


**O/788/18**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 278 789:  FOR  
GOODS IN CLASS 09 BY BROADSTONE ENGAGE LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY BERGHOF GMBH

## Background and pleadings

1. Broadstone Engage Limited (the applicant) applied to register the trade mark



No 3 278 789: in the UK on 22<sup>nd</sup> December 2017. It was accepted and published in the Trade Marks Journal on 19<sup>th</sup> January 2018 in respect of the following goods in Class 09:

*Computer software; computer software applications for mobile communication devices; downloadable computer software; computer hardware; computer software applications for managing, searching and booking security services.*

2. Berghof GmbH (the opponent) oppose the trade mark on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of its



earlier European Union Trade Mark No 1 168 738: The following Class 09 goods are relied upon in this opposition:

*Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, monitoring, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, storing, regulating or controlling electricity; equipment for recording, transmission or reproduction of sound or images; magnetic data carriers, gramophone records; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing hardware, computers; computer software; fire-extinguishing equipment; scales; displays; measuring, counting, recording, monitoring, testing, electronic and electrical regulation and control apparatus (included in this class); traffic lights [light-signal systems]; analysis equipment, not for medical purposes; analysis equipment for determining water content with and without computer-aided control; connectors for electrical leads; apparatus and instruments for scientific research in*

*laboratories; autoclaves for laboratory and technical purposes with and without computer-aided control; automatic elution apparatus for scientific and laboratory purposes; facsimile transmission apparatus; chemistry apparatus and instruments; chromatography apparatus for laboratory purposes; computers; computer operating programs [stored]; computer peripherals; computer programs [downloadable]; computer programs; computer software [stored]; computer software; computer keyboards; data-processing equipment; detectors; diagnostic apparatus, not for medical purposes; pressure measuring equipment; pressure recorders; electrical systems for remote control of industrial processes; electrical connectors; electrical resistance heating wires; electrical and electronic monitoring and control apparatus; electronic display panels; electronic pens [for video display units]; receiving apparatus [sounds or images]; remote control devices; fluoroplastics laboratory apparatus; gas analysis equipment; printed circuit boards; printed circuits; hardware for data processing; integrated circuits; interfaces [interface devices or programs for computers]; boiler control devices; plastics components for separating gases and liquids as parts of physical and electrotechnical apparatus; laboratory pressure vessels; guide systems consisting of electrical and electronic control, monitoring and regulating apparatus for goods handling; air analysis equipment; solenoid valves [electromagnetic switches]; solenoid valves; materials testing instruments and machines; membranes for scientific apparatus; microprocessors; microwave devices for laboratory purposes with and without computer control; monitors [computer hardware]; monitors [computer programs]; physical apparatus and instruments; test stands consisting of test apparatus for vehicle maintenance; relays [electrical]; switchboards; switches; switching devices [electrical]; transmitters for electronic signals; signal remote control apparatus [electrodynamic]; signal boards, luminous or mechanical; probes for scientific purposes; temperature indicators; electronic temperature regulators; pressure indicator plugs for valves; junction sleeves for electric cables; water level indicators; laboratory apparatus for scientific and technical purposes; central processing units [for data processing]; control devices for machines or engines; temperature regulators; electrical heating blocks. Goods and services limited to: Scientific, nautical, surveying, photographic,*

*cinematographic, optical, weighing, measuring, signalling, monitoring, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, storing, regulating or controlling electricity; equipment for recording, transmission or reproduction of sound or images; magnetic data carriers, gramophone records; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing hardware, computers; computer software; fire-extinguishing equipment; scales; displays; measuring, counting, recording, monitoring, testing, electronic and electrical regulation and control apparatus (included in this class); traffic lights [light-signal systems]; analysis equipment, not for medical purposes; analysis equipment for determining water content with and without computer-aided control; connectors for electrical leads; apparatus and instruments for scientific research in laboratories; autoclaves for laboratory and technical purposes with and without computer-aided control; automatic elution apparatus for scientific and laboratory purposes; facsimile transmission apparatus; chemistry apparatus and instruments; chromatography apparatus for laboratory purposes; computers; computer operating programs [stored]; computer peripherals; computer programs [downloadable]; computer programs; computer software [stored]; computer software; computer keyboards; data-processing equipment; detectors; diagnostic apparatus, not for medical purposes; pressure measuring equipment; pressure recorders; electrical systems for remote control of industrial processes; electrical connectors; electric controls for heating blocks; electrical and electronic monitoring and control apparatus; electronic display panels; electronic pens [for video display units]; receiving apparatus [sounds or images]; remote control devices; fluoroplastics laboratory apparatus; gas analysis equipment; printed circuit boards; printed circuits; hardware for data processing; integrated circuits; interfaces [interface devices or programs for computers]; boiler control devices; plastics components for separating gases and liquids as parts of physical and electrotechnical apparatus; laboratory pressure vessels; guide systems consisting of electrical and electronic control, monitoring and regulating apparatus for goods handling; air analysis equipment; solenoid valves [electromagnetic switches]; solenoid valves; materials testing*

*instruments and machines; membranes for scientific apparatus; microprocessors; microwave devices for laboratory purposes with and without computer control; monitors [computer hardware]; monitors [computer programs]; physical apparatus and instruments; test stands consisting of test apparatus for vehicle maintenance; relays [electrical]; switchboards; switches; switching devices [electrical]; transmitters for electronic signals; signal remote control apparatus [electrodynamic]; signal boards, luminous or mechanical; probes for scientific purposes; temperature indicators; electronic temperature regulators; pressure indicator plugs for valves; junction sleeves for electric cables; water level indicators; laboratory apparatus for scientific and technical purposes; central processing units [for data processing]; control devices for machines or engines; temperature regulators; electrical heating blocks. Goods and services limited to: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, monitoring, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, storing, regulating or controlling electricity; equipment for recording, transmission or reproduction of sound or images; magnetic data carriers, gramophone records; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing hardware, computers; computer software; fire-extinguishing equipment; scales; displays; measuring, counting, recording, monitoring, testing, electronic and electrical regulation and control apparatus (included in this class); traffic lights [light-signal systems]; analysis equipment, not for medical purposes; analysis equipment for determining water content with and without computer-aided control; connectors for electrical leads; apparatus and instruments for scientific research in laboratories; autoclaves for laboratory and technical purposes with and without computer-aided control; automatic elution apparatus for scientific and laboratory purposes; facsimile transmission apparatus; chemistry apparatus and instruments; chromatography apparatus for laboratory purposes; computers; computer operating programs [stored]; computer peripherals; computer programs [downloadable]; computer programs; computer software [stored]; computer software; computer keyboards; data-processing equipment; detectors; diagnostic apparatus, not for medical*

*purposes; pressure measuring equipment; pressure recorders; electrical systems for remote control of industrial processes; electrical connectors; electric controls for heating blocks; electrical and electronic monitoring and control apparatus; electronic display panels; electronic pens [for video display units]; receiving apparatus [sounds or images]; remote control devices; fluoroplastics laboratory apparatus; gas analysis equipment; printed circuit boards; printed circuits; hardware for data processing; integrated circuits; interfaces [interface devices or programs for computers]; boiler control devices; plastics components for separating gases and liquids as parts of physical and electrotechnical apparatus; laboratory pressure vessels; guide systems consisting of electrical and electronic control, monitoring and regulating apparatus for goods handling; air analysis equipment; solenoid valves [electromagnetic switches]; solenoid valves; materials testing instruments and machines; membranes for scientific apparatus; microprocessors; microwave devices for laboratory purposes with and without computer control; monitors [computer hardware]; monitors [computer programs]; physical apparatus and instruments; test stands consisting of test apparatus for vehicle maintenance; relays [electrical]; switchboards; switches; switching devices [electrical]; transmitters for electronic signals; signal remote control apparatus [electrodynamic]; signal boards, luminous or mechanical; probes for scientific purposes; temperature indicators; electronic temperature regulators; pressure indicator plugs for valves; junction sleeves for electric cables; water level indicators; laboratory apparatus for scientific and technical purposes; central processing units [for data processing]; control devices for machines or engines; temperature regulators [machine parts]; electrical heating blocks.*

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.

5. Neither side filed evidence. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## **DECISION**

### **Section 5(2)(b)**

6. 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”.

## **Comparison of goods and services**

7. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

8. 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.

9. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 für 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”.

10. The later goods are: *computer software; computer software applications for mobile communication devices; downloadable computer software; computer software applications for managing, searching and booking security services.*



The earlier goods are computer software at large. According to terms in Meric, they are clearly identical.

11. The remaining later term is: computer hardware. The earlier terms include *monitors [computer hardware]* and *computer keyboards*. Both are types of computer hardware and so, according to the terms in Meric, are also identical to the later term.



## Comparison of marks

12. 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 Court of Justice of the European Union 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.”

13. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

14. The respective trade marks are shown below:

|   |  |
|---|--|
|  |  |
| <p>Earlier trade mark</p>   | <p>Contested trade mark</p>  |

15. Both trade marks are figurative; the earlier mark contains the letter B encased in a black box together with a hexagon shape. It is clear that the letter B is the dominant element of the mark and catches the eye first. Though the hexagon may also be noticed, it is notably smaller. The later trade mark also contains the letter B displayed within a dark coloured box. There are differences in the exact presentation of the B as shown above. However, they have a notably similar overall impression for the reasons already outlined. As such, it is considered that there is a medium degree of visual similarity.

16. Aurally, it is considered highly likely that each of the trade marks will be referred to as “B” (bee). They are aurally identical.

17. Conceptually, each mark will be understood as the second letter of the English speaking alphabet. The hexagon in the earlier trade mark will be understood as representing a shape but this has no clear relationship with the letter B. As such, there is no conceptual gap. They are conceptually identical.

## Average consumer and the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

19. 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.”

20. The average consumer is both the public at large and the professional user (namely those involved in security). The goods in question are not everyday consumables and can be (at least relatively) expensive. They can be purchased in an online environment or at a bricks and mortar equivalent. The purchasing process is likely to involve research and reviews or word of mouth recommendations. Thus both visual and aural considerations are important. The degree of attention one would expect to be displayed during the purchasing process is at least medium and may in fact be high.

## Distinctive character of the earlier trade mark

21. 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 *Windsurfing Chiemsee 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).”

22. There is no claim from the opponent regarding an enhanced degree of distinctiveness. As such, the earlier trade mark must be assessed on a prima facie basis. It is noted that the applicant claims that the letter B, in itself is “substantially devoid of distinctive character”. The opponent on the other hand, argues that the earlier trade mark has no meaning in relation to the goods and as such there is no reason as to why B should have only a weak or low level of distinctiveness. It submits that the earlier trade mark has at the very least, an average degree of distinctiveness.

23. The distinctiveness of single letters as trade marks is only an issue when the letter is meaningful, for example the letter E in respect of electronic goods. There is no evidence to suggest that the letter B is meaningful in respect of these goods. As such, it is considered that B, in itself, is entirely meaningless in respect of the relevant goods in these proceedings. The earlier trade mark is distinctive to an average degree.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

24. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### *The principles*

(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.

25. The goods have been found to be identical. This is important as the interdependency principle is in full operation here. The trade marks are conceptually and aurally identical and visually similar to a medium degree. Notably, the marks coincide in respect of the letter B which is visually dominant (though it is appreciated that there are some differences in the respective presentation of the letter). The earlier trade mark is distinctive to an average degree. It is also noted that the relevant consumer will display a medium to high degree of attention during the purchasing process. This can negate against the effects of imperfect recollection, though will not eliminate it as even in such circumstances a mark can still be imperfectly recalled. It is true that the earlier trade mark includes an additional element that has no counterpart in the later trade mark, namely the hexagon shape. Though this is unlikely to go unnoticed on a visual appreciation, it is highly unlikely to be aurally articulated and does not have the impact of creating a conceptual gap. Bearing in mind all of the aforesaid, it is considered that the relevant consumer is likely to misremember the details as the overall impression of the respective trade marks is notably similar. As such, it is considered that it is likely that the relevant consumer will mistake one trade mark for the other and so it is concluded that there is a likelihood of direct confusion.

26. As such, the opposition succeeds in its entirety.

## **COSTS**

27. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement (and official fee) - £500

TOTAL - £500

28. I therefore order Broadstone Engage Limited to pay Berghof GmbH the sum of £500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 11<sup>th</sup> day of December 2018**

**Louise White**  
**For the Registrar**