

O-316-17

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO 501167
BY SHENZHEN MAIBO ELECTRONICS CORPORATION
TO DECLARE INVALID REGISTRATION NO 3123172
IN THE NAME OF MICROLAB PROBIT LIMITED

Background

1. The trade mark **microlab** is registered under no 3123172 and stands in the name of Microlab Probit Limited (“the registered proprietor”). It was applied for on 19 August 2015 and was entered in the register on 19 February 2016 for goods in Class 9. I shall return to these later.

2. On 24 March 2016 Shenzhen Maibo Electronics Corporation (“the applicant”) applied to declare the registration invalid. It did so under the provisions of section 47(2) of the Trade Marks Act 1994 (“the Act”) based on an objection under section 5(2)(b) of the Act. In support of its objection it relies on the following trade mark:

Mark	Dates	Goods and services
EUTM 11455185 	Filing date: 27 December 2012 Date of entry in register: 18 April 2013	Registered for goods and services in classes 9 and 35.

3. The registered proprietor filed a counterstatement in which it denies that either the respective marks or respective goods and services are similar and denies there is any likelihood of confusion.

4. Neither party filed evidence nor did they file written submissions in lieu of evidence. Neither requested to be heard nor filed written submissions in lieu of a hearing.

Decision

5. Section 47 of the Act states:

“47. – (1)...

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

6. The mark relied on by the applicant is an earlier mark within the meaning of the Act but it is not subject to any requirement that proof of its use be shown as it had not been on the register for the requisite five year period. The applicant is therefore entitled to rely on it for each of the goods and services for which it is registered.

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

“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”.

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of the respective goods and services

9. The competing goods and services are as follows:

Applicant	Registered proprietor
<p>Class 9 Computer peripheral devices; Cabinets for loudspeakers; Diaphragms [acoustics]; Receivers (Audio-- and video--); Television apparatus; Horns for loudspeakers; Portable media players; Headphones; Acoustic couplers; Microphones.</p> <p>Class 35 Outdoor advertising; Advertising; Publicity; Business management consultancy; Business investigations; Organization of exhibitions for commercial or advertising purposes; Procurement services for others [purchasing goods and services for other businesses]; Personnel management consultancy; Import-export agencies; Sales promotion for others.</p>	<p>Class 9 Handheld computers; Personal computers; Arm rests for use with computers; Backup drives for computers; Car navigation computers; Dust covers for computers; Handheld personal computers; Internal cooling fans for computers; Wearable computers; Add-in cards for micro computers; Add-on-cards for computers; Cabinets adapted to hold computers; Cases adapted for computers; Compact disc players for use with computers; Components for computers; Covers (shaped-) for computers; Mainframes [computers]; On-board computers; Personal home computers; Process computers; Programs for computers; Trip computers; Underwater dive computers; Work stations [computers]; Cash registers, calculating machines, data processing equipment, computers; Cartridges for toner [empty] for use with computers; Notebook computers; Disk drives for computers; Drives (Disk -) for computers; Printers for use with computers; Computers (Printers for use with -); Magnetic tape units for computers; Tape units (Magnetic -) for computers; Juke boxes for computers;</p>

	<p>Interfaces for computers; Navigation apparatus for vehicles [on-board computers]; Vehicles (Navigation apparatus for -) [on-board computers]; Wrist rests for use with computers; Computers; Laptop computers; Tablet computers; Desktop computers; Communications computers; Computer programs for connecting remotely to computers or computer networks; Computer programs for searching the contents of computers and computer networks by remote control; Computers for use in data management; Electronic components for computers; Electronic computers; Software for tablet computers; Thin client computers; Joysticks for use with computers, other than for video games; Audio speakers; Speakers; Audio speakers for home; Car speakers; Speakers [audio equipment]; Pairable wireless speakers; Digital tablets; Electronic tablets; Graphics tablets; Keyboards for tablets; Audio speakers; Speakers; Audio speakers for home; Car speakers; Speakers [audio equipment]; Pairable wireless speakers; Digital tablets; Electronic tablets; Graphics tablets; Keyboards for tablets; Tv cameras; Tv monitors; Relays for radio and TV stations; Lcd panels; LCD [liquid crystal display]; Liquid crystal display (LCD) televisions; LCD large-screen displays; LCD monitors; LCD projectors; Bags adapted for laptops; Camera cases; Camera hoods; Camera filters; Camera flashes; Camera lenses; Camera stands; Camera straps; Television camera tubes; Camera tripods; Exposed camera film; Camera closures; Camera containing a linear image sensor; Communications servers [computer hardware]; Computer memory hardware; LAN [local operating network] hardware; VPN [virtual private network] hardware; WAN [wide area network] hardware; Computer hardware; Data</p>
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	<p>communications hardware; Hardware (computer-);Monitors [computer hardware];Microchips [computer hardware];Virtual reality game software; Application software; Computer game software; Computer software platforms; Games software; Interface software; Video game software; Video games software; VPN [virtual private network] operating software; WAN [wide area network] operating software; Software; Recorded computer software; Computer games programs downloaded via the internet [software];Computer games programs [software];Computer games software; Computer software programs; Computer software [programmes];Data communications software; Data processing software; Pre-recorded software; Software drivers; Computer software; Computer software, recorded; Software (Computer -), recorded; Computer programs [downloadable software];Programs (Computer -) [downloadable software];Computer software applications, downloadable; Downloadable application software; Computer application software; Software for processing images, graphics and text; Software for the operational management of portable magnetic and electronic cards; Computer application software for mobile telephones; Digital telephone platforms and software; Downloadable computer game software via a global computer network and wireless devices; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones; Computer operating software; Computer screen saver software; Computer software for controlling self-service terminals; Computer software for controlling the operation of audio and video devices; Computer software for creating and editing music and sounds;</p>
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	<p>Computer software for organizing and viewing digital images and photographs; Computer software for processing digital images;</p> <p>Computer software for processing digital music files; Computer software for use in processing semiconductor wafers; Computer software for wireless content delivery; Computer software to enable the transmission of photographs to mobile telephones; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Computer software to maintain and operate computer system; Gesture recognition software; Application software for cloud computing services; Application software for wireless devices; Application software for mobile phones; Community software; Computer antivirus software; Computer software for advertising; Software for tablet computers; Software development kit [SDK]; Application software for social networking; Application software for social networking services via internet; Electronic cables; Electronic card readers; Electronic circuit board; Electronic circuit cards; Electronic coding units; Electronic indicator boards; Electronic indicator panels; Electronic integrated circuits; Electronic payment terminal; Electronic semi-conductors; Electronic speed controllers; Electronic warning bells; Carrying cases for portable electronic devices; Downloadable electronic publications; Electronic buzzers; Electronic cash registers; Electronic circuit boards; Electronic currency converters; Electronic databases; Electronic decoders; Electronic encryption units; Electronic global positioning systems; Electronic lottery apparatus; Electronic pest control equipment; Electronic publications recorded on computer media; Electronic sound pickup for guitars and</p>
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	basses; Electronic touch sensitive switches; Electronic transformers; Encoded electronic chip cards; Instruction manuals in electronic format; Printed electronic circuits; Publications in electronic format; Pocket translators, electronic; Audio electronic apparatus; Card operated electronic locks; Circuits [electric or electronic]; Circulators [electric or electronic components]; Computer documentation in electronic form; Directories [electric or electronic]; Electronic amplifiers; Electronic balances; Electronic blackboards; Electronic bulletin board apparatus; Electronic carbon dioxide monitors [other than for medical purposes]; Electronic carbon dioxide recorders [other than for medical purposes]; Electronic coding apparatus; Electronic colour analyzers; Electronic communication installations; Electronic components; Electronic control apparatus; Electronic control circuits; Electronic control systems; Electronic control units; Electronic controllers; Electronic copy boards; Electronic cruise control apparatus.
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10. I note in passing that a number of terms appear twice in the registered proprietor's specification e.g. *audio speakers*.

11. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

12. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

13. 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."

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

15. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

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

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

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

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

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

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

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.”

19. In *Separode Trade Mark* BL O-399-10 (AP) the Appointed Person stated:

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

20. Other than ticking a box on the appropriate form to indicate that it claims each of the registered proprietor's goods to be identical or similar to those goods and services covered by the earlier mark, the applicant has provided no indication of which goods and services it considers to be identical and which similar or why. It was asked to provide such information but declined to do so, indicating it relied on the "settled principles deriving from the Court of Justice". This is a wholly unhelpful and inadequate response given the breadth of the respective specifications. In its counterstatement, the registered proprietor denies the respective goods and services are similar but makes no further submissions. This is not surprising given the lack of specificity in the applicant's claims.

21. Absent any submissions or evidence to assist me, and taking the guidance set out in the case law above into account, I can see no way in which any of the applicant's services in class 35 are similar to any of the registered proprietor's goods as registered. That leaves the respective goods in class 9 to be compared.

22. The registered proprietor's *Handheld computers; Personal computers; Car navigation computers; Handheld personal computers; Wearable computers; Mainframes [computers]; On-board computers; Personal home computers; Process computers; Trip computers; Underwater dive computers; Work stations [computers]; data processing equipment, computers; Notebook computers; Navigation apparatus for vehicles [on-board computers]; Vehicles (Navigation apparatus for -) [on-board computers]; Computers; Laptop computers; Tablet computers; Desktop computers; Communications computers; Computers for use in data management; Electronic computers; Thin client computers; Digital tablets; Electronic tablets; Graphics tablets;* are each computers. *Electronic communication installations;* will include computers. *Computer peripheral devices* as are included within the applicant's specification are devices that, in my experience, do not reside within a computer but are designed to work with or connect to them to provide either access to additional capabilities or access to external services. They include input, output or storage devices. The respective goods may be made by the same undertakings, be distributed through the same trade channels, are similar in nature and used by the same end users. I consider them to be highly similar goods.

23. *Communications servers [computer hardware]; LAN [local operating network] hardware; VPN [virtual private network] hardware; WAN [wide area network] hardware; Computer hardware; Data communications hardware; Hardware (computer-); Electronic global positioning systems;* will include such hardware being *Computer peripheral devices* and, as such, these respective goods are identical on the basis of *Meric*.

24. *Backup drives for computers; Add-in cards for micro computers; Add-on-cards for computers; Disk drives for computers; Drives (Disk -) for computers; Printers for use with computers; Computers (Printers for use with -); Magnetic tape units for computers; Tape units (Magnetic -) for computers; Juke boxes for computers; Interfaces for computers; Monitors [computer hardware]; Compact disc players for use with computers; Joysticks for use with computers, other than for video games; Audio speakers; Speakers; Audio speakers for home; Speakers [audio equipment]; Pairable wireless speakers; Keyboards for tablets; Computer memory hardware; Camera containing a linear image sensor; Electronic card readers;* are each input, output or storage devices and included within the term *computer peripheral devices*. They are therefore identical to them on the basis of *Meric*. I find *car speakers* to be closely similar goods.

25. I have already found that the term *Computer peripheral devices* includes cameras. *Camera hoods; Camera filters; Camera flashes; Camera lenses; Camera stands; Camera straps; Camera tripods; Camera closures;* are each goods closely used with cameras. I find the respective goods to be complementary and similar to a low degree.

26. The registered proprietor's *Relays for TV stations, Tv cameras; Tv monitors; Liquid crystal display (LCD) televisions; Television camera tubes;* are each included within and therefore identical to the applicant's *Television apparatus* on the basis of *Meric*. The registered proprietor's *Lcd panels; LCD [liquid crystal display]; LCD large-screen displays; LCD monitors;* are alternative terms for TV screens or are used to display television or other images and are also identical goods. *LCD projectors* do not display television images but project images onto a screen and are reasonably similar, at least, to the applicant's *Television apparatus*. I consider the registered

proprietor's *Relays for radio stations* to be reasonably similar, at least, to the applicant's *Television apparatus*.

27. Like televisions and LCD screens, *Electronic indicator boards; Electronic indicator panels; Electronic blackboards; Electronic bulletin board apparatus; Electronic copy boards;* are each goods which may be used to display information, whether on a static or moving basis. I consider them to be reasonably similar to the applicant's *Television apparatus*.

28. *Cash registers and Electronic cash registers;* are goods, used most commonly in stores, food and drink outlets and other business premises, to calculate what the customer owes to that business and to receive his payment. They may be part of or otherwise be connected to a computer system in order to, for example, monitor stock levels or extract information regarding customers' purchasing preferences or to identify trends for marketing or other trading purposes. Similarly, *Electronic payment terminal, calculating machines and Electronic lottery apparatus;* are used by stores at point of sale and are connected to a computer or a network. I consider them to be included within and therefore on the basis of *Meric* identical to the term *computer peripheral devices* as is included in the applicant's specification.

29. The registered proprietor's *Programs for computers; Computer programs for connecting remotely to computers or computer networks; Computer programs for searching the contents of computers and computer networks by remote control; Software for tablet computers; Virtual reality game software; Application software; Computer game software; Computer software platforms; Games software; Interface software; Video game software; Video games software; VPN [virtual private network] operating software; WAN [wide area network] operating software; Software; Recorded computer software; Computer games programs downloaded via the internet [software]; Computer games programs [software]; Computer games software; Computer software programs; Computer software [programmes]; Data communications software; Data processing software; Pre-recorded software; Software drivers; Computer software; Computer software, recorded; Software (Computer -), recorded; Computer programs [downloadable software]; Programs (Computer -) [downloadable software]; Computer software applications,*

downloadable; Downloadable application software; Computer application software; Software for processing images, graphics and text; Software for the operational management of portable magnetic and electronic cards; Computer application software for mobile telephones; Digital telephone platforms and software; Downloadable computer game software via a global computer network and wireless devices; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones; Computer operating software; Computer screen saver software; Computer software for controlling self-service terminals; Computer software for controlling the operation of audio and video devices; Computer software for creating and editing music and sounds; Computer software for organizing and viewing digital images and photographs; Computer software for processing digital images; Computer software for processing digital music files; Computer software for use in processing semiconductor wafers; Computer software for wireless content delivery; Computer software to enable the transmission of photographs to mobile telephones; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Computer software to maintain and operate computer system; Gesture recognition software; Application software for cloud computing services; Application software for wireless devices; Application software for mobile phones; Community software; Computer antivirus software; Computer software for advertising; Software for tablet computers; Software development kit [SDK]; Application software for social networking; Application software for social networking services via internet are each software. Although the physical nature and methods of use of software differs from that of hardware such as is included within the applicant's *computer peripheral devices*, the users, intended purpose and trade channels may coincide. There is a well-established complementary relationship between software and hardware such that one is "important or indispensable" for the other and is likely to lead the average consumer to assume "that the responsibility for them lies with the same undertaking". I consider the respective goods to be similar to a high degree.

30. The registered proprietor's *Downloadable electronic publications; Electronic publications recorded on computer media; Instruction manuals in electronic format; Publications in electronic format; Computer documentation in electronic form;*

Directories [electric or electronic]; are each electronic publications which may be made available to consumers through specific software (e.g. via an app) to a computer peripheral device. The users may be the same, however, the respective goods differ in nature and uses and they are not complementary in line with the above case law. I consider them to be dissimilar to any of the applicant's goods.

31. The registered proprietor's *Audio electronic apparatus* would include *Portable media players* as are included within the applicant's specification and these are therefore identical goods on the basis of *Meric*. Similarly, an *Electronic sound pickup for guitars and basses* is a type of contact microphone and will therefore be included within and identical to *microphones* as included within the applicant's specification.

32. Comparing the registered proprietor's *Cabinets adapted to hold computers;* to the applicant's *cabinets for loudspeakers*, both are items of furniture used to hold the stated goods. They may have the same users and may be sold through the same trade channels given that loudspeakers are commonly part of a computer set-up. Indeed, a single piece of furniture may incorporate the facility to hold both computers and loudspeakers. I find the respective goods to be highly similar if not identical.

33. *Arm rests for use with computers; Dust covers for computers; Cases adapted for computers; Covers (shaped-) for computers; Wrist rests for use with computers; Bags adapted for laptops; Carrying cases for portable electronic devices; Camera cases;* are each types of accessories for use with computers, computer peripheral devices and portable electronic devices. They will have the same end users as the applicant's *Computer peripheral devices* or *Portable media players* though the nature and purpose of the respective goods differ. Whilst they are unlikely to be made by the same manufacturer, they are goods that will be sold in the same (parts of) stores to the same users. There is a low level of similarity between the respective goods.

34. Absent any submissions or evidence to the contrary, I can see no way in which any of the applicant's goods are similar to the registered proprietor's *Exposed camera film; Electronic currency converters; Electronic pest control equipment; Pocket translators, electronic; Card operated electronic locks; Electronic balances; Electronic carbon dioxide monitors [other than for medical purposes]; Electronic*

carbon dioxide recorders [other than for medical purposes]; Electronic colour analyzers; Electronic cruise control apparatus.

35. *Internal cooling fans for computers; Cartridges for toner [empty] for use with computers; Electronic cables; Electronic circuit board; Electronic circuit cards; Microchips [computer hardware]; Electronic coding units; Electronic integrated circuits; Electronic circuit boards; Electronic semi-conductors; Printed electronic circuits; Circuits [electric or electronic]; Electronic components; Electronic components for computers; Components for computers; Encoded electronic chip cards; Electronic speed controllers; Electronic warning bells; Electronic buzzers; Electronic decoders; Electronic encryption units; Electronic touch sensitive switches; Electronic amplifiers; Electronic transformers; Circulators [electric or electronic components]; Electronic coding apparatus; Electronic control apparatus; Electronic control circuits; Electronic control systems; Electronic control units; Electronic controllers; may be components of computer peripheral devices, however, in *Les Éditions Albert René v OHIM*, Case T-336/03, the General Court found that:*

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

Whilst there may be some overlap in the respective users, in each case the natures and uses of the respective goods differ and one is not in competition with the other. I consider them to be dissimilar goods to any of the goods within the applicant's specification.

36. *Electronic databases* are organised collections of information which can be searched electronically. Whilst such information may be stored on or accessed from a computer peripheral device and so have the same users, the respective goods differ in nature, uses and trade channels and they are not complementary as set out in the above case law. Absent submissions to the contrary, I consider them to be dissimilar goods to any of the applicant's goods.

The average consumer and the nature of the purchasing process

37. As the case law above indicates, it is necessary for me to 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 in the course of trade.

38. 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.”

39. The average consumer of all of the goods at issue is either a member of the general public or a business user selecting on behalf of a commercial undertaking. I consider that all of the goods at issue will be obtained by self-selection i.e. from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue. Visual considerations are likely therefore to be an important part of the selection process, however, given the technological nature of the goods at issue, it is also likely that such goods will be the subject of, for example, oral enquiries to sales assistants (whether in person or by telephone), indicating that aural considerations must not be forgotten. Absent submissions to the contrary, I see no reason why the same conclusions would not apply to a business user. As to the degree of care the average consumer will display when selecting the goods at issue, given the nature of the goods and as even a member of the general public buying for personal use is likely to be alive to a range of factors such as compatibility with existing devices, security, speed, price, colour reproduction, tone etc. I would expect an above average degree of attention to be paid by them during the selection process. A

business user is likely to be conscious of many of the same factors. They will also have in mind the business's existing infrastructure and the potential impact of any selection they make on that infrastructure (and its likely impact on the well-being of the business). In addition, as costs in the business sector are likely to be higher and, for example, meetings with potential suppliers and a tendering arrangement may also be a part of the process, I would expect a business user to pay an even higher degree of attention to the selection of the goods at issue, though not necessarily the highest degree.


Comparison of the respective marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, artificially to 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 created by them.

41. The marks to be compared are as follows:

Registered proprietor's mark	Applicant's mark
microlab	

42. The registered proprietor's mark consists of a single element presented as the word **microlab** in lower case letters. The same word, also presented in lower case, makes up the first word of the applicant's mark. Whilst the font used in both is slightly different, as can be seen on careful inspection of the letter 'a' within the word, both are in a standard typeface and the differences are not material. Also in the applicant's mark, the words **just listen** appear underneath the word **microlab**. These words are also presented in lower case letters but, extending only from the letter 'c' to the letter 'b' of the word **microlab**, are smaller in size to the word appearing above them. To the right of the middle of the letter 'i' in the word listen, there are two short curved lines with the one nearest the middle being shorter than the other. Given the respective size and positions of the various elements, it is the word **microlab** that is the dominant element of the mark, the other words appearing as a strapline and are unlikely to be given any trade mark significance. The element **microlab** is not, as far as I have been made aware, a dictionary word but it naturally breaks down to the word micro, meaning small and lab which is a known abbreviation for the word laboratory. It is a word with an average degree of inherent distinctive character.

43. In its counterstatement, the registered proprietor denies that the respective marks are similar but makes no submissions to explain its position. Clearly, there is some similarity between the marks given that the same word appears in both either as the only element or as the first and dominant element though there are also some visual differences due to the other elements in the applicant's mark which have no counterpart in that of the registered proprietor. Overall, I find the marks are visually similar to a fairly high degree.

44. I think it unlikely that the **just listen** element of the applicant's mark will be enunciated in which case the marks are aurally identical. Even if it were enunciated, the marks are aurally similar to a fairly high degree.

45. Conceptually, whatever message is conveyed by the word **microlab** will be the same in both cases though the inclusion of the words **just listen** with the stylisation reminiscent of soundwaves present in the applicant's mark, brings to mind something used for listening. Overall, I find the marks are conceptually similar to a reasonable degree.

The distinctiveness of the earlier mark

46. 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).”

47. Absent the filing of any evidence of use of the earlier mark, I have only its inherent distinctiveness to consider. I commented above on the distinctiveness of the word **microlab**. The words **just listen** is a strapline inviting the customer to do just that and, as I indicated above, are words unlikely to be given any trade mark significance. Considering the mark as a whole, I find it to be a mark of average distinctive character. That is not, of course, an end to the matter as it is the distinctiveness of the shared element that I have to consider further. I shall return to this in due course.

The likelihood of confusion

48. 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the earlier trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

49. Earlier in this decision I concluded that:

- some of the respective goods are identical, others similar to varying degrees and yet others dissimilar;
- the average consumer of the goods is a member of the public or a business user;
- the purchasing process will be primarily a visual one but aural considerations will also play a part;
- the degree of care taken in that purchase will vary but be at least above average;

- the respective marks have a fairly highly degree of visual similarity, at least a fairly high degree of aural similarity and a reasonable degree of conceptual similarity;
- absent use, the earlier mark has an average degree of inherent distinctive character.

50. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

51. For those goods which I have found not to be similar, there can be no likelihood of confusion. These goods are: *Internal cooling fans for computers; Components for computers; Cartridges for toner [empty] for use with computers; Electronic components for computers; Exposed camera film; Microchips [computer hardware]; Electronic cables; Electronic circuit board; Electronic circuit cards; Electronic coding units; Electronic integrated circuits; Electronic semi-conductors; Electronic speed controllers; Electronic warning bells; Downloadable electronic publications; Electronic buzzers; Electronic circuit boards; Electronic currency converters; Electronic databases; Electronic decoders; Electronic encryption units; Electronic pest control equipment; Electronic publications recorded on computer media; Electronic touch sensitive switches; Electronic transformers; Encoded electronic chip cards; Instruction manuals in electronic format; Printed electronic circuits; Publications in electronic format; Pocket translators, electronic; Card operated electronic locks; Circuits [electric or electronic]; Circulators [electric or electronic components]; Computer documentation in electronic form; Directories [electric or electronic]; Electronic amplifiers; Electronic balances; Electronic carbon dioxide*

monitors [other than for medical purposes]; Electronic carbon dioxide recorders [other than for medical purposes]; Electronic coding apparatus; Electronic colour analyzers; Electronic components; Electronic control apparatus; Electronic control circuits; Electronic control systems; Electronic control units; Electronic controllers; Electronic cruise control apparatus;

52. In considering the likelihood of confusion in relation to the remaining goods, as I mentioned earlier, it is the distinctive character of the shared element that is key. This approach was confirmed in *Kurt Geiger v A-List Corporate Limited*, BL O-07513, when Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the trade marks that are identical or similar. He stated:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask “in what does the distinctive character of the earlier mark lie?” Only after that has been done can a proper assessment of the likelihood of confusion be carried out. Earlier in this decision, I concluded that the shared component i.e. the word **microlab** has an average degree of inherent distinctive character. It forms the whole of the registered proprietor’s mark and the dominant and distinctive element of the applicant’s mark. The significant role this shared component plays in the overall impression the trade marks convey, in my

view, will lead to a likelihood of direct confusion where there is similarity, at whatever level, of goods.

Summary

53. The application to cancel the registration succeeds in part. The registration will be cancelled and deemed never to have been made in respect of all goods **except those set out in paragraph 51 above.**

Costs

54. The applicant has had the larger measure of success and is entitled to an award of costs to reflect the extent of that success. In addition, during the course of the proceedings, a case management conference (“CMC”) was appointed to determine a request by the registered proprietor for an extension of time to the period for it to file evidence. On the appointed day both parties attended (via their legal representatives) by telephone, however, the registered proprietor immediately indicated it was withdrawing its request. The CMC was thus rendered unnecessary. The applicant’s representative requested an award of costs in respect of its preparation for and attendance at the CMC, acknowledging that the amount concerned would be small.

55. I agree that the applicant is entitled to an award of costs in respect of the CMC. Given that it had been arranged to determine a request by the registered proprietor for an extension of time, it is unlikely that the applicant would have needed to carry out any significant amount of preparation. Certainly, its representative did not suggest it had. I accept that the registered proprietor could and should have indicated earlier that it no longer sought an extension of time so that the CMC could have been cancelled, however, given its immediate withdrawal of the request, the CMC was brief and was by telephone rather than e.g. personal attendance. In view of this and taking into account the extent of the applicant’s success and that neither side file either evidence or submissions, I make the award on the following basis:

Preparation of the application for cancellation:	£200
Official filing fee:	£200

Subtotal:	£400
Less amount to reflect extent of success:	£100
Less amount for aborted CMC:	£50
Total:	£250

56. I order Microlab Probit Limited to pay Shenzhen Maibo Electronics Corporation the sum of £250. This sum is to be paid within fourteen days of the expiry of the period for appeal.

Dated this 7th day of July 2017

Ann Corbett
For the Registrar
The Comptroller General