre. Mr Leitner states that in order to facilitate his explanation he will concentrate on the reception of a wireless signal by an antenna and its transmission to the product itself. He states that the same explanation applies, mutatis mutandis, to the transmission of a wireless signal by an antenna in which the signal is led from the networking product eg a computer by means of a cable connection to the antenna. In order to ensure a good signal quality when leading the signal from the networking product to the antenna and vice versa, radio frequency cables and radio frequency cable connection terminals must be employed. Mr Leitner states that pages 3.01 – 3.05 of the catalogue shows these kinds of cable connection terminals. He states that Sihm also produces coaxial cables for the connection of antennae and the corresponding wireless networking products as per pages 4.01 - 4.03 of the catalogue. Mr Leitner states that the amplifiers shown on pages 5.01 – 5.10 of the catalogue can also be used, and are used, in wireless networks. He refers to page 5.11 of the catalogue which states that the WISI global line system comprises an amplifier and fibre nodes for universal application in large HFC (hybrid fibre coaxial) based distribution networks with heavy channel loads. He states that this clearly demonstrates that Sihm's products are to be employed in a network. Mr Leitner states that the satellite antennae depicted on pages 7.01 – 7.05 of the catalogue are also employed in wireless networks. He states that page 8.05 of the catalogue shows that Sihm is selling wireless television and audio transmission systems, used in particular for monitoring and observation as well as security purposes. It would appear that Mr Leitner means page 8.06. He states that the functional principle of such a wireless local area network is described on page 8.06:

“The functional principle is simple. Instead of making a connection with incoming and outgoing cables the WISI directional radio system connects wireless, even at greater distances.”

Mr Leitner states that the data produced by a video camera, nowadays digital data, is sent wirelessly to a receiving station in order to evaluate the data. The receiving station is or includes a computer in order to evaluate the digital video data.

9) Mr Leitner states that Sihm, as shown on pages 9.01 – 9.05 of the catalogue, also produces devices and components such as optical transmitters and receivers to be

employed in telecommunication fibre optical systems. The following appears on page 9.01:

“As before TV and Radio signals are distributed to the subscriber. Additionally data are carried back and forth between the client and the headend system. These data may be internet access, telephony, remote reading of water and electricity meter.”

Mr Leitner states that optical fibre networks are complementary to wireless networks as they both represent state of the art technology to distribute messages, data and information.

Evidence of Alliance

10) This consists of a declaration by Paul Meche. Mr Meche is the secretary of Alliance and, at the time of this signing the declaration, had been associated with it for a year. He states that Alliance adopted the two certification marks worldwide in March 2000, including specifically in the United Kingdom. He states that since that time Alliance has been continuously and extensively certifying numerous products including all of those included in the specifications of the applications. Mr Meche states that, to the best of his knowledge, in the four years of use of Alliance’s certification marks there have no instances of confusion with the trade mark of Sihh. He states that in that time there have been numerous conferences, workshops, media coverage and press coverage in relation to the certification process and the technology certified under the certification marks. Mr Meche states that numerous products are certified under its certification marks in the United Kingdom in a number of sectors, including finance, transportation, manufacturing, healthcare and networking. He states that numerous multi-national companies have been manufacturing products submitted for certification by Alliance by reference to its certification marks; these include: Apple, AT&T, Aviva, Cisco Systems, Dell, Hewlett Packard, Hitachi, IBM, Intel, Microsoft, Motorola, Nokia, Philips, Panasonic, Samsung Electro Mechanics, Sony, Toshiba and Toyota. Alliance operates a website which provides extensive information regarding the methodology by which it certifies various products. Mr Meche states that Alliance has over two hundred member companies, most of whom have products certified by it. At exhibit A there is a list of the companies. Mr Meche states that Alliance has spent millions of dollars globally on the promotion of its certification marks.

Likelihood of confusion – section 5(2)(b) of the Act

11) Section 1(2) of the Act states:

“(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see section 49) or certification mark (see section 50).”

Section 50 (2) of the Act states:

“(2) The provisions of this Act apply to certification marks subject to the provisions of Schedule 2.”

Consequent upon the above the provisions of section 5(2)(b) of the Act apply to certification marks. According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

The registered trade mark is an earlier trade mark within the meaning of the Act.

12) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P*.

Average consumer and the purchasing process

13) A local area network (LAN) is a computer network that covers a local area; this could be an office, a group of buildings or a home. LANs connect workstations, personal computers and devices such as printers. The purchase of LAN devices is likely to be the result of a careful and educated decision making process; there are issues of compatibility, robustness and technical support to be considered. This decision making process is likely to be the same if the purchase is for the office or the home. These are not products bought in a supermarket dash. If the purchaser of the goods of Sihm is buying the goods for home use, he or she is likely to exercise a good deal of care to be certain of compatibility and reliability. The home purchaser is likely to be an intermittent purchaser and so is likely to use a good deal of care and consideration in the purchase. The commercial purchaser will have expertise and knowledge and will make the purchase after a good deal of consideration.

Comparison of trade marks

14) The marks to be compared are:

Sihn's trade mark:

WISI

Alliance's certification marks:

WI-FI



15) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

16) I consider that there is no distinctive and dominant component in the word marks. In the stylised certification mark it is the word that is the distinctive and dominant component. I will consider Alliance's word only mark first. The public are used to hearing and seeing Hi-Fi and Sci-Fi. Consequent upon this knowledge, I consider that the collective mark will be seen as the phonetic equivalent of Why Fie. I can not envisage pronouncing Sihn's trade mark in a similar fashion. I consider that it will be pronounced as wizee. So there is no common phonetic element. Consequently, I consider that the marks are not only not phonetically similar but are phonetically dissimilar. WISI has no meaning as far as I know. I have no evidence that at the date of application that WI-FI had any meaning. There is an absence, therefore, of both conceptual similarity but there is also no conceptual dissonance, so the conceptual position is neutral. This leaves the visual impression. The differences rest with the third letters and the hyphen. In word marks the visual similarity has to be considered in relation to the perception that arises from the use of words and letters. The eye sees but it is the brain that perceives and the brain will perceive on the basis of what it has learnt. Part of what it will have learnt is the differentiation between letters; language would become rather difficult if the brain could not identify the differences between words by their differences; phonemes would not work, they would not exist. Of course, by their nature phonemes exist in words with meanings, in this case the words are without

meaning. In short words a small difference will be noticed, in this case the difference represents a quarter of the word. Differences as well as similarities have to be taken into account when considering similarity. Taking into account the lack of meaning of the marks and the common elements, I have come to the conclusion that the respective marks are visually similar, if not overwhelmingly so, owing to the nature of the marks. **Taking into account the phonetic dissimilarity, the neutral conceptual position and the degree of visual similarity, I conclude that overall the respective marks have a low degree of similarity.**

17) Most of what I have written above in relation to the word only mark also applies to the stylised mark. The presentation of the “Wi” and “Fi” elements in title case will, in my view, lead to the same phonetic dissimilarity. There is the same conceptual neutrality. The stylisation, to my eyes, separates the two word elements more; the “Fi” element emphasises the letter “F” through its capitalisation. The stylisation is relatively simple, but none the less striking. The use of the contrasting black and white emphasises the separate nature of the “Wi” and “Fi” elements. Having similarities does not mean that things are similar, the two should not be conflated. Again the differences between the marks have to be taken into account. It is my conclusion that the marks are not visually similar. **Consequently, I find that the marks are not similar.** I am fortified in this view by the nature of the average consumer, the purchasing process and the resulting perception of the average consumer. In the context of the goods, and the scrutiny used in their purchase, I do not consider that the average consumer will find the marks similar.

Comparison of goods

18) The goods of the earlier trade mark are:

apparatus and instruments for receiving, transmitting, amplifying, processing and measuring television signals, apparatus and instruments for receiving, transmitting, amplifying, processing and measuring radio frequency signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes; parts and fittings for the aforesaid goods.

The goods of the certification marks are:

computer hardware and peripherals, namely wireless local area networking products

19) Mr Meche comments upon what Sihm does and makes references to the catalogue. What is shown in the catalogue and what Sihm does are not necessarily the same as what the specification covers. It is the specification of the earlier registration that has to be considered. However, Mr Meche refers to products which are encompassed by the specification of the earlier registration. He makes statements as to the close relationship between wireless networks and various of the goods of the earlier registration (see paragraphs 7 and 8). A wireless network must include, inter alia, LANs. Mr Meche’s evidence was put up front, it is clear and definite. Alliance put in no evidence to

contradict the evidence of Mr Meche. In its submissions Alliance refers to the different operating system that it uses. The specification covers all potential operating systems and it is the specification that has to be considered. Anyway, submissions are not evidence and Alliance had the opportunity to file evidence to contradict and challenge what Mr Meche says. In a technical area such as this I will be guided by the evidence; it comes from one side only, Sihh. There is nothing in Mr Meche's evidence that strikes me as being contradictory or illogical. **I take the view that Sihh has established that peripherals of its applications contain some goods that would be identical to the goods of the earlier registration and so the respective goods must be considered to be identical** (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05 where the Court of First Instance (CFI) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

In relation to the other goods Sihh has established that there is a dependent relationship and so that the goods are highly complementary. **In my view it has, consequently, established that the remaining goods are highly similar.**

Conclusion

20) To succeed under section 5(2)(b) of the Act the marks have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel BV v Puma AG*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public.”

The ECJ in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models)* (OHIM) stated:

“51 For the purposes of applying Article 8 (1)(b) of Regulation No 40/94, the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the

earlier mark is registered. Those conditions are cumulative (see to that effect, on the identical provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 22).

52 Contrary to Vedral's claim, the Court of First Instance did not rely on the visual, aural and conceptual differences between the earlier mark and the mark applied for in deciding that there was no likelihood of confusion.

53 After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

54 Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned."

21) Owing to the lack of similarity between the stylised mark (the subject of application no 2209133) and the earlier trade mark, there cannot be a likelihood of confusion. There can be no global appreciation where one of the two fundamental building blocks is missing; the cumulative process collapses. If the marks aren't similar there is just not going to be confusion.

22) This leaves the non-stylised collective mark. In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between the marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are identical or highly similar. There is a low degree of similarity between the marks. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). The earlier trade mark does not refer or allude to the goods for

which it is registered. It is an invented word; probably derived from the name of the proprietor, **Wilhelm Sihh**. In my view it has a high degree of inherent distinctiveness. In the other scale of the balance are the limited similarity of the marks and the nature of the purchasing process. In considering the limited similarity it is necessary to bear in mind that the goods are likely to be bought by the eye rather than orally and so the limited visual similarity has to have an increased weight. The goods, as has been discussed, will be bought as the result of a careful purchasing process. The customer will spend some time considering them and the mark that is used in relation to them. **Taking this into account and the phonetic dissonance, which cannot be strictly compartmentalised, it is going to flow into the visual perception of the mark, I have come to the conclusion that there is not a likelihood of confusion.**

23) In its evidence Alliance referred to its use of the certification marks and the absence of evidence of confusion. However, there has been no clear evidence of the nature of the use in the United Kingdom. This claim tells me nothing. An absence of confusion would anyway tell one little in relation to a likelihood of confusion as noted by Millet LJ in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

Alliance also makes reference to the marks being certification marks and governed by regulations. These regulations are subject to change, they do not set the use of the certification marks in aspic; regulations can be and are amended. I have to consider the marks in the manner in which they have been applied for and for the goods that the specification covers. Alliance submits that the its marks, being certification marks, do not and cannot indicate origin. The average customer is very unlikely to know about certification marks, he or she will just see a mark. Alliance also submits that goods bearing the marks will normally carry trade marks. This may be likely but it is not certain and it is not relevant. I have to consider normal and fair use of the certification marks based on their specifications and their inherent characteristics. It is also not uncommon for computer products to bear several trade marks, the computer in front of me bears three different trade marks of three different undertakings.

COSTS

Wi-Fi Alliance having been successful is entitled to a contribution towards its costs. I order Wilhelm Sihh Jr KG to pay Wi-Fi Alliance the sum of £900 This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of October 2006

**David Landau
For the Registrar
the Comptroller-General**