

**O-045-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3076335  
BY TRINSIC LIMITED TO REGISTER THE TRADE MARK**

**TRINSIC**

**IN CLASSES 9, 35, 38 AND 42**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 403752  
BY TRINSIC INTERNATIONAL BVBA**

## Background and pleadings

1) Trinsic Limited (“the applicant”) applied to register the trade mark “Trinsic” in the UK on 10 October 2014. It was accepted and published in the Trade Marks Journal on 7 November 2014. The goods and services of the application relevant to this opposition are:

**Class 9:** *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), [...] apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; [...], calculating machines, data processing equipment, computers; computer software; [...].*

**Class 35:** *[...]; data processing; [...]; retail services connected with the sale of apparatus for recording, transmission or reproduction of sound or images, computers and computer software.*

**Class 38:** *Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.*

**Class 42:** *Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.*

2) Transic International BVBA (“the opponent”) partially oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier Community Trade Mark 8288367 in respect of the trade mark “TRANSICS”. It has a filing date of 8 May 2009 and this, being before the filing date of the opposed trade mark, is an “earlier mark” for the purposes of these proceedings, as defined in Section 6 of the Act. The date of entry on the register is 26 January 2014. This is less than five years before the publication date of the opposed trade mark. Therefore, the earlier mark is not subject to the proof of use provisions at Section 6A of the Act. The following goods and services are relied upon in this opposition:

**Class 9:** *Data processing apparatus and computers; board computers and detection and tracking apparatus and installations; software for the aforementioned products, board computers for telematics applications in vehicles; electric, electromechanic, electronic installations and apparatus for the transmission, modification, storage, processing, linking, monitoring, controlling, retrieval, registration, measuring, recording, analysing, comparing, exchanging, also copying of operational data, actual operating conditions and other information such as trip purposes, routes, driving time, vehicle stands, namely vehicles for the transport of goods and persons; communication*

*systems, telematics systems with apparatus for recording, transmission and reproduction of speech, data and information, including computers, telephones, fax and displays for the wireless communication between vehicles, namely in-between vehicles for the transport of goods and persons and/or stationary and mobile locations via terrestrial radio installations and extraterrestrial satellites; location systems for vehicles and transportable goods linked to a satellite supporting Global Positioning System (GPS); hardware and software for information, controlling and communication in a vehicle fleet and/or large vehicle fleet; apparatus for recording, transmission and reproduction of data, sound or images; data, sound, image and program carriers; data processing apparatus and computers, telecommunication and data communication apparatus; computer programs recorded on data carriers of all kinds, also for use on the Internet; itinerary planning and ordering systems as well as programs for vehicle fleet, expeditions, transporting companies.*

**Class 38:** *Telecommunication; wireless data communication between a mobile object such as a vehicle and a fixed or mobile, movable reception, analysis, service, operation, controlling and guarding station.*

**Class 42:** *Scientific and technological services, as well as research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; development and maintenance of computer programs recorded on data carriers of all kinds, also for use on the Internet, namely for telematics services.*

3) The opponent argues that the respective goods and services are identical or similar and that the trade marks are similar. By email of 16 December 2015, the opponent reduced the scope of its opposition and the list of goods and services in paragraph 1 reflects the list of goods and services being opposed taking account of the opponent's email.

4) The applicant filed a counterstatement denying the claims made.

5) Neither side filed evidence. A Hearing took place on 20 January 2016, with the applicant represented by Ms Eesheta Shah for Marriott Harrison LLP. The opponent did not attend but provided written submissions in lieu. It was represented by Harrison IP Limited in these proceedings.

## **DECISION**

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

6) Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### ***Comparison of goods and services***

7) In the judgment of the Court of Justice of the European Union (“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”.

8) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“the GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

10) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary”, in the sense referred to in *Canon*, means:

“...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”.

11) In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.

12) At the hearing, it was submitted, on behalf of the applicant, that the opponent’s specifications are weighted towards goods and services for use in transport and vehicles and I should infer from this that all the goods and services, even when not specifically limited in this way, relate to this field. I dismiss this approach. It is well established that marketing considerations are not relevant when considering likelihood of confusion. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

13) Whilst these comments were made in the context of consideration of likelihood of confusion, it follows that it is not permissible to take marketing considerations into account when comparing goods and services. Therefore, I keep this guidance in mind when undertaking the following comparison:

*Class 9*

14) My findings are set out in the table below:

<b>Applicant's goods</b>	<b>Opponent's goods</b>	<b>Finding</b>
<i>measuring [...] apparatus and instruments</i>	<i>electronic installations and apparatus for the [...], measuring, [...] of operational data, actual operating conditions and other information such as trip purposes, routes, driving time, vehicle stands, namely vehicles for the transport of goods and persons</i>	The applicant's term is broad and includes the goods of the opponent. When applying the guidance in <i>Meric</i> , the respective goods are identical.
<i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, [...], signalling, checking (supervision), [...] apparatus and instruments</i>	<i>electronic installations and apparatus for the transmission, modification, storage, processing, linking, monitoring, controlling, retrieval, registration, measuring, recording, analysing, comparing, exchanging, also copying of operational data, actual operating conditions and other information</i>	The applicant's terms are very broad but overlap with the equally broad terms of the opponent's specification. Therefore, the parties' terms include goods that are common to both. The respective terms, therefore, include identical goods.
<i>apparatus for recording, transmission or reproduction of sound or images;</i>	<i>apparatus for recording, transmission and reproduction of data, sound or images</i>	These terms self-evidently cover identical goods.
<i>magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; [...],</i>	<i>data, sound, image and program carriers</i>	The opponent's broad term covers all the goods covered by the applicant's terms. Applying the guidance in <i>Meric</i> , the goods are identical.
<i>calculating machines, data processing equipment, computers; computer software</i>	<i>Data processing apparatus and computers</i>	The opponent's broad term covers all the goods covered by the applicant's term. Applying the guidance in <i>Meric</i> , the goods are identical.

### Class 35

15) The term *data processing* in this class covers a business service and there are no equivalent or even similar goods and services in the opponent's list of goods and services. The opponent, in its written submissions merely makes a broad statement that all goods and services not self-evidently identical are similar. However, I do not see any similarity here. The opponent's Class 9 specification does include *data processing apparatus* but I am not aware that consumers would expect the provider

of data processing services to also provide data processing apparatus. Therefore, I conclude that there is no overlap in trade channels. There is no similarity in terms of nature, purpose or methods of use. In the absence of any detailed submissions from the opponent I, therefore, find that there is no similarity between the applicant's *data processing* and any of the opponent's goods and services.

16) The applicant's Class 35 specification includes *retail services connected with the sale of apparatus for recording, transmission or reproduction of sound or images, computers and computer software*. There are no equivalent services in the opponent's earlier mark, but the goods that are the subject of the applicant's services are covered by its Class 9 specification. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

17) In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v. goods. He said that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut.”

18) However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

19) Therefore, I recognise that retail services are different in nature, purpose and method of use to goods but that retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree (*Oakley*). However, having regard for Mr Hobbs' comments, I must consider the issue carefully. The retailing of apparatus for recording, transmission or reproduction of sound or images, computers and computer software is usually undertaken by third party retailers. Consequently, there is not a consumer expectation that the provider of the goods and the provider of the retail services is the same or a linked undertaking. Consequently, I find that beyond some complementarity at a high level, there is no similarity.

#### *Class 38*

20) The applicant's *Telecommunications services* are self-evidently identical to the opponent's *Telecommunication*. Further *portal services* and *providing user access to the Internet* also appear to describe a telecommunication service and I find that this is also covered by the opponent's *Telecommunication*.

21) Further, the online Oxford Reference dictionary defines "Telecommunication" as "Communication over a distance by cable, telegraph, telephone, or broadcasting"<sup>4</sup>. The applicant's *chat room services*, *e-mail services* are communications conducted on or over the Internet. In other words, they are communications conducted over distance by cable. With the dictionary definition in mind, these services are covered by, and therefore identical to the opponent's *Telecommunication*. Further, "broadcasting" is specifically mentioned, in the dictionary definition, as being a telecommunication. Consequently, I find that *radio and television broadcasting* are identical to the opponent's *Telecommunication*.

#### *Class 42*

22) The applicant's *Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming* cover identical services to the opponent's *Scientific and technological services, as well as research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software*.

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<sup>4</sup> <http://www.oxfordreference.com/search?q=telecommunication&searchBtn=Search&isQuickSearch=true>



23) The applicant's *installation, maintenance and repair of computer software and computer consultancy services* share similarities with the opponent's *design and development of computer hardware and software; computer programming*. All of the applicant's services requires the skills of a computer programmer and, consequently, such services are likely to be provided by the same or linked undertakings. Therefore, there is an overlap of trade channels. This overlap exists because the nature of all the services is that of programming software or providing advice regarding the same. This also results in similarity of intended purpose, where all these services have the purpose of producing software (and possibly hardware) to undertake a particular role defined by the customer. Taking all of this into account, I conclude these services share a good deal of similarity.

24) It is not clear to me why the opponent considers that the applicant's *design, drawing and commissioned writing for the compilation of web sites and creating, maintaining and hosting the web sites of others* are similar to its goods and services. These are specialist services and the evidential burden falls upon the opponent to demonstrate that there is similarity between such goods or services (*Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, paragraph 43). Consequently, I am unable to conclude that there is any similarity.

25) The applicant's broad term *design services* includes the opponent's *design [...] of computer hardware and software*. With the guidance provided in *Meric* in mind, I find that the respective services are identical.

### **Comparison of trade marks**

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

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

27) 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.

28) The respective trade marks are shown below:

<b>Earlier trade mark</b>	<b>Contested trade mark</b>
TRANSICS	Trinsic

29) Both parties' marks consist of a single word and consequently the distinctive character of each trade mark resides in the whole words.

30) Visually, both trade marks share a number of similarities, being similar in length (seven and eight letters respectively), both beginning with the letters "Tr" and both containing the identical letter sequence "nsic". These similarities are countered to a degree by the third letters being different and the opponent's trade mark also having an additional letter "s" at the end of the trade mark. However, these differences are relatively small and do not off-set, to any great degree, the visual similarities that exists between the trade marks. I conclude that they share a moderately high degree of visual similarity.

31) Aurally, the applicant's trade mark consists of the two syllables "trin" and "sic". The opponent's trade mark also consists of two syllables, namely "tran" and "sics". Both syllables are similar to the corresponding syllable in the other trade mark and I conclude that they share a moderately high level of aural similarity.

32) The opponent states that neither trade mark has a meaning. The applicant submits that the respective marks are conceptually dissimilar because the consumer will perceive the applicant's mark to have its origins in the word "intrinsic" and evokes the sense of "belonging" or "essential". It submits that the word "transics" includes the prefix "trans" that is used to mean "across, through, over, to or on the other side of, beyond, outside of, from one place, person, thing, or state to another. I am unconvinced by the applicant's arguments. The meaning of the word "intrinsic" is lost when the first two letters are removed. Further, even if I am wrong on this point, the meaning of "intrinsic" is nebulous when used in respect of the applicant's goods and services. So if the meaning could also apply to the applicant's trade mark, it would be lost when used in respect of the goods and services listed. The opponent's mark consists of the prefix "trans" and the letter combination "ics". With the second component having no meaning it creates the effect of the word, as a whole, being an invented word with no meaning. In this case, the "trans" element does not stand out because there is no descriptive second element that the prefix would be perceived as applying to. It is my view that the trade mark, as a whole, will be perceived as a made up word with no meaning.

33) The opponent's trade mark may give the impression of being a plural because of the presence of the letter "s" at the end. Taking this and all of the above into account, I conclude that the respective trade marks are neither conceptually similar nor dissimilar.

***Average consumer and the purchasing act***

34) 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*.

35) 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.”

36) The applicant submits that the respective goods and services are specialist in nature and are purchased by knowledgeable consumers who pay an above average level of attention during the purchasing act. This is certainly true for many of the respective goods and services, but others, such as *apparatus for reproduction of sound* includes ordinary household musical goods such as speakers, radios and devices for playing tracks from a stored music catalogue or online music library. Whilst there is a reasonable level of care and attention paid by the consumer when purchasing such goods, the consumer is not a specialist and generally consists of ordinary members of the public. The purchase of such goods is primarily visual in nature, but I do not disregard that aural considerations may also play a part where, for example the goods or services are procured by telephone.

### ***Distinctive character of the earlier trade mark***

37) 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).”

38) There is no evidence of use and therefore I am unable to make a finding regarding whether the opponent's trade mark has acquired an enhanced distinctive character through use. However, as I have already noted, the trade mark consists of a made up word and, therefore, is endowed with a high level of inherent distinctive character.

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

39) 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.

40) I have found that all of the applicant's Class 9 goods and Class 38 services and the following Class 42 services are either identical or share a good deal of similarity with the opponent's goods and services:

*Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software and computer consultancy services; [...] design services*

41) I have also found that the respective trade marks share a moderately high degree of visual and aural similarity and that neither mark has any conceptual meaning. The average consumer ranges from the general public to specialist buyers, and that in respect of the former there is a reasonable degree of care and attention and an enhanced level of care and attention in respect of the latter. Finally, I found that the opponent's earlier trade mark is endowed with a high level of distinctive character.

42) Whilst the applicant points out that the marks are not identical, I find that the similarities are such that there is a likelihood of confusion where the trade marks are confused with each other. Whilst there is an enhanced level of attention during the purchasing process of many of the respective goods and services, this is offset to a degree when factoring in imperfect recollection and the high level of distinctive character of the earlier mark.

43) The applicant relied heavily upon a claim that the marks are conceptually different. It is true that conceptual similarities can result from parts of invented words (see *Usinor SA v OHIM*, Case T-189/05, paras 62 to 68). It follows that conceptual dissimilarity may also result from parts of invented words. However, as I have already explained, I do not agree with the applicant when it identifies meanings that will be attributed to each trade mark.

44) The applicant also relied upon a submission that because the opponent is in the field of transport and vehicles, the terms in its specifications are coloured by this. I have already discussed this approach in paragraph 12, above.

45) Therefore, there is a likelihood of confusion in respect of the goods and services identified in paragraph 41, above.

## **Applicant's fall-back position**

46) By letter of 19 November 2015, the applicant offered a fall-back position that consists of adding the following exclusion to all three of its specifications:

*“; none of these [goods] [services] relating wholly or primarily to vehicle control systems, fleet control and fleet management.”*

47) I dismiss this because the addition of the exclusion has no impact upon my findings. The goods and services of the opponent's earlier mark that I have found to be identical or to share a good deal of similarity to the applicant's goods and services, are not limited to a particular field (see the first column of the table at paragraph 14 and the opponent's services referred to in paragraphs 15, 20, 23, 24 and 25). Consequently, the limitation offered by the applicant will not alter the analysis of the level of similarity. Even with the proposed limitation, the applicant's goods and services (as identified) will still be identical or share a good deal of similarity with the opponent's broad terms.

## **Conclusion**

48) The opposition has been successful in respect of the following of the applicant's goods and services:

**Class 9:** *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), [...] apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; [...], calculating machines, data processing equipment, computers; computer software; [...].*

**Class 38:** *Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.*

**Class 42:** *Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; [...]; design services.*

49) The opposition fails in respect of the following:

**Class 35:** *[...]; data processing; [...]; retail services connected with the sale of apparatus for recording, transmission or reproduction of sound or images, computers and computer software.*

**Class 42:** *[...] design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others*

## **COSTS**

50) The opponent has been successful in approximately 80% of its opposition and is entitled to a contribution towards its costs. The opponent submits that the applicant has been the cause of additional, unnecessary costs by requesting a hearing. However, the applicant was entitled to be heard and the opponent did not attend the hearing but, rather, provided brief written submissions. Therefore, the opponent's costs associated with the hearing were not high. Consequently I decline to make an enhanced award as requested.

51) Taking account of all of the above, I award the opponent costs in respect of its opposition fee and 80% of what I would have awarded for the other items if it had been successful in its entirety. The award is as follows:

Preparing a statement and considering the counterstatement	£240
Opposition fee	£200
Written submissions	£320
<b>Total</b>	<b>£760</b>

52) I therefore order Trinsic Limited to pay Trinsic International BVBA the sum of £760. The above sum should be paid within fourteen 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 27<sup>th</sup> day of January 2016**

**Mark Bryant**  
**For the Registrar,**