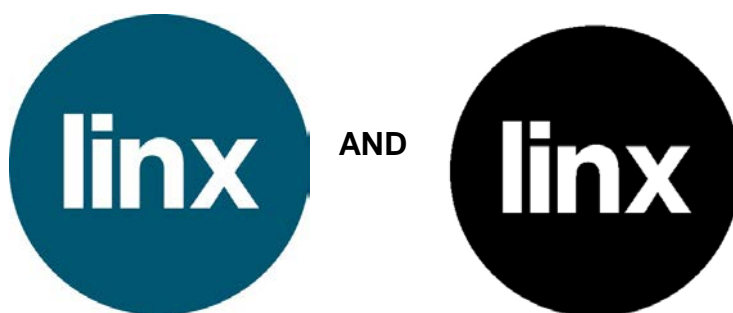


O-661-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3123487
BY EXERTIS (UK) LTD TO REGISTER THE FOLLOWING SERIES OF TWO
TRADE MARKS**



CLASSES 9, 16, 37, 41 & 42

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 406102
BY LINX PRINTING TECHNOLOGIES LIMITED**

BACKGROUND AND PLEADINGS

1) Exertis (UK) Ltd (hereafter “the applicant”) applied to register a series of two trade marks under no. 3123487, the relevant details of which are:



Filing date: 21 August 2015

Publication date: 27 November 2015

2) Following a voluntary restriction after the commencement of these proceedings, the goods and services of the application have been amended to:

Class 9: *Gaming notebooks; Gaming PC's; Tablet PC'S; Network cables; AV cables; monitors; Projectors; Computers; Audio players; Video players; Mobile phones; Cases for mobile phones; Wearable monitors; Wearable computers; Wearable smart phones; Wearable activity trackers; Wearable portable media players; Wearable communications devices in the form of wristwatches; Keyboards; Mobile docks; Mobile stands; Digital cameras; Digital photo frame; e-readers; remote controls; Sat Nov's; TV's; Webcams; Docking stations; Smartpens; Computer hardware; Cable connectors; Computer stylus; Stylus [light pens]; Capacitive styluses for touch screen devices; Graphic tablets; Mice; Wireless computer mice; Mouse Pads; Microphones; Hands-free microphones for mobiles; Microphones for telecommunication apparatus; Speakers; Monitor speakers; Wireless audio speakers; Portable speakers; Headphones; Earphones; Headsets; Computer software; Games consoles; Bags and cases adapted or shaped to contain any or all of the aforesaid goods; none of the aforementioned goods relating to printers, marking*

apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus, or adapted for use in industrial printing, marking or coding.

Class 16: *Printed matter; Instructional and teaching material (except apparatus); Plastic materials for packaging (not included in other classes) Printed publications; Computer hardware publications; Computer manuals; Publications relating to technology, digital technology and gadgets; Cardboard; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.*



Class 37: *Maintenance and repair of tablet computers.*

Class 41: *Education; Publishing; Providing information, news, articles and commentary in the field of education and educational institutions; Education services in the nature of classroom instruction and on-line distance learning on topics of education, language, math, business, science, hobbies, technology; interactive educational services in the nature of computer-based and computer-assisted instruction on topics of education, language, math, business, science, hobbies, technology; Educational services in the nature of podcasts, webcasts, and continuing programs featuring news and commentary in the field of audio-visual works, music, audio works, books, literary works, recreational activities, leisure activities, exhibitions, radio, comedy, visual works, games, gaming, publishing, animation, and multimedia presentations accessible via the internet or other computer or communications networks; none of the aforementioned services relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.*

Class 42: *Scientific and technological services and research and design relating thereto; Design and development of computer hardware and software;*

Computer hardware and software consulting services; Multimedia and audio-visual software consulting services; Computer programming; Support and consultation services for developing computer systems, databases and applications; Graphic design for the compilation of web pages on the Internet; Information relating to computer hardware or software provided on-line from a global computer network or the Internet; Creating and maintaining web-sites; Information, advisory and consultancy services relating to all the aforesaid; Rental of computer hardware; Application service provider (ASP) services; Maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks; Providing information in the field of technology, computers, software, computer peripherals, computer hardware, engineering and testing via the internet or other computer or communications networks; Design and development of computer software; Computer software installation and maintenance; Providing a website featuring technical information relating to computer software and hardware; Computer application and network consulting services; Providing technical troubleshooting support for computer hardware; Document data transfer from one computer format to another; Hosting of digital content on global computer networks, wireless networks, and electronic communications networks; Providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software; Providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences; Monitoring of computerised data and computer systems and networks for security purposes; none of the aforementioned services relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

3) Linx Printing Technologies Limited (hereafter “the opponent”) opposes the trade mark. The opposition is directed against all the goods and services. The opponent relies upon the following two earlier European Union (formerly Community) trade marks and two earlier UK trade marks:

Mark and relevant dates	Identical list of goods and services in respect of all four earlier trade marks
<p>EU10247542</p> <p>LINX</p> <p>Filing date: 7 September 2011 Date completed registration procedure: 30 March 2012</p>	<p>Class 2: <i>Pigments, printers' pastes, printing ink; paints, varnishes, lacquers, resins, colourants, dye stuffs.</i></p> <p>Class 7: <i>Printing machines, conveyors being parts of printers and printing machines, air compressors, control mechanisms for printing machines, compressors and conveyors being parts of printing machines; filters for cleaning and cooling air (for printing and coding machines), ink spray heads for printing machines; printing machines; ink jet printing machines; printing apparatus; mechanisms for performing operational steps in printing machines; parts and fittings for all of the aforesaid goods.</i></p>
<p>UK2594210</p> <p>LINX</p> <p>Filing date: 13 September 2011 Date completed registration procedure: 23 December 2011</p>	<p>Class 9: <i>Lasers, laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers; control apparatus, conveyors being parts of printers, compressors being parts of printers; control apparatus for performing operational steps in printing machines; software for performing operational steps in printing machines; parts and fittings for all of the aforesaid goods.</i></p>
<p>EU10247583</p>  <p>Colours claimed: Blue, white, red</p> <p>Filing date: 7 September 2011 Date completed registration procedure: 30 March 2012</p>	<p>Class 9: <i>Lasers, laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers; control apparatus, conveyors being parts of printers, compressors being parts of printers; control apparatus for performing operational steps in printing machines; software for performing operational steps in printing machines; parts and fittings for all of the aforesaid goods.</i></p>
<p>UK2594213</p>  <p>Filing date: 7 September 2011 Date completed registration procedure: 20 March 2012</p>	

4) The opponent's four trade marks are all earlier marks within the meaning of section 6(1) of the Act because they all have filing dates earlier than the filing date of the contested application. All four earlier marks completed their registration procedures less than five years before the publication date of the contested application. As a result, none of the earlier marks are subject to the proof of use provisions contained in section 6A of the Act. The consequence of this is that the opponent may rely upon the full range of goods listed in the specifications of its earlier marks.

5) The opponent's grounds are as follows:

- Registration of the contested marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ("the Act") because they are similar to the earlier marks, that the contested goods and services are identical with, or similar to the goods of the earlier marks and that there is a likelihood of confusion;
- Use of the contested marks would offend under section 5(3) of the Act because they are similar to the opponent's marks that have a reputation in the UK in respect of *pigments, printers' pastes, printing machines, printers, printing apparatus, laser beam printers, laser operated marking and identifying apparatus, ink jet printers*. Use of the contested marks, without due cause, would:
 - (i) be detrimental to the distinctive character opponent's marks by diluting the same such that it would no longer be capable of arousing immediate association with the goods for which it is registered;
 - (ii) be detrimental to the repute of the opponent's mark if the use was in respect of inferior quality goods and would reduce the power of attraction of the opponent's goods;
 - (iii) take unfair advantage of the earlier marks'by free-riding on their distinctive character or repute;
 - (iv) constitute exploitation of the renowned earlier marks and/or an attempt to trade upon their reputation.

6) The opponent also relies upon grounds based upon section 5(4)(a) in respect of its unregistered rights in two signs that correspond to its earlier marks. It claims that it has used its sign LINX since 1987 and its logo sign since 1996 continuously throughout the UK. As a result, it claims that opponent enjoys extensive goodwill and reputation in respect of the following goods:

Printing inks; printing machines; printers; coding machines; manuals in electronic format; printed matter; instructional and teaching material; printed publications; printed manuals; machinery Installation services; machinery repair services; machinery maintenance services; installation, repair and maintenance of printing machines, printers, coding and marking machines; education and training services in relation to printing apparatus and equipment: technical support services in relation to printing apparatus and equipment.

7) It submits that use of the contested marks would constitute a misrepresentation and would cause confusion and damage to its goodwill.

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

9) The opponent filed evidence and written submissions. The applicant filed no evidence, but did file written submissions in response to the opponent's evidence. I will summarise the evidence to the extent that it is considered necessary and I will keep the submissions in mind. Neither side requested a hearing and I make my decision after careful consideration of the papers.

10) The opponent was represented in these proceedings by Maguire Boss and the applicant by Brian McElligott.

Opponent's Evidence

11) This takes the form of a witness statement by David Tate, trade mark attorney with Maguire Boss, the opponent's representatives in these proceedings. The purpose of this evidence is to illustrate the scope and scale of use of the opponent's

marks. I do not intend to summarise it here but will refer to it as necessary in this decision.

DECISION

Section 5(2)(b)

12) Section 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, 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

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

14) 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.

15) I also keep in mind the following guidance of the General Court (“the GC”) in *Boston Scientific Ltd v OHIM* - T-325/06:

“82 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).”

16) I also keep in mind the following guidance:

Avnet Incorporated v Isoact Limited - [1998] F.S.R. 16 (HC):

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another [2000] F.S.R. 267 (HC):

“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.”

Class 9

Gaming notebooks; Gaming PC's; Tablet PC'S; Network cables; AV cables; monitors; Projectors; Computers; Audio players; Video players; Mobile phones; Cases for mobile phones; Wearable monitors; Wearable computers; Wearable smart phones; Wearable activity trackers; Wearable portable media players; Wearable communications devices in the form of wristwatches; Keyboards; Mobile docks; Mobile stands; Digital cameras; Digital photo frame; e-readers; remote controls; Sat Nov's; TV's; Webcams; Docking stations; Smartpens; Computer hardware; Cable connectors; Computer stylus; Stylus [light pens]; Capacitive styluses for touch screen devices; Graphic tablets; Mice; Wireless computer mice; Mouse Pads; Microphones; Hands-free microphones for mobiles; Microphones for telecommunication apparatus; Speakers; Monitor speakers; Wireless audio speakers; Portable speakers; Headphones; Earphones; Headsets; Computer software; Games consoles; Bags and cases adapted or shaped to contain any or all of the aforesaid goods; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus, or adapted for use in industrial printing, marking or coding.

17) The opponent's submissions on similarity of the respective goods and services are set out in its statement of case. The applicant subsequently amended its specifications and added an exclusion to the specification that results in it containing no goods that are identical to those of the opponent. The opponent submits that the exclusion in the applicant's specification does not remove the "considerable overlap" between the respective goods and services. It provides the example of the applicant's various data processing apparatus being closely similar to the opponent's printers and similar goods regardless of whether or not printers are covered by the applicant's specification. I keep this in mind when considering similarity.

18) The opponent's actual submission is that the applicant's *Computer software* includes *software for performing operational steps in printing machines* and the respective terms, therefore, include identical goods. This is no longer the case in light of the exclusion added to the applicant's specification. The opponent also submits that to the extent that the applicant's software does not perform operational steps in printing machines, it is closely similar because it has the same nature, intended use and distribution channels. I concur that their respective nature is identical, however, their intended use and trade channels will differ because of their different purposes. Certainly, there is no evidence before me to demonstrate that computer software with different purposes is provided by the same undertakings. I conclude that there is some similarity, but it is very low.

19) The opponent submits that the broad term *portable and handheld electronic devices....* are identical insofar as they include *printers*. The applicant has subsequently removed this broad term but its specification contains numerous such devices, namely *Gaming notebooks, Tablet PC'S, Mobile phones, Digital cameras, Smartpens; Computer stylus; Stylus [light pens]; Capacitive styluses for touch screen devices; Graphic tablets*. None of these goods would normally be considered or expected to include printers. Therefore, comparing these goods to printers, they have different purposes, nature, methods of use and are not in competition with each other. Whilst the respective goods may be available from a general electronics retailer, they would appear in different parts of the shop (or website). In respect of complementarity, whilst tablet PC's or digital cameras, for example, may be paired with a printer, neither are essential for the other. However, in order to print from such

devices, a printer is required. Therefore, I conclude there is an element of complementarity between such goods but I find this results in no more than a very low level of similarity overall between *printers* and *Gaming notebooks*, *Tablet PC'S*, *Mobile phones*, *Digital cameras* and *Graphic tablets*. In respect of *Smartpens*; *Computer stylus*; *Stylus [light pens]*; *Capacitive styluses for touch screen devices* it is not clear to me how such goods would be used with printers and I conclude that there is no similarity to *printers*.

20) My findings relating to “portable and handheld devices” in the previous paragraph also extend to “wearable” devices also listed in the applicant’s specification, namely *Wearable monitors*; *Wearable computers*; *Wearable smart phones*; *Wearable activity trackers*; *Wearable portable media players*; *Wearable communications devices in the form of wristwatches* where the same considerations apply and they share only a very low level of similarity.

21) In respect of the applicant’s *computers*, the opponent submits that these are complementary with, and share distribution channels and relevant public to its *laser beam printers*, *laser operated marking and identifying apparatus*, *printers*, *printing machines*, *ink jet printers*. I agree. It is common for such goods to be provided from the same outlets and they function together as part of a package of devices such as the computer itself, a keyboard, computer mouse and a printer in order to deliver the desired functionality for the consumer. Offset against this, is the intended purpose, nature and methods of use of the respective goods which are all different. Taking all of this into account, I conclude that the respective goods share a low level of similarity. Parallel considerations exist in respect of the applicant’s *Keyboards*; *Mice*; *Wireless computer mice*. Consequently, I find these also share a low level of similarity. In respect of *Webcams* and *Mouse Pads* it is not obvious to me, nor is there any evidence that such goods are normally sold as part of package of devices that also includes printers. Consequently, I find that there is no similarity.

22) The opponent submits that the applicant’s *Cases for mobile phones* are closely similar to its *printers and parts and fittings* because they are telecommunication devices and multifunction printers can also be telecommunication devices. I disagree. Cases for mobile phones are not “devices” in this sense and would not

naturally be described as a telecommunication device. Therefore, any similarity is tenuous when I keep in mind that they have different natures, purposes, methods of use and are not in competition. Therefore, I find that there is no similarity.

23) In respect of the applicant's *monitors; audio players; Video players; Computer hardware; Cable connectors; Speakers; Monitor speakers; Wireless audio speakers; Portable speakers; Headphones; Earphones; Headsets; microphones* the opponent claims that they are all "closely similar" to its *laser beam printers, printers, printing machines, ink jet printers* because the respective goods are all computer peripherals that have the same distribution channels, the same relevant public and they are also complementary. It is not clear to me why *audio players, video players* or *microphones* would ordinarily be considered computer peripherals and nothing specific has been submitted that would suggest otherwise. I, therefore, find that there is no similarity. However, in respect of the other goods, they can be in the form of computer peripherals and sold as such and I agree with the opponent that there is similarity, but taking account of the different nature, purpose and methods of use, I would put this similarity as low.

24) Further, *mobile docks* are the same or at least overlap with *docking stations* that was present in the applicant's original specification and which were grouped by the opponent with the goods in the previous paragraph. As with my findings there, the similarity is very low.

25) The opponent submitted that the applicant's *telecommunications apparatus* is closely similar to its *printers, printing machines*. The applicant's specification no longer includes this broad term, but does include *Hands-free microphones for mobiles; Microphones for telecommunication apparatus* that I consider to be a subset of such goods. Such particularisation reduces any similarity because the applicant's goods are different in nature, methods of use and purpose. Further, they are not in competition. I disagree with the opponent when it claims that the respective goods are complementary because the respective goods are not important or essential for the use of the other in the sense explained in *Boston Scientific*. I find that there is no similarity.

26) In respect of the applicant's *Bags and cases adapted or shaped to contain any or all of the aforesaid goods*, the opponent submits that they are closely similar to its *laser beam printers, printers, printing machines, ink jet printers* because the respective goods are complementary, share distribution channels, relevant public and providers/producers. In light of the exclusion added to the specification by the applicant, the specification no longer contains bags or cases that could be adapted for use with printers. This removes the complementarity that would have otherwise existed. They are also different in terms of nature, methods of use and purpose. Further, they are not in competition. Therefore, the only similarity would result from the claimed overlap of trade channels. Whilst the respective goods may be sold from the same outlets, they would be displayed in different parts of the shop and it is not clear to me that they would originate from the same producer/provider. Certainly, there is no evidence that this, in fact, would be the case. In summary, I find that if there is any similarity it is only very low.

27) There are a number of goods listed in the applicant's amended specification that are not neatly covered by the opponent's submissions and I comment on these briefly:

- Unlike the applicant's *computers* (discussed in paragraph 21, above) its *Gaming PC's; Games consoles* would not normally be connected to a printer and would not be considered as part of the same package of devices. Accordingly, I find that there is no obvious similarity.
- The applicant's *Network cables; AV cables* are also required in the operation of both many of its other goods such as computers, however, whilst this leads to an element of complementarity, they are different in terms of nature, purpose, method of use and they are not in competition. Therefore, I conclude that any similarity is low;
- In respect of the applicant's *Projectors; Mobile stands; Digital cameras; Digital photo frame; e-readers; remote controls; Sat Nav's [sic]; TV's* it is not obvious

to me what similarity exists when compared to the opponent's goods and I find they share no similarity.

Class 16

Printed matter; Instructional and teaching material (except apparatus); Plastic materials for packaging (not included in other classes) Printed publications; Computer hardware publications; Computer manuals; Publications relating to technology, digital technology and gadgets; Cardboard; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

28) As with Class 9, the applicant has added an exclusion to this specification, but unlike Class 9 it does not have the effect of removing identical goods because the opponent has no Class 16 goods to rely upon (that may have otherwise been identical).

29) The opponent makes no submissions in respect of the applicant's *printed matter; Instructional and teaching material (except apparatus); Printed publications; Computer hardware publications; Computer manuals; Publications relating to technology, digital technology and gadgets*. Further, keeping the added exclusion in mind, it is not obvious to me what similarity there is with the opponent's various goods. I conclude that there is no similarity.

30) In respect of the remaining goods, namely *Plastic materials for packaging (not included in other classes)* and *Cardboard*, the opponent submits that they are similar to its *lasers; laser beam printers; laser operated marking and identifying and identifying apparatus; printers; printing machines; ink jet printers*. The claimed reason is that the respective goods are complementary, but no further explanation is provided. I assume that the claim is made on the basis that the applicant's goods are used in the packaging of the opponent's goods. However, such a tenuous link is insufficient for me to find that the respective goods are complementary. The applicant's goods are not important or essential for the existence of the opponent's

goods and, therefore, they are not complementary in the sense expressed by the General Court in *Boston Scientific*. I find that there is no similarity.

Class 37

Maintenance and repair of tablet computers.

31) The opponent submits and neither is it obvious as to why the respective goods and services are similar. I find that there is no similarity.

Class 41

Education; Publishing; Providing information, news, articles and commentary in the field of education and educational institutions; Education services in the nature of classroom instruction and on-line distance learning on topics of education, language, math, business, science, hobbies, technology; interactive educational services in the nature of computer-based and computer-assisted instruction on topics of education, language, math, business, science, hobbies, technology; Educational services in the nature of podcasts, webcasts, and continuing programs featuring news and commentary in the field of audio-visual works, music, audio works, books, literary works, recreational activities, leisure activities, exhibitions, radio, comedy, visual works, games, gaming, publishing, animation, and multimedia presentations accessible via the internet or other computer or communications networks; none of the aforementioned services relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

32) The opponent submits that the applicant's *publishing* is closely similar to its *software for performing operational steps in printing machines* in Class 9 because "[c]omputer software is published and the respective goods and services are therefore complementary and have the same relevant public". I disagree. The WIPO Nice Classification System classifies "software development in the framework of software publishing" in Class 42 and suggests to me that the type of publishing covered by the applicant's term in Class 41 does not include "publishing of software"

that is more akin to the development services in Class 42. It follows that there is no similarity between the applicant's *publishing* and the opponent's goods. Even if I am wrong, I find that the similarity between these goods and services is no more than very low because they differ in their methods of use, nature, purpose.

33) The opponent provides no further submissions regarding the similarity of its goods and the applicant's Class 41 services and it is not obvious to me that there is any similarity. I conclude that the remaining Class 41 services share no similarity with the opponent's goods.

Class 42

Scientific and technological services and research and design relating thereto; Design and development of computer hardware and software; Computer hardware and software consulting services; Multimedia and audio-visual software consulting services; Computer programming; Support and consultation services for developing computer systems, databases and applications; Graphic design for the compilation of web pages on the Internet; Information relating to computer hardware or software provided on-line from a global computer network or the Internet; Creating and maintaining web-sites; Information, advisory and consultancy services relating to all the aforesaid; Rental of computer hardware; Application service provider (ASP) services; Maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks; Providing information in the field of technology, computers, software, computer peripherals, computer hardware, engineering and testing via the internet or other computer or communications networks; Design and development of computer software; Computer software installation and maintenance; Providing a website featuring technical information relating to computer software and hardware; Computer application and network consulting services; Providing technical troubleshooting support for computer hardware; Document data transfer from one computer format to another; Hosting of digital content on global computer networks, wireless networks, and electronic communications networks; Providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software; Providing temporary use of online non-

downloadable computer software that generates customized recommendations of software applications based on user preferences; Monitoring of computerised data and computer systems and networks for security purposes; none of the aforementioned services relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

34) The opponent submits that the applicant's *Design and development of computer software* is closely similar to its *software for performing operational steps in printing machines* in Class 9 because they have the same producer/provider, the same relevant public, the same distribution channels and are complementary. I agree that the services of designing and development of software shares similarities to the specialist software as exemplified by the opponent's goods. Such specialist software is likely to be obtained from a software developer rather than "off the shelf" and therefore, they will share the same distribution channels and share some relevant public. I also agree with the opponent that the respective goods and services are complementary in the sense expressed in *Boston Scientific* because the design and development services are indispensable or important for the opponent's goods. However, they have different methods of use, nature and purpose. Taking all of this together, I conclude that the respective goods and services are similar but to no more than a medium level.

35) The opponent submits that the applicant's *Information relating to computer hardware or software provided on-line from a global computer network or the Internet; Information, advisory and consultancy services relating to all the aforesaid* are closely similar to its *Printing machines; ink jet printing machines; printing apparatus* in Class 7 and its *laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers, software for performing operational steps in printing machines* in Class 9 because they have the same relevant public, producers/providers and distribution channels and because they are complementary. It is clear that the respective goods are different in terms of their nature, purpose and method of use, but I agree with the opponent that the relevant public of the applicant's information, advice and consultancy services overlap with the relevant public of printers and printing machines. This is because

computer hardware is a broad term that includes peripherals that may be sold as part of a package or designed to be used with specific printers and therefore, the applicant's "information" includes information about complementary (but not identical because of the effect of the applicant's exclusion) goods that the opponent relies upon and will attract the same relevant public. Taking all of this into account, I conclude that if the respective goods and services share any similarity it is no more than very low.

36) It is also submitted that the applicant's *Rental of computer hardware* are closely similar to the opponent's *Printing machines; ink jet printing machines; printing apparatus* in Class 7 and its *laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers, software for performing operational steps in printing machines* in Class 9 because they have the same relevant public, producer/provider and because they are complementary. For similar reasons set out in the previous paragraph, I agree with some of the opponent's reasoning but also keep in mind differences in methods of use, purpose and nature together with the effect of the applicant's exclusion. I conclude that the respective goods and services share a very low level of similarity.

37) It is submitted that the applicant's *Maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks* are closely similar to the opponent's *software for performing operational steps in printing machines* because they have the same distribution channels, relevant public, producer/provider and because they are complementary. To my mind, it is far from obvious that the provider of software security services of the sort described in the applicant's specification have anything in common with operational software for printing machines. Consequently, it is not obvious that they would share any of the same characteristics identified by the opponent. Further, they clearly do not have the same methods of use, intended purpose or nature. Taking all of this into account, if there is any similarity, it is only very low.

38) The opponent submits that the applicant's *Providing information in the field of technology, computers, software, computer peripherals, computer hardware, engineering and testing via the internet or other computer or communications*

networks are closely similar to its *Printing machines; ink jet printing machines; printing apparatus* in Class 7 and its *laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers, software for performing operational steps in printing machines* in Class 9 because they have the same relevant public, distribution channels, producer/provider and because they are complementary. I disagree that the distribution channels and providers are the same because a person obtaining information in the field of computers and computer peripherals is likely to seek out an information provider and not a hardware provider. In making such a finding, I make a distinction between a computer peripherals and computer hardware provider giving information about its own products (that is not use in respect of information) and an undertaking providing information generally in this field (that is use). Further, they have different purposes, natures and methods of use. Taking all of this together, I conclude that there is similarity, but it is no more than very low.

39) The opponent submits that the applicant's *Computer software installation and maintenance* is closely similar to its *software for performing operational steps in printing machines; laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers*, in Class 9 because they share the same relevant public, distribution channels, producer/provider and because they are complementary. The applicant's exclusion has removed much similarity that may have otherwise existed, however, is still likely to be the case that the relevant public for printers would consider approaching an undertaking that maintains and installs software for associated goods such as computers to maintain or repair its software for printers. Taking this into account, I find that the respective goods and services share a low to medium level of similarity.

40) The opponent submits that the applicant's *Providing a website featuring technical information relating to computer software and hardware; Computer application and network consulting services; Providing technical troubleshooting support for computer hardware* are similar to its *printing machines; ink jet printing machines; printing apparatus* in Class 7 and its *laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers, software for performing operational steps in printing machines* in Class 9 because they have the

same relevant public, distribution channels, producer/provider and because they are complementary. This group of services is diverse and the opponent has provided no more detail in its submissions. Taking the first term *providing a website featuring technical information relating to computer software and hardware*, considerations are the same as discussed in paragraph 38, above, and I conclude that there is similarity, but that it is no more than very low. In respect of the applicant's other two terms, they can no longer describe services that include those directly relating to printers or applications for accessing printers because of the effect of the applicant's disclaimer. Therefore, the respective goods and services are different in terms of nature, purpose, methods of use and are not in competition or complementary. I conclude that if they share any similarity, it is only very low.

41) In respect of the applicant's *Providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences*, the opponent submits that they are similar to its *software for performing operational steps in printing machines* in Class 9 because they have the same nature, methods of use, distribution channels, relevant public and the same producer/provider. I do not agree. The comparison is between services and goods that are fundamentally different in nature. Further, the stated temporary use in the applicant's term is different to the purpose of the opponent's software. As a result of these differences, it is not obvious to me that they share distribution channels, relevant public or producers. Consequently, I find that there is no similarity.

42) Some of the applicant's terms are not commented upon by the opponent. I briefly comment on the remaining of the applicant's terms below:

- *Scientific and technological services and research and design relating thereto*: and it is not clear to me that such services share any similarity with the opponent's goods. I find that there is no similarity;
- *Design and development of computer [...] hardware*: The applicant's addition of an exclusion removes the possibility of these services covering the goods of interest to the opponent, however, it still covers other computer hardware

that may form a package with printers. Therefore, this may result in a modicum of similarity but I would put it no higher than very low;

- *Computer hardware and software consulting services; Multimedia and audio-visual software consulting services; Support and consultation services for developing computer systems, databases and applications:* The considerations are very similar to the provision of information discussed in paragraph 38 and I find that any similarity is very low;
- *Computer programming* is akin to *design and development of computer software*, discussed in paragraph 34, above. I conclude that the respective goods and services share no more than a medium level of similarity;
- *Graphic design for the compilation of web pages on the Internet; Creating and maintaining web-sites; [...]; Application service provider (ASP) services; Document data transfer from one computer format to another; Hosting of digital content on global computer networks, wireless networks, and electronic communications networks; Providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software; Monitoring of computerised data and computer systems and networks for security purposes:* There is no obvious similarity to any of the opponent's goods and I find no similarity;

Comparison of marks


43) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

44) 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.

45) Whilst the opponent relies upon four earlier marks, they are all in respect of an identical list of goods and services and are in respect of only two marks. The word only mark LINX provides the opponent with its best case because the logo mark introduces differences with the contested mark that are absent when comparing the contested mark with the opponent’s word only mark. Further, whilst the contested application is for a series of two marks, nothing hangs of the colour present in the second of these. For procedural economy, I will restrict my analysis to the black and white version of the contested mark. I will, therefore, proceed on the basis of similarity between the opponent’s word mark and the black and white version of the contested mark. If the opponent cannot succeed in respect of its word mark, it will not succeed in respect of its word and device mark. The respective marks are:

Earlier mark	Contested mark
LINX	

46) The opponent’s mark consists of the word LINX and this is self-evidently the dominant and distinctive element. The contested mark consists of the same word appearing in white and placed in the centre of a black circle. Whilst the circle

contributes to the overall impression, the overwhelming dominant element is also the word “linx”.

47) Visually, they are similar because of the common occurrence of the word LINX/linx. The opponent’s mark is presented in upper case, but as a plain word mark, it is also protected for “LINX”, “Linx” and “linx” in any ordinary typeface. Consequently, the fact that in one mark the word LINX is presented in upper case, and the other in lower case does not create a point of difference. However, there is a difference created by the black circle present in the applicant’s mark and the word “linx” appearing thereon in white. Taking all of this into account, I conclude that the respective marks share a reasonably high level of visual similarity.

48) Only the word element of the applicant’s mark is likely to be expressed and, consequently, the respective marks are aurally identical.

49) The conceptual content of both marks resides in the word LINX, being the phonetic equivalent of the word “lynx” being a type of wildcat¹. In the absence of any other obvious meanings, the similarity to “lynx”, if any concept is perceived in either mark, it is likely to be this.

Average consumer and the purchasing act

50) 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*.

51) 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:

¹ <http://www.oxfordreference.com/search?q=lynx&searchBtn=Search&isQuickSearch=true>

“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.”

52) The respective goods and services of the parties cover broad range from printed matter at large in the applicant’s Class 16, to scientific services in its Class 42. Such a broad range will result in there being an equally broad range of average consumers from members of the general public making casual purchases where the care and attention is no more than average, to specialist corporate purchases who will pay close attention during the purchasing process where due diligence will require a thorough and considered approach to the purchasing process. The purchasing process for the majority of goods and services is likely to be primarily visual in nature with the consumer using promotional material or internet research to locate the providers of such goods and services. However, I do not ignore the fact that aural factors may also play a role.

Distinctive character of the earlier trade mark

53) 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).”

54) For the purposes of this decision I have taken the opponent’s word version of its mark that consists of the word LINX. This is an invented word pronounced in an identical fashion to the word LYNX, being the name of a type of wildcat. Being an invented word, the mark is endowed with a good level of inherent distinctive character. The opponent claims that its mark also benefits from an enhanced level of distinctive character. I do not assess this because if this is the case, in light of the already good level of inherent distinctive character, any enhancement is not likely to have a material impact upon the strength of the opponent’s case based upon this ground of opposition.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

55) The following principles are gleaned from the decisions of the CJEU 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.

56) I now consider the likelihood of confusion between the parties' marks keeping in mind that I must make a global assessment taking account of all relevant factors. I take due account of the fact that there is an interdependence between the relevant factors, including that a lesser degree of similarity between the goods and services may be offset by a great degree of similarity between the marks and vice versa.

57) The opponent's mark consists of the invented word LINX and the applicant's mark prominently includes the same word as the dominant and distinctive part of its mark. This has led me to conclude that the respective marks share a reasonably high level of visual similarity, that they are aurally identical and that both marks resemble the word LYNX, being a kind of wild cat, and therefore, if any concept is perceived in either mark, it is likely to be this. The opponent's mark is endowed with a good level of distinctive character. In addition, there is a broad range of goods and services involved with a consequent range of average consumers and degrees of attention paid during the purchasing process.

58) Taking all of the above into account, I conclude that there is a likelihood of confusion where the respective goods and services share a low degree of similarity or higher. On this basis, the opposition based upon this ground of opposition succeeds against the following of the applicant's goods and services:

Class 9: *Network cables; AV cables; monitors; Computers; Keyboards; Computer hardware; Cable connectors; Mice; Wireless computer mice; Speakers; Monitor speakers; Wireless audio speakers; Portable speakers; Headphones; Earphones; Headsets; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or*

laser printing instrument and apparatus, or adapted for use in industrial printing, marking or coding.

Class 42: *Design and development of computer [...] software; Computer programming [...] Design and development of computer software; Computer software installation and maintenance*

59) In respect of any goods or services where there is no, or only a very low level of similarity, I find that there is no likelihood of confusion. These goods and services are:

Class 9: *Gaming notebooks; Gaming PC's; Tablet PC'S; [...] Projectors; [...] Audio players; Video players; Mobile phones; Cases for mobile phones; Wearable monitors; Wearable computers; Wearable smart phones; Wearable activity trackers; Wearable portable media players; Wearable communications devices in the form of wristwatches; [...] Mobile docks; Mobile stands; Digital cameras; Digital photo frame; e-readers; remote controls; Sat Nov's; TV's; Webcams; Docking stations; Smartpens; [...] Computer stylus; Stylus [light pens]; Capacitive styluses for touch screen devices; Graphic tablets; [...] Mouse Pads; Microphones; Hands-free microphones for mobiles; Microphones for telecommunication apparatus; [...] Computer software; Games consoles; Bags and cases adapted or shaped to contain any or all of the aforesaid goods; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus, or adapted for use in industrial printing, marking or coding.*

Class 16: *Printed matter; Instructional and teaching material (except apparatus); Plastic materials for packaging (not included in other classes) Printed publications; Computer hardware publications; Computer manuals; Publications relating to technology, digital technology and gadgets; Cardboard; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software*

for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

Class 37: *Maintenance and repair of tablet computers.*

Class 41: *Education; Publishing; Providing information, news, articles and commentary in the field of education and educational institutions; Education services in the nature of classroom instruction and on-line distance learning on topics of education, language, math, business, science, hobbies, technology; interactive educational services in the nature of computer-based and computer-assisted instruction on topics of education, language, math, business, science, hobbies, technology; Educational services in the nature of podcasts, webcasts, and continuing programs featuring news and commentary in the field of audio-visual works, music, audio works, books, literary works, recreational activities, leisure activities, exhibitions, radio, comedy, visual works, games, gaming, publishing, animation, and multimedia presentations accessible via the internet or other computer or communications networks; none of the aforementioned services relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.*

Class 42: *Scientific and technological services and research and design relating thereto; Design and development of computer hardware [...]; Computer hardware and software consulting services; Multimedia and audio-visual software consulting services; Support and consultation services for developing computer systems, databases and applications; Graphic design for the compilation of web pages on the Internet; Information relating to computer hardware or software provided on-line from a global computer network or the Internet; Creating and maintaining web-sites; Information, advisory and consultancy services relating to all the aforesaid; Rental of computer hardware; [...] Application service provider (ASP) services; Maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks;*

Providing information in the field of technology, computers, software, computer peripherals, computer hardware, engineering and testing via the internet or other computer or communications networks; [...] Providing a website featuring technical information relating to computer software and hardware; Computer application and network consulting services; Providing technical troubleshooting support for computer hardware; Document data transfer from one computer format to another; Hosting of digital content on global computer networks, wireless networks, and electronic communications networks; Providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software; Providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences; Monitoring of computerised data and computer systems and networks for security purposes; none of the aforementioned services relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

Section 5(4)(a)

60) I consider the grounds based upon section 5(4)(a) only insofar as the goods and services of the applicant have survived the opposition based upon section 5(2)(b).

61) Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

62) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

63) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant date

64) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and quoted with approval the following summary provided by Mr Allan James, for the Register, in *SWORDERS TM* O-212-06:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’

65) The opponent claims use of its word marks from 1987 and its stylised marks since 1996. In the absence of a counterclaim of antecedent use by the applicant, the only relevant date for the purposes of these proceedings is the filing date of 21 August 2015.

Goodwill, misrepresentation and damage

66) I keep in mind that the opponent claims that its signs identify its goodwill in respect of the following list of goods and services:

Printing inks; printing machines; printers; coding machines; manuals in electronic format; printed matter; instructional and teaching material; printed publications; printed manuals; machinery Installation services; machinery repair services; machinery maintenance services; installation, repair and maintenance of printing machines, printers, coding and marking machines; education and training services in relation to printing apparatus and equipment: technical support services in relation to printing apparatus and equipment.

67) The evidence provided in support of the opponent's claim to goodwill can be summarised as follows:

- The opponent adopted the name Linx Printing Technologies Plc on 6 July 1987 and subsequently changed its name to Linx Printing Technologies Limited²;
- Extracts from the opponent's annual reports and accounts are provided³ that illustrate the following:
 - Its "principle activity is the development, manufacture, sale and service of products in the field of coding and marking technologies";
 - Turnover rose steadily year on year from nearly £51 million in 2009 to nearly £71 million in 2015. In the region of £8.5 – £9.9 million a year related to turnover in the UK⁴;
- Archived extracts from the opponent's website⁵ illustrate both its word sign and its logo sign in use in respect of industrial printing apparatus used for marking, coding or printing upon packaging of goods on a packaging line.

² Mr Tate's witness statement, para. 4 and Exhibit DT1

³ Exhibit DT2

⁴ Mr Tate's witness statement, para. 8

⁵ Exhibit DT3

These were obtained from its website dated 2 June 2013. The applicant submits that this evidence fails to demonstrate specific use of the earlier mark and needs further explanation. I do not agree. The evidence does show use of the opponent's marks in respect of specific goods and the narrative contained on the internet pages sheds light on the goods provided by the opponent;

- Over the years, the opponent has won numerous awards in respect of its export success and its design and innovation prowess;
- A copy of a report by the Office of Fair Trading, dated 21 December 2004⁶, regarding the anticipated acquisition of the opponent by Danahar Corporation observed that the opponent's goods are various types of printers for printing variable information to be printed on to packages on a production line without stopping that production line. This is consistent with the more contemporaneous evidence;
- The UK market share envisaged after the merger was expected to be 10 to 20%. The merger was not referred to the Competition Commission and the merger went ahead in 2005;
- A selection of product sheets and extracts from operating manuals for the opponent's products are provided⁷. These are hand dated as being from 2003, 2011 to 2015 (and some carry corroborative copyright notices) and show either or both of the opponent's signs in use in respect of a number of its products. The applicant criticises this evidence as failing to demonstrate any link between this information and use of the opponent's marks and its specifications. I find that the evidence provides part of a picture of the opponent's activities and whilst this criticism may have some merits if it is viewed in isolation, when considered in the context of the evidence as a whole, it assists the opponent in demonstrating the goods in respect of which its marks are used.

68) I find that this evidence illustrates that the opponent is one of the UK's major suppliers of industrial printing apparatus used for marking, coding or printing upon packaging of goods on a packaging line, however, the evidence does not support a claim to goodwill to any goods outside of this market. Reliance upon the annual

⁶ Exhibit DT5

⁷ Exhibit DT6

reports is criticised by the applicant as not being evidence of use. Whilst this has some merits, the information contained in an annual report has some relevant weight because such reports are a reliable source of information, therefore, when taken in conjunction with other evidence they may shed light on the company's activities. With this in mind, I accept the statement in the various annual reports that the opponent provides servicing of its products. Further, it is inconceivable that the opponent would not also provide technical support services for its products also.

69) I will proceed to consider misrepresentation on the basis that the opponent's goodwill existed as of the relevant date of 21 August 2015 and as defined in the previous paragraph.

Misrepresentation and damage

70) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148*. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175*; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

71) The question before me is whether the opponent's customers or potential customers, upon seeing the applicant's mark in use, will be deceived into believing that its goods originate from the opponent.

72) The opponent makes a number of specific submissions⁸ regarding the similarity of the applicant's goods and services to its goods and services in which it claims goodwill. However, as I noted earlier, these submissions were made prior to the applicant amending its specifications and adding an exclusion to its Class 9, 16, 41 and 42 specifications. Further these submissions ignore the specialist area of business that the opponent is involved in. Rather, comparisons are made with the broad terms (listed in paragraph 64, above) and do not take account of where its goodwill resides. Whilst it is well established that when assessing misrepresentation, there is no requirement for the parties to be involved in the same field of activity, the closeness or otherwise is, nonetheless, a relevant consideration.

73) In the current case, the opponent's evidence illustrates that its field of activity is confined to providing printers and coding machines for use in production or packaging lines of a broad variety of goods. Such a specialist area decreases the likelihood of misrepresentation. Its strongest case lies with terms contained in the applicant's specifications that are identical to services of the opponent where it has demonstrated it has the requisite goodwill. For example, the applicant's Class 16 specification includes the following:

Printed matter; [...]; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus.

74) The opponent claims goodwill in respect of *printed matter* at large. However, I have found any such goodwill is limited to its specific field of activity and this is excluded in the applicant's specification by the addition of its exclusion. Therefore, the high point of the opponent's case is that the applicant's use of its mark in respect of printed matter related to goods similar to printers etc would amount to misrepresentation. It is not clear to me that misrepresentation would occur. If the applicant's printed matter related to, for example, computer hardware or computer

⁸ Statement of case, paras 38, 41, 42, 44, 46, 47, 50, 53 and 56

peripherals generally (but not printers), it is my view that the opponent's customers would not be deceived into believing the printed matter originated from the opponent. This is because the evidence demonstrates a strong goodwill in respect of the opponent's specialist field, but even though this has existed for a number of decades there is no evidence that it has expanded to providing goods and services outside of this specialist field. Its goodwill is not so large that recognition of its signs transcends its field of activity.

75) The same reasoning and finding can be made in respect of other of the applicant's goods and services such as machinery repair and maintenance. In summary, I conclude that use of the applicant's mark will not result in misrepresentation or damage and the opponent's case, based upon section 5(4)(a) does not improve upon its case based upon section 5(2)(b).

Section 5(3)

76) As with my considerations in respect of section 5(4)(a), I will only consider these grounds insofar as it may improve the opponent's case over and above my findings based upon section 5(2)(b).

77) Section 5(3) states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

(b) (repealed)

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

78) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009]

ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

79) In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part

of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

80) In the current case, I accept that the use shown by the opponent is sufficient to demonstrate a reputation in respect of the following goods and services:

Class 7: *Printing machines, conveyors being parts of printers and printing machines, [...], control mechanisms for printing machines, compressors and conveyors being parts of printing machines; filters for cleaning and cooling air (for printing and coding machines), ink spray heads for printing machines; printing machines; ink jet printing machines; printing apparatus; mechanisms for performing operational steps in printing machines; parts and fittings for all of the aforesaid goods; all for use in industrial production or packaging lines of a broad variety of goods*

Class 9: *[...], laser beam printers, laser operated marking and identifying apparatus; printers; printing machines; ink jet printers; control apparatus, conveyors being parts of printers, compressors being parts of printers; control apparatus for performing operational steps in printing machines; software for performing operational steps in printing machines; parts and fittings for all of the aforesaid goods; all for use in industrial production or packaging lines of a broad variety of goods*

81) The above list does not include the opponent’s Class 2 that, in my view does not advance its case even if its reputation extends to such goods. Further, the list does not include *air compressors* in Class 7 and *lasers* in Class 9 because the evidence does not support a claim to use of such goods. It is also my view that they do not advance the opponent’s case beyond the goods where I have found that its marks have a reputation.

Link

82) When assessing the existence of a link, I keep in mind the following guidance of the CJEU in Case C-408/01, *Adidas-Salomon*:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

83) Therefore, the assessment of similarity between the respective marks is the same as for section 5(2). However, I also keep in mind that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion (*Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, paragraph 72).

84) I have found that the respective marks share a reasonably high level of visual similarity, that they are aurally identical and, insofar that either mark is perceived as having a concept, it will be the same. In respect of the remaining goods and services of the applicant, I have found that they share a very low, or no similarity with the opponent's goods. Keeping in mind that the applicant has excluded from most of its specifications, any goods or services being or relating to the opponent's goods, I find that this is a factor that distances the parties' goods and services. Whilst the common occurrence of the word LINX in both parties' marks is something I keep at the forefront of my mind, it is my view that the relevant section of the public will not

make a connection between the applicant's mark and the opponent's mark. Even in the situation where a person familiar with the opponent's goods encounters the applicant's mark, any bringing to mind is likely to be fleeting. The distance between the respective goods and services and the specialist area in which the opponent operates are factors that lead me to conclude that the requisite link will not exist in the minds of the relevant section of the public.

85) In light of my finding, it is not necessary for me to consider the opponents case in respect of detriment and unfair advantage.

86) I find that the grounds based upon section 5(3) of the Act do not improve the opponent's case over and above its limited level of success under its grounds based upon section 5(2)(b).

Summary

87) The opposition succeeds in respect of the following goods and services:

Class 9: *Network cables; AV cables; monitors; Computers; Keyboards; Computer hardware; Cable connectors; Mice; Wireless computer mice; Speakers; Monitor speakers; Wireless audio speakers; Portable speakers; Headphones; Earphones; Headsets; none of the aforementioned goods relating to printers, marking apparatus, laser coders, laser coding instruments and apparatus, or software for printers, marking apparatus, laser coders or laser printing instrument and apparatus, or adapted for use in industrial printing, marking or coding.*

Class 42: *Design and development of computer [...] software; Computer programming; Design and development of computer software; Computer software installation and maintenance*

88) The opposition fails in respect of all other of the applicant's goods and services and the application can proceed to registration in respect of these goods and services.

Costs

89) The applicant has been successful to a greater degree than the opponent and it is entitled to a contribution towards its costs consistent with, what I estimate, is about 70% success. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016, and I keep this in mind when awarding costs as follows:

Considering statement of case and preparing counterstatement	£250
Considering other side's evidence	£300
Submissions in lieu of a hearing	£300
(reduction to 70% of full amount)	(£255)
TOTAL	£595

90) I order Linx Printing Technologies Limited to pay to Exertis (UK) Ltd the sum of **£595**. This sum is to 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 18th day of October 2018

Mark Bryant

For the Registrar

The Comptroller-General