

O-555/15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3067502
BY SIMTEK (INTERNATIONAL) LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9, 12, 35 & 37:**

SIMTEK

AND

**AN OPPOSITION THERETO (No 403344) BY
CONTINENTAL AUTOMOTIVE GMBH**

Background and pleadings

1. The trade mark the subject of this dispute consists of the word: **SIMTEK**. It was filed by Simtek (International) Limited (the applicant) on 7 August 2014 and was published for opposition purposes on 5 September 2014. Registration is sought for the following goods and services:

Class 9: Electronic control units, Motorsport engine management control units all for racing vehicles, software and programs for tuning vehicles. Computer software; computer programs; computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning; software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning; ECU software; software updates; electronic publications; instructional material, teaching materials and data provided on-line from computer databases; computer networks; global computer networks; computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet; computer software for database and digital data management and integration; computer software to enable searching and management of data; user and instruction manuals provided in electronic form; computer software for facilitating or enabling access to databases, communications networks and e-mail services; virtual reality systems; computers; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods; magnetic data carriers including magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data; discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded; CD-ROMs; MP3; electronically, magnetically and optically recorded data for computers; electronic publications; downloadable electronic publications; credit cards, debit cards and loyalty cards; apparatus for the use in cleaning the aforesaid goods; parts and fittings for all of the aforesaid goods.

Class 12: Parts of land vehicles.

Class 35: Retail services connected with the sale of computer software, computer programs, computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, ECU software, software updates, electronic publications, instructional material, teaching materials and data provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and websites), computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet, computer software for database and digital data management and integration, computer software to enable searching and management of data, user and instruction manuals provided in electronic form, computer software for facilitating or enabling access to databases, communications networks and e-mail services, virtual reality systems, computers, cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, magnetic data carriers including magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data,

discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded, CD-ROMs, MP3, electronically, magnetically and optically recorded data for computers, electronic publications, downloadable electronic publications, credit cards, debit cards and loyalty cards, apparatus for the use in cleaning the aforesaid goods, parts and fittings for all of the aforesaid goods; establishment of business and retail stores; the preparation and distribution of promotional materials; business management services; the bringing together for the benefit of others computer software, computer programs, computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, ECU software, software updates, electronic publications, instructional material, teaching materials and data provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and websites), computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet, computer software for database and digital data management and integration, computer software to enable searching and management of data, user and instruction manuals provided in electronic form, computer software for facilitating or enabling access to databases, communications networks and e-mail services, virtual reality systems, computers, cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, magnetic data carriers including magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data, discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded, CD-ROMs, MP3, electronically, magnetically and optically recorded data for computers, electronic publications, downloadable electronic publications, credit cards, debit cards and loyalty cards, apparatus for the use in cleaning the aforesaid goods, parts and fittings for all of the aforesaid goods, enabling customers conveniently to view and purchase those goods in a retail store, from an Internet web site or by means of telecommunications; advertising, marketing and publicity services; advertising in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising, operating, management, advertising and marketing of online websites; public relations; direct marketing services; business management and administration; business advisory services; market surveys, analysis and research; business advisory services in relation to the provision of sponsorship; event marketing; organisation of business shows; database marketing; sales promotion services; preparing and placing of advertisements; consultancy services relating to advertising, publicity and marketing; management consultancy services; business advisory services; advisory and consultancy services relating to all the aforesaid.

Class 37: Vehicle tuning, Mobile vehicle tuning services, software and product training.

2. Registration of the mark is opposed by Continental Automotive GmbH (the opponent) on a ground under sections 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition relates only to the terms that are underlined in the above list of goods and services. The opponent relies on the following trade mark:

Community trade mark (CTM) registration 11228236

SIMTEC

Filing date: 1 October 2012

Date of entry on the register: 28 February 2013

Class 9: Parts for internal combustion engines for land vehicles, namely electric engine controls.

3. The applicant filed a counterstatement. It states that:

- i) The opponent's mark was filed in 2012 but the applicant has been using its mark for over 10 years and there has not been an issue over this before, and, also, it is not aware of any confusion.
- ii) The applicant is in the motorsport sector fitting its (Engine Control Unit) ECU product to rally and track modified cars whereas the opponent's product is fitted to normal cars.

4. The opponent is represented by Haseltine Lake LLP. The applicant is self-represented.

5. The opponent filed evidence. It consists of a witness statement of Ms Heather Orr, a trade mark attorney at Haseltine Lake. Her evidence relates to ECUs for vehicles. I will return to her evidence later, particularly when I consider the issue of goods/service similarity.

6. The applicant submitted some documents in the form of various exhibits which purported to be evidence. However, such material was not accompanied by a witness statement, affidavit or statutory declaration and was, therefore, not accepted into the proceedings. The rules governing evidence in proceedings before this tribunal are set out in rule 64(1) of the Trade Marks Rules 2008 (as amended) (the rules). The material filed does not constitute evidence as required by those rules. The applicant was given an opportunity to put matters right and to re-file the evidence in proper evidential form. The applicant did not do so. The consequence of this is that the material filed shall not be taken into account.

7. Neither side requested a hearing. The opponent filed written submissions in lieu of a hearing, the applicant did not.

Section 5(2)(b)

8. Section 5(2)(b) of the Act states that:

“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.”

9. The following principles are gleaned from the judgments 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The marks

10. 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 (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.”

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

12. The overall impression of both marks will be based upon the single invented words of which they consist.

13. Visually, the marks are of identical length and share the first 5 letters in the same order. They differ only in respect of their final letters K/C. There is no great visual similarity between the letters C and K. Nevertheless, overall, I conclude that the marks have a high degree of visual similarity.

14. Aurally, both marks have two syllables. The first syllable (SIM) of each mark is the same and will be articulated in the same way. In relation to the second syllable (TEK/TEC), I come to the view that both will be pronounced with a hard “ck” sound as in the end of words such as heck, peck, deck etc. The consequence is that both marks will be articulated as SIM-TECK. They are aurally identical.

15. Conceptually, although the endings of both marks are evocative of the word technology, as a whole they will be perceived as invented words and as a whole they have no real concept. Consequently, the conceptual comparison is neutral.

The goods

16. When making a comparison, all relevant factors relating to the goods and services at issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

17. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

18. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

19. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

20. Before making my assessment, I will detail the evidence filed by the opponent’s witness, Ms Orr. She carried out Internet research in connection with ECUs. She provides extracts from four websites, as follows:

- i) Exhibit HO1 contains prints from the website of Performance Electronics Limited. The company describes itself (on page 8) as:

“Specializing in the design of custom and production embedded control systems. We have been supplying quality products to racers, automotive enthusiasts and research scientists since 1998.”

The information also describes what an ECU is. It is described as a “...computer that controls all of the engine related functions”. Other information demonstrates that an ECU can be linked up to a PC so that certain aspects of engine performance can be modified or tuned, such as changing the fuel injection or fuel flow parameters. The information also shows that tuning software is used as part of this process.

- ii) Exhibit HO2 contains prints from the website of “Bosch in the UK”. The information provided shows that it has an automotive electronics division which manufactures, amongst other things, ECUs. It describes an ECU as being for body electronic, brake control systems and engine management. There is also a page about Bosch’s automotive aftermarket spare parts business.

- iii) Exhibit HO3 contains a print from a different Bosch website and contains information about reprogramming ECUs for the purpose of meeting particular EU standards for diesel emissions.

- iv) Exhibit HO4 contains a print from the website of Turbo Dynamics. The information begins

“Most modern vehicles contain an ECU... that is effectively a small computer which controls how the engine works”.

Turbo Dynamics perform what is known as ECU remapping, a process which involves remapping the parameters of the ECU away from the default settings the manufacturer initially used. The re-mapping process is sold on the basis of increasing performance, improving fuel efficiency and reducing carbon emission.

21. The opponent's specification reads:

Class 9: Parts for internal combustion engines for land vehicles, namely electric engine controls

22. The use of the word namely in the opponent's specification has a limiting effect, limiting the specification to the named goods which essentially become:

Electronic engine controls (in class 9) being a part for the internal combustion engines of land vehicles.

23. The applied for specification is wider and more varied. I will go through the applied for goods and services one by one, albeit grouping them when it is reasonable to do so.

Class 9

Electronic control units, Motorsport engine management control units all for racing vehicles

24. Although different terminology is used, the essence of the goods in both specifications is the same. They equate to ECUs. I note the applicant's point in its counterstatement that its ECU is for rally and track cars whereas the opponent's ECU is for normal cars. This is not pertinent because the opponent's specification is not limited to a particular type of ECU with the consequence that its specification covers all types. The goods are identical, or, if they are not, they must be similar to the highest possible degree.

Software and programs for tuning vehicles; Computer software; computer programs; computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning; software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning; ECU software

25. It is clear from the evidence that software is used in conjunction with an ECU to perform maintenance, remapping and tuning of certain aspects of engine performance. The goods therefore have a similar purpose. The nature is of course different as are the methods of use. The goods do not compete as you would not buy one instead of the other. However, there does seem to be a clear complementary relationship with the software being important (possibly even indispensable) for the use of the ECU (and vice versa) and is the type of relationship whereby consumers may think that the responsibility for the respective goods lies with the same undertaking. The goods are also likely be sold through the same trade channels. There is a reasonably high degree of similarity.

Software updates

26. On the basis that such goods could be software updates for ECU software, the position is similar to the above, although, perhaps, one step removed (because it is the update code rather than the original code). The step, though, is not sufficient to say that there is no similarity. The goods are still aimed at tuning the performance of an engine and there is still a complementary relationship and the competing goods still likely to be offered through the same trade channels. There is a medium level of similarity.

Electronic publications; instructional material, teaching materials ... provided on-line from computer databases; user and instruction manuals provided in electronic form; downloadable electronic publications.

27. I think it is reasonably clear that such goods could all relate to ECUs and their use. For example, the goods could be instructional manuals informing the user how to operate an ECU. The purpose is related, the nature and method of use different, the trade channels potentially the same and there may be a degree of complementarity. I consider there to be a moderate degree of similarity. I acknowledge that the applied for goods notionally include goods for other purposes, potentially which have nothing to do with ECUs. However, given that the applicant comments in its counterstatement that its business relates to ECUs, and given that the applicant has not provided any form of limited fall-back specification, it would not, in my view, be appropriate to consider the position in so far as goods not relating to ECUs is concerned.

Computers

28. The term “computers” is broad enough to cover not just devices such as PCs or laptops, but also other devices which perform, as their primary role, basic computational functions. There are a number of references in the evidence to an ECU being, or effectively being, a computer. In *Gérard Meric v OHIM* (Case T-133/05) the General Court explained that goods can be considered as identical if they fall within the ambit of a general category of the competing specification, it stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, *OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

29. In consequence of the above, I conclude that there is identity on the basis that the goods of the earlier mark fall within the general category of the term computers in the applied for mark. Again, I acknowledge that there is less (and potentially no) similarity between a computer such as a PC compared to an ECU, but, as already

stated, it is not appropriate to consider such notional fall-backs in the circumstances before me.

Electronically, magnetically and optically recorded data for computers; ...data provided on-line from computer databases

30. Whilst with some of the goods assessed so far it has been reasonable to infer that they relate in some way to ECUs, it is difficult to make such an assumption about data. Whilst ECU software may extract data from the ECU for diagnostic purposes, this is not data which could be offered for sale by a business. In its submissions, the opponent refers to Exhibit HO1 which contains a reference to ECUs having data logging capabilities. This may be so, but the point I have made applies here. The data (from the engine) may be stored in the ECU, but there is no trade in the data. The applicant has applied to use the mark in relation to data. Without being in a position to understand what the link could be between an ECU and the data the applicant has applied to register its mark for, my finding is that the goods cannot be held to be similar.

Class 12

Parts of land vehicles.

31. As the opponent points out in its submissions, parts for land vehicles would include engine components, and, also, complete engines for land vehicles. An ECU is an engine part (the specification of the earlier mark says as much) so there must be some similarity with the purpose of other engine parts, albeit the particular role the parts play in the engine may be different. The goods may have a different nature (given the electronic nature of an ECU compared to the more mechanical nature of traditional engine parts), will have a different method of use and do not compete. However, there is likely to be some complementarity and, also, the potential for the goods to be sold through the same or similar trade channels. I consider there to be a moderate level of similarity between the goods.

Class 35

Retail services connected with the sale of computer software, computer programs, computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, ECU software, software updates

32. In the field of ECUs, it strikes me that there must be some similarity between the ECU itself and the retail sale of ECU software. Although the retail relates to the software not to the ECU, there is still some form of complementary relationship and consumers would, in my view, readily assume that the responsibility for those goods lies with the same undertaking as the retail service given the inextricable link that exists between ECUs and ECU software more generally. However, given that this is the retail aspect of ECU software (not the ECU), the similarity must be assessed as low.

Retail services connected with the sale of electronic publications, instructional material, teaching materials, user and instruction manuals provided in electronic form, electronic publications, downloadable electronic publications

33. I think the same applies here as set out above. There is a low degree of similarity.

Retail services connected with the sale of data provided on-line from computer databases and data provided on-line from computer databases

34. As I have found data not to be similar to the opponent's goods, the opponent can be in no better position here. These services are not similar to the goods.

The bringing together for the benefit of others.....

35. The applicant has also applied for the term "the bringing together for the benefit of others..." in relation to the same goods as per its retail services. The findings I have made so far apply in equal measure.

Class 37

Vehicle tuning, mobile vehicle tuning services.

36. To tune a vehicle the person providing the service will no doubt make use of the ECU and its accompanying software. Thus, the service serves a similar purpose (the end result being to tune and improve engine performance). The goods do not really compete because one cannot tune without an ECU, so both are needed. However, there seems to me to be a strong degree of complementarity as the customer who has an ECU fitted will need, if they do not have the technical skills themselves (or access to the relevant software), to use the services to unleash the potential of the ECU. It is the type of relationship that consumers will readily assume that the responsibility for those goods lies with the same undertaking. I consider there to be a medium degree of similarity between the goods and the service.

Software and product training

37. Whilst I have reservations as to the whether this service has been classified correctly, there is clear potential for the services to relate to ECUs and the software to be used in conjunction with them. Thus, the training would have a complementary relationship with the goods of the earlier mark, albeit one I would pitch at a low degree.

Average consumer and the purchasing act

38. 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*. 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. For items such as ECUs, the average consumer is more likely to be a tradesperson such as a mechanic who is tasked with fitting or replacing an ECU in the engine of a vehicle. It may be possible that a keen amateur member of the general public may also attempt the job and buy the part accordingly. However, I must also bear in mind that the end consumer may be the person who has to pay for the part (and the work in fitting it) so they may also be involved in the purchasing process.

40. Whilst the goods may be selected after perusal of website and brochures, which suggests a visual selection process, there may also be an aural aspect to the process as parts for vehicles may be ordered at a trade counter or even ordered over the telephone. Therefore, both the visual and aural impacts of the marks are important.

41. The purchase of an ECU is unlikely to be routine (even for a tradesperson) and such things are unlikely to be low cost items. Care will also need to be taken to ensure the compatibility of the product and the features it will offer. This, therefore, equates to a degree of care somewhat higher than the norm. Much of what I have said applies in equal measure to the other applied for goods and services given that there are, largely speaking, ancillary goods and services to ECUs. I accept, though, that some (the retail service for example, or manuals etc) may be selected with only a medium degree of care.

Distinctiveness character of the earlier marks

42. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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. The opponent has filed no evidence of use of its mark, consequently, I have only its inherent characteristics to consider. The word SIMTEC is an invented word, albeit the ending TEC may be evocative of the word TECHNOLOGY. As a whole it makes no suggestive or allusive nod to the goods save that they may be technological products. Overall, I consider that this equates to a mark of a slightly higher than normal level of inherent distinctive character, albeit, not of the highest level.

Likelihood of confusion

44. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

45. Part of the applicant’s pleaded defence is based on the prior use of its mark and the absence of confusion. This defence fails for a number of reasons. Firstly, no evidence from the applicant has been accepted into the proceedings so none of what it has pleaded has been made good. Secondly, even if the evidence had been accepted into the proceedings, and even if I had accepted that it demonstrated prior use, prior use alone is not a defence. This is because the opponent has a valid mark which predates the applicant’s mark. The question under section 5(2)(b) is simply about confusion, so prior use does not alter this (other than in certain circumstances I will come on to). If the applicant considered that it had a prior right (prior to the opponent’s mark) then it could have sought to invalidate the opponent’s mark, so clearing the way for its own mark. This has not been done. The significance, or more accurately the lack of significance, of all this is set out in tribunal practice notice 4 of 2009.

46. Notwithstanding what I have said, there may be certain circumstances in which prior use can assist. One circumstance relates to an absence of confusion, a point argued by the applicant here. However, whilst an absence of confusion in the marketplace has the potential to have some indicative value, this would require, at the very least, parallel trading. If there has been no parallel trading then the absence of confusion is indicative of little because no opportunity for confusion will have arisen. In any event, even if there has been parallel trading then an absence of confusion is not always a silver bullet to the likelihood of confusion because there are often extraneous factors which have assisted in preventing actual confusion,

factors which often do not form part of the notional assessment before the tribunal. There is no evidence of parallel trading, so the absence of confusion argument fails. One further circumstance I should mention is that, sometimes, honest concurrent use of two marks may be relevant even if their use would ordinarily lead to confusion. However, such an outcome is rare and is only likely to apply in exceptional circumstances¹. There are no exceptional circumstances here and, in any event, there is no evidence of any concurrent use, even if the applicant's "evidence" had been accepted.

47. In relation to ECUs as applied for in class 9 (and similar terms), the goods are identical. The marks are highly similar visually and aurally identical. The conceptual impact is neutral. I have also assessed that the earlier mark has a slightly higher than average level of distinctive character. Most of these factor point towards confusion than away from it. I bear in mind that the purchase of the goods may be subject to a higher degree of care than the norm. This has the capacity to reduce the effects of imperfect recollection. However, notwithstanding this, the marks are simply too close to avoid confusion for the identical goods in play. **There is a likelihood of confusion.**

48. In relation to the other applied for goods and services, I come to the same conclusion. Whilst the goods and services are not identical, and, indeed, have varying degree of similarity, they are all, to some extent, part and parcel of the goods and services likely to be offered by the manufacturer of an ECU. I have borne in mind that a lesser degree of goods similarity has the potential to offset a higher degree of similarity between the marks, however, the closeness of marks and the relationship between the various goods and services leads me to conclude that there is a likelihood of confusion.

49. The opposition succeeds for all of the opposed goods and services, save those that relate to data. The opposition fails for the data related goods and services because if the goods/services are not similar then there can be no likelihood of confusion².

Conclusion

50. The opposition succeeds in respect of:

Class 9: Electronic control units, Motorsport engine management control units all for racing vehicles, software and programs for tuning vehicles. Computer software; computer programs; computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning; software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning; ECU software; software updates; electronic publications; instructional material, teaching materials provided on-line from computer databases; user and instruction manuals provided in electronic form; computers; electronic publications; downloadable electronic publications.

¹ As per *Budějovický Budvar, národní podnik v Anheuser-Busch Inc* Case C-482/09 [2012] ETMR 2

² As per *Waterford Wedgwood plc v OHIM* Case C-398/07

Class 12: Parts of land vehicles.

Class 35: Retail services connected with the sale of computer software, computer programs, computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, ECU software, software updates, electronic publications, instructional material, teaching materials provided on-line from computer databases, computer software, user and instruction manuals provided in electronic form, electronic publications, downloadable electronic publications; the bringing together for the benefit of others computer software, computer programs, computer software for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, software programs for use in vehicle tuning, car tuning, ECU remapping and diesel tuning, ECU software, software updates, electronic publications, instructional material, teaching materials provided on-line from computer databases, user and instruction manuals provided in electronic form, electronic publications, downloadable electronic.

Class 37: Vehicle tuning, Mobile vehicle tuning services, software and product training

51. But, bearing in mind where the opposition failed, and bearing in mind the goods and services not opposed, the application may proceed in respect of:

Class 9: Data provided on-line from computer databases; computer networks; global computer networks; computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet; computer software for database and digital data management and integration; computer software to enable searching and management of data; computer software for facilitating or enabling access to databases, communications networks and e-mail services; virtual reality systems; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods; magnetic data carriers including magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data; discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded; CD-ROMs; MP3; electronically, magnetically and optically recorded data for computers; credit cards, debit cards and loyalty cards; apparatus for the use in cleaning the aforesaid goods; parts and fittings for all of the aforesaid goods.

Class 35: Retail services connected with the sale of data provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and websites), telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet, computer software for database and digital data management and integration, computer software to enable searching and management of data, computer software for facilitating or enabling access to databases, communications networks and e-mail services, virtual reality systems, computers, cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, magnetic data carriers including

magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data, discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded, CD-ROMs, MP3, electronically, magnetically and optically recorded data for computers, credit cards, debit cards and loyalty cards, apparatus for the use in cleaning the aforesaid goods, parts and fittings for all of the aforesaid goods; establishment of business and retail stores; the preparation and distribution of promotional materials; business management services; the bringing together for the benefit of others data provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and websites), computer software and telecommunications apparatus (including modems) to enable connection to databases, computer networks, global computer networks and the Internet, computer software for database and digital data management and integration, computer software to enable searching and management of data, computer software for facilitating or enabling access to databases, communications networks and e-mail services, virtual reality systems, computers, cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, magnetic data carriers including magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data, discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded, CD-ROMs, MP3, electronically, magnetically and optically recorded data for computers, publications, credit cards, debit cards and loyalty cards, apparatus for the use in cleaning the aforesaid goods, parts and fittings for all of the aforesaid goods, enabling customers conveniently to view and purchase those goods in a retail store, from an Internet web site or by means of telecommunications; advertising, marketing and publicity services; advertising in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising, operating, management, advertising and marketing of online websites; public relations; direct marketing services; business management and administration; business advisory services; market surveys, analysis and research; business advisory services in relation to the provision of sponsorship; event marketing; organisation of business shows; database marketing; sales promotion services; preparing and placing of advertisements; consultancy services relating to advertising, publicity and marketing; management consultancy services; business advisory services; advisory and consultancy services relating to all the aforesaid.

Costs

52. The opponent has succeeded to a large extent and is entitled to a contribution towards its costs. My assessment is set out below:

Opposition fee - £100

Preparing a statement and considering the other side's statement - £300

Filing evidence - £500

Written submissions - £400

Total - £1300

53. I therefore order Simtek (International) Limited to pay Continental Automotive GmbH the sum of £1300. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of November 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**