

O-509-20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3447955
BY PANORAMA ANTENNAS LIMITED
TO REGISTER

SHARKEE

AS A TRADE MARK IN CLASS 9

AND

OPPOSITION THERETO
UNDER NO. 600001366
BY SHAREKEY SWISS AG

Background and pleadings

1. On 29 November 2019, Panorama Antennas Limited (“the applicant”) applied to register the trade mark shown below under number 3447955:

SHARKEE

2. The application was published for opposition purposes on 7 February 2020 for the following goods in Class 9:

Antennas; Coaxial cables

3. SHAREKEY Swiss AG (“the opponent”) filed a notice of opposition under the fast-track opposition procedure on 17 March 2020. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent bases its claim on the following trade mark registration:

Mark:



International registration no. 01357299

International registration date: 20 April 2017

Date protection granted in EU: 4 January 2018

Registered for goods and services in classes 9, 38, 42 and 45

4. It is clear from the filed Form TM7F (notice of opposition in fast-track proceedings) that the opponent relies only on goods in class 9, not on its registered services. However, it was not entirely clear which goods were claimed; this element of ambiguity arises firstly from differences between the precise specification for the goods as worded in the register and the wording given in the Form TM7F. Thus, in response to Q1, which asks the opponent which goods covered by the earlier trade mark are relied on for the opposition, the goods are listed as “*computer programs, recorded; computer*

operating programs, recorded; computer software, recorded; interfaces for computers; timetables (Electronic -); computer programs [downloadable software]; encoded identification bracelets, magnetic; computer software applications, downloadable; encoded key cards; security tokens [encryption devices]". The wording of these goods is slightly different from how they appear in the register as accessible to the UK IPO, which likely arise from small diversions in translation. However, it is clear that the goods listed have very obvious proxies or equivalents in the registered specification, and on that basis, I consider the goods relied to be as follows (reflecting the wording in the register):

Goods relied on:

Class 9 Recorded computer programs; recorded computer operating system programs; software [recorded programs]; interfaces [for computers]; electronic agendas; computer programs [downloadable software]; magnetic identification bracelets; downloadable computer software applications; encoded key cards; safety tokens [encryption devices].

However, the ambiguity secondly arises from the way in which the opponent refers to its goods in its statement of grounds as set out in the continuation sheet to the Form TM7F, which it characterises as "telecommunication devices" and where it lists only the following goods: "*encoded identification bracelets, magnetic; encoded key cards; security tokens [encryption devices]*". To resolve these ambiguities in my task of comparing the respective goods as part of this decision, I shall refer to the full list of goods relied on as I have presented above.

5. The applicant filed a counterstatement denying the grounds of opposition.
6. These fast-track proceedings do not involve the filing of evidence and a decision is made from the papers filed. Only the applicant filed written submission.
7. The applicant is represented by Wilson Gunn and the opponent is represented by Deshoulières Avocats Associés.

DECISION

Section 5(2)(b)

8. The opposition is based upon section 5(2)(b) of the Act, which read 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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its protection process more than five years before the application date of the contested application,

it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

11. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *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 the mark as a whole and does not proceed to analyse its various details;
- (d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

12. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

13. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because

the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

15. 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 (“GC”) stated that ‘complementary’ means:

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

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

17. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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

whilst on the other hand:

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

Class 9 of the contested application

Antennas; Coaxial cables

18. As I explained in the background section at the start of this decision, I consider the goods stated to be relied on to be as follows:

Class 9 Recorded computer programs; recorded computer operating system programs; software [recorded programs]; interfaces [for computers]; electronic agendas; computer programs [downloadable software]; magnetic identification bracelets; downloadable computer software applications; encoded key cards; safety tokens [encryption devices].

However, again as I explained earlier, in its statement of grounds, the opponent has identified only the following terms as similar to the applicant’s goods, which it describes as “telecommunication devices”, namely: “Encoded identification bracelets, magnetic; Encoded key cards; Security tokens [encryption devices]”.

19. The opponent submits:

“In order to install the security telecommunication devices provided by Sharekey, they would necessary have to use all the material elements such as antennas or cables, including coaxial cables.”¹

20. For its part, the applicant submits:

“It is denied that the Applicant’s goods are identical, or even similar to the Opponent’s goods. The Applicant’s goods are hardware antennas which

¹ See page 5.

provide coverage for multiple technologies including GPS, WiFi and LTE and do not operate in the data security or encryption field. On the other hand, the Opponent's goods are software as well as security hardware products."²

21. I shall first compare the applied-for goods with the opponent's "telecommunications devices" on which it focuses, i.e. *magnetic identification bracelets; encoded key cards; safety tokens [encryption devices]*.

22. Broadly speaking, the applicant's goods are antennas and cables used for transmission of signals. According to *Collins English Dictionary* an antenna is a device that sends and receives television or radio signals, and coaxial cable is a cable consisting of an inner insulated core of stranded or solid wire surrounded by an outer insulated flexible wire braid, used especially as a transmission line for radio-frequency signals.³ I find those definitions accord with the average consumer's approximate understanding of the terms. As I understand it the opponent's goods "*magnetic identification bracelets; encoded key cards; safety tokens [encryption devices]*" are security hardware used particularly for authentication purposes. Their purpose and method of use are different and although they are all in very broad terms electronic components, they are also different in the specifics of their natures. The users may overlap on a high level of generality. The goods do not compete.

23. While I note the applicant's contention that its goods provide coverage for multiple technologies such as WiFi, I also bear in mind the opponent's submissions that applicant's goods are necessary to install the opponent's goods. Although there is no evidence filed in these proceedings, I accept that since the opponent's goods are used to authenticate the identity electronically, the applicant's goods may be important at the installation stage of the opponent's goods, to gain access to or link to a computer network/database. However, the opponent's devices have very specific fields of application and are likely to be manufactured by companies specialised in security hardware. I do not think that the degree of complementarity between the competing goods are sufficiently pronounced for it to be accepted that from the customer's point

² See counter statement para 13.

³ <https://www.collinsdictionary.com/dictionary/english/antenna> - accessed 13 October 2020.

of view, electrical accessories such as coaxial cables or antennas and security hardware come from the same undertaking – they are not in my view complementary in the case law sense. Considering all these factors, I find that the competing goods are dissimilar. However, if I am wrong in this finding, then the goods are similar only to a low degree.

24. Turning to the opponent's remaining goods: *recorded computer programs; recorded computer operating system programs; software [recorded programs]; interfaces [for computers]; electronic agendas; computer programs [downloadable software]; downloadable computer software applications*. I do not consider these goods similar to the applicant's antennas and coaxial cables. The nature, purpose and method of use of the competing goods are different. Their channels of trade are not obviously shared. They are neither complementary nor in competition. The users may overlap. However, that factor alone is not determinative of a finding of similarity. Considering these factors, I find that the competing goods are dissimilar. Since some similarity of goods is an essential requirement to succeed in a claim under section 5(2)(b), these goods play no further part in my analysis below.⁴

The average consumer and the nature of the purchasing act

25. As the case law above indicates, I must determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. I have concluded that if there is a similarity between the opponent's encoded identification bracelets, magnetic; encoded key cards and security tokens [encryption devices], it is, at best, similar to the applicant's goods only to a low degree.

26. 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:

⁴ See for example *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).

“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”.

27. The applicant submits:

“In this case, the average consumer is both professional and non-professional. However, as the products in question are not everyday consumer goods but somewhat sophisticated technological products which serve a very specific purpose, consumers will pay a higher level of attention to ensure for example that the antenna or coaxial cable of the Applicant are correct and will fit the goods they will be connected to. Similarly, with the Opponent’s goods, consumers will pay a relatively high level of attention to ensure they get the correct product. This high level of attention will be transferred to the trade marks under which these goods are sold, thus reducing the likelihood of confusion.”⁵

28. Given that the opponent’s goods are specialised products, for example, used to ensure restricted access to premises or computer networks, the average consumer is more likely to be business users. The average consumer of the applicant’s goods includes both the general public and business users. The goods at issue will be selected primarily by visual means, after research conducted on websites, from brochures, catalogues, or through an official procurement process. There may also be an aural aspect to the purchase if advice is sought from sales representatives or other businesses. The professional user of the goods at issue is likely to pay attention to details such as the business needs, the technological interface, the functionalities, or costs which, in my view, are likely to be important business decisions. Therefore, the level of attention paid will be fairly high by professional users. The general public when purchasing the applicant’s goods are likely to pay some attention to factors such as

⁵ See the applicant’s written submissions dated 10 August 2020

compatibility or costs. However, I do not consider that these factors will result in an especially high level of attention. The general public is likely to pay a medium degree of attention to the purchase of the applicant's goods.

Distinctiveness of the earlier mark

29. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

30. As the opponent filed no evidence, I have only the inherent position to consider. The earlier mark contains the word “Sharekey”. I agree with the applicant that the average consumer is likely to recognise the words “share” and “key” in the mark and

construe it as a key that is shared.⁶ In relation to the opponent's goods namely, magnetic identification bracelets, encoded key cards and security tokens [encryption devices], the term is allusive of an authentication method in which a pre-shared key allows the hardware devices to access a computer network or restricted premises. The stylised representation of the letter "S" is the first letter of the word "Sharekey" and adds little to the distinctive character of the mark.

31. Considering these factors, I conclude that, as a whole, the earlier mark has a low degree of distinctive character in relation to magnetic identification bracelets; encoded key cards; safety tokens [encryption devices].

Comparison of marks

32. 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

33. The CJEU stated in 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.”

34. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

⁶ See the counterstatement para 10.

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

35. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	SHARKEE

36. The opponent's mark consists of the word "Sharekey" presented in an unremarkable font in white. A stylised letter S which perhaps represents the first letter of the word "Sharekey" is placed on the left of the word. The top curve of the letter S is presented in blue and the bottom curve in green. The colours are presented in a fading pattern. The word "Sharekey" and the stylised S are presented on a blue rectangular background. Although the stylised S with its colour pattern and the background on which it appears will not be ignored, it is the word "Sharekey" that dominates the overall impression of the mark.

37. The applicant's word mark is simply "SHARKEE". The overall impression and the distinctiveness of the mark lie in this word.

38. Visually, the marks are comprised of 8 and 7 letters, respectively. All of the letters in the applicant's mark are contained in the opponent's mark. The marks share the first three letters S-H-A-R in the same order. The letter E is presented twice; at the second to last and last positions in the applicant's mark and at the second to last and fourth to last positions in the opponent's mark. "K" is presented in both marks in the third last positions. The opponent mark ends with the letter "Y" which does not have a counterpart in the applicant's mark. The stylised representation of the letter S is also absent from the applicant's mark. Although the opponent's mark is presented in a blue background, the notional and fair use would entitle the opponent to use the mark in any background colour. Therefore, this difference is insignificant in my comparison. Similarly, the presentational differences in the typeface is also not relevant because

the notional and fair used would allow the applicant to use its mark in any font type/typeface. Considering these factors, in my view, the marks are visually similar to a reasonably high degree.

39. In an aural comparison, the opponent submits:

“At the phonetic level, the two signs “Sharekey” and “SHARKEE” are pronounced in almost the same way in English. The fact that the two syllables are written differently has only a very small incidence as the syllables are hugely identifiable and have a strong phonetic identity.”⁷

40. For its part, the applicant submits:

Phonetically, the trade marks in question are not confusingly similar. Although there are some letters in common, the letters that do differ result in a noticeable difference in pronunciation. There are two syllables in both trade marks however, the first syllable will be pronounced differently. The first syllable of the Opponent’s would be pronounced as S-H-E-H, whereas the Applicant’s trade mark would be pronounced as S-H-A-H. These differences in pronunciation have an impact on how the whole word will be pronounced, particularly because they are at the beginning of the trade marks.”⁸

41. The only component likely to be pronounced in the opponent’s mark is the two-syllable word “sharekey”. Given that the opponent’s mark is formed by conjoining two known words, the average consumer, when articulating the mark would naturally take a pause between the words and pronounce it as “share key”. The applicant’s mark can be pronounced in more than one way. It could be pronounced as “SHAAR-KEE”; “SHAAR” as in the word “shar-p” and the ending “KEE” will be pronounced like the word “KEY”. Equally, some average consumers may pronounce the mark as “SHAARK-EE” (sounding like “sharky”). Although both marks begin with a “sh” sound, in neither of the pronunciations identified above, will the first part of the opponent’s

⁷ See statement of grounds

⁸ See the applicant’s written submissions dated 10 August 2020 para 13.

mark be pronounced as “share”. In my view, the marks are aurally similar to a medium where the opponent’s mark is pronounced as “SHAAR-KEE” and aurally similar to a fairly low degree where the mark is pronounced as “SHAARK-EE”.

42. On conceptual similarity, the opponent argues:

“At the conceptual level, the two signs evoke strictly the same thing, namely the notion of sharing, “Share”, of different keys, “key”. The orthograph of the syllables has no incidence here on the meaning of the final word. “Sharekey” and “Sharkee” having the exact same meaning.”⁹

43. The applicant submits:

“The opponent’s mark SHAREKEY is made up of two words, ‘share’ and ‘key’. These two words invoke the idea of a key that can be shared, or a universal key. This is reinforced by the fact that the some of the opponent’s goods are electronic keycards, security tokens and encoded ID bracelets, which essentially function as keys. This is not the case for the Applicant’s mark, as its mark is a made-up word which will be construed by consumers as a playful modification of the word SHARK. This is reinforced by the fact that the Applicant’s product is in the shape of a shark fin.”¹⁰

44. From a conceptual perspective, the average consumer will see the opponent’s mark as comprising of the words share and key and is likely to construe it to mean “a key that is shared”. The applicant’s mark is likely to be seen as an invented word with no meaning. It seems to me that there may be some average consumers who due to the aural identity, may approximate “KEE” to the word “KEY”. However, the concept introduced by the opponent’s mark is that of a key that is shared; this, in my view, creates a conceptual difference between the marks. There may also be another group of average consumers who are likely to recognise the word “shark” in the mark and think that it is a made-up word created from the word “shark” or approximate it to

⁹ See statement of grounds page 3.

¹⁰ See counter statement para 10.

“sharky”, a word used informally to refer to the characteristics of a shark. In any event, the applicant’s mark does not evoke a concept of “share”. Considering these factors, I find that the marks are conceptually dissimilar.

Likelihood of confusion

45. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

46. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

47. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

49. In my view, the stylised letter S with its complex colour pattern is prominent to avoid direct confusion. The leaves only the indirect confusion to be considered.

50. Earlier in the decision, I concluded that:

- The respective marks are visually similar to a reasonably high degree, aurally similar to a medium or fairly low degree depending on how the mark is articulated and conceptually dissimilar;
- The goods will be selected primarily by visual means. The opponent’s goods will be selected with a fairly high degree of attention by business users while the applicant’s goods will be selected with a fairly high degree of attention by business users and a medium degree by the general public;
- The goods are, at best, similar to a low degree;
- The earlier mark is distinctive to a low degree in respect of the goods where any similarity exists.

51. Although the marks are visually similar to a reasonably high degree and aurally similar to a medium degree, the low degree of distinctive character of the opponent’s mark and the distance between the goods is such that I do not find there to be a likelihood of indirect confusion. Even taking into account the effects of imperfect recollection, I am of the view that the average consumer when faced with the competing goods which are similar only to a low degree is likely to put the similarities between the marks down to co-incidence as opposed to economic connection. There is no likelihood of confusion.

Conclusion

52. The opposition has failed, and the application will proceed to registration.

Costs

53. The applicant has been successful and is entitled to an award of costs. Awards of costs in fast-track proceedings are governed by Tribunal Practice Notice (“TPN”) 2/2015. I award costs to the applicant on the following basis:

Considering the other side’s statement and preparing a counter statement:	£200
Filing written submissions:	£200
Total:	£400

54. I order SHAREKEY Swiss AG to pay Panorama Antennas Limited the sum of £400. 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 14th day of October 2020

Karol Thomas
For the Registrar