

O-463-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3162713 BY
INTERCONNECT SOLUTIONS LTD
TO REGISTER:**



INTERCONNECT SOLUTIONS

AS A TRADE MARK IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 407329 BY INTERCONTEC PFEIFFER
INDUSTRIE-STECKVERBINDUNGEN GMBH**

BACKGROUND & PLEADINGS

1. On 4 May 2016, Interconnect Solutions Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods shown in paragraph 13 below. The application was published for opposition purposes on 10 June 2016.

2. On 6 September 2016, the application was opposed in full by Intercontec Pfeiffer Industrie-Steckverbindungen GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon the following International Registration designating the European Union (“IREU”):

No. 1007957 for the trade mark shown below which designated the EU on 14 April 2009 (claiming an International Convention priority date of 21 October 2008 from Germany) and which was granted protection in the EU on 18 June 2010. The opponent relies upon all the goods for which the trade mark is protected, full details of which can be found in the Annex to this decision.



3. In its Notice of Opposition, the opponent states:

“...The dominant and distinctive element of the earlier trade mark is the word INTERCONTEC...The word SOLUTIONS and the device contained within the mark of the application, add little, if any, distinctive character to the mark of the application. As a consequence, the marks are visually and phonetically similar. The opposition is directed against goods that are highly similar, if not identical to those for which the earlier trade mark is registered.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied. It stated:

“The opposition has claimed that the goods are similar in nature. This is not the case, as there are no goods mentioned by the opposition party. However, “Interconnect Solutions” deals in network infrastructure (copper, fibre, RF/wireless network) and power back up solutions.

We also disagree that there is any resemblance between the sign of the opposition and the sign stated by us. There is no similarity what so ever in the logo stated by us, as the mark illustrated is based on 2 elements, which are as follows:

1) The Swoosh “Orange and Blue” have been conceptually designed to illustrate a firm handshake with the pantone 653C and 715C. The Swoosh in the logo itself is a mark of brand recall and bear no resemblance with that of the opposition.

2) Furthermore the words “Interconnect Solutions” are developed in “Frizquadrata” font and are not in any way resembling to the fonts in the mark of the opposition. The sign of the opposition “intercontec” does not hold any meaning, however the word “interconnect” is a technical jargon and means “to connect (two or more things) with each other”. The word “Solutions” is added into our sign due to the reason that we are solution providers. Therefore I disagree that there is any resemblance to our mark as stated by the opposition and that a state of confusion will be caused amongst the audience. This cannot be considered in a state where there is a difference in visual and aural state of signs.

The signs are also aurally not similar as well; as our brand sign is read as Interconnect Solutions all over the world, which is also how we illustrate it on our website and on our promotional materials. This is not the case with our

opposition as their sign is read as “Intercontec”. A significant difference can be observed at this point.”

5. In these proceedings, the opponent is represented by Urquhart-Dykes & Lord LLP; the applicant represented itself. Only the applicant filed evidence. At the conclusion of the evidence rounds the tribunal wrote to the parties. Its letter of 21 June 2017 included the following:

“The case has now been reviewed by the Hearing Officer and it is noted that the respective goods are specialist electronic items and that neither party has provided submissions regarding why/why not the respective goods are identical/similar.”

6. The parties were allowed a period of 14 days to: “provide written submissions regarding the similarity of the goods and whether the goods are similar or identical or not”; only the opponent responded to that invitation. Although neither party asked to be heard, both elected to file written submission in lieu of attendance at a hearing (the opponent’s submissions were included in its response to the specific issue raised by the tribunal in its letter of 21 June); I will refer to these submissions, as necessary, later in this decision.

DECISION

7. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. An earlier trade mark is defined in section 6 of the Act, 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had been protected for more than five years at the date when the application was published, it is, in principle, subject to proof of use, as per section 6A of the Act. In its Notice of Opposition, the opponent indicated that its earlier trade mark had been used upon all the goods for which it is protected and upon which it relied. However, because in its counterstatement the applicant elected not to put the opponent to proof of use, it was not necessary for the opponent to make good its claim. The opponent can, as a consequence, rely upon all the goods it has identified.

The applicant’s evidence

10. This consists of a witness statement from Fahad Muneer Vakassi, the applicant’s Assistant Manager Marketing. Mr Vakassi states:

“2. The trade mark “Interconnect Solutions” was first used and promoted in the year 2005 in the United Arab Emirates. As our target market/audience is based in the Middle East region therefore all our business operations take place in the Middle East region.”

11. Mr Vakassi goes on to explain that the applicant’s trade mark has been used upon “network infrastructure products and power back-up solutions” and he provides seven exhibits in support, these are as follows:

Exhibit TMS1 - contains two trade marks; the first, is said to have been used from 2005-2013 and the second (which although shown in black and white I infer is the trade mark the subject of the application) from 2014 onwards;

Exhibit TMS2 – consists of an undated photograph of “a sample carton of a box of connectors” from 2005 bearing the pre 2014 trade mark;

Exhibit TMS3 – consists of an undated photograph of “a sample carton of a box of Hybrid Matrix 4x4” which bears the trade mark the subject of the application (albeit in black and white);

Exhibit TMS4 - consists of an undated page obtained from the applicant’s website www.i-sol.co.uk bearing (i) a copyright date of 2007 and (ii) the pre 2014 trade mark;

Exhibit TMS5 - consists of an undated page obtained from the above website bearing the trade mark the subject of the application (albeit in black and white);

Exhibit TMS6 - consists of a copy of an advertisement which appeared in the “Teletimes Magazine” in October 2016, the trade mark the subject of the application (in black and white) appears in the advertisement;

Exhibit TMS7 - consists of photographs of four catalogues from 2013 and 2016, the trade mark the subject of the application (in black and white) can be seen on the back pages of the catalogues from 2016.

Section 5(2)(b) – case law

12. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in

mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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.

Comparison of goods

13. Although in its Notice of Opposition the opponent relied upon all of the goods for which its earlier trade mark is protected i.e. in classes 6, 7, 8, 9 and 17, in its submissions, it refers exclusively to its goods in class 9; the applicant adopted the same approach in its submissions filed in lieu of a hearing. The opponent's approach is, in my view, a sensible one. It amounts to an admission that it considers its goods in class 9 to represent its strongest case and an acceptance that if it does not succeed on the basis of its goods in class 9, it will be in no better position in relation to the other goods for which its earlier trade mark is protected. Proceeding on that basis, the comparison of goods is as follows:

The opponent's goods	The applicant's goods
<p>Class 9 - Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; electrical and electronical devices (included in this class); electrical connectors, bushes, plugs, right angle plugs and couplers, rectangular connectors; electrical connector sockets, halves of electrical connector sockets as well as component parts of electrical connectors and electrical connector sockets, like housing for electrical connectors or electrical connector sockets; pin inserts and female inserts for connectors and plugs; housing and covering for connectors; metal housing for connectors; metal housing with plastic</p>	<p>Class 9 - Coaxial Cables; LAN Cables; Patch Cords; Cable Markers; Coaxial Connectors; Splicing Connectors; Signal & Data Connectors; Face Plates; Patch Panels; Networking Cabinets & Racks; Optical Cables; FTTH - Outdoor Fiber Cable Assemblies; Optical Patch Cords; Optical Pigtails; PLC Splitters; Optical Connectors; Optical Adaptors; Mechanical Splice; Optical Attenuators; Optical Media Converters; Transceivers; Outdoor Splice Closures; Optical Face Plates & Terminal Boxes; Fiber Optic Outdoor Cabinets; Feeder Cables; Connectors & Adaptors; Passive Components; RF Power Splitters; RF Couplers; Hybrid Matrix apparatus to combine multiple input signals to output</p>

<p>coating for connectors; mounting boxes of metal, also for radial and axial sealing elements (included in this class); accessories for the electrical installation (included in this class), in particular accessories for the installation of connectors or plugs, namely prongs, female plugs, retainers, safety-clamps, protection covers, protecting caps, strain relieves, cable sleeves, gaskets and sealing-rings (all above mentioned goods, included in this class).</p>	<p>ports with minimum insertion loss and minimum intermodulation; RF Combiners; RF Termination Loads; RF Attenuator; Surge & Lightening Protection; Antennas; RF Jumper Cables; Tower accessories namely, surge lighting protectors, grounding kits, cable clamps, cable entry systems and hoisting grips; Grounding Kits; Cable Clamps; Cable Entry Systems; Hoisting Grips; Online UPS; Modular UPS; Dry Batteries; Gel batteries; Pure Gel Batteries.</p>
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14. 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”.

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 enquiry 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.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

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

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v 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 Vedral 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).”

15. In its response to the tribunal’s letter of 21 June, the opponent provided a detailed analysis of the competing goods. It concluded that as the applicant’s goods were either included in general categories which appear in its specification in class 9 and/or that if the phrase “apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity” is given its natural meaning (i.e. a range of goods whose purpose is to transmit electricity), the applicant’s goods are either identical or highly similar to its goods in class 9.

16. Although in its submissions filed in lieu of a hearing the applicant maintained that none of the competing goods were similar, it did not take issue with any of the descriptions the opponent provided of the goods in its specification. It did, however, state by reference to the broad phrase mentioned above:

“The goods mentioned here are actually the features of a good and not the goods itself, they are in terms the essence of any electrical product, and therefore comparing a tangible product with an intangible element is not possible.”

And:

“The opponent cannot claim any product to be similar against generic words “Apparatus and instruments”, this can mean any apparatus and instruments, as an apparatus and instrument is a category not the goods itself, furthermore to make a proper comparison specific products must be mentioned.”

17. Finally, the applicant also refers to the fact that “apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity” are not mentioned in the product listing category of the opponent’s website. As the applicant has not asked the opponent to provide proof of use of its earlier trade mark, it matters not whether the opponent has actually used its trade mark upon these goods; it is the specification of goods as it appears on the Trade Mark’s Register that matters.

18. As I mentioned above, the opponent’s trade mark includes, inter alia, the phrases “apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity” and “electrical and electronical devices (included in this class)”. These are broad terms which would include a wide range of goods. Notwithstanding the applicant’s submissions above, the decision in *Gérard Meric* makes it clear that “goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application...or when the goods designated by the trade mark application are included

in a more general category designated by the earlier mark.” I note that the opponent’s specification also includes the following phrases “electrical connectors” and “housing and covering for connectors; metal housing for connectors; metal housing with plastic coating for connectors”.

19. Applying the principles in *Meric* and keeping in mind the opponent’s descriptions of the goods in the application, it appears to me all of the applicant’s goods are, inter alia, likely to fall in one or other of the broad categories in the opponent’s specification. They are, as a consequence, to be regarded as identical.

The average consumer and the nature of the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

21. In its submissions, the opponent states:

“49...The opponent submits that the process of purchasing the goods of the applicant may involve accessing secure websites. As a consequence, the average consumer is likely to pay, at least, an average degree of attention.”

22. Although a member of the general public may be the average consumer of some of the goods at issue in these proceedings, many of the goods are, it appears to me, more likely to be aimed at specialist business users. As to the purchasing process, the goods at issue may be selected from the shelves of a bricks and mortar retail outlet or wholesaler and, as the applicant's evidence and the opponent's submissions indicate, from the pages of a website or catalogue; all the above strongly suggests that visual considerations will have an important part to play in the selection process. However, as many of the goods appear to be technical in nature, aural enquiries to, for example, those involved in the manufacture and sale of the goods (both in person and by telephone) and in the context of word-of-mouth recommendations from, for example, one business user to another, are also likely to be a feature of the selection process. In its submissions, the opponent submits that the average consumer will pay “at least an average degree of attention” during the selection of, it appears, the applicant's goods. Whilst that may also be the case in relation to, for example, less specialist goods which appear in the competing specifications, given what appears to be the technical nature of many of the goods at issue, I would expect both sets of average consumers to have a range of factors in mind when selecting the goods and to pay a fairly high degree of attention during that process. This level of attention is, in my view, likely to rise still further as the cost, specialist nature and, for example, commercial importance to an undertaking of the item being selected increases.



Comparison of trade marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

24. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade mark
	

25. The applicant’s trade mark consists of two components. The first, is a device consisting of two coloured elements (presented in blue and orange) forming a nearly circular whole. Although I note the applicant’s description of this device i.e. “a firm handshake”, I doubt this is how it will be understood by the average consumer. It is nonetheless a distinctive component and given its size and positioning will make an important contribution to the overall impression the trade mark conveys. The second component consists of the words “INTERCONNECT SOLUTIONS”, presented in a stylised but, in my view, unremarkable font. In its counterstatement and again in its submission filed in lieu of a hearing, the applicant states:

“However the word “INTERCONNECT” of the applicant is a technical jargon meaning “to connect (two or more things) with each other.”

26. Collinsdictionary.com defines “interconnect” as, inter alia, “a device that connects things” and “things that interconnect or are interconnected are connected to or with each other”. That accords with my own understanding of the word “interconnect” and, more importantly, will, in my view, accord with that of the average consumer. The word “SOLUTIONS” and its meaning i.e. “a specific answer to or way of answering a problem” (collinsdictionary.com refers) will also be well-known to the average consumer. The opponent considers this word to have “little if any distinctive character” and the applicant appears to agree indicating that this word indicates that “[it is a] solutions provider”; I agree with the parties’ views on this word. In my view, the words in the second component of the applicant’s trade mark form a “unit”, meaning an answer to one’s (an undertaking’s) interconnectivity issues. Although placed below the device, these words extend to the left and right of the device and will also make an important contribution to the overall impression the trade mark conveys. I will return to the distinctiveness of this unit below.

27. The opponent’s trade mark also consists of two components. Despite the stylisation present in the sixth and seventh characters (i.e. the interconnected letters “c” and “o”), the first component is most likely to be seen by the average consumer as consisting of the letters “i-n-t-e-r-c-o-n-t-e-c”. In relation to the second component, in its submissions, the opponent states:

“52...The words “INFINITE CONNECTIONS” are descriptive of the relevant goods that form the basis of the opposition proceedings. The earlier trade mark conveys the idea of connection solutions provided by the applicant.”

28. There can be little doubt that given its size and positioning in the context of the trade mark as a whole, the component consisting of the letters “i-n-t-e-r-c-o-n-t-e-c” will dominate the overall impression conveyed; I shall return to how this component will be

construed and its distinctiveness shortly. As the words “infinite connections” are much smaller and form a strapline which relate to the goods upon which the opponent relies, any distinctiveness they may have and any relative weight they may play in the overall impression conveyed will, in my view, be low.

The visual, aural and conceptual comparison

29. The competing trade marks contain, inter alia, components consisting of the letters i-n-t-e-r-c-o-n-t-e-c and word INTERCONNECT. They are eleven and twelve letters long respectively, the first eight letters will, in my view, be construed by the average consumer as identical and both components also contain the letters “EC” in the same order. Bearing that in mind, but reminding myself of the other components present in the competing trade marks, in particular the device element present in the applicant’s trade mark, results, in my view, in a moderate degree of visual similarity between the competing trade marks.

30. It is well established that when trade marks consist of a combination of words and figurative components, it is by the word components that the trade mark is mostly to be referred. In my view, the opponent’s trade mark will be referred to as in-ter-con-tec. As the word components of the applicant’s trade mark will be well-known to the average consumer their pronunciation is predictable i.e. IN-TER-CON-NECT SO-LU-TIONS, resulting in a fairly high degree of aural similarity between the competing trade marks. However, even if the opponent’s trade mark is referred to in full i.e. as in-ter-con-tec in-fi-nite con-nect-ions (which, in my view, is doubtful) and the applicant’s trade mark solely by the word “IN-TER-CON-NECT (which, in my view, is more arguable), there remains a reasonable degree of aural similarity.

31. Finally, the conceptual comparison. In its submissions, the opponent states:

“57. Conceptually, it is clear that [the competing trade marks] refer to goods in the “connections” field which make the marks conceptually very similar.”

32. In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).

63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, ‘galva’, which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes ‘llia’ and ‘lloy’ were meaningless.

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word ‘alloy’, corresponding to ‘alliage’ in French, even if the first letter of that word (‘a’) has merged with the last letter of the prefix ‘galva’, according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix ‘allia’ is combined with the prefix ‘galva’ in the same way. The evocative force of the suffix ‘allia’ will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word ‘alliage’. That process of identification is

facilitated still further by the association of the idea of 'alliage' (alloy) with that of galvanisation, the suffix 'allia' being attached to the prefix 'galva'.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark".

33. I agree that the presence of the word "INTERCONNECT" in the applicant's trade mark and, inter alia, the letters i-n-t-e-r-c-o-n-t-e-c in the opponent's trade mark (which, in my view, are highly reminiscent of the word INTERCONNECT), render the competing trade marks conceptually similar to a high degree. This conclusion is not affected by the device component in the applicant's trade mark (which does nothing to alter the conceptual message sent by the word INTERCONNECT) and is reinforced by the presence of the words "infinite connections" in the opponent's trade mark.

Distinctive character of the earlier trade mark

34. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

35. As the opponent has filed no evidence I have only the inherent characteristics of its trade mark to consider. In its submissions, the opponent states:

“59...Further, the opponent submits that the earlier trade mark has no link to any of the goods for which its registered, save for the word “connections”, which as discussed above does not form part of the dominant and/or distinctive element of the earlier trade mark. Further, the earlier trade mark is registered and, therefore, it is not for the office to conclude that the mark has anything other than a normal level of distinctiveness...”

36. In this regard, the opponent refers to the decision of the CJEU in *In Formula One Licensing BV v OHIM*, Case C-196/11P in which the CJEU found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community

trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

37. Although I understand the applicant’s submission to the effect that the word “intercontec” in the opponent’s trade mark “does not hold any meaning and is a designed word”, as I mentioned above, it is highly reminiscent of the word “interconnect”. As I also mentioned above, this conclusion is further supported by the presence in the opponent’s trade mark of the words “infinite connections”. As to the opponent’s submission to the effect that it is not open to me to find that its earlier trade mark “has anything other than a normal level of distinctiveness”, that is not correct. Whilst I must assume it has at least some distinctive character, as the case law explains, what I am required to do is to make an overall assessment of the greater or lesser capacity of the opponent’s trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings. Given what, in my view, are the highly reminiscent qualities of the dominant component of the opponent’s trade mark to the word “interconnect” and the relevance of this word to the opponent’s goods (which it refers to as “goods in the connections field”), the dominant component and the trade mark as a whole is, in my view, inherently distinctive to a fairly low degree. It is, of course, only the distinctiveness of the component in conflict that matters. I shall return to this point below.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons

between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are to be regarded as identical;
- while the average consumer of some of the goods at issue may be a member of the general public, many of the goods are only likely to be selected by specialist business users;
- as the goods at issue may be selected from the shelves of a retail outlet or wholesaler or from the pages of a website or catalogue, visual considerations will play an important part in the selection process. However, as many of the goods are technical in nature, aural considerations must also be kept in mind;
- while the degree of attention paid by the various average consumers to the selection of the goods at issue may vary (with at least an average degree of attention paid by all consumers), given the technical nature of many of the goods at issue, one would expect a fairly high degree of attention to be paid to the selection of the majority of the goods at issue;
- the component consisting of the letters “i-n-t-e-r-c-o-n-t-e-c” dominates the overall impression the opponent’s trade mark conveys;
- while both components of the applicant’s trade mark will contribute to the overall impression it conveys, the device component will make a distinctive contribution;
- the competing trade marks are visually similar to a moderate degree, aurally similar to at least a reasonable degree and conceptually similar to a high degree;
- the opponent’s earlier trade mark is inherently distinctive to a fairly low degree.

39. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to

increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

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

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

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

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

42. The only meaningful similarity between the competing trade marks is in respect of a component which either consists of the word INTERCONNECT or which despite its presentation and spelling, I have concluded is highly reminiscent of that word. When considered in relation to the goods at issue, the word INTERCONNECT and by parity of reasoning a word that so nearly resembles that word, has very little distinctive

character. In those circumstances, an average consumer paying at least an average degree of attention during the selection of the goods at issue in these proceedings is, notwithstanding either the dominant role the component which resembles that word plays in the opponent's trade mark or the contribution it makes to the unit in the applicant's trade mark, in my view, most unlikely to assume that the identical goods at issue emanate from either the same or economically linked undertakings. Much more likely, in my view, is that they will simply assume that unrelated undertakings competing in the same or similar fields have, unsurprisingly, elected to use a word in their trade mark which informs potential customers of the general field of business in which they are engaged i.e. to use the opponent's words "the connections field". There is, as a consequence, no likelihood of either direct or indirect confusion.

43. I reached the above conclusion on the basis of consumers paying at least an average degree of attention during the selection process. However, if, as I suspect, consumers are much more likely given the technical nature of the goods at issue to pay a fairly high degree of attention when selecting such goods (thus making them even less prone to the effects of imperfect recollection) this will reduce the likelihood of confusion still further.

Overall conclusion

44. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

45. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs, and if so, to complete a

pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”.

46. As the applicant did not respond to that invitation within the timescale allowed (nor has any response been received from the applicant prior to the date of the issuing of this decision), and as the applicant has not incurred any official fees in defending its application, I make no order as to costs.

Dated this 27th day of September 2017

C J BOWEN

For the Registrar

Annex

The full list of goods relied upon by the opponent

Class 6

Metal building materials; non-electric cables and wires of common metal; clamping rings made of metal, cable clamps made of metal, flanges made of metal, hinged flanges, screw connections for cables, cap plugs for metallic couplers; non-electrical mounting boxes of metal, also for radial and axial sealing elements (included in this class); clamps, bolts and female screws made of metal; goods of common metal (included in this class).

Class 7

Machines and machine tools; mechanical tools and devices for the connection of cables with elements of connectors or plugs; supplies for mechanical tools and devices for the connection of cables with elements of connectors or plugs, namely crimping jaws, guide-bolts, guide bushes, parts for the junction of cables and positioning inserts (included in this class).

Class 8

Hand tools and implements (hand operated); hand tools and implements for the connection of cables with elements of connectors or plugs; hand-operated removing tools for insulating elements; supplies for hand tools and implements for the connection of cables with elements of connectors or plugs, namely crimping jaws, guide bolts, guide bushes, parts for the junction of cables and positioning inserts (included in this class).

Class 9

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; electrical and electronical devices (included in this class); electrical connectors, bushes, plugs, right angle plugs and couplers, rectangular connectors; electrical connector sockets, halves of electrical connector sockets as well as component parts of electrical connectors and electrical connector sockets, like housing for electrical connectors or electrical connector sockets; pin inserts and female

inserts for connectors and plugs; housing and covering for connectors; metal housing for connectors; metal housing with plastic coating for connectors; mounting boxes of metal, also for radial and axial sealing elements (included in this class); accessories for the electrical installation (included in this class), in particular accessories for the installation of connectors or plugs, namely prongs, female plugs, retainers, safety-clamps, protection covers, protecting caps, strain relieves, cable sleeves, gaskets and sealing-rings (all above mentioned goods, included in this class).

Class 17

Packing, stopping and insulating materials; insulators and insulated contact brackets for electrical connectors or connector sockets, contact elements for electrical connectors or connector sockets; gaskets for the housing of electrical connectors or connector sockets; coupling elements for cable screens in electric connectors; gum, raw or partially processed, synthetic gum; flexible pipes, not of metal, flexible pipes made of textile material; plastic, partially processed.