

IN THE MATTER OF APPLICATION NOS. 2209133 AND 2209134 IN THE  
NAME OF WI-FI ALLIANCE

AND IN THE MATTER OF OPPOSITION NOS. 52854 AND 52855 THERETO BY  
WILHELM SIHN JR KG

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DECISION

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Introduction

1. On 21 September 1999 Wireless Ethernet Compatability Alliance Inc (now called Wi-Fi Alliance) applied to register (1) the word WI-FI and (2) the device reproduced below as certification marks in Class 9. Both applications were published for opposition purposes with the specification “computer hardware and peripherals, namely wireless local area networking products”.



2. The applications were subsequently opposed by Wilhelm Sihh Jr KG on the ground that registration of the marks applied for would be contrary to section 5(2)9b) of the Trade Marks Act 1994 having regard to its earlier United Kingdom registration No. 810575 for the trade mark WISI. As a result of the decision of Geoffrey Hobbs QC sitting as the Appointed Person in *WISI Trade Mark* [2006] RPC 22, the specification of the opponent’s registration was restricted with effect from 25 May 1966 to the following 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.

3. Both sides filed evidence and written submissions, but neither requested an oral hearing. In a written decision dated 16 October 2006 (O/290/06) David Landau acting for the Registrar dismissed both oppositions. The opponent now appeals. As before the hearing officer, both parties filed written submissions and requested that I decide the matter on the papers without the benefit of an oral hearing.

#### Section 5(2)(b) of the Trade Marks Act 1994

4. Section 5(2)(b) provides:

(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 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

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5. This provision implements 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.

#### The hearing officer's decision

6. Having summarised the evidence filed by the parties, the hearing officer began his decision by stating that he took into account the guidance provided by the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v*

*Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881 and Case C-106/03P *Vedial SA v OHIM* [2004] ECR I-9573.

7. The hearing officer next considered the identity of the average consumer of the goods in question and the care that would be taken in their purchase as follows:

[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 Sihh 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.

8. With regard to the comparison between the respective trade marks, the hearing officer's analysis was as follows:

[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 Sihh'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 emphasizes 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.

9. On comparing the goods, the hearing officer found that some of the goods covered by the applications were identical to goods covered by the opponent’s registration and the remainder were highly similar.

10. The hearing officer expressed his overall conclusions as follows:

[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 Sihm**. 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.**

11. Finally, he added that the applicant's claim that there had been no evidence of confusion despite it having used its marks was unpersuasive.

#### Standard of review

12. This appeal is a review of the hearing officer's decision. The hearing officer's decision involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

A decision does not contain an error of principle merely because it could have been better expressed.

### The appeal

13. It is convenient to begin by considering the opponent's appeal against the hearing officer's decision so far as it relates to the word mark.
14. The opponent contends that the hearing officer erred in the following respects. First, in failing to apply the interdependency principle established by the jurisprudence of the ECJ. Secondly, in failing to take into account the highly distinctive character of the opponent's mark. Thirdly, in wrongly concluding that the goods in question would be purchased with considerable care and attention. Fourthly, in wrongly concluding that the marks were phonetically dissimilar. Fifthly, in wrongly concluding that the marks were not very visually similar. Sixthly, in failing to make allowance for imperfect recollection.
15. In none of these respects, however, has the opponent identified any error of principle on the part of the hearing officer. Furthermore, in three cases the opponent's submissions that the hearing officer failed to take something into account are simply wrong.
16. So far as the first point is concerned, the hearing officer did expressly apply the interdependency principle in paragraph [22] of his decision, which I have quoted above. Furthermore, he found in the opponent's favour that the goods were identical or highly similar and expressly took this into account in his overall assessment of the likelihood of confusion.
17. As to the second point, again the hearing officer expressly found that the opponent's mark had a high degree of inherent distinctiveness and took this

into account in his assessment of the likelihood of confusion in paragraph [22] of his decision.

18. So far as the third point is concerned, the hearing officer addressed this question in paragraph [13] of his decision, which I have quoted above. While I myself might not have put the degree of care that would be exercised quite as high as he did, I see no error of principle in his reasoning and I consider that his conclusion was one that was open to him on the evidence.
19. With regard to the fourth point, in the absence of evidence as to how the marks were pronounced by members of the public, the hearing officer had to make his own assessment. While I have some sympathy with the opponent's argument that both marks are open to a variety of pronunciations, I again see no error of principle in the hearing officer's decision on this point. Equally, it seems to me that the hearing officer could legitimately have concluded that there was a greater degree of conceptual difference between the marks than he did given that WISI is (as he found) meaningless while WI-FI in the context of the applicant's goods is a fairly obvious abbreviation of WIreless FIdelity; but I consider that the hearing officer was entitled to take the view that he did.
20. As for the fifth point, the hearing officer's finding was that the marks were "visually similar, if not overwhelmingly so". In my judgment this assessment is unimpeachable.
21. So far as the sixth point is concerned, the hearing officer expressly reminded himself of the need to allow for imperfect recollection in paragraph [15] of his decision. I see no reason to believe that he had forgotten this by the time he got to paragraph [22].
22. I therefore conclude that the hearing officer made no error of principle in his decision with regard to the word mark, and was entitled to conclude that there was no likelihood of confusion.

23. So far as the device mark is concerned, the opponent makes essentially the same points, but adds with regard to the fifth point that the hearing officer was wrong to conclude that the marks were “not visually similar” and therefore “not similar” overall. In my judgment this point is well founded. I consider that this is a further instance of the same error of principle which Mr Hobbs QC corrected in *Citybond Holdings plc’s Application* (O/136/05) and which I corrected in *Hyundai Mobis Co Ltd’s Application* (O/20/07). Given that the device mark consists primarily of the letters WI-FI and that three out of four letters are the same as in the mark WISI, I do not think that it can possibly be said that there is either no visual similarity or no similarity overall. Furthermore, I consider that the hearing officer’s assessment in this regard was inconsistent with his assessment of the degree of similarity in the case of the word mark.
24. That said, however, I consider that, even if the hearing officer had correctly assessed the two marks as having some degree of similarity, he would nevertheless have been bound to conclude that the likelihood of confusion was no greater in the case of the device mark than in the case of the word mark. Indeed, any other conclusion would have been perverse. Given that I have not overturned his decision with regard to the word mark, I do not consider that it would be right for me to reach a different conclusion with regard to the device mark.
25. I am fortified in this view by the decision of First Board of Appeal of OHIM dated 26 October 2006 in Case R 864/2005-1 rejecting an opposition by the opponent based on a Community registration for its WISI mark to an application by the applicant to register the device mark as a Community collective mark. The Board concluded that there was no likelihood of confusion despite the identity of the respective goods due to the differences between the respective marks, and in particular the visual and conceptual differences.

### Conclusion

26. The appeal is dismissed.

Costs

27. The hearing officer ordered the opponent to pay the applicant the sum of £900 as a contribution to its costs. I will order the opponent to pay the additional sum of £200.

5 April 2007

RICHARD ARNOLD QC

Eleanor Coates of Murgitroyd & Co Ltd made written submissions on behalf of the opponent (appellant).

Chris Parry of Saunders & Dolleymore made written submissions on behalf of the applicant (respondent).