

O-323-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2481367 AND 2481368
BY
MIMOMAX WIRELESS LIMITED
TO REGISTER THE TRADE MARKS**

MIMOMAX

AND

mimo^(®)max

IN CLASS 09

AND

**THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS 97931 AND 97932
BY
SEQUANS COMMUNICATIONS SA**

Trade Marks Act 1994

**In the matter of application nos 2481367 and 2481368
by Mimomax Wireless Limited
to register the trade marks:**

MIMOMAX

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**in class 9
and the consolidated oppositions thereto
under nos 97931 and 97932
by Sequans Communications SA**

1. On 3 March 2008, Mimomax Wireless Limited (which I will refer to as MW) applied to register the above trade marks. Following examination, both applications proceeded to publication in the *Trade Marks Journal* on 20 June 2008 with the following specification:

Electronic transmitter and receiver equipment for providing voice and data communications.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. On 19 September 2008, Sequans Communications SA (which I will refer to as SC) filed notices of opposition to both trade mark applications. The oppositions are directed at the complete list of goods. SC claims that registration of 2481367 would be contrary to section 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act) and that registration of 2481368 would be contrary to section 5(2)(b) of the Act.

3. The oppositions are based upon United Kingdom trade mark registration no 2470413. This registration is for the trade mark MIMOMAX. It is registered in classes 9 and 42 for the following goods and services:

Class 9: Semiconductor devices including transistors; diodes; microprocessors; integrated circuits; personal computer chip sets, namely, a collection of integrated circuits; sub-systems and components being hardware used by computers in relation to wired and wireless broadband networks; motherboards, namely, the main printed circuit board in an electronic device; daughterboards, namely, a printed circuit board that connects to the main printed

circuit board; software; computer software for the design, manufacture or exploitation of integrated circuits; computer software for the recording, processing, reception, reproduction, transmission, modification, compression, decompression, broadcast of sound, images and data.

Class 42: *Technology consulting and engineering services in the fields of computer hardware and software, design and testing of electronic components, data processing, systems and telecommunications networks of all types and in particular of wireline, wireless and/or optical types; technical support in the fields related to computer hardware and software.*

4. The applications for registration were made on 3 March 2008; SC's mark was applied for on 24 October 2007 and its registration procedure was completed on 4 July 2008. SC's trade mark is therefore an earlier trade mark which is not subject to proof of use¹. SC claims that the respective trade marks are either identical or similar and that the respective goods are identical or similar.

5. MW filed counterstatements. In relation to its application 2481367, it denies the grounds of opposition under sections 5(1) and 5(2)(a) of the Act because it states that the goods covered by its application are not identical or similar to those of the earlier mark. In relation to its application 2481368, it denies the grounds of opposition under section 5(2)(b) of the Act because it states that the marks are not similar and the goods are not identical or similar.

6. The proceedings were consolidated early in the evidence rounds. Neither side filed evidence, but both filed written submissions. A hearing was also held on 9 October 2009. The parties were represented by their respective professional representatives in this matter; Ms Clare Turnbull of Brookes Batchellor LLP for SC and Mr Huw Evans of Chapman Molony for MW. I will refer to the submissions (written and oral) where appropriate in this decision.

Decision

7. Sections 5(1) and 5(2) of the Act state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

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

(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.”

8. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

Comparison of goods

9. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose², their method of use and whether they are in competition with each other or are complementary³. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed⁴.

² The earlier incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected.

³ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

⁴ He considered that the following should be taken into account when assessing the similarity of goods and/or 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;

12. At the hearing, Ms Turnbull explained that although the TM7 had indicated a reliance on all the goods and services of SC's earlier mark, it in fact only relied upon all the goods. Consequently, I need only make a comparison between the goods contained in Class 9 of the earlier mark's specification and those of the applications.

13. For ease of reference, the goods are:

| SC's specification | MW's specifications |
|--|--|
| <p><i>Semiconductor devices including transistors; diodes; microprocessors; integrated circuits; personal computer chip sets, namely, a collection of integrated circuits; sub-systems and components being hardware used by computers in relation to wired and wireless broadband networks; motherboards, namely, the main printed circuit board in an electronic device; daughterboards, namely, a printed circuit board that connects to the main printed circuit board; software; computer software for the design, manufacture or exploitation of integrated circuits; computer software for the recording, processing, reception, reproduction, transmission, modification, compression, decompression, broadcast of sound, images and data.</i></p> | <p><i>Electronic transmitter and receiver equipment for providing voice and data communications.</i></p> |

14. Ms Turnbull submitted at the hearing that 'sub-systems and components being hardware used by computers in relation to wired and wireless broadband networks' could be described as electronic transmitter and receiver equipment for providing voice and data communications, for example, modems and soundcards. These could be contained within a computer or outside of a computer. For his part, Mr Evans submitted that the word 'equipment' in the applications indicated a stand-alone item, not a component. He submitted that the goods of the applications would need an integrated microphone to enable reception and transmission of voice data and that this separated the goods of the

(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."

applications from those of the earlier mark. Mr Evans referred me to *Raleigh International Trade Mark* BL O/253/00, a decision of Mr Geoffrey Hobbs QC, sitting as the appointed person where he said “Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks.” This was in the context of paragraph 22 of *Canon*, to which Mr Hobbs had already referred:

“It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

Mr Evans’ position was that there was no similarity of goods which could be compensated for by identity or any similarity⁵ between the marks. He submitted that the goods of the applications are physical stand-alone apparatus such as telephones, radio receivers and radio transmitters; further that the goods are specialist hardware devices for transmitting and receiving data signals, used by communications engineers to establish communications links between spatially separate locations.

15. I envisage from this submission that Mr Evans is confining his interpretation of MW’s goods to, for example, such apparatus as radio masts and satellite phones. However, there is nothing in the way of a positive limitation to the specification to indicate specific goods of the kind Mr Evans describes. ‘Electronic transmitter and receiver equipment for providing voice and data communications’ could cover modems and routers. Modems are found inside and outside of computers, digital television ‘boxes’ and in mobile phones. Such goods would appear to be identical to SC’s ‘sub-systems and components being hardware used by computers in relation to wired and wireless broadband networks’ and similar to ‘computer software for the reception and transmission of sound, images and data’, the computer software being necessary for the functioning of the modems and routers. The uses would be the same because the nature of both wired and wireless broadband networks is that they require the transmission and reception of data to function. I do not accept that there is no similarity because Mr Evans submits that voice communication requires a

⁵ More recently, the ECJ has said in *Waterford Wedgwood plc v OHIM* Case C-398/07 “34 However, the interdependence of those different factors does not mean that the complete lack of similarity can be fully offset by the strong distinctive character of the earlier trade mark. For the purposes of applying Article 8(1)(b) of Regulation No 40/94, even where one trade mark is identical to another with a particularly high distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 8(5) of Regulation No 40/94, which expressly refers to the situation in which the goods or services are not similar, Article 8(1)(b) of Regulation No 40/94 provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar (see, by way of analogy, *Canon*, paragraph 22).”

microphone and computers do not contain microphones; a computer or modem does not need a microphone to receive voice communication and will use amplification to provide the voice communication. Mr Evans accepted that the users could be engineers for both SC and MW's marks but submitted that the channels of trade would be very different. Given that both SC's mark and MW's marks could cover modems and routers (whether inside or outside of a computer) which can be bought in high street computer retail shops, the channels of trade could converge.

16. This is a technical area which would have benefited from evidence from the parties as to what the various terms in their specification encompass. There are parts of SC's specification which share no similarity with the goods of the applications. However, in relation to 'sub-systems and components being hardware used by computers in relation to wired and wireless broadband networks' in SC's mark, I consider all the goods of the application to be highly similar, if not identical; in relation to 'computer software for the reception and transmission of sound, images and data' in SC's mark, I consider there to be a high level of similarity with all the goods of the application.

Average consumer and purchasing process

17. SC's mark had not been registered at the time the applications were published for opposition purposes and so it is not subject to proof of use. That being the case, I must consider the relevant public across the entire range of the goods and services. The matter must be judged through the eyes of the average consumer for the goods or services in question (*Sabel*), so I have to assess the nature of the average consumer and how they are most likely to encounter and/or purchase the goods and services. MW submits that the relevant public for the earlier mark and the applications comprises engineers in various complex technical fields who have a high level of formal education and technical expertise and who are particularly intelligent, circumspect and well informed. These are undoubtedly goods of a technical nature. If the purchase is being made by an engineer, such a purchase will be made with a good deal of knowledge and circumspection, mitigating the effects of imperfect recollection. If the purchase of a router or modem is being made for domestic purposes from a retail establishment by the owner of a personal computer or laptop, the level of expertise may be less, but the level of attention will still be high. Such goods are not everyday purchases. They will be bought after careful study of product information, whether in literature or on the packaging. The purchasing process will be primarily visual, although the goods may be referred to aurally when making a recommendation, e.g. in a procurement meeting.


Comparison of trade marks

18. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I

have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

19. MIMOMAX and MIMOMAX are obviously identical; there is no modification or addition in the application to constitute a difference between the application and the earlier mark⁶.

20. In relation to application 2481368, the opponent has objected to registration under section 5(2)(b) of the Act. This means that the opponent does not contend that the marks are identical, in contrast to 2481367 where the ground raised is 5(1) or 5(2)(a)). The comparison is to be made between:

| SC's mark | MW's mark |
|-----------|--|
| MIMOMAX |  |

MW submits that its mark is a device mark, which is a reference to the way in which the 'i' is represented. MW calls this representation a transmitter beacon and submits that the stylization clearly and unequivocally differentiates the marks when considered as wholes.

21. There is no single dominant element in SC's mark. In the application, there is a split in the application between the positioning of the 'MIMO' and 'MAX' elements. Max has a recognisable meaning of greatest or most (or even a male forename). The MIMO element is bolder and much larger than the MAX element and represents the dominant element of the mark. The dot of the 'i' is surrounded by double brackets. In the context of the goods, this could strike the average consumer as referring to the emission of a signal of some description. However, it is a very small part of the overall mark, to the point of being negligible. Despite the split between MIMO and MAX, and the emphasis or

⁶ In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the European Court of Justice stated: "54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

dominance of the MIMO element, the marks retain a strong visual similarity and they are identical aurally. MW submits that the application is conceptually different to SC's mark. The combination of MIMO and MAX creates an invented word (I will say more about this later); invented words have a high inherent distinctive character, but no concept of their own. There is neither conceptual dissonance nor conceptual similarity, beyond the fact that both marks consist of the same invented word. The MAX element indicates some element of quantity or magnitude, but since MIMO is unknown, there is no overall concept. Comparing the marks as wholes, the strength of similarity on both the visual and aural levels leads me to conclude that there is a high degree of similarity between the marks.

Distinctive character of the earlier mark

22. SC did not file any evidence of use of their mark which could have assisted in demonstrating an enhanced distinctive character, and so I can only take into account the inherent distinctive character of the mark.

Conclusion in relation to likelihood of confusion

23. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion⁷. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public⁸. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings⁹. SC's mark is an invented word with a distinctive character at the higher end of the scale. The marks are identical or highly similar and the goods are identical or highly similar. Bearing in mind the interdependency principle, whereby a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa, the position here is of identity or a strong degree of similarity between the marks and the goods.

24. MW submits that it has been selling the goods applied for under the marks applied for since September 2007 and that it has not been aware that any confusion has existed in the market-place. Absence of confusion has been the

⁷ *Sabel BV v Puma AG* [1998] RPC 199.

⁸ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

⁹ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

subject of judicial comment and a registry tribunal practice notice, TPN 4/2009¹⁰; it seldom has an effect on the outcome of a case brought under section 5(2)(b) of the Act. There is no evidence from MW to show that consumers have encountered both marks and been able to differentiate between them.

25. Ms Turnbull submitted that it was in SC's favour that, during examination of the applications, the examiner had notified SC of the publication details of the applications¹¹. Whether a notification was or was not made at *ex officio* stage has no bearing upon the assessment I must make, which must be done afresh. Ms Turnbull also considered it relevant that the preliminary indication went in SC's favour. Far from being a relevant factor, it would be remiss of me to give any consideration to the preliminary indication, as per the comments of Lindsay J in *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch).

10 "7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held: "22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

8. (In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented: "99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...")

9. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated: "Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

¹¹ See *The Trade Marks (Relative Grounds) Order 2007* S.I. 2007 No. 1976, "4. The registrar may, in connection with an examination under section 37(1) of the Trade Marks Act 1994, carry out a search of earlier trade marks for the purpose of notifying the applicant and other persons about the existence of earlier trade marks that might be relevant to the proposed registration."

26. Mr Evans sought to introduce at the hearing an argument as to the MIMO element of the marks having a technical meaning. This is an evidential point; no evidence has been filed in the proceedings. Mr Evans did not seek leave to file late evidence; consequently, whether MIMO has a meaning which affects my assessment of the marks' distinctive character cannot be entertained. However, even if there was substance to the point, I bear in mind what was said by the Court of First Instance of the European Communities in *Air Products and Chemicals, Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Joined Cases T – 305/06 to T 307/06:

“59 With regard to the weak distinctiveness of the common components and of the earlier marks as a whole, it should be recalled that the finding of a weak distinctive character for the earlier trade mark does not preclude a finding that there is a likelihood of confusion. While the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, *Canon*, paragraph 24), it is only one of a number of elements entering into that assessment. Even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Case T-134/06 *Xentral v OHIM – Pages jaunes (PAGESJAUNES.COM)* [2007] ECR II-5213, paragraph 70; see, to that effect, Case T-112/03 *L'Oréal v OHIM – Revlon (FLEXI AIR)* [2005] ECR II-949, paragraph 61).

60 In addition, the argument of OHIM and of the applicant in that regard would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that, where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question (order of the Court of 27 April 2006 in Case C-235/05 P *L'Oréal v OHIM*, not published in the ECR, paragraph 45). Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 (judgment of 15 March 2007 in Case C-171/06 P *T.I.M.E. ART v Devinlec and OHIM*, not published in the ECR, paragraph 41, and *PAGESJAUNES.COM*, paragraph 71).”

27. In relation to 2481367, I have found identity of marks and identity or a high degree of similarity between the goods. The opposition under the section 5(1) ground succeeds. In case I am wrong in assessing the goods as identical, they are nevertheless highly similar and so the opposition would succeed under the section 5(2)(a) ground because there would be a likelihood of confusion.

28. I have found that SC's mark is highly similar to MW's 23481368 application. I have also found that the average, relevant consumer will pay a high degree of attention to the selection of the goods. A specialist consumer's circumspection does not automatically obviate confusion, as the CFI said in *Honda Motor Europe Ltd v OHIM* Case T- 363/06:

"61 The Court considers that the applicant, in putting forward those four factors, appears to be claiming that the relevant public's degree of attention is high, whether that public is professional or not, such that any confusion between the two conflicting marks would be avoided. In that regard, the Board of Appeal's assessment at paragraph 35 of the contested decision must be upheld, namely, that the likelihood of confusion between the two conflicting marks is in no way undermined by the fact that the public is mostly composed of specialists. As the Board of Appeal states, the trade in components and spare parts for motor vehicles is not restricted to authorised car dealers of one brand only, with the result that it cannot be ruled out that a Spanish car dealer or mechanic stocking up on components or spare parts from different manufacturers will assume that the goods marketed under the trade mark applied for come from Seat or from a manufacturer economically linked to Seat.

"62 Furthermore, although the relevant consumer's high degree of attention may, admittedly, lead him to be aware of the technical characteristics of car seats in order that he may ensure their compatibility with the relevant car model, it should be borne in mind that, taking into account the identity of the goods concerned, the similarity of the conflicting marks and the high distinctive character of the earlier trade mark, the fact that the relevant public may consist of professionals is not sufficient to rule out the possibility that they may believe that the goods come from the same undertaking or, as the case may be, from economically-linked undertakings (see, to that effect, *ALADIN*, paragraph 100). While the relevant public's high degree of attention implies that it will be well informed about vehicle seats and may thus avoid making mistakes regarding the compatibility of those seats with the relevant car model, it cannot prevent that public from believing that the seats bearing the MAGIC SEAT trade mark are part of a new range of products developed by the well-known Spanish car manufacturer Seat."

29. The marks are highly similar visually and aurally. Bearing in mind this together with the proximity of the goods and the nature of the purchasing process, I consider that the average relevant consumer for the goods will believe that MW's mark is an alternative form of the word-only mark, such as might be encountered within product description text. The opposition succeeds under section 5(2)(b).

Costs

30. SC has been successful and is entitled to a contribution towards its costs. Mr Evans did not have any comments to make regarding costs, but Ms Turnbull referred to the examination notification, and lack of withdrawal after notification of the impending opposition and the preliminary indication as being factors to take into account in a cost award. I see no reason to depart from the published scale. Costs are awarded on the following basis:

| | |
|---|-------|
| Opposition fee x2: | £400 |
| Preparing a statement and considering the other side's statement x2 | £600 |
| Written submissions | £200 |
| Preparation and attendance at the hearing | £300 |
| Total: | £1500 |

49) I order Mimomax Wireless Limited to pay Sequans Communications SA the sum of £1500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of October 2009

**Judi Pike
For the Registrar,
the Comptroller-General**