

O-223-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 817390  
AND THE REQUEST BY KONINKLIJKE PHILIPS ELECTRONICS N.V.  
TO PROTECT THE TRADE MARK  
BRILLIANCE  
IN CLASSES 9 & 10**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 71220  
BY BELDEN TECHNOLOGIES INC.**

## BACKGROUND

1) On 17 December 2003, Koninklijke Philips Electronics N.V. (hereinafter the applicant), of Groenewoudseweg 1, NL-5621 BA Eindhoven, Netherlands on the basis of its international registration based upon its registration held in Benelux, requested protection in the United Kingdom of the trade mark BRILLIANCE. An International Priority date of 2 July 2003 was claimed with regard to its Benelux registration. Protection was sought for the following goods:

In Class 9: Electric apparatus and instruments for recording, processing, analyzing and reproducing medical data; recorded computer (software) programs for medical applications; all for use in CT-scanning.

In Class 10: CT-scanners.

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3) On 27 July 2005 Belden Technologies Inc. of 7701 Forsyth Blvd, Suite 800, St Louis, Missouri 63105, United States of America filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Effective date	Class	Specification
BRILLIANCE	CTM 3204351	30.5.03	9	Electrical cables and wires; electronic cables and wires; microphone cables for sound and audio applications.

b) The opponent claims that the goods are identical and/or similar and that the marks are confusingly similar. The mark therefore offends against Section 5(2)(a) & (b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement accepting that the marks are identical but denying that the goods are the same or similar. The applicant claims to have been using its mark since 1991.

5) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard, although the opponent filed written submissions which will be referred to as and when necessary.

## OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 18 January 2007, by Werner Eich the Marketing Manager of Belden Wire & Cable B.V. a wholly owned subsidiary of the opponent company. He is based in the Netherlands and has held his position since

1990. He states that his company is responsible for overseeing the sales and promotional activities of Belden throughout Europe. He states that the opponent's BRILLIANCE cables have been sold in the UK since 1996. He provides at exhibit WE1 summaries of sales reports for various countries for the past ten years. From these he has provided the following sales figures for BRILLIANCE cables in the UK with values converted into £ sterling:

Year	Sales in £
1999	675,000
2000	920,000
2001	750,000
2002	345,000
2003	350,000
2004	780,000

7) He states that the cables and wires sold under the mark in the UK have been sold to, inter alia, Maser, R S Component, Anixter UK, Farnell El, Hagemeyer and Webro. At exhibit WE2 he provides samples of invoices to these customers. At exhibit WE3 and 4 he provides copies of pages from the company's catalogues which shows the various cables on offer over the years 2001-2003. These are primarily aimed at the audio/ visual market with cables for Hi-fi connections and speaker cables as well as connections between TV's and DVD/video's. He estimates that approximately £10,000 per annum has been spent on marketing the cables in the UK.

## DECISION

8) The grounds of opposition are under section 5(2)(a) & (b) which read:

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

- (a).... it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

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

10) The opponent is relying on its trade mark CTM 3204351 which has an effective date of 30 May 2003 which is clearly an earlier trade mark even allowing for the International Priority date claimed by the applicant of 2 July 2003.

11) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux B.V.* [2000] E.T.M.R 723. It is clear from these cases that:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*;

(h) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux B.V.*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

12) In essence the test under section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

13) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

14) The opponent has provided some evidence of use. However, the average sales in the four years prior to the relevant date amount to approximately £670,000 per annum. The opponent has not supplied any indication of market share or the total sales in the cable market. Nor has it supplied any evidence from the trade. The opponent, therefore, cannot benefit from an enhanced level of protection due to reputation. I also have to consider whether the opponent's mark is inherently distinctive. The opponent's mark consists of the word BRILLIANCE. The mark is registered for, *inter alia*, electronic cables and wires. “Brilliance” is a well known English word and whilst when used on audio cables it alludes to the sound quality it must still be regarded as inherently distinctive.

15) In the applicant’s counterstatement it is accepted that the marks are identical. I therefore move onto consider the specifications of both parties. For ease of reference these are as follows:

Applicant’s specification	Opponent’s specifications
In Class 9: Electric apparatus and instruments for recording, processing, analyzing and reproducing medical data; recorded computer (software) programs for medical applications; all for use in CT-scanning.	Electrical cables and wires; electronic cables and wires; microphone cables for sound and audio applications.
In Class 10: CT-scanners	

16) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon* [1999] ETMR 1. In its judgement, the ECJ stated at page 6 paragraph 23:

“23. 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 end users, their method of use and whether they are in competition with each other or are complementary.”

17) I must also consider the average consumer for the types of goods covered by the specifications of both parties. In my opinion, they would fall into two camps. The applicant’s goods are highly specialised and would be purchased for hospitals and other large medical centres by a professional group consisting of doctors and procurement departments. By contrast the applicant’s goods, although capable of being used in conjunction with very specialised machinery are also purchased by the general public for use in the home on hi-fi systems and televisions. The applicant’s goods are, I would suggest, unlikely to be purchased without very careful study of the specifications which would probably entail a visit to the medical facility by a representative of either the applicant or one of its agents. The opponent’s goods will be sold in shops and via catalogues and the internet. I accept that it is possible that the opponent’s cables might be used to connect parts of the equipment supplied by the applicant. However, in my opinion there is a considerable difference between an extremely complex piece of advanced medical equipment and a piece of cable.

18) Taking account of all of the above when considering the marks globally, I believe that, despite the marks being identical, there is not a likelihood of the relevant consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(a) & 5(2)(b) therefore fail.

**COSTS**

19) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,000. This sum to be paid within seven days of the expiry of the appeal period or within seven

days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 7th day of August 2007**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**