

O/101/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003398709

**BY FINDER YANGI GUVENLIK ELEKTRONIK SISTEMLERI MUHENDISLIK SAN.
VE TIC A.S**

TO REGISTER THE FOLLOWING MARK:



IN CLASS 9

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 418212

BY ENFIELD SAFETY SUPPLIES

Background and pleadings

1. On 13 May 2019, Finder Yangı Güvenlik Elektronik Sistemleri Mühendislik San. ve Tic A.Ş (“the applicant”) applied to register the trade mark shown below and the application was published for opposition purposes on 26 July 2019.



2. The registration is sought for the following goods:

Class 9 Fire alarms; Fire control apparatus; Fire detecting apparatus; Fire detection apparatus; Fire detectors; Fire extinguishers; Fire extinguishing apparatus; Fire extinguishing apparatus for automobiles; Fire extinguishing systems; Fire fighting apparatus; Fire hose nozzles; Alarms (Fire -); Automatic fire extinguishing apparatus; Clothing for protection against fire; Electric alarms for fire; Footwear for protection against fire; Garments and clothes for protection against fire; Fire sprinklers; Fire-extinguishers; Fire-extinguishing apparatus; Fire-extinguishing systems; Fireproof clothing; Fireproof garments; Sprinkler apparatus [automatic] for fire extinguishing; Sprinkler systems for fire extinguishing; Sprinkler systems for fire protection.

3. Enfield Safety Supplies (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application, namely its Class 9 goods. The opponent relies on the trade mark below, number UK00003021465, which was filed on 10 September 2013 and registered on 4 July 2014.

DEFENDER

4. Of the goods and services for which this mark is registered, the opponent relies just on the following goods:

Class 9 Safety apparatus and equipment; protection apparatus and equipment for personal use against accident, injury, fire and contamination; fire extinguishing apparatus and equipment and recharging apparatus therefor; fire-fighting and fire-preventing apparatus, appliances and systems; fire escapes; fire, flame, smoke, gas, temperature, intrusion and theft detecting and indicating apparatus, instruments and systems; alarms and alarm systems; alarm bells and sirens; fire hose nozzles and valves; fire buckets and blankets; apparatus, appliances and clothing for protection against accident, injury, fire or contamination; breathing apparatus and respirators; protective helmets, goggles and masks; electric batteries and cables; luminous, illuminated and reflective signs; parts and fittings for all the aforesaid goods; none of the aforesaid goods being for or related to vehicles.

5. In its notice of opposition, the opponent argues that the respective goods are identical or similar and that the marks are identical or similar.
6. The applicant filed a Form TM8 denying the claims made. Referencing supporting documentation, it writes of the business activities of its company and group of companies in Turkey, the current and planned business activities in the UK of its group of companies, and its other trade mark applications in the UK. However, none of this is relevant to my decision as it is the notional use of the application in the UK that I must consider.
7. The opponent filed evidence. The applicant did not file evidence.
8. The opponent filed a written submission in lieu of a hearing, while the applicant did not file a written submission.

9. The applicant is represented by Mehmet Gokhan Alper Yalcin and the opponent is represented by Marks & Clerk LLP.

Evidence

10. The opponent filed evidence in the form of a witness statement from Hans Stacey, dated 28 September 2020. Mr Stacey's statement was accompanied by 6 exhibits, coded HS1 to HS6. Mr Stacey has been the opponent's Sales and Marketing Director since 2015, having had the role of Marketing Director since 2010.
11. Mr Stacey considers the sales of "DEFENDER" branded products to have been "substantial" with annual turnover from sales being as follows:

Year	Turnover £
2014	450,234.41
2015	623,242.51
2016	745,247.36
2017	960,479.72
2018	954,841.72

12. Exhibit HS1 shows instances of use of "Defender" together with various logos and text that it uses alongside it in the safety field generally. Of particular note, shown below, is the use of "Defender" with a flame logo to the left of it with "FIRE CONTROL" and "BY ENFIELD" (the latter underlined) underneath.



DefenderTM
FIRE CONTROL BY ENFIELD

13. Exhibit HS2 consists of photographs of a fire extinguisher, a “fire point”, a fire extinguisher trolley, a fire alarm, a “GSM TEXT MASTER”, an emergency call point, and a labelled piece of packaging. All of these items display “Defender” with the flame logo and accompanying text referred to above. The mark, with the additional elements, is shown as white on a red background.
14. Exhibit HS3 contains a number of extracts from the proprietor’s website, enfieldsafety.co.uk, showing a wide range of products available for direct sale. The fire protection products that are featured either have “Defender” (with the flame logo and accompanying text) directly on them, or “Defender” features in the product description, or both are present. There are also some hand sanitisation products which feature “Defender” with a stylised “i” to the left of it and the words “SAFETY STATION” and “BY ENFIELD” below (the latter being underlined). There is also a stretcher which features “Defender” in the product description to the left of which is a green cross inside a broken grey circle. Where prices are shown, they range from £13.20 to £795.00 including VAT.
15. Exhibit HS4 consists of a selection of 49 invoices spanning the period 13 January 2014 to 14 May 2019. The majority are for customers with business addresses in London and the home counties, but there is also evidence of customers in Oxfordshire, West Yorkshire, Hampshire, Bristol, County Durham, Manchester, Nottinghamshire, Derbyshire, Wales, and Scotland. With the exception of one invoice for £80,276.84, the amounts invoiced for range from £69.48 to £5,766.90. The prices of individual items are redacted. Apart from one instance, which appears to be a description of a custom-made

sign, the word “Defender” only appears in the description field of the invoices in relation to fire alarms. There are many other fire protection products that are itemised. There are also non-fire protection products listed that relate to wider safety activities or their administration and support.

16. Mr Stacey states that “DEFENDER” products have been advertised and promoted in the UK with marketing expenditure reaching approximately £30,000 per annum since 2014. This has taken the form of externally distributed “pamphlets, brochures, catalogues and other promotional and instructional materials”. Exhibit H5 consists of example catalogues which comprehensively feature “Defender” with the flame logo and accompanying text.

17. Mr Stacey states that the company has participated in a number of exhibitions, trade fairs and shows in the UK, including exhibiting at the Safety & Health Expo at the London Excel in June of every year from 2015 to 2019. Exhibit HS6 features two undated photographs of its stand at the Safety & Health Expo where “Defender” with the flame logo and accompanying text, can be seen.

DECISION

18. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

19. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) a European Union 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.”

20. The “proof of use” provisions are set out in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

...”

21. Given their respective filing dates, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined in section 6(1) and (2) of the Act. In relation to proof of use, I note that the opponent indicated that its earlier mark was subject to the proof of use provisions, that the applicant requested proof of use, and that the opponent subsequently filed evidence directed at this point. However, when preparing this decision it became apparent to me that proof of use was not actually relevant in these proceedings because the earlier trade mark had not completed its registration procedure more than 5 years before the filing date of the application¹ in issue in these proceedings and it is not, therefore, subject to proof of use pursuant to section 6A of the Act. The Tribunal wrote to the parties on 18 January 2021 to advise them of this and invited comments. The opponent queried the dates, mistakenly believing that the five year period ended on the date on which the notice of threatened opposition was filed. The Tribunal confirmed that this was not correct as the five year period, according to the legislation

¹ The applicant's mark was filed on 13 May 2019, so the relevant five year period is 14 May 2014 to 13 May 2019. The opponent's mark was registered on 4 July 2014.

above, ends on the date on which the contested trade mark was filed. Accordingly, proof of use is not relevant in these proceedings and the opponent can, therefore, rely upon all of the goods it has identified without the need to conduct a proof of use assessment.

Section 5(2)(b) – case law

22. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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

24. The goods in question are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 9</u></p> <p>Safety apparatus and equipment; protection apparatus and equipment for personal use against accident, injury, fire and contamination; fire extinguishing apparatus and equipment and recharging apparatus therefor; fire-fighting and fire-preventing apparatus, appliances and systems; fire escapes; fire, flame, smoke, gas, temperature, intrusion and theft detecting and indicating apparatus, instruments and systems; alarms and alarm systems; alarm bells and sirens; fire hose nozzles and valves; fire buckets and blankets; apparatus, appliances and clothing for protection against accident, injury, fire or contamination; breathing apparatus and respirators; protective helmets, goggles and masks; electric batteries and cables; luminous, illuminated and</p>	<p><u>Class 9</u></p> <p>Fire alarms; Fire control apparatus; Fire detecting apparatus; Fire detection apparatus; Fire detectors; Fire extinguishers; Fire extinguishing apparatus; Fire extinguishing apparatus for automobiles; Fire extinguishing systems; Fire fighting apparatus; Fire hose nozzles; Alarms (Fire -); Automatic fire extinguishing apparatus; Clothing for protection against fire; Electric alarms for fire; Footwear for protection against fire; Garments and clothes for protection against fire; Fire sprinklers; Fire-extinguishers; Fire-extinguishing apparatus; Fire-extinguishing systems; Fireproof clothing; Fireproof garments; Sprinkler apparatus [automatic] for fire extinguishing; Sprinkler systems for fire extinguishing; Sprinkler systems for fire protection.</p>

reflective signs; parts and fittings for all the aforesaid goods.	
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25. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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.”

26. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for

instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

27. 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.”

28. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

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

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

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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 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 the responsibility for those goods lies with the same undertaking.”

31. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public

are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

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

While on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

32. The applicant contends that the type of goods for which it has applied are not in conflict with the opponent's trade mark.
33. The opponent, providing its analysis of individual terms in a written submission, considers all the applicant's goods to be identical to its class 9 goods.
34. I will now make my comparison with reference to the applicant's goods.
35. The applicant's "Fire alarms", "Alarms (Fire -)" and "Electric alarms for fire" are *Meric* identical to the opponent's "alarms and alarm systems" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
36. "Fire control apparatus" is identical, on the *Meric* principle, to the opponent's "fire-fighting and fire-preventing apparatus, appliances and systems", as

control apparatus will form part of the appliances and systems covered by the earlier mark. If I am wrong, they are highly similar.

37. "Fire detection apparatus" and "Fire detectors" are *Meric* identical to the opponent's "fire, flame, smoke ... detecting and indicating apparatus, instruments and systems."
38. "Fire extinguishing apparatus," "Fire extinguishing systems," "Automatic fire extinguishing apparatus," "Fire-extinguishers," "Fire-extinguishing apparatus", "Fire extinguishing apparatus for automobiles", and "Fire-extinguishing systems" are identical to the opponent's "fire extinguishing apparatus and equipment and recharging apparatus therefor."
39. "Fire fighting apparatus" is identical to the opponent's "fire-fighting ... apparatus, appliances and systems."
40. "Fire hose nozzles" are identical to the opponent's "fire hose nozzles and valves."
41. "Clothing for protection against fire" and "Garments and clothes for protection against fire" are *Meric* identical to the opponent's "... clothing for protection against accident ... fire ..."
42. "Fireproof clothing" and "Fireproof garments" are *Meric* identical to the opponent's "... clothing for protection against ... fire ..." If I am wrong, and there is deemed to be a difference between clothing which offers protection against fire and clothing which is fireproof, the goods are highly similar in that they have the same broad purpose, are sold through the same trade channels and would be in direct competition.
43. "Footwear for protection against fire" is *Meric* identical to the opponent's "... clothing for protection against ... fire ..." If I am wrong, and footwear was deemed to be in a separate category from clothing, they are highly similar in that both are intended to offer protection against fire, and both would be sold

through the same trade channels. There is complementarity in that one is important for the other when the aim is to achieve whole body protection against fire and is so in the sense that the average consumer may think the responsibility for those goods lies with the same or linked undertakings.

44. “Fire sprinklers,” “Sprinkler apparatus [automatic] for fire extinguishing,” “Sprinkler systems for fire extinguishing” and “Sprinkler systems for fire protection” are *Meric* identical to the opponent’s “fire-fighting and fire-preventing apparatus, appliances and systems”. If I am wrong, and sprinklers were somehow seen as different from the opponent’s goods in this case, they would be highly similar in that both are apparatus or systems which fight fires or prevent fire from breaking out more widely. All such apparatus and systems would be sold through the same trade channels and there will be competition between them.

45. I find that no other of the opponent’s goods put them in a stronger position than those discussed above.

The average consumer and the nature of the purchasing act

46. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

47. In respect of fire extinguishers and fire detectors, these items will be purchased both by members of the public and professional people for the home, car, or office and will entail a medium degree of attention given the safety considerations involved. For the other goods listed, which are aimed at system-wide fire protection for commercial premises and public buildings, the average consumer in this case will be a professional person who is responsible for procuring fire safety equipment and clothing. Given the importance of fire safety and the expense that one would need to go to fit out premises to be compliant with fire safety legislation, the degree of attention that would be required would be high. While I do not discount verbal factors entirely, the degree of consideration and the usual circumstances of the purchases would lead to visual considerations predominating in the purchasing process.

Comparison of the trade marks


48. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

49. 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.

50. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
DEFENDER	

51. The applicant makes no comment as to the similarity of the marks.

52. The opponent, in a detailed analysis, considers the marks to be visually and phonetically virtually identical, or at the least, highly similar, and conceptually identical.

53. I set out my analysis below.

54. The opponent's mark is simply a word mark, DEFENDER. There are no other visual elements that contribute to the overall impression of the mark.

55. The applicant's mark is the word "Defender" in bold navy blue text, to the immediate left of which the letter "D" is repeated in bold and navy blue text inside a stylised circle. The stylised circle gives emphasis to the repeated

letter “D”. The word itself strongly contributes to the overall impression, but the repeated letter “D” inside the stylised circle also has a role to play.

56. Visually, the earlier mark is a plain word mark. The applicant’s mark consists of the same word, to the left of which is its initial letter repeated and placed inside a circle, giving emphasis to the repeated letter. The opponent’s mark is plain text, while the applicant’s mark is in bold and navy blue. However, the weight and colour of the text does not make a difference given the potential notional use of the plain word work. While the “D” creates a difference, I still consider the marks to be highly similar bearing in mind the overall impressions of the marks.

57. The average consumer is unlikely to articulate the repeated initial letter “D” in the applicant’s mark. Consequently, the words “DEFENDER” and “Defender” would be articulated. The words are aurally identical. If I am wrong, and the consumer articulated the repeated letter “D”, so that they said “D”, “Defender”, I would still place the marks as being highly similar aurally.

58. Conceptually, the words “DEFENDER” / “Defender” are suggestive of or allusive to the goods for which the marks are registered, conveying the impression of something which plays a defensive or protective role. The repeated initial letter in the applicant’s mark simply serves to reinforce the initial letter of the whole word and underscores the conceptual content. I consider the marks to be conceptually identical (or else they are highly similar).

Distinctive character of the earlier mark

59. 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).”

60. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

61. In the first instance, I make an assessment of the inherent distinctive character of the earlier mark. It is a word mark, “DEFENDER”, which I consider the average consumer would see as something with a defensive or protective role. It is suggestive of or allusive to the goods for which it is registered, and I find the mark to be inherently distinctive to a low degree.

62. Given the evidence filed, I now consider whether the evidence of the earlier trade mark's use shows that it has an enhanced degree of distinctive character beyond its inherent distinctive character.
63. I note that the mark in question is used in upper and lower case (whereas it is in all uppercase lettering as registered) and that it is more often than not used alongside some other elements.
64. However, I bear in mind two things: i) the mark as registered protects the word itself, so the difference in casing does not matter, ii) a mark may acquire distinctiveness either through use on its own, or alongside other components².
65. Evidently, the mark is in use and its products are purchased by companies across the UK (albeit not in a huge number of locations) and the evidence shows that this has been the case in the years 2014 to 2019. The evidence does not contain a statement as to the market share held by the mark. The turnover figures provided, while not insignificant, do not strike me as indicative of a level that would lead to the capacity of the mark, measured from the perspective of the average consumer, to more greatly identify the goods for which it has been registered as coming from a particular undertaking, beyond its inherent capability to do so. I have also noted the marketing expenditure, but, again, I do not consider its level to be particularly significant.
66. Overall, I do not find that the evidence shows use of the mark such that the level of distinctiveness can be raised above the finding that I have made for the mark's inherent distinctive character, that of a low degree.

² Case C-353/03 *Société des produits Nestlé SA v Mars UK Ltd*

Likelihood of confusion

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 that they have retained in their mind.

68. The opponent contends that, considering its view on the visual, aural and conceptual similarity of the marks, along with its argument that the goods are identical, there is a real likelihood of confusion.

69. I have found the parties' marks to be visually similar to a high degree, aurally identical, or, if I am wrong, highly similar, and conceptually identical. In respect of fire extinguishers and fire detectors, I have found that these will be purchased by members of the public and professional people, entailing a medium degree of attention. For the other goods listed, the average consumer will be a professional person who will exhibit a high degree of attention. While I have not discounted verbal factors, visual considerations will predominate in the act of purchasing. I have found the earlier mark to be inherently distinctive to a low degree and my analysis of

the evidence of use has not resulted in a finding of an enhanced level of distinctiveness.

70. I consider that there is a sufficient difference between the marks to avoid them being mistakenly recalled as each other. Particularly, the repetition of the letter “D” to the left of the word “Defender” in the applicant’s mark, and its enclosure in a stylised circle, is noticeable. I consider it noticeable to the extent that it would be recalled by the average consumer, even allowing for the principle of imperfect recollection. Notwithstanding my finding that the marks are highly similar visually, aurally identical, or, if I am wrong, highly similar, and conceptually identical (or else highly similar), I am therefore satisfied that there is no likelihood of direct confusion. This is even in relation to the identical (or, if I am wrong, highly similar) goods which require only a medium degree of attention.

71. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

72. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

73. The opponent argues that there is a real likelihood of association (indirect confusion). It contends that consumers would assume that the figurative letter “D” in the applicant’s mark was merely a new logo format that the opponent had employed for its trade mark.

74. The marks feature the words “DEFENDER” / “Defender” which are identical aurally (or, if I am wrong, highly similar) and identical conceptually (or else highly similar). The visual dissimilarity of the repeated letter “D” to the left of the word “Defender” in the applicant’s mark, and its enclosure in a stylised circle serves to reinforce the initial letter of the whole word. That would be seen as symptomatic of a brand variation. Consequently, looking at the identical (or, if I am wrong, highly similar) goods, I consider that the various factors set out above will lead the average consumer to conclude that the parties’ marks indicate goods sold by the same or economically linked undertakings. Given the comments in the *Whyte and Mackay* case, I should

make two things clear. First, I regard the word “Defender” to be independently distinctive within the applied for mark itself. Second, I have borne in mind that it does not follow from the first point that a likelihood of indirect confusion should be found. However, notwithstanding my finding of a low level of distinctiveness (which I accept is an important point in this case), I consider that there is a likelihood of indirect confusion bearing in mind the closeness of the goods and the marks, and the role that the letter “D” plays, and the likely assumption that it is the initial letter of the word “Defender”.

CONCLUSION

75. The opposition has succeeded in full. Subject to appeal, the application will be refused.

COSTS

76. The opponent has been successful in its opposition. From the nature of its submissions, it appears that the evidence provided by the opponent was filed for the purposes of proof of use. However, the evidence was not required for this purpose, for the reasons detailed earlier. Whilst the applicant put the opponent to proof of use, this would unlikely have been done if the opponent had not mistakenly indicated that the provisions were applicable in the first place. Given this, and given that the evidence did not establish enhanced distinctiveness either, I do not consider it appropriate for an award of costs to be made in the opponent's favour for filing this evidence. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to the opponent as follows:

Official fees:	£100
Preparing the Notice of Opposition:	£200
Preparing a written submission:	£400
Total:	£700

77. I order Finder Yangı Güvenlik Elektronik Sistemleri Mühendislik San. ve Tic A.Ş to pay Enfield Safety Supplies the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of February 2021

JOHN WILLIAMS
For the Registrar