

O-858-22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS UK00003615681 AND UK00003615702 BY
THYSSENKRUPP STEEL EUROPE AG TO REGISTER:**

smart steel

AS A TRADE MARK IN CLASSES 6, 9, 16, 35, 40, 41 AND 42

AND

**IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 426397 AND 427251
BY ANSTAR OY**

Background & Pleadings

1. On 24 March 2021, ThyssenKrupp Steel Europe AG (“the applicant”) applied to register “smart steel” as a trade mark in the United Kingdom in respect of:

Class 9: Printed matter stored on data carriers and parts thereof, including information material in the form of printed matter and photographs; downloadable electronic printed matter and parts thereof, including information material in the form of printed matter and photographs.

Class 16: Photographs, periodic and non-periodic printed matter, printed matter, information material in the form of printed matter, books, newspapers, magazines, paper, notebooks, brochures, notebooks, address books, calendars, brochures, leaflets, posters, placards, signs and photographs.

Class 35: Providing commercial information to consumers when choosing products and services; advertising; presentation of Class 6 goods, in particular ores, base metals and their alloys, in particular steel, made from raw and partially processed base metals or their alloys, in particular steel, manufactured products, namely slabs, plates, strips, sheets, tubes, white sheets and ultra-fine sheets, electrical steel in grain-oriented and non-grain-oriented design; business management; company administration; clerical services; updating of advertising material; business management and organization consultancy; consultancy regarding public relations communication strategies; consultancy regarding advertising communication strategies; business management consultancy; advisory services for business management; providing business information via a web site; business management consultancy; design of advertising materials; public relations services; billboard advertising; corporate communications services; organization of trade fairs for commercial or advertising purposes; rental of billboards [advertising boards]; distribution of advertising material (leaflets, prospectuses, printed matter, samples); management of customer loyalty programs; economic lobbying; target marketing; all the aforementioned services not relating to trucks, buses, commercial vehicles and their parts, in particular axles, axle systems and other attachments and accessories for truck trailers, semi-trailers and trucks.

Class 41: Education; training; organization and staging of specialist conferences, congresses, seminars, training courses, workshops [training], webinars; video-recording services; education and training consultancy; providing television programmes, not downloadable, via video-on-demand services; providing online videos, not downloadable; correspondence

courses; distance learning courses; providing online electronic publications, not downloadable; online publication of electronic books and journals; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of workshops [training]; arranging and conducting of colloquiums; conducting online seminars including specialist product training for customers.

The application, to be referred to as “the first application”, was published for opposition purposes on 28 May 2021.

2. Also on 24 March 2021, the applicant applied to register “smart steel” as a trade mark in the UK in respect of:

Class 6: Ores; base metals and their alloys, in particular steel; products made from crude or partially worked base metals or their alloys, in particular steel, namely, slabs, plates, strips, sheets, tubes, tinplates and fines; electrical sheets in grain-oriented and non-grain-oriented forms; none of the aforesaid being connecting parts for concrete structures, consoles (of steel), Steel building materials, lifting systems (of steel), reinforcement products (of steel).

Class 40: Material processing, namely, prefabrication of workpieces, production of profiles, production of slit strips, cutting of sheets, plates or trapeziums, material hardening and surface finishing, in particular by hot-dip galvanizing, hot-dip aluminizing, electrolytic galvanizing or organic coating; waste, sewage and pollutant processing, recycling of waste, sewage, scrap and garbage.

Class 42: Architectural services for products of steel and erection of plants for the production of steel; civil engineering services for products of steel and erection of plants for the production of steel; mining engineering services; chemist services for products of steel and the production of steel; design and development of computer hardware and software for controlling plants for the production of steel; engineering services for products of steel and plants for the production of steel; research and consulting services in the field of physics for products made of steel and the production of steel; construction design services for products made of steel and the construction of facilities for the production of steel; technical draftsman services for products made of steel and the construction of facilities for the production of steel; surveying services for products made of steel and the construction of facilities for the production of steel; research services for the production of steel and products made of steel; remediation of contaminated sites, namely design of remediation measures to clean up sites after steel production.

The application, to be referred to as “the second application”, was published for opposition purposes on 2 July 2021.

3. Both applications were opposed by Anstar Oy under sections 5(2)(a) and/or 5(2)(b) of the Trade Marks Act 1994 (“the Act”); the first application on 24 August 2021 and the second application on 1 October 2021. On receipt of the applicant’s counterstatements on 19 November 2021 and 29 December 2021, respectively, the proceedings were consolidated on 6 January 2022. The opponent relies upon the following trade mark and all goods and services for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 917484148

SMART STEEL.

Filing date: 15 November 2017

Registration date: 27 February 2018

Class 6: Connecting parts for concrete structures, consoles (of steel); Steel building materials; Lifting systems (of steel); Reinforcement products (of steel).

Class 37: Building, maintenance, consultancy and repair services relating to construction beams.

4. The opponent contends that there exists a likelihood of confusion and/or association due to the high similarity or identity between the respective trade marks and the high similarity between the parties’ goods and services.

5. The applicant accepts that there is some visual and aural similarity between the marks, but denies that they are identical. It denies any identity, similarity or relatedness in regards the parties’ goods and services, and ultimately concludes that there is no likelihood of confusion nor association.

6. The applicant is represented by Baron Warren Redfern and the opponent by Lane IP Limited. Neither party filed evidence during the evidential rounds. Neither party requested a hearing, though the opponent elected to file submissions in lieu. Whilst I do not propose to summarise those submissions here, I will keep them in mind throughout and intend to refer to them only where necessary.

7. 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 my decision will continue to make reference to the trade mark case law of EU courts.

Pleaded grounds

8. As detailed above, the opponent has made a pleading under sections 5(2)(a) and 5(2)(b) of the Act, with section 5(2)(a) requiring that the marks are identical and section 5(2)(b) requiring only that they are similar. The opponent contends that the full stop positioned at the end of the opponent's mark would be deemed insignificant and would go unnoticed by the relevant consumer and, as such, the marks should be considered identical. In the alternative, it submits that the marks are highly similar. The applicant denies that the marks are identical and does not agree that the punctuation is insignificant and will therefore go unnoticed. I propose to proceed, at least initially, on the basis of section 5(2)(b), given that this ground does not demand an identity between the competing marks. I intend to return to consider the matter of identity only if appears necessary.

Decision

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

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

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

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

10. Section 5A reads:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

11. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark... or international trade mark (UK)... 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.”

12. Under the provisions outlined above, the opponent’s trade mark clearly qualifies as an earlier mark. In accordance with section 6A of the Act, as it had not completed its registration procedure more than five years prior to the filing date of the applicant’s mark, it is not subject to the proof of use requirements. Consequently, the opponent can rely upon its mark and all goods and services it has identified without providing evidence of use.

Section 5(2)(b) - Case law

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

The principles:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. The goods and services to be compared are set out at paragraphs 1, 2 and 3 to this decision.

15. Both parties' specifications include *steel building materials; lifting systems (of steel)* and *reinforcement products (of steel)* in class 6. These goods are literally identical.

16. In my comparison of the remaining goods and services, I will consider factors including their nature, intended purpose, method of use and whether they are in competition or are complementary.¹

¹ *Canon*, Case C-39/97

17. 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 General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

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

- (a) The respective 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.

Printed matter stored on data carriers and parts thereof, including information material in the form of printed matter and photographs; downloadable electronic

printed matter and parts thereof, including information material in the form of printed matter and photographs. (Class 9)

19. Whilst the opponent contends that the aforementioned goods share a complementary relationship with the opponent's class 37 services, insofar as the content of the printed matter could concern building, maintenance etc, I can see no tangible similarity. The respective uses are very different and I see little likelihood of correlation in users, except to the extent that, broadly speaking, the general public may have access to both. There is nothing similar in the nature between the goods and services, nor in their trade channels, and there is no element of competitiveness between the two. I am not swayed by the opponent's comments regarding the complementary relationship; whilst I accept that printed matter *could* concern services similar to those relied upon by the opponent, the term is not restricted in such a way. Nonetheless, the goods and services are not indispensable for one another and are not typically provided by the same entity. Weighing all factors, I find the goods and services dissimilar.

Photographs, periodic and non-periodic printed matter, printed matter, information material in the form of printed matter, books, newspapers, magazines, paper, notebooks, brochures, notebooks, address books, calendars, brochures, leaflets, posters, placards, signs and photographs. (Class 16)

20. The opponent makes the same contention in respect of the above goods. However, much of my earlier reasoning applies. Other than a broad opportunity for a crossover in users, there is little between the goods and services to justify a finding of similarity. The uses are distinct, as are the channels of trade and nature. The goods and services are not competitive nor complementary, to the extent that they can be considered indispensable. I find no similarity.

Presentation of Class 6 goods, in particular ores, base metals and their alloys, in particular steel, made from raw and partially processed base metals or their alloys, in particular steel, manufactured products, namely slabs, plates, strips, sheets, tubes, white sheets and ultra-fine sheets, electrical steel in grain-

oriented and non-grain-oriented design; all the aforementioned services not relating to trucks, buses, commercial vehicles and their parts, in particular axles, axle systems and other attachments and accessories for truck trailers, semi-trailers and trucks. (Class 35)

21. Whilst there is a distinction between the class 6 goods such as those relied upon by the opponent and the aforementioned services, there is, in my view, a relationship to be found. The uses are different; the goods will be used by practical means whereas the services involve the display of the same or similar goods, to aide consumers in their selection of the appropriate goods – though the intended result is similar and the users are likely to be the same. There is a distinction in nature, though the goods and services may move through similar channels. There is not an element of competitiveness, but there could be a degree of complementarity; the presentation of goods such as those specified in the application could precede the purchase of similar class 6 goods relied upon by the opponent, for example, and it would not seem uncommon for a single entity to present goods, or similar goods, to those it offers, simultaneously. I find the similarity to be between a low and medium degree.

Providing commercial information to consumers when choosing products and services; advertising; business management; company administration; clerical services; updating of advertising material; business management and organization consultancy; consultancy regarding public relations communication strategies; consultancy regarding advertising communication strategies; business management consultancy; advisory services for business management; providing business information via a web site; business management consultancy; design of advertising materials; public relations services; billboard advertising; corporate communications services; organization of trade fairs for commercial or advertising purposes; rental of billboards [advertising boards]; distribution of advertising material (leaflets, prospectuses, printed matter, samples); management of customer loyalty programs; economic lobbying; target marketing; all the aforementioned services not relating to trucks, buses, commercial vehicles and their parts, in particular axles, axle systems and other attachments and accessories for truck trailers, semi-trailers and trucks. (Class 35)

22. The opponent submits that the aforementioned services are “so broad that they could encompass commercial services related to steel building materials or construction beams, or consultancy services relating to construction beams”. Whilst there are terms encompassing consultancy in the applicant’s services, they relate to specific areas (advertising or business management, for example) which have little relationship to the opponent’s area of consultancy (construction beams). Whilst I acknowledge the opponent’s submission, there is little similarity in the uses of the respective services; the opponent’s services will be used to gain guidance or assistance in the maintenance or installation of construction beams whereas the applicant’s will be sought, generally, to assist in the running or promotion of a business. Some users may be shared, broadly speaking, though the applicant’s will typically be accessed by a professional entity or individual. The channels of trade are likely to be distinct and the services are not competitive nor complementary. On reflection, I find no similarity.

Education; training; organization and staging of specialist conferences, congresses, seminars, training courses, workshops [training], webinars; education and training consultancy; correspondence courses; distance learning courses; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of workshops [training]; arranging and conducting of colloquiums; conducting online seminars including specialist product training for customers. (Class 41)

23. Of the applicant’s class 41 services, the opponent submits that they are “so broad that they would encompass training and education in respect of steel building materials or construction beams and/or consultancy and repair services which are explicitly covered by the opponent’s mark.” The opponent relies upon *building, maintenance, consultancy and repair services relating to construction beams* in class 37. Applying the terms’ natural meanings, the services are utilised for different purposes. Whilst I acknowledge that the subject matter is unspecified in the applicant’s services, the services will be accessed for the purpose of acquiring knowledge or training in a particular area, for personal or professional purposes, and the terms are not restricted,

whereas the opponent's services will be accessed to provide care for construction beams specifically. Broadly speaking, the services can be accessed by the general public, though the applicant's services will also be selected by educational institutions or businesses and the opponent's services are likely only applicable to a smaller demographic. The nature of the services is likely to differ; the opponent's services are likely to be mostly physical, with the exception of consultancy which may take more of an advisory form, whereas the applicant's services are intended to be informative, and will be delivered as such, though I accept services such as 'training' can incorporate a physical element, but typically in an artificial environment. I do not find the services competitive, nor are they complementary and, generally speaking, I would expect the services to be provided by separate entities. On balance, I find the services are not similar.

Video-recording services; providing television programmes, not downloadable, via video-on-demand services; providing online videos, not downloadable; providing online electronic publications, not downloadable; online publication of electronic books and journals (Class 41)

24. There may be some crossover in respective users but I see no opportunity for similarity in the remaining factors with the above services and the goods and services relied upon by the opponent. The respective uses are distinct, the nature is dissimilar and I do not consider there to be any opportunity for competitiveness nor complementarity; the goods/services are not indispensable, nor are they likely to be provided by the same entity. I find no similarity.

Base metals and their alloys, in particular steel; products made from crude or partially worked base metals or their alloys, in particular steel, namely, slabs, plates, strips, sheets, tubes, tinplates and fines (Class 6)

25. The above goods list steel as a 'particular' material, which is to be treated as an example, rather than a limitation². Where the aforementioned goods are not necessarily encompassed by the opponent's *steel building materials*, they are likely to

² *Häfele GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, T-336/09

be used, or at least can be used, for the same or similar purposes, e.g. building or construction, and will be purchased by the same users. There may be some correlation in physical nature, though of course this is limited when the materials are different. I would expect the goods to reach the market via the same trade channels and there could be a competitive element. The goods are not strictly complementary but can be used alongside one another and provided by a single entity. I find a high degree of similarity.

Ores (Class 6)

26. I understand that ores are rocks or sediments from which minerals are derived. To my knowledge, that which can be extracted can be used in a variety of settings which could include those in which the opponent's class 6 goods are used; as building materials, for example. In that scenario, there could be some correlation in the goods' users, though I accept this will not always be the case. There is a distinction in the goods' physical nature as the materials are not the same, though some physical characteristics may be shared. The trade channels will not be shared, at least exclusively, though there could be some crossover where the intended settings are the same or similar. The goods are unlikely to be competitive and, to my mind, are not strictly complementary but, as above, could be utilised alongside one another in the same environment. Weighing those considerations, I find the similarity to be of a low degree.

Electrical sheets in grain-oriented and non-grain-oriented forms; none of the aforesaid being connecting parts for concrete structures, consoles (of steel) (Class 6)

27. The opponent relies upon *connecting parts for concrete structures, consoles (of steel); steel building materials; lifting systems (of steel) and reinforcement products (of steel)*. The aforementioned goods may not be made of steel but they can be, to my knowledge, used in the process of building or construction. That aside, the goods' different properties likely means that they will be used in different ways, or to fulfil different roles, in the construction process. The goods are likely to be accessed by the same users but the physical nature is likely to be distinct. With different physical

properties, the goods are unlikely to be competitive, though the goods are likely to be available through the same or similar distribution channels. The goods may not be strictly complementary but may be used alongside one another in the same trade. On balance, I find there is similarity between the goods, but of a fairly low degree.

Material processing, namely, prefabrication of workpieces, production of profiles, production of slit strips, cutting of sheets, plates or trapeziums, material hardening and surface finishing, in particular by hot-dip galvanizing, hot-dip aluminizing, electrolytic galvanizing or organic coating (Class 40)

28. The opponent submits that the above services “all relate to the treatment of materials which would naturally include treatment of the Class 6 goods covered by the opponent’s mark” and are therefore complementary, directed at the same public and offered by the same undertaking. It further submits that the services should also be considered similar to the opponent’s class 37 services on the basis that “material processing is a form of building maintenance and repair”. I understand that the competing services may both entail the treatment of materials, to an extent, but the services’ respective purposes are fairly distinct, and of course the opponent’s services relate solely to construction beams. There may be some broad overlap in the services’ users but their nature is unlikely to be similar, particularly in light of (but not limited to) the examples cited in the applicant’s terms. The services are likely to move via different trade and distribution channels and, given the different uses, I do not consider there to be a competitive element. To my knowledge, the services are not indispensable for one another nor are they typically provided by the same or a single origin, therefore I find no complementarity. I find no similarity in the above class 40 services and those relied upon by the opponent in class 37.

29. With regards the opponent’s class 6 goods, the respective uses are different. The opponent’s goods are used for the purpose of building or construction whereas the applicant’s services relate to the specific processing of material(s). Both may be accessed, broadly speaking, by the same consumers, including those in the construction trade. There is naturally a distinction in nature insofar as one is a good and the other a service, though I acknowledge that the ‘materials’ being processed in the applicant’s services could include, for example, *steel building materials*, so there

could be a common element. In that respect, whilst not exclusive, nor indispensable, there could be an opportunity for some similarity in trade channels and for the services and goods to be used alongside one another. Additionally, it would not seem unreasonable for the consumer to expect an entity offering goods such as those relied upon by the opponent to also conduct the kind of processing laid out in the applicant's term, to prepare the relevant materials for use. Weighing all factors, and applying due weight, I find a very low degree of similarity.

Waste, sewage and pollutant processing, recycling of waste, sewage, scrap and garbage (Class 40)

30. In the case of the above class 40 services, there is a distinction in the respective uses, when considered against both the goods and services relied upon. There may be some shared users, broadly speaking, to the extent that consumers of building materials or indeed repair services for construction beams, for example, may, at times, require services such as those outlined above to appropriately dispose of any excess materials. The trade channels are unlikely to be the same as those utilised by the opponent's goods or services and I do not consider there to be any competitiveness or complementarity; whilst I accept that the applicant's services may be utilised subsequently to the purchase or selection of the opponent's goods or services, to my knowledge, they are not typically provided by the same entity and I would not describe the services as indispensable. On balance, I find no similarity.

Research and consulting services in the field of physics for products made of steel and the production of steel; research services for the production of steel and products made of steel (Class 42)

31. When considered against the opponent's class 6 goods, the respective uses are different, though there may be some crossover in users; those looking to purchase products of steel, particularly those in the construction industry, for example, may also elect to access research services concerning the production of steel. Other than both concerning steel, the nature of the goods and services is not similar. The goods and services are likely to move through distinct trade channels and they are not competitive. That said, it would not seem unreasonable to expect an entity offering

steel-based goods to also undertake research services such as those stipulated above alongside the evolution of the relevant industry and, whilst they may not be directly complementary, it seems likely that research into steel and steel production would precede the production of steel, and the steel materials relied upon by the opponent. On balance, I find the similarity to be of a fairly low degree.

Architectural services for products of steel; design and development of computer hardware and software for controlling plants for the production of steel; construction design services for products made of steel and the construction of facilities for the production of steel; chemist services for products of steel and the production of steel; technical draftsman services for products made of steel and the construction of facilities for the production of steel; surveying services for products made of steel and the construction of facilities for the production of steel; civil engineering services for products of steel; engineering services for products of steel and plants for the production of steel; remediation of contaminated sites, namely design of remediation measures to clean up sites after steel production. (Class 42)

32. I intend to consider the above services against the opponent's class 6 goods, though I have noted its submissions regarding both the goods and services relied upon. Whilst the above services specifically concern steel or the production thereof, each pertains to a very specific field and the respective uses are quite different. There may be some correlation in the users of the goods and services, but I see no similarity in nature and the trade channels are likely to be distinct. Given the nature of the services, I find it unlikely that the consumer would expect the goods and services to originate from a single origin; the services are very specialised and would likely be provided by a dedicated entity, with the relevant qualification or training (where applicable). Whilst I accept there may be some degree of succession in the use or application of the respective services and goods, there is not necessarily an indispensable element and I can see no opportunity for competitiveness. On balance of the factors considered, I find no similarity.

Mining engineering services

33. I see little similarity in use between the above services and the goods and/or services relied upon by the opponent, with the above services used, to my knowledge, to identify and extract raw materials sourced during the mining process. The respective users are unlikely to be shared to any real extent and I see no similarity in nature. The trade channels are likely to be distinct and neither the goods or services relied upon are competitive when considered against the above. I am also unable to identify a complementary element. I find no similarity.

34. For those goods and services where I have failed to find any similarity, the opposition fails at this juncture. If there is no similarity, there is no likelihood of confusion to be considered³.

The average consumer and the nature of the purchasing act

35. 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. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. I note the opponent's submissions regarding the average consumer, specifically:

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“The Applicant’s Marks covers a range of goods/services, which are primarily functional and so the consumers level of attention would be low given they would focus their attention on the functionality of the items/services themselves rather than the origin of the mark which therefore increases the risk of a likelihood of confusion.”

37. I disagree with this approach. To my mind, the average consumer of the remaining goods and services is likely to be either a member of the general public or a professional entity or individual, including those working in the building or construction industry. I would expect the consumer to be confronted by the marks alongside goods and services selected from catalogues or at trade fairs, for example. The goods and services are unlikely to be selected with any real degree of frequency (with the exception of professional consumers in the relevant field) and the associated costs are likely to be significant. In approaching the selection, the average consumer will likely be alive to factors such as compatibility, quality and the reputational standing of the provider. The mark’s visual impression is likely to play the greater weight in the selection process, though I do not overlook the relevance of the mark’s aural impression; orders may be made over the telephone, for example. Weighing all factors, I find the average consumer will likely apply between a medium and high degree of attention to the purchase.

Comparison of trade marks

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

“34. ...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.”

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

40. The trade marks to be compared are displayed in the table below:

Opponent’s mark	Applicant’s mark⁴
SMART STEEL.	smart steel

41. The earlier mark comprises the words ‘SMART STEEL’, followed by a full stop. The applicant’s mark comprises the words ‘smart steel’. Little hangs on the variation between upper case and lower case as the registration of word marks allows for their presentation in various cases and typefaces. I find the marks visually similar to (at least) a high degree.

42. Aurally, both marks will likely be articulated in two syllables; SMART-STEEL. I find it unlikely that the average consumer will seek to articulate the punctuation of the earlier mark. On that basis, I find the marks aurally identical.

43. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer⁵. I am confident that both of the words in each mark will be readily understood by the average consumer; ‘steel’ as a common alloy and ‘smart’ as

⁴ The applicant has applied for two marks yet, as they are identical, and in light of my findings on the respective specifications, I find it appropriate to group the marks together and make a single assessment.

⁵ *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

a descriptor for something which is either well-presented or intelligent. When paired together, those words in combination are likely to convey a concept of steel which performs perhaps additional functions to what is expected or is superior to traditional steel in some respect. The full stop in the opponent's acts only as a means of punctuation, and doesn't contribute to or alter the mark's conceptual position. I find the marks conceptually identical.

Distinctive character of the earlier trade mark

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. 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).”

45. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

46. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence of use, I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark comprises two ordinary words which will be readily understood by the average consumer. When considered against the goods and services relied upon, the term 'smart steel', keeping in mind what I have said regarding its conceptual position, plays somewhat of a descriptive or suggestive role. The mark's punctuation contributes little in terms of the mark's distinctive character. Weighing those considerations, I find the earlier mark's inherent distinctiveness to be between a low and medium degree.

Likelihood of confusion

47. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

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

49. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he explained that:

“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 recognized 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.””

50. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

51. I will begin by considering a likelihood of direct confusion. As above, this is a simple matter of the consumer mistaking one mark for another. The interdependency principle sets out that a lesser degree of similarity between the specifications can be offset by a greater degree of similarity between the respective marks. I have found the marks to be at least highly similar visually, and aurally and conceptually identical, and further concluded that the average consumer will apply between a medium and high degree of attention to their selection of the goods and/or services. To my mind, notwithstanding the degree of inherent distinctiveness attributed to the earlier mark, even where the average consumer applies a high degree of attention to its purchase, the respective marks are so similar and there is so little to differentiate between the two, in all respects, that wherever similarity is engaged in the respective specifications, even were it to be of a very low degree, the consumer will directly confuse the marks.

52. Despite finding that the average consumer will directly confuse the marks and mistake one for the other, I will briefly consider the matter of indirect confusion; where the consumer identifies that the marks are different but attributes their similarities to the marks originating from a single or economically related undertaking. With the registration of a word mark allowing for its presentation in different cases, the difference between the parties' marks is essentially the full stop (or absence thereof) which follows the words 'SMART STEEL'. This element of punctuation contributes so little to the overall impression of the mark and its distinctive character that the average consumer, upon identifying the difference, may believe it to be a natural adaptation or variation. Even then, the consumer may not be able to accurately recall which of the marks had a full stop (and which didn't). This seems the likely outcome wherever the respective goods and services are similar, to any degree. In short, if I am wrong in finding that the consumer will directly confuse the marks, I find that the consumer will at least indirectly confuse the marks.

Conclusion

53. Given that I have found a likelihood of confusion under section 5(2)(b) of the Act on the basis that the respective marks are highly similar, at least wherever similarity has been identified between the respective specifications, it would appear to be of no real benefit to the opponent if I were to go on to assess the merits of its claim to identity in any real detail. Where the opposition has failed, it has failed on the basis that I have found no similarity between the respective goods or services, and the position would therefore be unaltered were I to have approached the comparison on the basis of identical marks under section 5(2)(a). However, if I were to express a brief view on the matter, bearing in mind the case law on identity, I would have been minded to find the respective marks identical (given that the distinguishing punctuation is likely to be so often overlooked).

54. The opposition has succeeded, in part, and, subject to any successful appeal, the relevant application will be refused in respect of:

The first application (UK00003615681):

Presentation of Class 6 goods, in particular ores, base metals and their alloys, in particular steel, made from raw and partially processed base metals or their alloys, in particular steel, manufactured products, namely slabs, plates, strips, sheets, tubes, white sheets and ultra-fine sheets, electrical steel in grain-oriented and non-grain-oriented design; all the aforementioned services not relating to trucks, buses, commercial vehicles and their parts, in particular axles, axle systems and other attachments and accessories for truck trailers, semi-trailers and trucks. (Class 35)

The second application (UK00003615702):

Ores; Base metals and their alloys, in particular steel; products made from crude or partially worked base metals or their alloys, in particular steel, namely, slabs, plates, strips, sheets, tubes, tinplates and fines; Electrical sheets in grain-oriented and non-grain-oriented forms; none of the aforesaid being connecting parts for concrete structures, consoles (of steel); Steel building materials, lifting systems (of steel), reinforcement products (of steel) (Class 6)

Material processing, namely, prefabrication of workpieces, production of profiles, production of slit strips, cutting of sheets, plates or trapeziums, material hardening and surface finishing, in particular by hot-dip galvanizing, hot-dip aluminizing, electrolytic galvanizing or organic coating (Class 40)

Research and consulting services in the field of physics for products made of steel and the production of steel; remediation of contaminated sites, namely design of remediation measures to clean up sites after steel production. (Class 42)

55. The opposition has failed in respect of the following and, subject to any successful appeal, the relevant application will proceed to registration in respect of:

The first application (UK00003615681):

Printed matter stored on data carriers and parts thereof, including information material in the form of printed matter and photographs; downloadable electronic printed matter and

parts thereof, including information material in the form of printed matter and photographs. (Class 9)

Photographs, periodic and non-periodic printed matter, printed matter, information material in the form of printed matter, books, newspapers, magazines, paper, notebooks, brochures, notebooks, address books, calendars, brochures, leaflets, posters, placards, signs and photographs. (Class 16)

Providing commercial information to consumers when choosing products and services; advertising; business management; company administration; clerical services; updating of advertising material; business management and organization consultancy; consultancy regarding public relations communication strategies; consultancy regarding advertising communication strategies; business management consultancy; advisory services for business management; providing business information via a web site; business management consultancy; design of advertising materials; public relations services; billboard advertising; corporate communications services; organization of trade fairs for commercial or advertising purposes; rental of billboards [advertising boards]; distribution of advertising material (leaflets, prospectuses, printed matter, samples); management of customer loyalty programs; economic lobbying; target marketing; all the aforementioned services not relating to trucks, buses, commercial vehicles and their parts, in particular axles, axle systems and other attachments and accessories for truck trailers, semi-trailers and trucks. (Class 35)

Education; training; organization and staging of specialist conferences, congresses, seminars, training courses, workshops [training], webinars; education and training consultancy; correspondence courses; distance learning courses; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of workshops [training]; arranging and conducting of colloquiums; conducting online seminars including specialist product training for customers. Video-recording services; providing television programmes, not downloadable, via video-on-demand services; providing online videos, not downloadable; providing online electronic publications, not downloadable; online publication of electronic books and journals (Class 41)

The second application (UK00003615702):

Waste, sewage and pollutant processing, recycling of waste, sewage, scrap and garbage (Class 40)

Architectural services for products of steel and erection of plants for the production of steel; design and development of computer hardware and software for controlling plants for the production of steel; chemist services for products of steel and the production of steel; technical draftsman services for products made of steel and the construction of facilities for the production of steel; surveying services for products made of steel and the construction of facilities for the production of steel; civil engineering services for products of steel and erection of plants for the production of steel; engineering services for products of steel and plants for the production of steel; remediation of contaminated sites, namely design of remediation measures to clean up sites after steel production; mining engineering services; construction design services for products made of steel and the construction of facilities for the production of steel (Class 42)

Costs

56. Both parties have achieved a measure of success, though a greater degree goes to the applicant, who is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In accordance with that TPN, I award costs as follows, reduced accordingly to reflect a partial success:

Considering the Notices of Opposition and preparing counterstatements:

£200

57. I order Anstar Oy to pay ThyssenKrupp Steel Europe AG the sum of £200. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 4th day of October 2022

**Laura Stephens
For the Registrar**