

O/661/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3571179
IN THE NAME OF LG DISPLAY CO., LTD
IN RESPECT OF THE TRADE MARK**

Sapphire Black

IN CLASS 9

AND

**THE OPPOSITION THERETO UNDER NO. 600001788
BY PREMIER GROUP (UK) LTD**

Background and pleadings

Sapphire Black

¹ It was accepted and published in the Trade Marks Journal on 16 April 2021 in respect of the following goods:

Class 9: Televisions; digital signage; sound reproducing apparatus; telecommunication apparatus for use in cars; navigation apparatus for vehicles [on-board computers]; wrist mounted telecommunication machines and implements being watches; portable communications apparatus; wearable computers; smartphones; monitors; OLED panels; laptops [computers]; display apparatus; display panel; interactive whiteboards; computers; tablet PCs; holograms; optical film for polarizer; polarizer; OLED Polarizer; organic light emitting diodes (OLED).

2. Premier Group (UK) Ltd (“the opponent”) partially opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition was filed using the fast track opposition route. The opposed goods are set out below:

Class 9: Televisions; digital signage; portable communications apparatus; monitors; OLED panels; display apparatus; display panel; interactive whiteboards; computers; holograms; optical film for polarizer; polarizer; OLED Polarizer.

3. The opposition relies upon the opponent’s earlier UK Trade Mark registration number 2594673 for the word mark ‘Sapphire’ covering *Projection screens* in class 9. This mark holds a filing date of 15 September 2011 and a registration date of 30 December 2011. By virtue of its earlier filing date, it constitutes an earlier mark in accordance with section 6 of the Act.

4. In fast track opposition proceedings, Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235 (“the Fast Track Rules”),

¹ Priority claim from trade mark number 40-2020-0175286 located in Republic of Korea

disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. In addition, Rule (7) of the Fast Track Rules provides as follows:

“(7) Where the earlier mark is subject to proof of use under section 6A of the Act, the proof of use that the opponent wishes to rely upon shall be provided with the notice of fast track opposition.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions, other than where proof of use is required. Where proof of use is required, this should be filed with the initial Form TM7F.

7. In these proceedings, the opponent filed its initial proof of use evidence with its Form TM7F. The applicant's Form TM8 and counterstatement were received and in accordance with the fast track procedure, the case was considered ready for a decision to be issued. However, at that stage in the proceedings the opponent sought professional representation. The opponent's new representative requested leave to supplement the proof of use evidence and to amend the scope of question 11 within its Form TM7F. The impact of the amendment requested was to bring the opposition against an expanded list of services, namely those set out at paragraph 2 above. A Case Management Conference was held, and it was directed that the opponent may introduce the additional proof of use evidence into the proceedings and amend the scope of question 11 to its original Form TM7F. It was directed that as the evidence filed related strictly to proof of use of the earlier mark, the opposition may remain within the fast track proceedings, and the applicant was afforded an opportunity to make amendments to its original TM8 and counterstatement, which it did.

8. The opponent argues that the respective goods are identical or similar and that the marks are similar.

9. The applicant's counterstatement denies the claims, and states that the goods are dissimilar and the marks are easily distinguishable. It argues the opponent has not met the requirement for proving genuine use of its mark which it has requested.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; only the applicant filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

12. As identified above, the opponent's proof of use evidence was filed in two parts. I do not intend to summarise the evidence at this stage. However, I note the evidence includes an initial statement of use dated 16 April 2021 within the Form TM7F. The statement of use is made by Richard Thomas, the Managing Director of the opponent and is provided alongside Exhibits 1 to Exhibit 5. In addition, a further witness statement from Mr Thomas dated 2 December 2021 was filed along with a further four exhibits labelled Exhibit RT1 to RT4.

Proof of use

13. The relevant statutory provisions are as follows:

Relevant statutory provision: Section 6A:

“(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), (b) 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

14. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung Kameradschaft ‘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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

16. It is for the opponent to show that it has made genuine use of its mark within the relevant territory of the UK and within the relevant period, that being the five-year period preceding and ending with the priority date of the contested application, namely 6 October 2015 – 5 October 2020. The use shown must be in respect of the mark and the goods as relied upon.

Variant use

17. Some of the evidence shows the use of the mark with a small diamond shape sitting above the letter ‘I’. The text is also slightly stylised. Sometimes, it is shown to be used with the additional slogan ‘LIKE BEING THERE’. Examples of this use are as follows:



18. The earlier mark is registered as a word mark, which allows for its use in a range of standard colours and fonts and in upper-case and lower-case lettering, and this includes the presentation of the mark in slightly stylised uppercase lettering above, in addition to its presentation in blue as shown. In the second variant above, it is my view the wording ‘LIKE BEING THERE’ will be viewed as a promotional message, and I consider that the word ‘Sapphire’ maintains its role as an independent indication of origin within both of the examples above.² I therefore find use of the earlier mark in

² See paragraph 35 of *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 in which it states “...a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

the examples above to be use of an acceptable variant of the mark as registered for the purpose of evidencing use of the same.

Use of the mark

19. Both statements filed by Mr Thomas explain that the opponent has sold goods to the value of roughly £2.5 million a year under the mark over the past few years, and that prices of the goods vary from £28 to £2000 each. Whilst reference to sales "...over the last few years..." is vague, I note Mr Thomas' first statement is dated in 2021, and so it is reasonable to assume that this will cover at least part of the relevant period. In addition, invoices are provided at Exhibit RT1 showing sales were made throughout the relevant period. Whilst some of the invoices fall outside of the relevant period, a total of 24 invoices are provided from within the same, spread between 2016 and 2020. The majority show sales of between a few hundred pounds and a few thousand pounds. These show sales of goods to customers based in the UK within the relevant period, under descriptions such as 'Sapphire manual wall screen ...', 'Sapphire manual screen ...', 'Sapphire electric screen ...', 'Sapphire electric recessed screen ...' and 'Sapphire Tab Tensioned screen ...'.

20. Mr Thomas has also set out within both his statements that approximately £30,000 per annum is spent on marketing. It is not been made any clearer when the opponent began spending this sum of money on marketing in either statement. However, in his second statement Mr Thomas sets out that the opponent's main advertising route is via advertisements placed in trade magazines. Examples of adverts from these magazines are provided at Exhibit RT3, with one advert labelled by the opponent as '2016' showing as follows:

SAPPHIRE

"Ultimate Range"
of Tab Tensioned In-ceiling Screens

SSR from
Only £1,416.00

For when only the best will do ...



**5 Year
Warranty**

Imagine if

- * You had a screen that was almost invisible to visitors until in use. When you finish viewing the trap door closes magically to hide the fabric.
- * If the motor and the structure was designed to be whisper quiet.
- * If the screen was able to drop down automatically when you turn on your projector.
- * If the fabric was one of the best in the business for 4K projection giving vibrant colour with a perfectly flat soft tensioned surface.
- * If the product had a 5 year comprehensive warranty.

*Dreams are now
reality!*

Model Numbers	VIEWING SIZE (MM) (LxH)	SIZE (FEET)	CASING (MM) (LxHxD)	ASPECT
SETC200WSP-ATR	2030 x 1140	6'8" x 4'5"	2625 x 155 x 170	16:9
SETC240WSP-ATR	2340 x 1320	9'2" x 5'2"	2935 x 155 x 170	16:9
SETC270WSP-ATR	2670 x 1500	10'6" x 5'0"	3245 x 155 x 170	16:9

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21. Images of the packaged goods are provided as follows:



22. The evidence provided is not without its flaws, and more specific figures relating to the sale of the goods and the advertising spend would strengthen the same. In

addition, I note the promotional material provided by the opponent is limited. However, from the sum of the evidence, including the invoices from throughout the relevant time period to UK consumers relating to both the goods and the mark, the images of how the mark has been used within advertisements, and Mr Thomas' statement regarding the sales figures of £2.5 million 'over the last few years' clearly show that the mark has been put to use within the UK and within the relevant period, in respect of the goods relied upon. Further, whilst I have not been provided with any information as to the size of the market for the goods, it is my view that the level and consistency of the use evidenced shows a genuine attempt to create and maintain a share of the market in the UK. I therefore find the opponent to have shown genuine use in respect of 'Projection screens' as relied upon.

Decision

Section 5(2)(b)

23. 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

24. 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."

Likelihood of confusion (standard case law)

25. 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.

Comparison of goods and services

26. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

27. 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.

28. In the judgment of the Court of Justice of European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

29. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that goods may be considered “complementary” where:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

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

31. The goods for comparison are outlined in the table below:

Earlier goods	Contested goods
Class 9: Projection screens	Class 9: Televisions; digital signage; portable communications apparatus; monitors; OLED panels; display apparatus; display panel; interactive whiteboards; computers; holograms; optical film for polarizer; polarizer; OLED Polarizer.

32. It is my view that the contested goods *display apparatus* and *display panel* are identical to the earlier goods *projection screens* either self-evidently or in line with the principles set out in *Meric*. I consider that display apparatus will incorporate projection screens, and that a projection screen may also be referred to as a display panel. However, if I am wrong in my finding of identity in respect of display panels, I consider that both of the goods will be large flat screens for displaying images and therefore will be very similar in nature and intended purpose. I also consider that they are likely to be in competition on the basis that one might choose from a display panel or a projector screen for displaying images. It is my view they are likely to share trade channels and users, with them being sought for the same purpose. If they are not identical, I find the contested *display panels* to be highly similar to the opponent's *projection screens*.

33. I consider that the contested *digital signage* and *interactive whiteboards* are both of a similar nature and intended purpose to the opponent's goods, with these all typically being large flat screens for the display of images. Both projection screens and these contested goods may be used for either displaying advertisements in the case of digital signage, or for giving presentations or seminars in the case of interactive whiteboards, and as such there will be a level of competition between the same. However, I consider that the contested goods may house all of the required technology for the display of the images, whereas projection screens are likely to be reliant on

additional pieces of equipment. Despite the broader shared intended purpose, I do however note the differences in functionality between the goods, particularly in respect of interactive whiteboards which are likely to offer additional capabilities to projection screens generally. The consumers may be shared to the extent that the earlier goods and the contested goods may both be offered both to public and private sector educational institutions or to businesses generally. I consider the trade channels may also be shared, and that the contested goods are likely to be sold in the same specialised business technology wholesale stores as the earlier goods. I also consider that the similarities between the goods and the area of technology means it is likely the consumer will assume the goods are provided by the same undertaking. Overall, I consider these goods to be similar to the opponent's earlier goods to a medium degree.

34. In respect of *Televisions* and *monitors* I find these to be slightly further away in physical nature to the goods above, generally being slightly smaller in size and comprising black screens with a solid outer frame. However, I find televisions will be used in homes for the same purpose as projection screens, namely screening television programmes or films. I note therefore that there will be a level of competition between the goods, with the consumer choosing to purchase either a projection screen or a larger television for watching films at home. In addition, I note that professional consumers purchasing the goods on behalf of an educational institution may choose between either a projector screen or a large wall mounted monitor for using to teach classes or conduct presentations or seminars. I consider again they may both be sold in the same technology stores. Again, there will be differences in that televisions and monitors will likely have the required technology built in whereas projection screens may rely on another item such as a projector itself for their use. However, overall, I find the goods to share at least a medium level of similarity.

35. Without further evidence or submissions on this point from the opponent, it is my view that *optical film for polarizer; polarizer; OLED Polarizer* and *OLED panels* may in some circumstances be used to make projection screens. However, I consider that the nature, intended purpose, method of use and users will all differ. I do not consider the goods to be complementary or in competition. Whilst I therefore acknowledge it is possible these goods may form component parts of projection screens, I remind myself

of *Les Éditions Albert René v OHIM*, Case T-336/03, where the General Court found that:

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

36. In the absence of convincing submissions or evidence, I do not consider these goods to be similar.

37. In respect of the contested goods *portable communications apparatus* and *computers* I do not consider there will be a shared nature, method of use, or intended purpose with the earlier goods. I consider it is unlikely the goods will share specific trade channels or users, other than to the extent they may be sold to the general public in stores selling technological goods. I note that the goods may be used together on occasion, however, I do not consider the consumer would believe them to be offered by the same undertakings and I do not find them to be complementary or in competition with one another. Overall, I find these goods to be dissimilar to the opponent’s earlier goods.

38. In respect of the contested goods *holograms*, whilst I note these goods in addition to the opponent’s goods may both make use of or rely upon projectors, I do not consider they will have any similarity with projection screens in terms of nature or intended purpose. I find it unlikely the goods will share trade channels, and I do not find them to be important for one another. I find there will be no complementarity, and I find it highly unlikely there will be competition between these goods. In the absence of any convincing evidence or submissions on the contrary, I consider these goods to be dissimilar.

39. It is true that an opposition based on section 5(2)(b) of the Act may only succeed insofar as there is some similarity between the goods.³ On this basis, the opposition fails in respect of the goods I have found to be dissimilar as below:

Class 9: portable communications apparatus; OLED panels; computers; holograms; optical film for polarizer; polarizer; OLED Polarizer.

Comparison of marks

40. 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.”

41. 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.

42. The respective trade marks are shown below:

³ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

Earlier trade mark	Contested trade mark
Sapphire	Sapphire Black

43. The earlier mark is the single word Sapphire. The overall impression resides in the mark as a whole.

44. The contested mark is made up of the two words Sapphire Black. Whilst the font used appears to be slightly stylised, it is my view that this stylisation adds very little to the overall impression of the mark. I consider that the word Sapphire plays a more dominant role in the overall impression of the mark, with its position at the beginning of the mark where the consumer will pay more attention, and on the basis that it is the more unusual and thus more distinctive of the two elements. However, the overall impression of the mark resides in the use of the two words SAPPHIRE BLACK.

Visual comparison

45. Visually, the marks coincide by virtue of the shared use of the word SAPPHIRE. This element is the whole of the earlier mark and is the initial element of the later mark. The later mark also includes the second slightly shorter word 'BLACK' which helps to differentiate the marks visually. Overall, I consider the marks to be visually similar to between a medium and high degree.

Aural comparison

46. The earlier mark consists of two syllables, those being pronounced as 'SAF-FIRE'. The later mark begins with the same two identical syllables, but is longer, ending with a third syllable that is not present within the earlier mark, namely the word BLACK. By virtue of the two initial shared syllables, I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

47. The earlier mark is the known English word Sapphire. A sapphire is a precious stone, and it is my view this is the concept that will be conveyed to the consumer.

48. Within its written submissions, the applicant submits that as sapphires are typically blue, it has become synonymous with the colour blue. They argue on this basis, the applicant's mark effectively means 'blue black'. Whilst I accept that sapphires are most commonly blue, I do not accept these submissions. Sapphires come in a range of colours, and may be at least blue, yellow, white or pink to my knowledge. It is my view the average UK consumer will be aware that sapphires come in a range of colours, and this element of the mark will not indicate to the consumer the colour blue but will convey the concept of the precious stone. Further, it is my view that placing the word BLACK after the word SAPPHIRE means that the later mark will convey to the consumer the meaning of these words independently, that being the precious gem stone and the colour black. I do not consider that the mark will convey to the consumer the concept of a black coloured precious stone, which may be conveyed if the mark were to read BLACK SAPPHIRE. However, I do find the concept of the precious stone to be more unusual and memorable than that of the colour black.

49. Overall I consider that the dominant concept conveyed by both marks is that of the same precious stone. I find the marks are conceptually similar to a high degree.

Average consumer and the purchasing act

50. 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.

51. 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.”

52. The earlier goods may be purchased by both professional consumers and members of the general public, with projection screens being used both for home entertainment and within office and other professional and educational environments. The same is true for the contested goods, with the exception of goods such as digital signage and interactive whiteboards, which will primarily be purchased by businesses and educational facilities as opposed to members of the general public. It is my view that the level of attention of the general public will range from medium for goods such as projection screens where the cost of the goods will range from fairly low to high but where considerations as to the practicality, aesthetics and usability will form part of the decision making process; to above medium in respect of goods such as televisions and monitors, which are likely to be purchased less frequently and to sit at a slightly higher price point generally. The professional consumer is likely to pay at least an above medium level of attention in respect of all of the goods including those such as projection screens and will likely pay a fairly high level of attention in respect of the remaining goods, including those such as interactive whiteboards, where the functionality and specification is likely to be carefully considered prior to the purchase.

53. The purchasing process for the goods will be primarily visual. The general public will purchase goods in physical retail stores and their online equivalents, whereas the professional consumer may also purchase these in wholesale stores or online wholesale stores, or via brochures or catalogues. However, I consider that word of mouth recommendations, in addition to assistance from retail staff, and telephone orders in the case of professional consumers may all play a part in the purchasing process, and so aural considerations cannot be completely discounted.

Distinctive character of the earlier trade mark

54. 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).”

56. The earlier mark is the English word ‘Sapphire’. It is my view that whilst the consumer will understand its meaning as reference to a precious stone, it is not descriptive or allusive of the goods themselves. I therefore consider it holds a medium level of inherent distinctive character.

57. Whilst evidence of use has been provided by the opponent, as I have noted previously in this decision the evidence is not without its flaws. Without more specific information regarding how long the sales figures have sat at the level they are, the extent of the promotion and advertisement of goods under the mark, and the size of the UK market for the goods, I am unable to find the opponent has enhanced the distinctiveness of the earlier mark by virtue of the use made of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

58. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 25 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion, and that the likelihood of confusion may be increased where the distinctive character held by the earlier mark is high and may be less likely where it is low. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.⁴ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are selected will have a bearing on how likely the average consumer is to be confused.

59. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁵

⁴ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

⁵ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

60. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

61. I found the marks to be visually and aurally similar to between a medium and high degree, and conceptually similar to a high degree. I also found the earlier mark to be inherently distinctive to a medium degree, and that the average consumer would pay a medium or higher level of attention to the goods. I found that some of the goods were dissimilar to the earlier goods, and there will be no likelihood of confusion in respect of the same. However, in respect of the remaining goods, I found these to range from similar to a medium degree to identical.

62. With consideration to all of the factors, it is my view that where the goods are identical and the consumer is paying only a medium level of attention to the same, the high level of similarity between the marks will result in a likelihood of the consumer being directly confused between the marks. With consideration to the consumer's imperfect recollection, it is my view that in these circumstances they may well hold on to the concept of Sapphire, with it being the most dominant element of the contested mark and fail to recall or notice the addition or omission of the word 'Black'. I therefore find a likelihood of direct confusion in respect of the following goods:

Class 9: *display apparatus; and display panel*⁶

63. In respect of the remaining goods, I find the slightly higher level of attention that will be paid when purchasing the same means the consumer is more likely to recall and notice the additional element 'Black' in the contested mark. I therefore find that the find that for the remaining goods, there will be no likelihood of direct confusion.

64. I therefore consider if there will be a likelihood of indirect confusion between the marks. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis

⁶ Provided my initial finding of identity between the opponent's goods and *display panel* is correct.

Q.C., as the Appointed Person set out three examples of instances in which indirect confusion may occur, as follows:

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)”.

65. I remind myself that the categories above are not intended to be exhaustive, but also that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

66. I do not find the marks to fall into one of the categories set out in *L.A. Sugar* in this instance. Whilst I find it to be closet to category (b) above, I do not find 'BLACK' to simply be a non-distinctive element.

66. I consider therefore, if there is another proper basis on which the consumer may be indirectly confused between the marks. The marks share the common element

SAPPHIRE, and it is my view that this element does not hang together as a unit with 'Black' in the second mark, rather it appears to remain independent within the same. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

68. I consider the level of similarity between the marks in this instance, and the similarity and identity between the goods. I also consider that it would not be unusual in my experience for technological goods to be marketed under the same house mark but with reference to different sub brands as technology expands and advances. It is my view that reference to a colour could easily be construed as reference to a particular version of goods with a specific technological specification or price point. With consideration to the above, it is my view that the element ‘Sapphire’ in the contested mark, being the most dominant element and playing an independent role within the mark is likely to be considered by the consumer as an independent indicator of origin in the mark, with ‘Black’ easily being viewed as an indication of a sub-brand or brand extension, I find this to be likely in respect of all of the goods where similarity has been found. I therefore consider that even where the consumer is paying a higher level of attention and notices the differences between the marks, there will be a likelihood of indirect confusion between the same.

Final Remarks

69. The opposition has been partially successful, and subject to any successful appeal, the application will be refused in respect of the following goods:

Class 9: Televisions; digital signage; monitors; display apparatus; display panel; interactive whiteboards.

70. Subject to any successful appeal, the application will therefore proceed to registration in respect of the remaining goods, including those opposed as below:

Class 9: portable communications apparatus; OLED panels; computers; holograms; optical film for polarizer; polarizer; OLED Polarizer.

COSTS

71. Both parties have achieved a relatively equal level of success in these proceedings. I have considered the applicant's submissions with the Case Management Conference ("CMC") held in relation to these proceedings that the additional work undertaken in relation to considering the opponent's late evidence and filing an amended Form TM8 should be considered in costs should the applicant be successful. I also consider the cost implications for the parties of attending the CMC itself, held at the request of the applicant.

72. After careful consideration to the circumstances of these proceedings, I consider that each party should bear its own costs, and I make no award of costs in this instance.

Dated this 4th day of August 2022

Rosie Le Breton

For the Registrar