

**O/634/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003511993**

**BY OPSYS LTD TO REGISTER THE FOLLOWING TRADE MARK**

 OPSYS®

**IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 422109 BY OPSIS HOLDING AB**

## **Background and Pleadings**

1. On 14 July 2020, Opsys Ltd ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number UK00003511993. The application was published for opposition purposes in the *Trade Marks Journal* on 14 August 2020. Registration is sought in respect of:

### **Class 9**

*Computers; Computer servers; Computer joysticks; Computer controllers ; Micro-computer; Computer keyboards; Computer mice; Computer motherboards; Computer keypads; Computer chipsets; Computer cases; Computer mousepads; Computer monitors; Tablet computers; Personal computers; Laptop computers; Netbook computers; Notebook computers; Desktop computers; Mobile computers; Portable computers; Handheld computers; Computer graphics boards; Wireless computer mice; Speakers for computers; Notebook computer cooling pads; All-in-one computers; Internal cooling fans for computers; Wrist rests for computer mouse users; Computer hardware for games and gaming; Mats for use with a computer mouse; Computer hardware for the control of lighting; Virtual reality headsets; Virtual reality hardware; Flight simulators; Weapon simulators; Sports training simulators; Simulators for driving or control of vehicles; Smart phones; None of the aforementioned for use in the fields of computer-aided electronic system design, electronic circuit design, or silicon chip design, analysis, verification, monitoring, and testing; or in the fields of design, development, and integration of intellectual property cores and architecture for silicon chips; or in the fields of software design, verification, and security*

*and quality testing; none of the aforementioned goods being measuring apparatus and instruments, or computer programs.*

2. On 16 November 2020, the application was opposed by Opsis Holding AB ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application.
3. The Opponent relies on the following four earlier trade mark registrations for its section 5(2)(b) ground:

<p>i) EU(IR): WO0000001228581<sup>1</sup></p> <p style="text-align: center;"><b>OP SIS</b></p> <p>Priority date: 24 April 2014;  Priority country: Sweden;  International registration date: 25 August 2014;  Designation date: 19 January 2017;  Date of protection of the international registration in UK: 29 June 2017.</p>	<p>Class 9:  <i>Measuring apparatus and instruments, computer programs</i></p>
<p>ii) EUTM: EU015207715</p> <p style="text-align: center;"><b>OP SIS</b></p> <p>Filing date: 11 March 2016;</p>	<p>Class 42:  <i>Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware</i></p>

---

<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

<p>Date registration completed: 3 December 2016.</p>	<p><i>and software; Technical expertise and consultancy; Compilation of environmental information; Compilation of scientific information; Calibration [measuring]; Measurement services; Testing of scientific, electric, electronic, optical and measuring apparatus and instruments; Testing of computer hardware and computer software; Rental of scientific, electric, electronic, optical and measuring apparatus and instruments; Rental of computer hardware and computer software.</i></p>
<p>iii) EUTM: WE00001228581</p> <p style="text-align: center;"><b>OPSIS</b></p> <p>Filing date: 25 August 2014; Date registration completed: 2 November 2015; Priority date: 24 April 2014; Priority country: Sweden.</p>	<p>Class 9: <i>Measuring apparatus and instruments, computer programs</i></p>
<p>iv) IR: WO00001327269</p> <p style="text-align: center;"><b>OPSIS</b></p> <p>Priority date: 11 March 2016; Priority country: EUIPO office (Spain); International registration date: 5 September 2016;</p>	<p>Class 42: <i>Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; consultancy relating to technical analysis; calibration</i></p>

<p>Designation date: 19 January 2017; Date of protection of the international registration in UK: 13 July 2017.</p>	<p><i>[measuring]; measurement services; testing of scientific, electric, electronic, optical and measuring apparatus and instruments; testing of computer hardware and computer software; rental of scientific, electric, electronic, optical and measuring apparatus and instruments; rental of computer hardware and computer software.</i></p>
---	--

4. The Opponent claims that:

- The respective marks are ‘visually highly similar’ and aurally identical; and that ‘conceptually, neither mark has a meaning that would aid to distinguish them’;
- The Applicant’s goods are: identical to the class 9 goods covered by the earlier marks; and highly similar to the class 42 services covered by the earlier marks;
- Therefore, there is a likelihood of confusion between the respective marks.

5. The Applicant filed a defence and counterstatement, denying the claim in its entirety.

6. Neither party has filed evidence; both parties have filed written submissions in lieu of a hearing.

7. The Opponent is represented by Boulton Wade Tennant LLP; the Applicant is represented by Wilson Gunn.

8. The following decision has been made after careful consideration of the papers before me.

## **Relevant dates**

9. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the application date of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, Section 6A is not engaged because all of the registration dates/dates of protection of the international registrations in the UK, of the earlier marks are less than 5 years prior to the application date of the applied-for mark, i.e. 14 July 2020. Consequently, the Opponent is entitled to rely upon its marks in respect of all of the goods and services for which they are registered.<sup>2</sup>

## **Decision**

### **Section 5(2)(b) of the Act and related case law**

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

(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.”

11. The following principles are derived from the decisions of the CJEU<sup>3</sup> 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*

---

<sup>2</sup> Although the Applicant has, in its Defence and Counterstatement, requested that the Opponent provide proof of genuine use of the marks, the Opponent is not obliged to accede to its request.

<sup>3</sup> Although the UK has left the EU, section 6(3)(a) of the European Union (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.

*Klijisen 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 C120/04; Shake di L. Laudato & C. Sas v OHIM, Case C-334/05P; and Bimbo SA v OHIM, Case C-591/12P*

The principles:

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

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

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

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

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

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

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

## **Comparison of goods and services**

### **12. Similarity of goods and services – Nice classification**

Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.



(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

13. I must therefore be mindful of the fact that the appearance of respective goods in the same class is not a sufficient condition for similarity between those goods or services.

14. The Tribunal may group goods (or services) together for the purposes of assessment:

*Separode Trade Mark* BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

15. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

“[23] “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”.

16. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281<sup>4</sup>, identified the following factors for assessing similarity of the respective goods and services:

- (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.

17. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.<sup>5</sup>

18. 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 [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

---

<sup>4</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

<sup>5</sup> *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

“...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”.

19. The goods to be compared are as follows:

Opponent's marks:	Applied-for mark:
<p>i) EU(IR): WO0000001228581</p> <p style="text-align: center;"><b>OP SIS</b></p> <p><b>Class 9:</b> <i>Measuring apparatus and instruments, computer programs.</i></p> <p>ii) EUTM: EU015207715</p> <p style="text-align: center;"><b>OP SIS</b></p> <p><b>Class 42:</b> <i>Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Technical expertise and consultancy; Compilation of environmental information; Compilation of scientific information; Calibration [measuring]; Measurement services; Testing of scientific, electric, electronic, optical and measuring apparatus and instruments; Testing of computer hardware and computer</i></p>	<p><b>Class 9:</b> <i>Computers; Computer servers; Computer joysticks; Computer controllers ; Micro-computer; Computer keyboards; Computer mice; Computer motherboards; Computer keypads; Computer chipsets; Computer cases; Computer mousepads; Computer monitors; Tablet computers; Personal computers; Laptop computers; Netbook computers; Notebook computers; Desktop computers; Mobile computers; Portable computers; Handheld computers; Computer graphics boards; Wireless computer mice; Speakers for computers; Notebook computer cooling pads; All-in-one computers; Internal cooling fans for computers; Wrist rests for computer mouse users; Computer hardware for games and gaming; Mats for use with a computer mouse; Computer hardware for the control of lighting; Virtual reality</i></p>

<p><i>software; Rental of scientific, electric, electronic, optical and measuring apparatus and instruments; Rental of computer hardware and computer software.</i></p> <p>iii) EUTM: WE00001228581</p> <p style="text-align: center;"><b>OPSIS</b></p> <p><b>Class 9:</b> <i>Measuring apparatus and instruments, computer programs.</i></p> <p>iv) IR: WO00001327269</p> <p style="text-align: center;"><b>OPSIS</b></p> <p><b>Class 42:</b> <i>Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; consultancy relating to technical analysis; calibration [measuring]; measurement services; testing of scientific, electric, electronic, optical and measuring apparatus and instruments; testing of computer hardware and computer software; rental of scientific, electric, electronic, optical and measuring apparatus and instruments; rental of computer hardware and computer software</i></p>	<p><i>headsets; Virtual reality hardware; Flight simulators; Weapon simulators; Sports training simulators; Simulators for driving or control of vehicles; Smart phones; None of the aforementioned for use in the fields of computer-aided electronic system design, electronic circuit design, or silicon chip design, analysis, verification, monitoring, and testing; or in the fields of design, development, and integration of intellectual property cores and architecture for silicon chips; or in the fields of software design, verification, and security and quality testing; none of the aforementioned goods being measuring apparatus and instruments, or computer programs.</i></p>
--	--

20. The Opponent has submitted the following<sup>6</sup>:

In summary, all of the contested goods are either identical or similar to between an average to high degree to “*computer programs*” in class 9 of EUIR581 and UKIR581 and similar to between an average to high degree to “*rental of computer hardware and computer software*” in class 42 of EU715 and UKIR269.

21. The Opponent submits that the comparison between the terms highlighted above represents the strongest comparison between the respective goods and services<sup>7</sup>:

Although there is similarity between the contested goods and other goods and services for which the earlier marks are registered the Opponent accepts that the position in Annex A represents its best case such that if it does not succeed in respect of those parts of the specification of its earlier marks it has no better case in respect of other goods and services for which those marks are registered.

22. The Applicant submits the following<sup>8</sup>:

The respective goods in class 9 are completely dissimilar, the uses, users, nature and purpose of the goods is entirely different. The goods will not be available via the same trade channels and will not be in competition. The Applicant's goods are all 'hardware' items.

Furthermore, there is no overlap or similarity between the applicant's goods in class 9 and the opponent's services in class 42.

23. I will make my comparison with reference to the Applicant's goods and services.

The comparison will be made against the Opponent's registrations WO0000001228581 and EU015207715 only; owing to the fact that registration WE00001228581 concerns the same mark and specification as the former, and

---

<sup>6</sup> Opponent's written submissions, para [11].

<sup>7</sup> Opponent's written submissions, para [12].

<sup>8</sup> Applicant's written submissions, page 3.

registration WO00001327269 concerns the same mark, and almost the same specification<sup>9</sup>, as the latter.

24. Earlier registration WO0000001228581

I group the following of the Applicant's class 9 goods together, all of which relate to computers of one sort or another:

*Computers; Micro-computer; Tablet computers; Personal computers; Laptop computers; Netbook computers; Notebook computers; Desktop computers; Mobile computers; Portable computers; Handheld computers; All-in-one computers.*

25. The purpose of the respective goods will differ: the above 'computers'<sup>10</sup> are electronic devices used to store and manipulate data, whereas *computer programs* are the sets of instructions according to which computers operate. Users of both will include members of both the general and professional public; there will overlap to the extent that a purchaser of a computer might also purchase a certain program, or software comprising a set of programs, for that computer. The physical nature of the respective goods will differ: computers are items of hardware whereas *computer programs* are software. I consider trade channels to overlap; many retailers of *computers* will also sell *computer programs*, from the same physical shop or website. I also recognise that some businesses might deal solely in *computer programs*. I do not find the respective goods to be in a competitive relationship. I do, however, find complementarity; *computer programs* are indispensable to *computers* because, without them, they could not function. I consider that the average consumer may presume that responsibility for the respective goods lies with the same undertaking. Consequently, I find the respective goods to be similar to a medium degree.

26. I group the following of the Applicant's class 9 goods together, all being integrated components of computers:

---

<sup>9</sup> the slight difference in wording of some of the class 42 terms has no bearing on the comparison of the respective goods and services.

<sup>10</sup> i.e. all of the goods listed at paragraph [24].

*Computer motherboards; Computer chipsets; Computer monitors; Computer graphics boards; Internal cooling fans for computers.*

27. These goods are items of hardware integral to computers which enable them to function<sup>11</sup>, or improve their functionality. There is therefore some overlap in purpose with the Opponent's goods to the extent that *computer programs* also enable computers to function. Methods of use are, however, very different: the Applicant's goods are physically installed, whereas *computer programs* are loaded by way of inputting instructions electronically. In my view, with the possible exception of *computer monitors*, purchasers of the Applicant's goods will, in most cases, be members of the professional public e.g. manufacturers of computers for which these components are needed; or IT professionals. I recognise that a small number of the general public will have specialist knowledge of computers, by way of a hobby, and may purchase these components themselves. I consider that *computer monitors* will be purchased by both the general and professional public. The physical nature of the respective goods will differ; the Applicant's goods being hardware whereas *computer programs* are software. Trade channels will overlap somewhat; some retailers may sell *computer programs* alongside the Applicant's goods, although, as noted, some may only sell software, e.g. *computer programs*. There is no competition between the respective goods. I consider that there is complementarity; the components, at [26], require *computer programs* in order to integrate with other components in a computer and the public may presume that the goods originate from the same undertaking. I conclude that there is a low-medium level of similarity between the respective goods.

28. I group the following of the Applicant's goods together, all being computer peripherals:

---

<sup>11</sup> It is appreciated that, strictly speaking, a computer can *function* without a monitor; but the monitor enables the consumer to *use* the computer effectively.

*Computer joysticks; Computer controllers; Computer keyboards; Computer mice; Computer keypads; Wireless computer mice; Computer hardware for games and gaming.*

29. These goods are auxiliary devices that connect to computers in order to: enable a computer to be used; improve ease of use; or to add a certain functionality (e.g. hardware to enable game-playing). The purposes of the respective goods are similar to the broad extent that *computer programs* enable peripheral devices, in conjunction with computers and/or other devices, to function. Methods of use are different, however: the peripheral devices listed above are physically connected to the computer. There will be user overlap; users of computer peripherals will necessarily also use *computer programs*. The respective goods will differ in physical nature in the way already described in the previous goods comparisons. Trade channels will be shared. I do not find the goods to be competitive. There is complementarity to the extent that *computer programs* are necessary to enable the peripherals to work in conjunctions with computers and the average consumer would presume that the respective goods originate from the same undertaking. Consequently, I find a low-medium level of similarity between the respective goods.

30. I group the following of the Applicant's goods together, all being computer accessories having an ergonomic function:

*Computer cases; Computer mousepads; Notebook computer cooling pads; Wrist rests for computer mouse users Mats for use with a computer mouse.*

31. The above goods are concerned with the physical comfort and ease of use of computers and their peripherals (or, in the case of *computer cases*, to enable portability) a different purpose to that of *computer programs*. However, users of the respective goods will be the same. The physical nature of the respective goods will differ. Trade channels will in many cases overlap. The goods are not in competition with one another. In my view, there is no complementarity; although the above goods are used in conjunction with computers, which, in turn, cannot function without *computer programs*, the above-mentioned accessories are not



essential for computers or *computer programs* to function. I therefore find only a very low level of similarity between the respective goods.

32. I group the following of the Applicant's goods together, all being connected with virtual reality:

*Virtual reality headsets; Virtual reality hardware; Flight simulators; Weapon simulators; Sports training simulators; Simulators for driving or control of vehicles.*

33. The above items enable the user to experience a virtual reality: in the course of game-playing or sports training; or to hone one's skills in fields such as combat or operating vehicles/craft. These purposes differ from those of *computer programs*. Users will overlap; using the above goods entails using the *computer programs* upon which the functioning of those goods relies. The physical nature of the respective goods will differ. Trade channels may overlap in some instances. The goods are not in competition with one another. There is complementarity to the extent that *computer programs* are necessary to enable the above goods to function and the average consumer may in some cases presume that the respective goods originate from the same undertaking. Consequently, I find a low level of similarity between the respective goods.

34. I now compare the Applicant's *computer servers* against the Opponent's goods.

A *computer server* is a computer that 'serves' information to other computers in a network. The purposes of the respective goods are similar only to the broad extent that *computer servers* enable networked computers to function in a network and *computer programs* enable computers to function in the first place. In my view, users of *computer servers* will almost always be businesses. There will be user overlap to the extent that users of servers will necessarily be using the *computer programs* without which servers could not function. The physical nature of the respective goods will differ. Trade channels may overlap in some instances. I consider there to be competition between the goods. I gather from my own general knowledge that any computer can be a server if the appropriate software is installed. Therefore, in some instances, an average consumer might deliberate over whether to purchase a *computer server*, or, instead, to simply

purchase an appropriate *computer program* to convert an existing computer into a server. I consider the respective goods to be complementary; *computer servers* cannot function without *computer programs* and some average consumers may presume that the respective goods originate from the same undertaking. I therefore find a low-medium level of similarity between the respective goods.

35. I now compare the Applicant's *speakers for computers* against the Opponent's goods. Speakers enable computers to have an audio function, a purpose different from that of *computer programs*. Users will overlap because using the speakers entails using the *computer programs* according to which they function. Physical nature and methods of use differ; speakers are items of hardware physically connected to a computer and/or peripherals. Trade channels may be shared in some instances. The goods are not in competitive relationship. There is some complementarity; *speakers for computers* require *computer programs* in order to function and some average consumers may presume that the respective goods originate from the same undertaking. I therefore find a low level of similarity between the respective goods.

36. I now compare the Applicant's *computer hardware for the control of lighting* against the Opponent's goods. The purpose of the Applicant's goods is to enable the user to control lighting systems from a computer; a different purpose to that of *computer programs*. Users will overlap because using the *hardware for the control of lighting* entails using the *computer programs* according to which that hardware interacts with the computer. Physical nature and methods of use of the respective goods will differ. Trade channels will be sometimes be shared. I do not consider the goods to be in a competitive relationship. There is some complementarity; *computer hardware for the control of lighting* requires a *computer program* in order to function and some average consumers may presume that the respective goods originate from the same undertaking. I therefore find a low level of similarity between the respective goods.

37. I now compare the Applicant's *smartphones* against the Opponent's goods. *Smartphones* are mobile telephones which have additional functions including, *inter alia*: internet access; camera and video; and the ability to play music. Their

purpose therefore differs from that of the Opponent's goods. Users will overlap: using *smartphones* entails using the *computer programs* according to which they operate; many users also purchase 'apps', which are *computer programs*, for their smartphones. The physical nature and methods of use of the respective goods will differ. Trade channels may overlap in some cases. I do not find the respective goods to be competitive. There is some complementarity; *smartphones* require *computer programs* in order to function and some average consumers may presume that the respective goods originate from the same undertaking. I therefore find a low level of similarity between the respective goods.

38. Earlier registration EU015207715

I now compare the Applicant's goods against the Opponent's services *rental of computer hardware and computer software*.

39. I group the following of the Applicant's goods together, all being items of computer hardware of one sort or another:

*Computers; Computer servers; Computer joysticks; Computer controllers; Micro-computer; Computer keyboards; Computer mice; Computer motherboards; Computer keypads; Computer chipsets; Computer monitors; Tablet computers; Personal computers; Laptop computers; Netbook computers; Notebook computers; Desktop computers; Mobile computers; Portable computers; Handheld computers; Computer graphics boards; Wireless computer mice; Speakers for computers; ; All-in-one computers; Internal cooling fans for computers; Computer hardware for games and gaming; Computer hardware for the control of lighting; Virtual reality headsets; Virtual reality hardware*

40. The purposes of the above goods have already been addressed in the course of the comparisons against the Opponent's registration WO0000001228581. There will be something of an overlap with the Opponent's services because they involve *provision* of the above goods. However, the purpose of the Opponent's services differs in that the supplier *owns* hardware that it provides, the consumer simply paying for the possession and use of the equipment for a limited time

period. Users of the respective goods and services will be shared; consumers of the respective goods and services will be seeking *computer hardware*, whether to own or rent. The physical nature of the respective goods and services is different; goods are tangible objects whereas services are acts of service. Purchasers of the Applicant's goods obtain ownership of those goods; whereas purchasers of the Opponent's services are paying a supplier for the benefit of possessing and using those goods, but without being encumbered by the obligations of ownership. Trade channels may often overlap; a purveyor of computers and associated hardware may well also offer rental packages. A consumer may deliberate over whether to purchase or rent computer hardware. The goods and services are therefore in a competitive relationship. I also find complementarity; computer hardware is indispensable to a business whose service is renting out such equipment. Consequently, I find the respective goods and services to have a medium level of similarity.

41. I now compare the following of the Applicant's goods against the Opponent's services:

*Notebook computer cooling pads; Computer mousepads; Wrist rests for computer mouse users; computer cases; Mats for use with a computer mouse.*

42. Purposes of the respective goods and services will differ to the extent that the above goods are concerned with the *comfort* of using computers and associated hardware, whereas the Opponent's services are concerned in the supply of *computer hardware*. Users will, however, overlap. The physical natures of the respective goods and services are different. Trade channels may be shared where some purveyors of computers, hardware and associated accessories (e.g. mousepads) also offer *rental of computer hardware*. The respective goods and services are not substitutable; therefore, they are not in competition. I do not find complementarity either. Although the above goods are, of course, ergonomically useful when using computers, they are not essential for the provision of a service which supplies computer hardware for rent. The average consumer would not look to rent a mousepad or wrist rest. I therefore find the respective goods and services have a low level of similarity.

43. I now compare the following of the Applicant's goods against the Opponent's services:

*Flight simulators; Weapon simulators; Sports training simulators; Simulators for driving or control of vehicles*

In my view, the purposes of the respective goods and services differ. The Applicant's goods are specifically intended to create a virtual reality experience in which to hone sports skills or, in the case of *flight simulators and simulators for driving or control of vehicles*, develop professional skills e.g. as pilots (or controllers of other vehicles). In my view, user overlap is possible but would be unusual; a purchaser of a *flight simulator* might, in some circumstances, rent a piece of software for the simulator, for example. To my mind, the above goods are so specialised that the software would likely be pre-loaded onto the machine at the time of purchase. The physical nature of the respective goods and services will differ. An overlap in trade channels is possible to the extent that a business selling the above goods might also offer rental of associated hardware and software. I do not find the respective goods and services to be either competitive or complementary. I therefore find that the respective goods and services are similar to a low degree.

44. I now compare the Applicant's *smartphones* to the Opponent's services. The purposes of the respective goods and services have already been addressed; they are different. I consider user overlap to be unlikely; average consumers of *smartphones* are unlikely to be seeking services falling under *rental of computer hardware and computer software* for those goods. The physical nature of the respective goods and services will differ. In my view, trade channels will unlikely be shared. I find neither competition nor complementarity between the respective goods and services. I therefore find the respective goods and services to be dissimilar.

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

45. 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.

46. In *Hearst Holdings Inc*<sup>12</sup> Birss J. (as he then was) described the average consumer thus:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

47. The average consumer of the class 9 goods will depend on the particular product purchased. To my mind, *computer servers* and the ‘simulators’ will almost always be purchased by the professional public. It would be unusual (but not impossible) for a member of the general public to purchase these items. With the exception of *computer monitors*, the goods listed at [26] (i.e. items of hardware which are components as opposed to peripherals or complete machines) will, in my view, be purchased in most cases by professionals e.g. businesses and IT experts. I acknowledge, however, that some of the general public may also purchase these items. The remainder of the class 9 goods will be purchased by both the general and professional public.

48. For those goods identified as being purchased mainly by the professional public, the average consumer will pay a high level of attention when making the purchase. For goods such as *flight simulators*, for example, which are highly

---

<sup>12</sup> *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).


specialised pieces of equipment important in training pilots, the purchasing act will likely conclude after consultation with the supplier and the purchaser having 'tried out' the machine. The purchasing act will be visual to the extent that the average consumer will likely have first encountered the supplier on a website or in a trade publication or catalogue. There will also be an aural aspect where prospective purchasers enquire about the goods with retail staff, or purchases are made after 'word-of-mouth' recommendations. *Computer servers* will also be purchased with a high level of attention. Factors considered will include: the IT needs of the business for which it is being purchased; the size of the equipment (some servers need to be housed in a room of their own owing to their size). A purchase will likely conclude only after detailed discussion with the seller of the goods.

49. For the remaining goods (i.e. *computers; computer programs, mobile phones* and the goods that can be categorised as computer peripherals and accessories) the purchasing act will be mainly visual. The goods would be purchased either online or from physical shops after viewing product information online or inspecting the goods. Some purchases will be made after seeking advice from retail staff or after word-of-mouth recommendations. *Computer programs* will likely be purchased online. I consider the average consumer to pay at least a medium level of attention when purchasing the goods.

50. I now consider the class 42 services *rental of computer hardware and computer software*. In my view, most purchases of these services will be by businesses. Computer hardware and software for use by the general public is typically less specialist and complex; more likely to be bought outright than rented. Equipment and software used by businesses is typically specialised; often requiring functionality and capacity for complex and high volumes of data. These requirements are very costly if the goods are bought outright and therefore, to my mind, businesses are more likely to opt for rental. I am aware, however, that the rental of software for gaming is becoming more commonplace and therefore that a number of members of the general public might also purchase the Opponent's services. The attention level of the average consumer will, to my mind, range from medium to high. Factors considered will include, *inter alia*: business needs;

compatibility with the purchaser's existing hardware and software. The purchasing act will be visual to the extent that the service-provider's website will show product listings showing the various rental packages. There will also be an aural aspect. Where the services are provided from a physical premises, some equipment is likely to be on display, but, in many cases, staff would be consulted for advice on which rental packages would accommodate the purchaser's needs.

### Comparison of the marks

Opponent's (earlier) mark	Applicant's (contested) mark
<b>OP SIS</b> <sup>13</sup>	

51. 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.

52. 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

<sup>13</sup> Although the Opponent is relying on 4 earlier registrations, the marks to which those registrations relate are all identical. The very slight difference in font in respect of one of the marks does not disturb that identity.



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.

53. The Opponent's mark comprises a single word element 'OP SIS' in a plain font, all letters of uniform size and in upper case. The overall impression resides in its entirety.

54. The Applicant's mark comprises two elements: a device and a single word. The device is a geometric shape composed of two isosceles triangles of different sizes arranged vertically on top of one another, the point formed by the equal sides of the larger triangle touching the corresponding point of the smaller triangle. This arrangement is positioned on top of what looks like a small upside-down 'T'. Beside the device is the single word element 'OP SYS'. The word is rendered in a plain font, all letters of uniform size and in upper case. 'OP SYS' is the dominant element and carries more weight in the visual impression owing to its size relative to the device. The device will play a secondary role in the overall impression.

55. Visual comparison

Both marks are short and contain word elements in plain font, all letters being in upper case. The respective marks share five letters 'O, P, S, S' appearing in that order. Points of difference are: the penultimate letter of the Opponent's mark being 'I', the penultimate letter of the Applicant's mark being 'Y'; the presence of the device in the Applicant's mark, absent from the Opponent's mark.

56. Courts have been willing to find similarity of marks where there is an identical verbal element that is shared by the respective marks, even though the remaining letters are different. The General Court in the case of *Lancôme v OHIM*<sup>14</sup> considered the word marks 'ACNO FOCUS' and 'FOCUS' and concluded that there was a certain visual similarity between them by virtue of both marks containing the common element 'FOCUS'.

---

<sup>14</sup> Case T-466/08 *Lancôme Parfums et Beauté & Cie v OHIM* EU:T:2011:182, para [63].

57. In *El Corte Inglés, SA v OHIM*, the General Court observed that the attention of the consumer is *usually* [my emphasis] directed to the beginning of a word mark<sup>15</sup>, but I am mindful that this is not an absolute rule.

58. Consequently, I find the respective marks to be visually similar to at least a medium degree.

59. Aural comparison

The Opponent's mark has two syllables and will be articulated as 'OP-S/SS', with the emphasis on the second syllable. The same can be said of the Applicant's mark. I therefore find the respective marks to be aurally identical.

60. Conceptual comparison

The Opponent has submitted<sup>16</sup> the following:

Conceptually the marks have no meaning and are therefore the conceptual comparison is neutral. In its counterstatement the Applicant has argued that OPSYS has a conceptual meaning in that it is an amalgamation of the words "OverPowered" and "Systems" and has some meaning in respect of gaming computers. However, it has not provided any evidence in support of that assertion. In any case the goods for which it seeks registration are not limited to the field of gaming and it is submitted that for the average member of the general public the mark has no conceptual meaning.

61. The Applicant has made the following comment in its counterstatement:

6. The opponent is wrong by suggesting the words have no conceptual meaning. OPSYS is an amalgamation of the terms 'OP', gaming slang for 'OverPowered', and 'SYS', in this case referring to 'Systems'. The name OPSYS is tied to the gaming computers we manufacture and we emphasise the meaning of the term in the marketing and branding we use, with constant use of the term 'OP' and it's context.

62. The Applicant has submitted<sup>17</sup> the following:

---

<sup>15</sup> Cases T-183/02 and T-184/02 at para [83].

<sup>16</sup> Opponent's written submissions in lieu of a hearing, at paragraph [24].

<sup>17</sup> Applicant's written submissions in lieu of a hearing, at page 1.

Phonetically, the marks are similar. But due to the visual differences and the fact that the marks are either conceptually different due to the perception of the letters SYS referring to 'system', and the fact that OPSIS has no meaning/concept, or the conceptual comparison is neutral, the marks in their entirety are dissimilar.

63. The word 'opsis' appears in the English dictionary<sup>18</sup> and is defined as 'indicating a specified appearance or resemblance'. It is a suffix rather than a complete word and indicates a resemblance to the thing named by the initial element.<sup>19</sup>

64. In my view, although 'opsis' appears in the English dictionary, a significant proportion of average consumers will not appreciate its meaning. The fact that it is a suffix means that it will not have been encountered by the average consumer as a freestanding word. I recognise that a small proportion will understand its meaning. However, I must be mindful of the extent to which certain knowledge may be ascribed to the average consumer.<sup>20</sup> I consider that a significant number of average consumers will perceive 'OPSIS' as an abbreviation of 'operating system', albeit with the 'SIS' element intentionally misspelt. The term 'operating system' refers to the fundamental piece of software that enables a computer to function. In my view, it is a term to which a significant proportion of average consumers will have been exposed and they will understand that it relates to computers, even if they do not appreciate its precise technical meaning.

65. I now turn to the Applicant's mark. In my view, the device will be seen simply as a made-up figurative element with no obvious meaning. For some consumers, the device may call to mind an hourglass/egg-timer, but the unequal size of the triangles would prevent the conclusion that that is what it represents. Some consumers might presume that the device is a symbol of some sort. To my mind, the average consumer is unlikely to perceive 'OPSYS' as 'an amalgamation of

---

<sup>18</sup> <https://www.collinsdictionary.com/dictionary/english/opsis>, accessed 12 August 2021, at 10:26.

<sup>19</sup> The example given of how the suffix is used is 'meconopsis', the name of a poppy-like plant; the 'mecon' element derived from the Greek word 'mēkōn' (meaning poppy).

<sup>20</sup> Ms Anna Carboni, as the Appointed Person in *Chorkee Ltd v Cherokee Inc* Case BL O/048/08 urged caution 'not to assume that one's personal experience, knowledge and assumptions are more widespread than they are.' Despite it being a fact that the word Cherokee denotes the name of a tribe indigenous to North America, the Hearing Officer was not entitled to attribute this knowledge to the relevant average consumer.

the words 'OverPowered' and 'Systems'. I consider that the majority of average consumers would perceive the word element 'OPSYS' as an abbreviation of 'operating system' for the reasons already provided.

66. Consequently, for the smaller group of consumer who are familiar with the dictionary meaning of 'opsis', the marks will be conceptually dissimilar; whereas for the larger group of average consumers, the respective marks will be highly conceptually similar. For the group of consumers who see the respective marks as invented words, the marks will be conceptually neutral.

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

67. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations  
(see *Windsurfing Chiemsee*, paragraph 51).”

68. I consider that ‘OP SIS’ will, for a significant number of average consumers, be perceived as an abbreviation of the term ‘operating system’. ‘Operating system’ is a term frequently used in relation to computers and computer-related products. The mark is therefore somewhat allusive of the goods and services for which it is registered. However, in my view, the way in which the abbreviations ‘op’ and ‘sis’ have been combined to create the ‘word’ ‘OP SIS’ shows some measure of inventiveness. Consequently, I find that the Opponent’s mark is inherently distinctive to a medium degree.

### **Likelihood of confusion**

69. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*<sup>21</sup>. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*<sup>22</sup>, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a ‘sub brand’, for instance.

70. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [11].

---

<sup>21</sup> Case BL O/375/10 at [16].

<sup>22</sup> *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

71. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

72. My comparison of the respective goods and services has determined that:

- The following of the Applicant's goods are similar to the Opponent's **class 9 goods** to a medium degree:

*Computers; Micro-computer; Tablet computers; Personal computers; Laptop computers; Netbook computers; Notebook computers; Desktop computers; Mobile computers; Portable computers; Handheld computers; All-in-one computers*<sup>23</sup>.

- The following of the Applicant's goods are similar to the Opponent's **class 42 services** to a medium degree:

*Computers; Computer servers; Computer joysticks; Computer controllers; Micro-computer; Computer keyboards; Computer mice; Computer motherboards; Computer keypads; Computer chipsets; Computer monitors; Tablet computers; Personal computers; Laptop computers; Netbook computers; Notebook computers; Desktop computers; Mobile computers; Portable computers; Handheld computers; Computer graphics boards; Wireless computer mice; Speakers for computers; ; All-in-one computers; Internal cooling fans for computers; Computer hardware for games and gaming; Computer hardware for the control of lighting; Virtual reality headsets; Virtual reality hardware*

- The following of the Applicant's goods are similar to the Opponent's **class 9 goods** to a low degree:

---

<sup>23</sup> I have found these goods to also be similar to the Opponent's *services* to a medium degree.

*Flight simulators; Weapon simulators; Sports training simulators; Simulators for driving or control of vehicles; smartphones.*

*(Flight simulators; Weapon simulators; Sports training simulators; Simulators for driving or control of vehicles are also similar to the Opponent's **class 42 services** to a low degree)*

- The following of the Applicant's goods have a low level of similarity with the Opponent's **class 42 services**:

*Notebook computer cooling pads; Computer mousepads; Wrist rests for computer mouse users; computer cases; Mats for use with a computer mouse.*

73. My comparison of the respective marks has found that:

- The level of visual similarity between the marks is medium;
- The marks are aurally identical;
- For the group of average consumers with knowledge of the meaning of 'opsis', the marks will be conceptually dissimilar; for the larger group of consumers, the marks will be conceptually highly similar. For the group of consumers who see the respective marks as invented words, the marks will be conceptually neutral.

74. I have found that the Opponent's mark is inherently distinctive to a medium degree. The CJEU held in *Sabel*<sup>24</sup> that:

"24. The more distinctive the earlier mark, the greater will be the likelihood of confusion."<sup>25</sup>

---

<sup>24</sup> *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

<sup>25</sup> This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited* BL O-075-13:

75. I find that a significant proportion of average consumers would confuse the marks. All of the Applicant's goods have some level of similarity with either the Opponent's goods or services; in the case of some goods there is similarity with the Opponent's terms in both class 9 and 42. The marks are aurally identical and, for a large proportion of average consumers, conceptually highly similar. For those average consumers for whom the marks are conceptually neutral, there are no conceptual differences to offset a likelihood of confusion. The word elements of the respective marks differ only by the penultimate letter. This slight difference in spelling, together with the presence of the device in the Opponent's mark, do not, in my view, disturb the high level of conceptual similarity (or, conceptual neutrality, for consumers perceiving the marks as invented words) between the marks. The device does not carry as much visual weight as the word element of the mark, owing to the fact that it appears to be a made-up shape to which the average consumer will not readily attach a meaning. In these circumstances, it is my view that when the average consumer encounters the Opponent's mark, they may well mistake it for the Applicant's mark because the mind's eye has failed to register the visual differences (i.e. the slight variation in spelling; and the device) between the marks. There is a likelihood of confusion. I find this to be the case even where the average consumer displays a high level of attention when purchasing the goods or services.

76. I have nevertheless recognised that there will be another group of average consumers who *will* understand the meaning of 'opsis'. I bear in mind the case of *Interflora Inc v Marks and Spencer plc* [2013]<sup>26</sup> in which it was held that there is no 'single meaning rule' according to which the court must 'identify one, and one

---

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

<sup>26</sup> EWHC 1291 (Ch)



only, perception amongst the relevant class of average consumer, and judge confusion accordingly'. In *Soulcycle Inc v Matalan Ltd*<sup>27</sup>, Mann J. approved the principle that a 'significant proportion' of average consumers being confused is sufficient for a finding of likelihood of confusion.

## Final Remarks

77. The Opposition has succeeded in full and the Application is refused.

## COSTS

78. I award the Opponent the sum of **£700** as contribution towards its costs, calculated as follows<sup>28</sup>:

Preparation of statement and consideration of the Applicant's statement:	£300
Official fee for 5(2)(b) only:	£100
Written Submissions in lieu of hearing:	£300
<b>Total:</b>	<b>£700</b>

79. I therefore order Opsys LTD to pay to Opsis Holding AB **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 25<sup>th</sup> day of August 2021**

---

<sup>27</sup> [2017] EWHC 496 (Ch)

<sup>28</sup> Based upon the scale published in Tribunal Practice Notice 2/2016.

**Mx N. R. Morris**  
**For the Registrar,**  
**the Comptroller-General**