

BL O/867/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3733975

BY

BLISSLIGHTS LLC

TO REGISTER THE FOLLOWING TRADE MARK:

SKYLITE

AND

OPPOSITION NO. 60002353 THERETO

BY

FLY DRAGON LIGHTING EQUIPMENT CO. LTD

Background and pleadings

1. On 16 December 2021, BLISSLIGHTS LLC (the “Applicant”) applied to register the word only trade mark SKYLITE. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 11 March 2022. Registration of the mark is sought in respect of the following goods:

Class 11 *Light projectors.*

2. On 5 May 2022, Fly Dragon Lighting Equipment Co. Ltd (the “Opponent”) filed a Fast Track opposition, opposing the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of one earlier United Kingdom Trade Mark (UKTM):

UKTM No. 0811320790

LIGHT SKY

Receiving date: 20 July 2019

Registration date: 25 August 2017

3. For the purposes of this Fast Track opposition, the Opponent relied upon all of the goods for which the earlier mark is registered, namely:

Class 11 *Lamps; stage lamps and lanterns; lighting apparatus and installations; refrigerating appliances and installations; air conditioning installations; radiators, electric; sockets for electric lights; lighting apparatus for vehicles; filters for drinking water; grills [cooking appliances].*

4. Since the filing date of the earlier mark predates that of the contested application, the Opponent’s mark is considered to be an “earlier mark” in accordance with section

6 of the Act.¹ However, as the mark has not been registered for a period of five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, 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.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought to file any evidence in respect of these proceedings.

7. 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.

8. The opposition is aimed against all of the goods in the contested application. The Opponent claimed that the contested goods are entirely encompassed within the lighting apparatus of the earlier mark, and must therefore be considered to be identical. The Opponent submitted that the marks at issue are highly similar visually, aurally and conceptually, with only the alternate spelling of the word LIGHT and LITE, and the reversal of the order of the words contained within the marks, preventing the marks from being entirely identical.

9. The Opponent argued that many of the letters in the words of each mark are identical and, with no other elements to consider, the marks must be considered to be

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

highly similar visually. In regard to the aural comparison, the Opponent argued that the elements LITE and LIGHT will be pronounced identically, and despite the different order of words, the marks are aurally similar to a significant degree. As for the conceptual comparison, the Opponent submitted that were the term SKYLITE to be spelt as SKYLIGHT then it would have the meaning of a window built into a roof to allow light in. The Opponent then submitted that both the earlier and contested marks strongly allude to a light that is arranged to illuminate the sky, or which emanates from the sky, with neither mark holding any immediate additional concept beyond the two words used in conjunction, regardless of the order in which the words are presented. The Opponent submitted that the marks are therefore conceptually identical.

10. The Opponent submitted that the level of attention of the average consumer in relation to lighting apparatus will be low, with the selection process being a combination of visual and aural aspects. The Opponent referred to previous decisions of the UKIPO, notably BL O/382/01 *NEXT GENERATION/GENERATION NEXT*, BL O/092/04 *BREATHE EASY/EASI-BREATHE*, and BL O/465/21 *BET CLOUD/CLOUDBET*, all of which "...considered that the only difference between the marks was the reversal of words [and] which was not enough to find no likelihood of confusion." The Opponent also included in its submissions reference to the judgment of the General Court (GC) T-194/14, *AEROSTONE*, and submitted that it does not necessarily follow that there is no likelihood of confusion where the beginnings of marks are different.

11. On 8 August 2022, the Applicant filed a counterstatement denying the grounds of opposition. The Applicant submitted that contrary to the Opponent's claims, the goods at issue are neither identical nor similar because "...light projectors are not about lighting". The Applicant submitted that the purpose, nature and method of use of the goods are different, and they are neither in competition nor are the complementary. The Applicant submitted that the contested *light projectors* are not inexpensive everyday goods, with a typical price ranging between £25 to £75. As a result, the goods would only be bought after a careful consideration. The Applicant gave more extensive and specific detailing as to why the goods are different, but these shall not be summarised here, rather they shall be introduced into the decision wherever I consider them to provide assistance and clarity.

12. The Applicant acknowledged that both marks contain the element 'SKY', however, the Applicant submitted that the element is a separate word placed at the end of the earlier mark, whereas it appears at the beginning of a single word in the contested mark. Considering the factors of one mark being a single word and the other not, the different positioning of the element 'SKY' in each mark, the stylisation of the earlier mark, and the different spelling of 'LITE' in the contested mark, the Applicant submitted that the marks are visually and aurally different. The Applicant argued that the strongest difference between the marks, however, is that of their respective meanings. The Applicant submitted:

“As far as the word ‘skylight’ [sic] is concerned, the Opponent mentions itself that it has a clear, unique and unmistakeable meaning in the English language that will not be missed – a window built into a roof to allow light in. This meaning is not reflected whatsoever in the Earlier Trademark “LIGHT SKY”.

13. The Applicant submitted that the earlier mark is arguably merely descriptive of a lamp that creates the impression of a bright sky.

14. No Hearing was requested and only the Applicant filed submissions in lieu of a Hearing.

15. In its submissions of 22 September 2022, the Applicant reiterated that the goods at issue are not similar, and again provided extensive submissions in this regard. In essence, the Applicant submitted that whilst the purpose of the *lamps; lighting apparatus* etc., of the earlier mark is to illuminate something, typically a room or object, the purpose of the contested *light projectors* is to transport and show specific visual information by using light as a medium: “In other words, light projectors ‘paint with light’.”

16. Both parties are professionally represented. The Applicant is represented by Fish & Richardson P.C, and the Opponent is represented by IPEY Limited.

Decision

17. 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.

Section 5(2)(b)

18. Section 5(2)(b) of the Act is as follows:

“(2) A trade mark shall not be registered if because-

(a) ...

(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”.

19. 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.

(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

20. Both parties provided submissions in relation to the respective goods at issue. Whilst the parties' comments are noted, the degree of similarity or identity of the specifications, as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods at issue. I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity.

Earlier mark	Application
Class 11: <i>Lamps; stage lamps and lanterns; lighting apparatus and installations; refrigerating appliances and installations; air conditioning installations; radiators, electric; sockets for electric lights; lighting apparatus for vehicles; filters for drinking water; grills [cooking appliances].</i>	Class 11: <i>Light projectors.</i>

21. In the judgment of the Court of Justice of the European Union (CJEU) 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”.

22. 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.

23. It has also been established by the GC in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

24. The Applicant has provided detailed submissions in order to support their position that, essentially, whilst the purpose of the contested goods is to project information via light, the purpose of the goods of the earlier mark is to provide illumination. The Applicant argued that the purpose of a light projector is “to paint with light”, which requires a type of light that is “more directional, controllable and variable”, and which is “completely unsuitable for illumination purposes”. The Applicant provided pictures in their submissions to illustrate the projection of images and wordings onto walls, ceilings, the sky etc., via projectors (although the device does not appear in each of the images). The Opponent’s position is more succinct, arguing that the goods of its

earlier mark, such as *lamps*, *lighting apparatus* and *installations*, would cover *light projectors*.

25. I agree with the Applicant that the notion of a lamp is to illuminate a fixed position. I also agree to a degree like a *light projector* is not intended to be used to illuminate an area for reading a book, for example. However, I would not go so far as the Applicant has in suggesting that using a *light projector* to find a book in a dark room is “doomed to fail”. This is because at its core a *light projector* uses a beam of light to project an image. As a consequence of the use of a light beam, illumination to some degree will inevitably occur.

26. It seems to me that the concept of the earlier mark’s *lighting apparatus* would encompass all manner of equipment and tools related to the provision or emission of light. For example, a *light projector* is a machine (i.e., piece of equipment/“apparatus”) that is effectively utilising a source of light to display a particular image or piece of information. By using a light source, a *light projector* is therefore essentially a piece of lighting equipment. In my opinion, the contested *light projector* would fall within the broader general category of the *lighting apparatus* of the earlier mark, and it is therefore considered to be identical in accordance with the *Meric* principle.

Comparison of the marks

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

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

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

28. 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.

29. The respective trade marks are shown below:

Earlier mark	Application
LIGHT SKY	SKYLITE

30. The earlier mark is classified as a figurative trade mark, and uses a stylised font for the words ‘LIGHT’ and ‘SKY’. Although the stylisation is minimal, it does nevertheless contribute to the overall impression of the mark. Each word is a common and well-recognised English-language word, with ‘LIGHT’ meaning a brightness or illumination, and ‘SKY’ referring to the space/expanse around the earth. Although the word ‘LIGHT’ has other meanings, such as ‘not heavy’ or ‘small amount’, or as a verb to ‘start a fire’, it is my opinion that the words ‘LIGHT’ and ‘SKY’ hang together, especially because they effectively form a combination in accordance with English grammar rules, whereby the word ‘LIGHT’ would invariably be understood as an adjective referring to colour or tone of the noun, ‘SKY’. As such, neither word can be considered to be more distinctive than the other, and because they are of equal size, I do not consider either word to be more dominant. The overall impression of the earlier mark therefore derives from the stylised combination of words ‘LIGHT’ and ‘SKY’.

31. The contested mark consists of the term 'SKYLITE, which is where the overall impression and any distinctiveness must lie. The word is presented in a standard typeface. 'SKYLITE' is not an English-language word, and does not appear in any dictionary. However, it may be perceived as a misspelling of 'SKYLIGHT'. Both the Opponent and the Applicant themselves have made submissions in relation to the contested mark as if it were written as 'SKYLIGHT'. I am of the opinion that the majority of average consumers will perceive the contested mark 'SKYLITE' as a misspelling for 'SKYLIGHT', whilst I do not dismiss the possibility that there may be a certain number of consumers for whom the contested mark is actually perceived as the correct spelling. As such, the overall impression of the contested mark lies in the perception of its meaning of a window built into a roof that allows light in.

Visual similarity

32. Visually, the marks are similar insofar as they each contain the word 'SKY'. Although the word 'SKY' is part of the conjoined contested mark, I consider it may still be discernible as a word. The marks also each contain the same additional three letters 'L', 'I' and 'T', although they are the 1st, 2nd and 5th letters in the earlier mark, and are the 4th, 5th and 6th letters in the contested mark. The different positioning of these three letters serves to constitute a visual dissimilarity between the marks. Further visual differences include the additional letters 'GH' in the earlier mark, which have no counterpart in the contested mark, the use of font in the earlier mark, and the use of a space in the earlier mark to create two clearly separate words 'LIGHT' and 'SKY', whereas the contested mark appears as one word.

33. The marks are considered to be visually similar to a degree between low and medium.

Aural similarity

34. Aurally, the marks are similar insofar as they each contain the same two syllables 'SKY' and 'LIGHT/LITE', which will be pronounced identically in each mark. The marks are aurally different, however, due to the order in which the identical vocals are pronounced, with 'LIGHT' being pronounced first and 'SKY' being pronounced second in the earlier, whilst the order will be pronounced in reverse in the contested mark.

35. The marks are considered to be aurally similar to no more than a medium degree.

Conceptual similarity

36. The earlier mark hangs together to create the overall impression of sky that is light in colour and tone. This concept is not shared with the contested mark. In each parties' submissions, the contested mark was referred to as 'SKYLIGHT', with the Applicant itself stating "As far as the words [sic] "skylight" is concerned, the Opponent mentions itself that it has a clear, unique and unmistakable meaning in the English language that will not be missed – window built into a roof to allow light in". In my opinion, the contested mark will either be perceived as a misspelling of 'SKYLIGHT', or the correct spelling of the same word, i.e., window built into a roof to allow light in.

37. The marks are considered to be conceptually dissimilar.

Average consumer and the purchasing act

38. 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.² 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."

39. The goods at issue include various types of lighting, lighting apparatus, lighting equipment, and an array of white goods and domestic appliances. The majority of such

² *Lloyd Schuhfabrik Meyer*, Case C-342/97

goods are considered to be everyday products, insofar as they are bought and used frequently or on a daily basis, and would tend to fall within a generally affordable price range of inexpensive items. This does not necessarily apply to the *refrigerators* and *air conditioning units*, which are more expensive than the other goods of the earlier mark. Nevertheless, they remain everyday products. It is noted that the Applicant submitted that the contested *light projectors* are not inexpensive everyday goods, and mentioned a typical price ranging between £25 to £75. I do not consider such a price range to necessarily support the position that the contested goods are inexpensive. There is no hard and fast rule to correlate whether a price does or does not reflect that something is an everyday good. For example, *bread* and *milk* are truly “inexpensive” everyday items, but everyday items may also include *clothing* and *alcohol*, which are more likely to fall within the price range mentioned by the Applicant. I do not, therefore, agree that the contested goods should automatically be considered as inexpensive. In addition, it should be noted that the price of a product is generally immaterial in defining the relevant public, as the price of the goods is not the subject of the registration.³ That having been said, I do agree that in certain instances the average consumer may pay more careful consideration when purchasing the contested goods, and would also pay particular attention when purchasing *refrigerators* and *air conditioning units*. However, even when purchasing these items, I would not label them particularly specialist, nor would I assume the purchaser to necessarily have a high degree of attention. In general, I consider the level of attention of the average consumer to be between low and medium.

40. Based on the nature of the goods at issue, I consider it most likely that the purchase process will be visually dominated. Whether the consumer is buying a *lamp*, *socket*, *refrigerator* or *projector*, etc., the consumer would predominantly be using their eyes, and would therefore most likely be making a purchase decision based on the visual appearance of the product. I do not entirely discount the possibility that the marks may be spoken, for instance when ordering a larger white good over the telephone or when engaging a sales assistant in conversation, and as such I accept that there may be an aural element to the purchasing process. However, I believe any aural aspect to be secondary to a visual one in the purchasing process.

³ *Bang & Olufsen A/S v OHIM*, T-460/05

Distinctive character of the earlier trade marks

41. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has the Opponent filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

42. 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).”

43. In *Kurt Geiger v A-List Corporate Limited* BL O-075-13, Mr Iain Purvis K.C., acting 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. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

44. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

45. The earlier mark is a figurative trade mark, consisting of the stylised combination of words ‘LIGHT SKY’. Due to the combination of words according with English grammar rules, I consider the combination to hang together to create the impression of sky that is light in colour. Such a concept would not appear to have any relationship to the goods at issue, and the earlier mark is therefore considered to be inherently distinctive to a medium degree.

Likelihood of confusion

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

47. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

48. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

49. In *Quelle AG v OHIM*, Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must

therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

50. Having conducted a full analysis and thorough comparison of both the marks and their respective goods at issue, I have determined that it is the visual considerations which are of a greater importance in the assessment of a likelihood of confusion, due to the purchasing process of the respective goods being visually dominated. With this in mind, it is important to reaffirm that I have found the marks to be visually similar to a degree that is between low and medium. It is also important to reaffirm that I did not rule out a part of the relevant public paying attention to the aural aspect of the marks during the purchasing process, in which case I consider the finding of aural similarity of a level of no more than a medium degree to also be of significance.

51. Whilst I acknowledge that the marks at issue each contain the word ‘SKY’ and also share the phonetically identical terms ‘LIGHT’ or ‘LITE’, I nevertheless do not consider

it likely that the marks will be directly confused. In conducting a comparison of marks, it is essential to assess the marks based on their overall impression. This is because the average consumer normally perceives a mark as a whole, and does not proceed to analyse its various elements. I am aware that in order to ascertain the overall impression of a mark it is of course permitted to analyse its components, and establish their relevant weight in the perception of the target public. By doing so it can be the case that a more dominant or distinctive component or element is discovered, which then becomes the component or element that the average consumer may most likely hold onto or retain in their mind. It may also be the case that following the analysis of a mark's components, a particular component or element is subsequently considered to be negligible, the result being that the assessment of the similarity between marks at issue can be carried out solely on the basis of the dominant element⁴.

52. In relation to the earlier mark, I do not consider either element 'LIGHT' or 'SKY' to be a more dominant or distinctive or negligible component/element. I am firmly of the opinion that the earlier mark will be perceived as a phrase that hangs together, with neither element 'LIGHT' nor 'SKY' being separated or perceived independently. The same applies to the contested mark, whereby although I have acknowledged that the word 'SKY' is discernible, I nevertheless do not believe it is separable from the overall conjoined term 'SKYLITE'. For the purposes of assessing a likelihood of confusion, it is therefore necessary for me to compare the overall impression of the combination of terms that hang together, i.e., LIGHT SKY, with the overall impression of the single term, i.e., SKYLITE.

53. Based on its overall impression, the concept of each mark is uniquely distinctive and clearly distinguishable from the other, with the earlier mark portraying a light-coloured sky and the contested mark portraying a type of window. I disagree with the Opponent's argument that both the earlier and contested mark strongly allude to a light that is arranged to illuminate the sky, or which emanates from the sky. In my opinion, such a concept does not belong to the Opponent's own earlier mark, as it seems to me the more obvious concept of the earlier mark is that of a sky which is light in colour/tone. It certainly does not appear to me to be the most natural concept of the contested mark, which I believe will in the majority of instances be perceived as

⁴ (see including C-334/05 P *OHIM v Shaker*, and C-193/06 P *Nestlé v OHIM*)

referring to a window in a roof. That having been said, I do not dismiss entirely the possibility that a certain number of consumers may interpret the contested mark 'SKYLITE' as referring to the illumination of the sky (although this is grammatically awkward). In either scenario, the concepts of each mark are different, and therefore I do not find it likely that the marks would be directly confused.

55. In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

56. As is established in the above, conceptual differences between signs may counteract any visual and phonetic similarities between them. With this in mind, the fact that the marks at issue are conceptually distinct and different serves to counteract the visual and aural similarities between them, which in any case, do not constitute particularly high levels of similarity.

57. I am aware that the average consumer rarely has the opportunity to make direct comparisons of marks side-by-side, and must instead rely upon the imperfect picture of them he has kept in his mind. I am also aware that the marks at issue share one element that is visually identical and another element that is aurally identical. However, focusing upon only one of the elements would require the average consumer to separate it from the overall impression of the mark they have retained in their mind, which I do not believe would occur. The marks cannot be dissected or dismantled into elements that would be incorrectly recalled, as the overriding impression of each mark is created from its perception as a whole. Therefore, despite the notion of imperfect recollection, it is my opinion that there is no likelihood of direct confusion due to the notable visual and aural differences between the marks, combined with the conceptual dissimilarity, all of which serve to ensure that the average consumer will not mistake one of the marks for the other.

58. Having found there to be no likelihood of direct confusion, I shall now consider the possibility of indirect confusion. It should be borne in mind 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.⁵

59. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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).

⁵ In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCH Civ 2017, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor KC’s (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.

(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).”

60. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

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

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

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

61. The beginnings of the respective marks at issue are clearly different. If the consumer is expected/assumed to attach more importance to the first parts of words, and therefore observes 'LIGHT' in the earlier mark and 'SKY' in the contested mark as the elements which make the greater visual and aural impact, then it seems to me to be relatively self-evident that the consumer cannot but help differentiate between the marks at issue, as the beginnings of each mark are significantly different.

62. In order to find a likelihood of indirect confusion I must consider it to be realistic that the average consumer would recognise the contested mark is different from the earlier mark, but would nevertheless consciously or subconsciously carry out the mental process whereby they distinguish a common element in the marks, and conclude that it is part of another brand from the same owner or an economically linked undertaking. It is arguable that each element of the respective marks is an element that the marks have in common, as the element 'SKY' appears in both marks, as does the element 'LIGHT' or its phonetic equivalent 'LITE'. However, as I have previously stated, I do not find either element of the earlier mark 'LIGHT SKY' to be the more dominant or distinctive, and so it is unclear which, if any, of these two elements in the earlier mark a consumer might latch onto, and search for or recognise in a later mark. In my opinion, the earlier mark will always be perceived as a whole, with the concept created being inherently distinctive to a medium degree, and totally dependent on its overall impression.

63. I have reviewed the previous cases issued by the Registry, which the Opponent referred to by way of precedent for establishing that the change of order of terms in a mark was not enough to find no likelihood of confusion. Firstly, it should be confirmed that the decisions of the Registry are not binding, and it should also be acknowledged that the referred to decisions are not judgments of a Court. It is my position that the previous decisions are not on all fours with the marks in the current proceedings, most notably due to the conceptual aspects. The first decision referred to by the Opponent is BL O/382/01, *NEXT GENERATION/GENERATION NEXT*. In paragraph 18 of this decision, the Hearing Officer found that:

18 *"In the present case the only difference in the marks in [sic] visually or aurally is the order in which the words appear and on a conceptual comparison I am unable to discern any real difference between them."*

64. This finding differs to my finding in relation to the marks at issue in these proceedings. In the current proceedings, not only have I found there to be visual differences *other* than the order of the words, but more significantly, I have also found there to be real discernible differences between the concepts of the marks, which is unlike the Hearing Officer found in NEXT GENERATION and GENERATION NEXT.

65. The second decision referred to is BL O/092/04, *BREATHE EASY/EASI-BREATHE*. In paragraphs 32-33, the Hearing Officer explained the following:

32)... The average consumer is well versed to companies using phonetic spelling in relation to trade marks. Use of correct spelling and the punctilious observation of grammar are, regrettably, now things of the past and would not be commented upon or noted even by a reasonably well informed and reasonably circumspect and observant consumer.

*33) Clearly there are visual and phonetic differences if one compares the two marks. However, there are also similarities. The fact that one mark is hyphenated is not, to my mind, significant, nor is the minor spelling difference. The marks both consist of the same two words but used in a different order. **Conceptually they convey the same message.** I accept that when seeking relief from breathing difficulties, as with any medication, the average consumer will take above average care in selecting a product. However, despite their visual and phonetic differences when compared directly to each other the marks have visual and phonetic similarities such that combined with the conceptual identity and allowing for the concept of imperfect recollection, I believe that the marks are similar.” [emphasis added]*

66. As similar to the Hearing Officer in the above decision, I have not found the misspelling of ‘LITE’ for ‘LIGHT’ in the current proceedings to be anything other than ‘minor’. In fact, it may be the case that a certain number of consumers believe that ‘LITE’ is actually the correct spelling. However, where the opinion of the Hearing Officer in BL O/092/04 differs from mine in the current proceedings is, again, in relation to the conceptual aspect of the marks. BREATHE EASY and EASI-BREATHE are combinations which have descriptive or allusive qualities in relation to the respective goods at issue in those proceedings, in which case the reversal of the order of wording

would not dispel the same concept. The same does not, however, apply in the current proceedings, for which the earlier mark is inherently distinctive, and whereby the reversal of words has a significant impact on the overall impression of the contested mark.

67. The third decision referred to is BL O/465/21, *BET CLOUD/CLOUDBET*, which stated in paragraph 81:

81: It is my view that in this present case, the relevant public would be likely to recall the words CLOUD and BET, but, as a result of imperfect recollection, be less certain about the order of those words. Keeping in mind the global assessment of the competing factors in my decision, and in particular the conceptual identity of the marks, I find that there is a likelihood of direct confusion for those goods and services where there was considered to be similarity.” [emphasis added]

68. It is clear that the order of words did not upset the conceptual similarity between BET CLOUD and CLOUD BET. However, I do not consider the change of order of words in the marks in the current proceedings to have no effect, as ultimately the reversal of ‘LIGHT SKY’ to ‘SKYLITE’ creates an entirely new concept.

69. The Opponent also referred to the GC judgment T-194/14, *Bristol Global Co Ltd v EUIPO (AEROSTONE)*. In said judgment, the GC held that there would be a likelihood of confusion between AEROSTONE (slightly stylised) and STONE, if both marks were used by different undertakings in relation to identical goods (*land vehicles and automobile tyres*). This was despite the fact that the beginnings of the marks were different. The common element ‘STONE’ was considered sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed. I do not consider this judgment to affect the finding of confusion in the current proceedings for two reasons: 1) unlike in the marks in the GC judgment, the ends of the marks at issue in the current proceedings are different (SKY and LITE respectively, unlike STONE and STONE); 2) the first element AERO in the contested mark AEROSTONE was considered to be a descriptive prefix, which is not a similar finding in the first element of either mark in the current proceedings.

70. I refer to *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which Mr James Mellor K.C., 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, as this would be mere association rather than indirect confusion. In my opinion, the fact that the marks at issue share the elements ‘SKY’ and ‘LIGHT/LITE’ is not enough, in and of itself, to find indirect confusion. The coincidence of the same terms within a complete phrase meaning a light coloured sky, or within a conjoined term referring to a window, would not lead the average consumer to assume that the users of the respective trade marks are one and the same. Neither element ‘SKY’ nor ‘LIGHT/LITE’ is so distinctive that the average consumer would assume no-one else but the brand owner would be using it in a trade mark at all, nor do I believe the consumer would find the rearranging of the words to be entirely logical and consistent with a brand extension or sub-brand. This applies especially so to the consumer whose level of attention is higher in relation to the white goods, as such an attentive consumer is more likely to notice differences between marks, which would reduce further the possibility of a likelihood of confusion⁶.

71. Having found there to be no direct confusion, there would need to have been a “proper basis” for finding there to be a likelihood of indirect confusion.⁷ Having maintained the correct principles of law firmly in mind, I am of the opinion that upon seeing the contested mark the attentive consumer would not carry out the mental process whereby they either consciously or subconsciously assume the contested mark to be a logical extension of the earlier mark based purely on the coincidence of terms, which create very different concepts in each mark, and which I do not believe the consumer would fail to notice or appreciate.

⁶ C-261/04 P, *Claude Ruiz-Picasso*,

40 “Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between the marks relating to such goods at the crucial moment when the choice between those goods and marks is made”.

⁷ *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCH Civ 2017, paragraph 13,

72. I am aware that determining whether there is a likelihood of confusion is a multifactorial assessment that includes the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.⁸ (see *Canon, C-39/97*, para 17). I am cogent to the fact that I have found the goods at issue to be identical. According to the principle of interdependency, such a degree of similarity between the respective specifications of goods could offset a lesser degree of similarity between the respective trade marks. However, in my opinion the marks at issue are conceptually entirely different. In addition, the marks have been found to be visually similar only to a degree between low and medium. Considering the fact that the visual aspect is the more dominant in the purchasing process of the goods at issue, this low level of visual similarity is significant. It is my opinion that neither the average or more specialist consumer would consider goods sold under a 'SKYLITE' mark to come from the same or an economically linked undertaking which produces 'LIGHT SKY' branded goods, even bearing in mind the notion of imperfect recollection. It is my finding, therefore, that the marks are not sufficiently similar for a finding of a likelihood of confusion, either directly or indirectly.

Conclusion

73. The opposition fails in its entirety. Subject to an appeal, the contested application may proceed to registration.

Costs

74. As the opposition has failed, the Applicant has been successful and is entitled to a contribution towards its costs. I bear in mind the guidance in Tribunal Practice Notice 2/2015 which governs costs in Fast Track proceedings issued after 1 October 2015. In the circumstances I award the Applicant the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering a notice of opposition and

⁸ *Canon, C-39/97*, para 17

filing a counterstatement	£200
Preparing submissions in lieu of a hearing	£100
Total	£300

75. I therefore order Fly Dragon Lighting Equipment Co. Ltd to pay BLISSLIGHTS LLC the sum of £300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of October 2022

Dafydd Collins

For the Registrar