

O/866/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK REGISTRATION NO. UK00918227155

IN THE NAME OF

VIVO MOBILE COMMUNICATION CO., LTD

IN CLASS 9

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

THERE TO UNDER NO. CA000504300

AND

IN THE MATTER OF

TRADE MARK REGISTRATION NO. UK00918227159

IN THE NAME OF

VIVO MOBILE COMMUNICATION CO., LTD

IN CLASS 9

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

THERE TO UNDER NO. CA000504301

Background and pleadings

1. There are two cancellation applications seeking a declaration of invalidity in these consolidated proceedings made by Honor Device Co., Ltd. (“Party A”) against trade marks registered to VIVO MOBILE COMMUNICATION CO., LTD (“Party B”).

Lead case - CA000504300

2. On 18 April 2020, Party B applied to register the mark shown below. It is registered under No. UK00918227155, dated 5 August 2020.

X1

3. The mark is registered for the following goods:

Class 9 Smartphones; Mobile phones; Earphones for cellular telephones; Protective cases for mobile phones; Stands adapted for mobile phones; Mobile phone display screen protectors in the nature of films; Mobile phone battery chargers; Displays for mobile phones; Keyboards for mobile phones; Batteries for mobile phones; Wireless headsets for mobile phones; Wireless headsets for smartphones; Headsets for mobile telephones; USB cables for cellphones; Power banks; Cases for mobile phones; Mobile phone straps; Selfie sticks used as smartphone accessories; Smart glasses; Smart watches; Smartbands; Smart speakers; Tablet computers; Headphones; Earphones; Headsets; Earbuds.

4. Party A made an application to have the above mark declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”) using Form TM26(I), accompanied by an extensive statement of grounds, which was received by the Registry on 2 November 2021. The application is based upon section

5(2)(b) of the Act and concerns all the goods that the contested mark is registered for.

5. Under section 5(2)(b), the applicant relies upon the marks below and all the goods and services for which they are registered.
6. The first earlier mark, registered under No. UK00918205521, was applied for on 5 March 2020. The registration procedure was completed on 10 September 2020.

X11

7. The registration covers the following goods:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching; transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; Mobile telephones; Mobile telephone handsets, USB modems, modems, data cards, computers, DPF (Digital Photo Frames), Tablet computer, digital readers, PDA (Personal Digital Assistant), wireless modem, gateway, household network terminal devices and equipment for accessing internet, ADSL (Asymmetric Digital Subscriber Line) broadband accessing terminal devices and equipment, routers, communication modules, software in communication field; computer software; Computer hardware, firmware, and software, namely computers, peripherals, computer networks

and networking components, and components for managing and interconnecting telecommunications networks, for providing computer and computer network security, and for providing network management and enhanced services development and deployment, and for managing and interconnecting multimedia, audio and video data equipment, namely, wired and wireless network interface devices, switching devices; computer software for use in the field of education, namely, for data communications among users; telecommunication equipment, namely, wireless radio frequency switches; radio transmitters and receivers for telecommunication; wireless local loop access apparatus for radio signal transmission comprised of base station controllers, antennas, subscriber units that transmit and receive signals, and network management switches for use in managing radio signals and voice transfer between subscriber terminals and local exchanges; wireless switching platforms for selection of optical channel connections for voice and signals, call processing and system maintenance; access network apparatus, namely base station controllers; directional and omni antennas; subscriber terminals; mobile phones, wireless telephones; wireless base stations, wireless antennas; transceivers for telecommunication purposes; and telecommunication trunk circuits and trunk line assemblies comprising trunk line cables and trunk line amplifiers; stored program controlled switching systems, namely, stored program controlled switching machine for use in processing the information from incoming calls to outgoing terminals in the public service telephone network; radio apparatus, namely, data, voice, and image switching equipment for mobile communications; optical telecommunications apparatus, namely, optical line terminal for use in receiving, transmitting and analyzing the optical signal, optical network unit, also known as an optical line terminal which manages the optical

network; fiber optical CATV transmissions equipment, namely, electric light switches, optic fibers, fiber optic cables; ISDN access adapter, telecommunication system, namely, intelligent high frequency network comprised of computer workstations telecommunication terminal equipment, namely, telephone phone, visual phone, digital enhanced cordless telecommunications (DECT) phone, mobile phone; and, digital phone; wireless local loop equipment, namely, connections for mobile subscribers to access switching systems; SPC (Stored program controlled) exchanges; cable television and internet transmitters and receivers; apparatus for communication and navigation not included on other classes; computer peripheral devices; recorded computer software; aerials; transmitters (telecommunication); video telephones; portable telephones; optical communication equipment; stored program controlled telephone switching equipment; network communication apparatus; printed circuits; integrated circuits; integrated circuits chips; wireless data cards; USB modems; wireless telephone; telephones for remote teleconference; telephone apparatus; routers; gateways; modems; central processing units; ADSL broadband accessing terminal devices and equipment; control apparatus for teleconference; set-top boxes; materials for electricity mains (wires, cables); telephone wires; electronic chips; data processing apparatus; processors (central processing units); data transmission equipment; downloadable telephone ring; mouse (data processing equipment); magnetic disks; floppy disks; computer keyboards; computers; MCU (Multipoint Control Units) for videoconference (communication equipment); group videoconferencing endpoint (communication equipment); communication modules; photo-telegraphy apparatus; electronic notice boards; sound reproduction apparatus; lightning arresters; transparencies (photography); digital photo frames; batteries; Network access apparatus for

domestic use; microphones; earphone; electronic audio books; internet access apparatus for making phone calls, accessing internet and viewing videos for domestic use; handheld e-book readers; television apparatus; mobile telephones; chargers; USB data line; headphones; integrated circuit cards; laptop computers; computer memories; recorded computer programmes (programs); couplers (data processing equipment); interfaces for computers; microprocessors; monitors (computer hardware); monitors (computer programs); optical data media; optical discs; disk drives for computers; notebook computers; megaphones; cameras; cabinets for loudspeakers; electric monitoring apparatus; video recorders; tape recorders; sound recording apparatus; camcorders; detectors; semi-conductors; low voltage power source; battery chargers; fiber optic faceplate; weak-current boxes; fiber optics panels; cable side terminal block; exchange side terminal block; electrical surge protection units; optical cable distribution frame; digital distribution frame; optical connector; copper connector; optical fiber terminal; communication cabinet; Animated cartoons; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Asbestos screens for firemen; Aviators (Protective suits for); Boats (Fire); Breathing apparatus for underwater swimming; Breathing apparatus, except for artificial respiration; Cabinets for loudspeakers; Cartoons (Animated); Cases (Eyeglass); Cases (Pince-nez); Cases especially made for photographic apparatus and instruments; Cases fitted with dissecting instruments (microscopy); Chains (Eyeglass); Cleaning apparatus for phonograph records; Cleaning apparatus for sound recording discs; Clips for divers and swimmers (Nose); Clothing especially made for laboratories; Clothing for protection against accidents, irradiation and fire; Clothing for protection against fire; Coils (Holders for electric); Coin-operated gates for car

parcs or parking lots; Computer game programs; Computer keyboards; Computer operating programs, recorded; Computer peripheral devices; Computer programmes (programs), recorded; Computer programs (downloadable software); Computer software, recorded; Contact lenses (Containers for); Containers for contact lenses; Containers for microscope slides; Covers for electric outlets; Diver's apparatus; Divers' masks; Diving suits; Ear plugs for divers; Electric installations for the remote control of industrial operations; Electrified fences; Electronic publications, downloadable; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Face-shields (Workmen's protective); Fences (Electrified); Filters for respiratory masks; Fire (Clothing for protection against); Fire beaters; Fire blankets; Fire boats; Fire engines; Fire hose nozzles; Firemen (Asbestos screens for); Furniture especially made for laboratories; Garments for protection against fire; Gates for car parks (Coin operated); Gloves for divers; Gloves for protection against accidents; Gloves for protection against X-rays for industrial purposes; Goggles for sports; Helmets (Protective); Helmets (Protective) for sports; Helmets (Riding); Holders for electric coils; Interfaces for computers; Juke boxes for computers; Kits (Hands free) for phones; Knee-pads for workers; Laboratories (Clothing especially made for); Locks, electric; Magnets; Magnets (Decorative); Masks (Divers); Masks (Protective); Masts for wireless aerials; Micrometer screws for optical instruments; Microscope slides (Containers for); Monitors (computer programs); Motor fire engines; Mouse pads; Nets (Safety); Nets for protection against accidents; Nose clips for divers and swimmers; Nozzles (Fire hose); Oxygen transvasing apparatus; Pads (Mouse); Peripheral devices (Computer); Pince-nez cases; Pince-nez chains; Pince-nez cords; Pince-nez mountings; Plotters; Programs (Computer) (downloadable software); Programs (Computer game);

Programs (Computer operating) recorded; protection devices against X-rays (Roentgen rays), not for medical purposes; Protection devices for personal use against accidents; Protective helmets; Protective helmets for sports; Protective masks; Protective suits for aviators; Publications (Electronic), downloadable; Push buttons for bells; Railway traffic safety appliances; Reflecting discs for wear, for the prevention of traffic accidents; Respirators for filtering air; Respirators, other than for artificial respiration; Respiratory masks, other than for artificial respiration; Restraints (Safety), other than for vehicle seats and sports equipment; Retorts' stands; Riding helmets; Road signs, luminous or mechanical; Roentgen rays (Protection devices against), not for medical purposes; Safety nets; Safety restraints, other than for vehicle seats and sports equipment; Safety tarpaulins; Screens for firemen (Asbestos); Shoes for protection against accidents, irradiation and fire; Signs, luminous; Software (Computer), recorded; Solderers helmets; Spark-guards; Spectacle cases; Spectacle frames; Sports (Goggles for); Sports (Protective helmets for); Stands for photographic apparatus; Steering apparatus, automatic, for vehicles; Teeth protectors; Theft prevention installations, electric; Traffic accidents (Reflecting discs, for wear, for the prevention of); Tripods for cameras; Vehicle breakdown warning triangles; Vests (Am) (Bullet-proof); Waistcoats (Bullet-proof); Warning triangles (Vehicle breakdown); Wireless aerials (Masts for); Workmen's protective face-shields; Wrist rests for use with computers; X-rays (Protection devices against), not for medical purposes; Smartphones; Laptops; Tablets; Smart Driving Recorder; Intelligent Distance Recorder; Laser Projection TV; smart audio story devices; Smart Camera; Smart Rear View Mirror; Car Charger; smart electrical outlet; Smoke Alarm; Natural Gas Alarm; Wireless Hygrometer; Smart handheld transceiver; Kitchen Electronic scales; Scales that

measure body fat for domestic use; telecommunication apparatus in the form of jewellery; phone holders for cars; e-book readers; learning machines; video monitors; head-mounted video displays; car TVs; Electric and electronic video surveillance Equipment; liquid crystal projectors; self sticking monopods for smart phones or cameras; air analysis instruments; gas detectors; audiovisual teaching instruments; speedometers for vehicles; measuring cups; gas analysis instruments; remote telemetry equipment; optical lenses; ultrasonic sensors; Sound alarms; Smoke detectors; Electric locks; Electronic anti-theft devices; Electronic anti-theft alarms; Digital door locks; 3D glasses; Mobile phone batteries; Charging devices for motor vehicles; Cartoon; Electric fences; Sunglasses; Home remote control; sensor; sleep sensor; security sensor Infrared Sensor; Temperature Sensor; Automatic Focusing Projector; Miniature Projector; Patch Panel; Security Camera Humanoid Robot with Artificial Intelligence; Intelligent Switch (Electrical); Smart Photo Printer; Mobile phones with style (decoration); TV monitor; TV with plasma display; LCD TV; HD TV; Car TV; TV receiver; Ultra HD TV; TV remote control; smart band; smartwatch.

8. The second earlier mark, registered under No. UK918206334, was applied for on 5 March 2020. The registration procedure was completed on 3 September 2020.

X13

9. The registration covers the same goods as for UK00918205521.

10. The third earlier mark, registered under No. UK918206326 was applied for on 5 March 2020. The registration procedure was completed on 3 September 2020.

X14

11. The registration covers the same goods as for UK00918205521.

12. The fourth earlier mark, registered under No. UK914741607 was applied for on 29 October 2015. The registration procedure was completed on 3 December 2016.

7X

13. The registration covers the following goods:

Class 9 Communications equipment; data communications apparatus; telecommunications apparatus; computers; portable computers; tablet computers; protective cases for tablet computers; wearable computers; smart bands; smart watches; smart watches comprised primarily of a wristwatch mainly for viewing, sending and receiving texts, emails, data and information and answering calls; wearable digital electronic devices comprised primarily of a wristwatch and also featuring a telephone, software and display screens for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers; jewellery that communicates data; smartphones in the shape of a watch or a bracelet; smart bracelets with the functions of wireless technology and remote control for use with mobile phones which can display the caller's number and short message; smart wrist wearable bands with display screens for viewing, sending and receiving texts, emails,

data and information and answering calls; smart eyeglasses for viewing, sending and receiving texts, emails, data and information and taking pictures; mobile phones; smartphones; protective cases for mobile phones; batteries for phones; earphones; headphones; audio equipment; stereos; wearable audio equipment; speakers; loudspeakers; set-top boxes; routers; wireless routers; communication software; application software; parts and fittings for all the aforesaid goods.

Class 35 Retail services in relation to communications equipment, data communications apparatus, telecommunications apparatus, computers, portable computers, tablet computers, protective cases for tablet computers, wearable computers, smart bands, smart watches, smart watches comprised primarily of a wristwatch mainly for viewing, sending and receiving texts, emails, data and information and answering calls; retail services in relation to wearable digital electronic devices comprised primarily of a wristwatch and also featuring a telephone, software and display screens for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers; retail services in relation to wearable digital electronic devices, smartphones in the shape of a watch or a bracelet; retail services in relation to smart bracelets with the functions of wireless technology and remote control for use with mobile phones which can display the caller's number and short message; retail services in relation to smart wrist wearable bands with display screens for viewing, sending and receiving texts, emails, data and information and answering calls; retail services in relation to smart eyeglasses for viewing, sending and receiving texts, emails, data and information and taking pictures; retail services in relation to mobile phones, smartphones, protective cases for mobile phones, batteries for phones; retail services in relation to

earphones, headphones, audio equipment, stereos, wearable audio equipment, speakers, loudspeakers, set-top boxes, routers, wireless routers, communication software, application software. In his respective TM26(I) forms, Party A argues that his mark is visually, phonetically and conceptually similar to Party B's marks to a very high degree and that the goods covered by the respective marks are identical, or if not considered identical, highly similar. He further contends that the dominant and distinctive elements of Party B's marks are identical to his mark, and, with the goods being identical, a likelihood of confusion on the part of the relevant public is inevitable.

14. The fifth earlier mark, registered under No. UK00003427498 was applied for on 10 September 2019. The registration procedure was completed on 31 July 2020.

Xtra

15. The registration covers the following goods:

Class 9 Computer memory devices; computer keyboards; mouse [computer peripheral]; integrated circuit cards [smart cards]; notebook computers; laptop computers; bags adapted for laptops; sleeves for laptops; tablet computers; pedometers; scales; modems; transponders; smartphones; Network communication apparatus; cabinets for loudspeakers; loudspeakers; microphones; sound transmitting apparatus; television apparatus; camcorders; headphones; portable media players; digital photo frames; Earphones; cameras [photography]; air analysis apparatus; gas testing instruments;

integrated circuits; video screens; Sensors; Electronic chips; batteries, electric; computer hardware; smartglasses [data processing]; smartwatches [data processing]; wearable activity trackers; covers for smartphones; cases for smartphones; Large-screen LCDs; Electronic diaries; Flat panel displays; Liquid crystal displays; Intercoms; Car televisions; Touch screens; Touch screen pens; Electronic pens; Flexible flat panel displays for computers; Stands adapted for tablet computers; Video printers; Stands adapted for mobile phones; USB cables; USB cables for cellphones; Digital door locks; Alarm central units; covers for tablet computers; black boxes [data recorders]; interactive touch screen terminals; humanoid robots with artificial intelligence; electronic sheet music, downloadable; smart rings [data processing]; Facial recognition apparatus; scales with body mass analyzers; bathroom scales; protective films adapted for smartphones; virtual reality headsets; Car video recorders; Set-top boxes; thermal imaging cameras; infrared detectors; digital weather stations; biochips; personal digital assistants [PDAs]; thin client computers; hand-held electronic dictionaries; recorded or downloadable; downloadable graphics for mobile phones; wearable computers; Portable digital electronic scales; telecommunication apparatus in the form of jewelry; Selfie sticks for use with mobile phones; Wrist-mounted smartphones; security surveillance robots; wearable video display monitors; selfie lenses; laboratory robots; teaching robots; Computer styluses; downloadable emoticons for mobile phones; electric plugs; electric sockets; 3D glasses.

16. Party B's Form TM8, received on 4 January 2022, was accompanied by a counterstatement which denied the claims made by Party A.

Second case - CA000504301

17. On 18 April 2020, Party B applied to register the mark shown below. It is registered under No. UK00918227159, dated 12 November 2020.

X4

18. The mark is registered for the same Class 9 goods as for UK00918227155.

19. Party A made an application to have the above mark declared invalid under section 47(2) of the Act using Form TM26(I), accompanied by an extensive statement of grounds, which was received by the Registry on 2 November 2021. The application is based upon section 5(2)(b) of the Act and concerns all the goods that the contested mark is registered for.

20. Under section 5(2)(b), the applicant relies upon the marks below and all the goods and services for which they are registered.

21. The first earlier mark, registered under No. UK00918186248 was applied for on 21 January 2020. The registration procedure was completed on 22 May 2020.

X45

Class 9 Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable

media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; smartglasses; smartwatches; smartphones; wearable activity trackers; cases for smartphones; covers for smartphones; protective films adapted for smartphones; selfie sticks [hand-held monopods]; digital photo frames; microphones; computer hardware; computer memory devices; integrated circuit cards [smart cards]; transponders; cabinets for loudspeakers; network communication equipment; modems; sleeves for laptops; batteries, electric; chargers for electric batteries; portable power supplies (rechargeable batteries); tablet computers; covers for tablet computers; stands adapted for tablet computers; flat panel display screens; flexible flat panel displays for computers; laptop computers; notebook computers; bags adapted for laptops; headphones; earphones; virtual reality headsets; automobile data recorder; set-top boxes; loudspeakers; portable media players; sound transmitting apparatus; camcorders; cameras [photography]; computer keyboards; mouse [computer peripheral]; pedometers; monitoring apparatus, other than for medical purposes; video monitors; connected bracelets [measuring instruments]; computer programs, recorded; computer software applications, downloadable; optical lenses; switchboards; transmitters of electronic signals; transmitting sets [telecommunication]; gas testing instruments; black boxes [data recorders]; interactive touch screen terminals; humanoid robots with artificial intelligence; electronic sheet music, downloadable; smart rings; audio interfaces; electric and electronic effects units for musical instruments; equalizers [audio apparatus]; digital weather

stations; biochips; infrared detectors; electronic key fobs being remote control apparatus; security tokens [encryption devices]; fingerprint identifiers; human face recognition devices; programme-controlled telephone exchange equipment; radios; air analysis apparatus; materials for electricity mains [wires, cables]; video screens; integrated circuits; electronic chips; thermal imaging cameras; weighing scales; scales with body mass analysers; personal digital assistants [PDAs]; computer software platforms, recorded or downloadable; thin client computers; hand-held electronic dictionaries; computer screen saver software, recorded or downloadable; computer software, recorded; downloadable graphics for mobile phones; wearable computers; telecommunication apparatus in the form of jewellery; selfie sticks for use with smartphones; security surveillance robots; wearable video display monitors; selfie lenses; laboratory robots; teaching robots; USB cables; USB cables for mobile phones; downloadable applications for use with mobile devices; holders for cell phones; touch screens; television apparatus; electric plugs; electric sockets; intercoms; digital door lock; central alarm; transducers; downloadable emoticons for mobile phones; computer operating programs, recorded; large-screen liquid crystal displays [LCDs]; electronic diaries; liquid crystal display [LCD] screens; electronic pens; video printers; portable digital electronic scales; wrist-mounted smartphones; car televisions; computer styluses; computer programs, downloadable; touch screen pens; scales.

22. The second earlier mark is UK00918206326, "X14", as detailed in paragraphs 10 and 11.

23. The third earlier mark is UK00914741607, "7X", as detailed in paragraphs 12 and 13.

24. The fourth earlier mark is UK00003427498, “Xtra”, as detailed in paragraphs 14 and 15.

25. Party B’s Form TM8, received on 4 January 2022, was accompanied by a counterstatement which denied the claims made by Party A.

The consolidated cases

26. The cases were consolidated on 21 February 2022.

27. Party A was the only party to file written submissions which it did on 23 May 2022. Neither party requested an oral hearing and no written submissions in lieu of a hearing were filed.

28. Party A is represented by Forresters IP LLP and Party B is represented by Ashfords LLP.

The law in relation to invalidity

29. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to Section 47 of the Act.

30. Section 47 reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), 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

[...]

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

31. Sections 5(2)(b) and 5A of the Act read as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

32. An earlier trade mark is defined in section 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.”

33. The marks relied upon by Party A qualify as earlier trade marks. Given their registration dates, none of the earlier marks is subject to the proof of use provisions contained in Section 47(2A) of the Act.

Section 5(2)(b) – relevant case law

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

The principles:

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

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

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

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

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

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

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

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

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

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

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

Lead case - CA000504300

Comparison of the trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by

reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

37. Party A’s and Party B’s marks are shown below:

Party A’s earlier trade marks	Party B’s trade mark
X11	X1
X13	
X14	
7X	
Xtra	

38. Although Party A relied on the argument that the marks relied upon form a “family of marks”, it did not file any evidence. Hence, my approach would have been to consider each mark separately. However, since I consider Party A’s “X11” mark to be its strongest mark by comparison with Party B’s mark, I will begin doing a comparative analysis of these marks because if I

find a likelihood of confusion in this respect, then it will not be necessary to consider Party A's other marks.

39. Party B's word mark is "X1", this letter and number being the only things that contribute to the overall impression.
40. Party A's word mark is "X11", the letter and number or numbers being the only things that contribute to the overall impression.
41. Visually, the marks only differ in that Party A's mark has an additional "1", the two marks sharing the same first and second characters and Party B's mark being incorporated within Party A's mark. The two marks are highly similar visually.
42. Aurally, Party B's mark is "EX WUN" and Party A's mark is "EX ELEVUHN" or "EX WUN WUN". By comparison with "EX ELEVUHN", the respective marks begin phonetically identically, but the second parts differ. On the basis of that comparison, the marks are aurally similar to a medium degree. By comparison with "EX WUN WUN", the two elements of Party B's mark are aurally identical to the first two elements of Party A's mark and I find them aurally similar to a medium to high degree.
43. Conceptually, the two marks consist of the letter "X" followed by the numbers "1" or "11"/"1,1". The marks do not give rise to a particular concept and would be perceived as a random letter with a random number or numbers, the combinations thereof not having a specific meaning. The marks are conceptually neutral.

Distinctive character of the earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

46. The earlier mark “X11” is not suggestive or allusive of the goods for which the mark is registered. The characters that make up the mark form neither invented nor dictionary words. However, they are simply a letter and a number or numbers. While numerals and letter/number combinations are accepted as trade marks provided that they appear sufficiently random to individualise the goods/services of one undertaking, they are not particularly

distinctive. As such, I consider the earlier mark to be of low to medium distinctive character.

Comparison of the goods

47. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the 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.”

48. Guidance on this issue has also come from Jacob J. (as he then was) in 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.

49. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

50. 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/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is 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”.

51. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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."

52. The competing goods, all of which are in Class 9, are as follows:

Party A's goods	Party B's goods
Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching; transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; Mobile telephones; Mobile telephone handsets, USB modems, modems, data cards, computers, DPF (Digital Photo Frames), Tablet computer, digital readers, PDA	Smartphones; Mobile phones; Earphones for cellular telephones; Protective cases for mobile phones; Stands adapted for mobile phones; Mobile phone display screen protectors in the nature of films; Mobile phone battery chargers; Displays for mobile phones; Keyboards for mobile phones; Batteries for mobile phones; Wireless headsets for mobile phones; Wireless headsets for smartphones; Headsets for mobile telephones; USB cables for cellphones; Power banks; Cases for mobile phones; Mobile phone straps; Selfie sticks used as smartphone accessories; Smart glasses; Smart watches; Smartbands; Smart speakers; Tablet computers; Headphones; Earphones; Headsets; Earbuds.

(Personal Digital Assistant), wireless modem, gateway, household network terminal devices and equipment for accessing internet, ADSL (Asymmetric Digital Subscriber Line) broadband accessing terminal devices and equipment, routers, communication modules, software in communication field; computer software; Computer hardware, firmware, and software, namely computers, peripherals, computer networks and networking components, and components for managing and interconnecting telecommunications networks, for providing computer and computer network security, and for providing network management and enhanced services development and deployment, and for managing and interconnecting multimedia, audio and video data equipment, namely, wired and wireless network interface devices, switching devices; computer software for use in the field of education, namely, for data communications among users; telecommunication equipment, namely, wireless radio frequency switches; radio transmitters and receivers for telecommunication; wireless local loop access apparatus for radio signal transmission comprised of base station controllers, antennas, subscriber units

that transmit and receive signals, and network management switches for use in managing radio signals and voice transfer between subscriber terminals and local exchanges; wireless switching platforms for selection of optical channel connections for voice and signals, call processing and system maintenance; access network apparatus, namely base station controllers; directional and omni antennas; subscriber terminals; mobile phones, wireless telephones; wireless base stations, wireless antennas; transceivers for telecommunication purposes; and telecommunication trunk circuits and trunk line assemblies comprising trunk line cables and trunk line amplifiers; stored program controlled switching systems, namely, stored program controlled switching machine for use in processing the information from incoming calls to outgoing terminals in the public service telephone network; radio apparatus, namely, data, voice, and image switching equipment for mobile communications; optical telecommunications apparatus, namely, optical line terminal for use in receiving, transmitting and analyzing the optical signal, optical network unit, also known as an optical line terminal which manages the optical network; fiber

optical CATV transmissions equipment, namely, electric light switches, optic fibers, fiber optic cables; ISDN access adapter, telecommunication system, namely, intelligent high frequency network comprised of computer workstations telecommunication terminal equipment, namely, telephone phone, visual phone, digital enhanced cordless telecommunications (DECT) phone, mobile phone; and, digital phone; wireless local loop equipment, namely, connections for mobile subscribers to access switching systems; SPC (Stored program controlled) exchanges; cable television and internet transmitters and receivers; apparatus for communication and navigation not included on other classes; computer peripheral devices; recorded computer software; aerials; transmitters (telecommunication); video telephones; portable telephones; optical communication equipment; stored program controlled telephone switching equipment; network communication apparatus; printed circuits; integrated circuits; integrated circuits chips; wireless data cards; USB modems; wireless telephone; telephones for remote teleconference; telephone apparatus; routers; gateways; modems; central processing units; ADSL

broadband accessing terminal devices and equipment; control apparatus for teleconference; set-top boxes; materials for electricity mains (wires, cables); telephone wires; electronic chips; data processing apparatus; processors (central processing units); data transmission equipment; downloadable telephone ring; mouse (data processing equipment); magnetic disks; floppy disks; computer keyboards; computers; MCU (Multipoint Control Units) for videoconference (communication equipment); group videoconferencing endpoint (communication equipment); communication modules; photo-telegraphy apparatus; electronic notice boards; sound reproduction apparatus; lightning arresters; transparencies (photography); digital photo frames; batteries; Network access apparatus for domestic use; microphones; earphone; electronic audio books; internet access apparatus for making phone calls, accessing internet and viewing videos for domestic use; handheld e-book readers; television apparatus; mobile telephones; chargers; USB data line; headphones; integrated circuit cards; laptop computers; computer memories; recorded computer programmes (programs); couplers (data processing equipment); interfaces for computers;

<p>microprocessors; monitors (computer hardware); monitors (computer programs); optical data media; optical discs; disk drives for computers; notebook computers; megaphones; cameras; cabinets for loudspeakers; electric monitoring apparatus; video recorders; tape recorders; sound recording apparatus; camcorders; detectors; semi-conductors; low voltage power source; battery chargers; fiber optic faceplate; weak-current boxes; fiber optics panels; cable side terminal block; exchange side terminal block; electrical surge protection units; optical cable distribution frame; digital distribution frame; optical connector; copper connector; optical fiber terminal; communication cabinet; Animated cartoons; Asbestos clothing for protection against fire; Asbestos gloves for protection against accidents; Asbestos screens for firemen; Aviators (Protective suits for); Boats (Fire); Breathing apparatus for underwater swimming; Breathing apparatus, except for artificial respiration; Cabinets for loudspeakers; Cartoons (Animated); Cases (Eyeglass); Cases (Pince-nez); Cases especially made for photographic apparatus and instruments; Cases fitted with dissecting instruments (microscopy); Chains (Eyeglass);</p>	
---	--

Cleaning apparatus for phonograph records; Cleaning apparatus for sound recording discs; Clips for divers and swimmers (Nose); Clothing especially made for laboratories; Clothing for protection against accidents, irradiation and fire; Clothing for protection against fire; Coils (Holders for electric); Coin-operated gates for car parks or parking lots; Computer game programs; Computer keyboards; Computer operating programs, recorded; Computer peripheral devices; Computer programmes (programs), recorded; Computer programs (downloadable software); Computer software, recorded; Contact lenses (Containers for); Containers for contact lenses; Containers for microscope slides; Covers for electric outlets; Diver's apparatus; Divers' masks; Diving suits; Ear plugs for divers; Electric installations for the remote control of industrial operations; Electrified fences; Electronic publications, downloadable; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglass frames; Face-shields (Workmen's protective); Fences (Electrified); Filters for respiratory masks; Fire (Clothing for protection against); Fire beaters; Fire blankets; Fire boats; Fire engines; Fire hose nozzles; Firemen (Asbestos screens

for); Furniture especially made for laboratories; Garments for protection against fire; Gates for car parks (Coin operated); Gloves for divers; Gloves for protection against accidents; Gloves for protection against X-rays for industrial purposes; Goggles for sports; Helmets (Protective); Helmets (Protective) for sports; Helmets (Riding); Holders for electric coils; Interfaces for computers; Juke boxes for computers; Kits (Hands free) for phones; Knee-pads for workers; Laboratories (Clothing especially made for); Locks, electric; Magnets; Magnets (Decorative); Masks (Divers); Masks (Protective); Masts for wireless aerials; Micrometer screws for optical instruments; Microscope slides (Containers for); Monitors (computer programs); Motor fire engines; Mouse pads; Nets (Safety); Nets for protection against accidents; Nose clips for divers and swimmers; Nozzles (Fire hose); Oxygen transvasing apparatus; Pads (Mouse); Peripheral devices (Computer); Pince-nez cases; Pince-nez chains; Pince-nez cords; Pince-nez mountings; Plotters; Programs (Computer) (downloadable software); Programs (Computer game); Programs (Computer operating) recorded; protection devices against X-rays (Roentgen rays), not for medical

purposes; Protection devices for personal use against accidents; Protective helmets; Protective helmets for sports; Protective masks; Protective suits for aviators; Publications (Electronic), downloadable; Push buttons for bells; Railway traffic safety appliances; Reflecting discs for wear, for the prevention of traffic accidents; Respirators for filtering air; Respirators, other than for artificial respiration; Respiratory masks, other than for artificial respiration; Restraints (Safety), other than for vehicle seats and sports equipment; Retorts' stands; Riding helmets; Road signs, luminous or mechanical; Roentgen rays (Protection devices against), not for medical purposes; Safety nets; Safety restraints, other than for vehicle seats and sports equipment; Safety tarpaulins; Screens for firemen (Asbestos); Shoes for protection against accidents, irradiation and fire; Signs, luminous; Software (Computer), recorded; Solderers helmets; Spark-guards; Spectacle cases; Spectacle frames; Sports (Goggles for); Sports (Protective helmets for); Stands for photographic apparatus; Steering apparatus, automatic, for vehicles; Teeth protectors; Theft prevention installations, electric; Traffic accidents

(Reflecting discs, for wear, for the prevention of); Tripods for cameras; Vehicle breakdown warning triangles; Vests (Am) (Bullet-proof); Waistcoats (Bullet-proof); Warning triangles (Vehicle breakdown); Wireless aerials (Masts for); Workmen's protective face-shields; Wrist rests for use with computers; X-rays (Protection devices against), not for medical purposes; Smartphones; Laptops; Tablets; Smart Driving Recorder; Intelligent Distance Recorder; Laser Projection TV; smart audio story devices; Smart Camera; Smart Rear View Mirror; Car Charger; smart electrical outlet; Smoke Alarm; Natural Gas Alarm; Wireless Hygrometer; Smart handheld transceiver; Kitchen Electronic scales; Scales that measure body fat for domestic use; telecommunication apparatus in the form of jewellery; phone holders for cars; e-book readers; learning machines; video monitors; head-mounted video displays; car TVs; Electric and electronic video surveillance Equipment; liquid crystal projectors; self sticking monopods for smart phones or cameras; air analysis instruments; gas detectors; audiovisual teaching instruments; speedometers for vehicles; measuring cups; gas analysis instruments; remote telemetry

<p>equipment; optical lenses; ultrasonic sensors; Sound alarms; Smoke detectors; Electric locks; Electronic anti-theft devices; Electronic anti-theft alarms; Digital door locks; 3D glasses; Mobile phone batteries; Charging devices for motor vehicles; Cartoon; Electric fences; Sunglasses; Home remote control; sensor; sleep sensor; security sensor Infrared Sensor; Temperature Sensor; Automatic Focusing Projector; Miniature Projector; Patch Panel; Security Camera Humanoid Robot with Artificial Intelligence; Intelligent Switch (Electrical); Smart Photo Printer; Mobile phones with style (decoration); TV monitor; TV with plasma display; LCD TV; HD TV; Car TV; TV receiver; Ultra HD TV; TV remote control; smart band; smartwatch.</p>	
--	--

53. Party B's "Smartphones" are identical to Party A's "Smartphones".

54. Party B's "Mobile phones" are identical to Party A's "Mobile telephones".

55. Party B's "Earphones for cellular telephones", "Wireless headsets for mobile phones", "Wireless headsets for smartphones", "Headsets for mobile telephones", "Headphones", "Earphones", "Headsets" and "Earbuds" are either identical to Party A's "headphones" or *Merix* identical in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.

56. Party B's "Mobile phone battery chargers" and "Power banks" are *Merix* identical to Party A's "chargers" in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.
57. Party B's "Batteries for mobile phones" are identical to Party A's "Mobile phone batteries".
58. Party B's "Tablet computers" is identical to Party A's "Tablet computer".
59. Party B's "Smart watches" is identical to Party A's "smartwatch".
60. Party B's "Smartbands" is identical to Party A's "smart band".
61. Party B's "Selfie sticks used as smartphone accessories" is identical to Party A's "self sticking monopods for smart phones or cameras".
62. Party B's "Smart speakers" are *Merix* identical to Party A's "sound reproduction apparatus" in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.
63. I compare Party B's "Smart glasses" with Party A's "Smartphones". While the former goods are worn on the head, the latter are held in the hand. However, they are both hi-tech, internet-enabled devices which have display, telephone, camera, and GPS functionality, with some smart glasses operating on a standalone basis, and others being dependent on interfacing with a smartphone. They share the same method of use – operation by touch or voice command – and users – members of the general public. Both goods are sold through the same trade channels – "tech" retailers. For standalone smart glasses, they are in competition in that both goods perform the same basic functions which means that the consumer will face a real choice as to which one to buy. Where the smart glasses are not standalone, there is complementarity in that a smartphone will be indispensable in such a way that customers may think that the responsibility

for the goods lies with the same undertaking. I find the respective goods to be highly similar.

64. I compare Party B's "Protective cases for mobile phones", "Stands adapted for mobile phones", "Mobile phone display screen protectors in the nature of films", "Displays for mobile phones", "Keyboards for mobile phones", "USB cables for cellphones", "Cases for mobile phones" and "Mobile phone straps" with Party A's "Mobile telephones". As accessories or replacement parts for mobile phones, while they have specific purposes and methods of use, they support the overall purpose of a mobile phone, and they share the same users – mobile phone users. They are sold through the same trade channels – mobile phone retailers. They are not in competition, but they are complementary in that a mobile phone will be indispensable to mobile phone accessories and replacement parts in such a way that customers may think that the responsibility for the goods lies with the same undertaking. I find the respective goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

65. 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 the goods are likely to be selected by the average consumer. 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.”

66. In the case of mobile phones, tablet computers, and smart products (phones, watches, bands, and glasses), the purchase would be made by a member of the general public. The purchasing process would require some attention as to the design and functionality of the product and the consumer might do some research before proceeding to buy it. There are budget models of such products available on the market as well as expensive ones. The purchasing process would require a medium degree of attention.
67. Accessories for mobile phones, tablet computers and smart products would also be bought by a member of the general public. While functionality would be more important than design in these cases, the consumer would pay attention as to whether the accessories were compatible with their mobile phones, tablet computers and smart products. The level of attention required would be medium.
68. For both the core goods and their accessories, the purchasing process would be one where visual considerations predominate, with verbal factors playing a minor role.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater

degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponents' trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that they have retained in their mind.

70. When compared with Party B's mark, I have found Party A's mark to be highly similar visually, of medium or medium to high similarity aurally, and conceptually neutral. The goods are either identical, highly similar, or of medium similarity. The average consumer, a member of the public, will pay a medium level of attention when purchasing the goods, with visual considerations predominating. The earlier mark is of a low to medium level of inherent distinctiveness.
71. Party B's mark is wholly contained within Party A's mark, being identical to the first two characters of Party A's mark. Party A's mark has only one extra character, an additional "1" to the "1" that is already present in both marks. I consider that this is a case where direct confusion is likely on the basis of the principle of imperfect recollection. Imperfect recollection is emphasised in this case given the conceptual neutrality that exists between the marks, with the consequence that neither provides a conceptual hook on which to base future recall. This, together with the closeness of the marks as I have assessed them and the fact that the goods are identical, highly similar, or of medium similarity, leads me to the conclusion that there is a likelihood of direct confusion.
72. If I am wrong, "X1" and "X11" would be plausible brand variations of "X" brand smart phones, tablet computers, and so on, such that I would make a finding of a likelihood of indirect confusion.

73. As the applicant has been successful based on the “X11” mark, I do not need to consider the cancellation application under the other earlier marks.

Conclusion

74. Party A’s cancellation application has been successful. Subject to appeal, the contested registration will be declared invalid in its entirety.

Second case - CA000504301

Comparison of the trade marks

75. Party A’s and Party B’s marks are shown below:

Party A’s earlier trade marks	Party B’s trade mark
X45	X4
X14	
7X	
Xtra	

76. Although Party A relied on the argument that the marks relied upon form a “family of marks”, it did not file any evidence. Hence, my approach would have been to consider each mark separately. However, since I consider Party A’s “X45” and “X14” marks to be their strongest marks by comparison with Party B’s mark, I will begin doing a comparative analysis of these marks because if I find a likelihood of confusion in these respects, then it will not be necessary to consider Party A’s other marks.

Party A’s “X45” mark

77. Party B’s word mark is “X4”, this letter and number being the only things that contribute to the overall impression.

78. Party A's word mark is "X45", the letter and number or numbers being the only things that contribute to the overall impression.
79. Visually, the marks only differ in that Party A's mark has an additional "5", the two marks sharing the same first and second characters and Party B's mark being incorporated within Party A's mark. The two marks are highly similar visually.
80. Aurally, Party B's mark is "EX FORE" and Party A's mark is "EX FORE-TEE-FYVE", or "EX FORE FYVE". In the former scenario, Party B's mark is phonetically identical to the first two parts of Party A's mark, Party A's mark having third and fourth parts that are different. In this scenario, I find the respective marks to be of medium similarity aurally. In the latter scenario, Party B's mark is phonetically identical to the first and second elements of Party A's mark, the third element being different. In the latter scenario, I find the respective marks to be of medium to high aural similarity.
81. Conceptually, the two marks consist of the letter "X" followed by the numbers "4" or "45"/"4,5". The marks do not give rise to a particular concept and would be perceived as a random letter with a random number or numbers, the combinations thereof not having a specific meaning. The marks are conceptually neutral.

Distinctive character of the earlier mark

82. The earlier mark "X45" is not suggestive or allusive of the goods for which the mark is registered. The characters that make up the mark form neither invented nor dictionary words. However, they are simply a letter and a number or numbers. While numerals and letter/number combinations are accepted as trade marks provided that they appear sufficiently random to individualise the goods/services of one undertaking, they are not particularly distinctive. As such, I consider the earlier mark to be of low to medium distinctive character.

Comparison of the goods

83. The competing goods, all of which are in Class 9, are as follows:

Party A's goods	Party B's goods
<p>Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; smartglasses; smartwatches; smartphones; wearable activity trackers; cases for smartphones; covers for smartphones; protective films</p>	<p>Smartphones; Mobile phones; Earphones for cellular telephones; Protective cases for mobile phones; Stands adapted for mobile phones; Mobile phone display screen protectors in the nature of films; Mobile phone battery chargers; Displays for mobile phones; Keyboards for mobile phones; Batteries for mobile phones; Wireless headsets for mobile phones; Wireless headsets for smartphones; Headsets for mobile telephones; USB cables for cellphones; Power banks; Cases for mobile phones; Mobile phone straps; Selfie sticks used as smartphone accessories; Smart glasses; Smart watches; Smartbands; Smart speakers; Tablet computers; Headphones; Earphones; Headsets; Earbuds.</p>

adapted for smartphones; selfie sticks [hand-held monopods]; digital photo frames; microphones; computer hardware; computer memory devices; integrated circuit cards [smart cards]; transponders; cabinets for loudspeakers; network communication equipment; modems; sleeves for laptops; batteries, electric; chargers for electric batteries; portable power supplies (rechargeable batteries); tablet computers; covers for tablet computers; stands adapted for tablet computers; flat panel display screens; flexible flat panel displays for computers; laptop computers; notebook computers; bags adapted for laptops; headphones; earphones; virtual reality headsets; automobile data recorder; set-top boxes; loudspeakers; portable media players; sound transmitting apparatus; camcorders; cameras [photography]; computer keyboards; mouse [computer peripheral]; pedometers; monitoring apparatus, other than for medical purposes; video monitors; connected bracelets [measuring instruments]; computer programs, recorded; computer software applications, downloadable; optical lenses; switchboards; transmitters of electronic signals; transmitting sets [telecommunication]; gas testing

instruments; black boxes [data recorders]; interactive touch screen terminals; humanoid robots with artificial intelligence; electronic sheet music, downloadable; smart rings; audio interfaces; electric and electronic effects units for musical instruments; equalizers [audio apparatus]; digital weather stations; biochips; infrared detectors; electronic key fobs being remote control apparatus; security tokens [encryption devices]; fingerprint identifiers; human face recognition devices; programme-controlled telephone exchange equipment; radios; air analysis apparatus; materials for electricity mains [wires, cables]; video screens; integrated circuits; electronic chips; thermal imaging cameras; weighing scales; scales with body mass analysers; personal digital assistants [PDAs]; computer software platforms, recorded or downloadable; thin client computers; hand-held electronic dictionaries; computer screen saver software, recorded or downloadable; computer software, recorded; downloadable graphics for mobile phones; wearable computers; telecommunication apparatus in the form of jewellery; selfie sticks for use with smartphones; security surveillance robots; wearable video display monitors;

<p>selfie lenses; laboratory robots; teaching robots; USB cables; USB cables for mobile phones; downloadable applications for use with mobile devices; holders for cell phones; touch screens; television apparatus; electric plugs; electric sockets; intercoms; digital door lock; central alarm; transducers; downloadable emoticons for mobile phones; computer operating programs, recorded; large-screen liquid crystal displays [LCDs]; electronic diaries; liquid crystal display [LCD] screens; electronic pens; video printers; portable digital electronic scales; wrist-mounted smartphones; car televisions; computer styluses; computer programs, downloadable; touch screen pens; scales.</p>	
--	--

84. Party B’s “Smartphones” are identical to Party A’s “smartphones”.

85. Party B’s “Mobile phones” are identical to Party A’s “smartphones”, being in this day and age interchangeable terms, or *Merix* identical in that a smartphone could be said to be a type of mobile phone (the other type of mobile phone being a “dumb” phone). If I am wrong, the respective goods are at least highly similar, both being portable phones, sharing the same users, the same principal communication functions, and the same trade channels.

86. Party B’s “Earphones for cellular telephones”, “Wireless headsets for mobile phones”, “Wireless headsets for smartphones”, “Headsets for mobile telephones”, “Headphones”, “Earphones”, “Headsets” and “Earbuds” are

either identical to Party A's "headphones" or *Merix* identical in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.

87. Party B's "Mobile phone battery chargers" and "Power banks" are *Merix* identical to Party A's "chargers for electric batteries" in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.
88. Party B's "Batteries for mobile phones" are *Merix* identical to Party A's "portable power supplies (rechargeable batteries)" in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.
89. Party B's "Tablet computers" are identical to Party A's "tablet computers".
90. Party B's "Smart watches" is identical to Party A's "smartwatches".
91. Party B's "Smartbands" are identical to Party A's "wearable activity trackers".
92. Party B's "Selfie sticks used as smartphone accessories" is identical to Party A's "selfie sticks for use with smartphones".
93. Party B's "Smart speakers" are *Merix* identical to Party A's "loudspeakers" in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.
94. Party B's "Smart glasses" are identical to Party A's "smartglasses".
95. Party B's "Protective cases for mobile phones" and "Cases for mobile phones" are identical or at least highly similar to Party A's "cases for smartphones".

96. Party B's "Mobile phone display screen protectors in the nature of films" are identical or at least highly similar to Party A's "protective films adapted for smartphones".
97. Party B's "USB cables for cellphones" are *Merit* identical to Party A's "USB cables" in that the goods designated by the later trade mark are included in a more general category designated by the earlier mark.
98. I compare Party B's "Stands adapted for mobile phones" with Party A's "stands adapted for tablet computers". Both would be made of the same materials, metal or plastic, and both have the purpose of holding a device in a fixed position. They have the same broad category of users – owners of devices. They are sold through the same trade channels (retailers of devices) and they would be found in the same part of the such virtual or physical shops. They are neither complementary, nor are they in competition. I find these goods to be of medium similarity.
99. I compare Party B's "Displays for mobile phones", "Keyboards for mobile phones" and "Mobile phone straps" with Party A's "smartphones". As replacement parts or accessories for mobile phones (which I consider to be identical or at least highly similar to smart phones), while they have specific purposes and methods of use, they support the overall purpose of a mobile phone/smart phone, and they share the same users – mobile phone/smart phone users. They are sold through the same trade channels – mobile phone/smart phone retailers. They are not in competition, but they are complementary in that a mobile phone/smart phone will be indispensable to mobile phone/smart phone accessories and replacement parts in such a way that customers may think that the responsibility for the goods lies with the same undertaking. I find the respective goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

100. See paragraphs 66 to 68.

Likelihood of confusion

101. When compared with Party B's mark, I have found Party A's mark to be highly similar visually and of medium or medium to high aural similarity and I have found the marks to be conceptually neutral. The goods are either identical, highly similar, or of medium similarity. The average consumer, a member of the public, will pay a medium level of attention when purchasing the goods, with visual considerations predominating. The earlier mark is of a low to medium level of inherent distinctiveness.
102. Party B's mark is wholly contained within Party A's mark, being identical to the first two characters of Party A's mark. Party A's mark has only one extra character, an additional "5". I consider that this is a case where direct confusion is likely on the basis of the principle of imperfect recollection. Imperfect recollection is emphasised in this case given the conceptual neutrality that exists between the marks, with the consequence that neither provides a conceptual hook on which to base future recall. This, together with the closeness of the marks as I have assessed them and the fact that the goods are identical, highly similar, or of medium similarity, leads me to the conclusion that there is a likelihood of direct confusion.
103. If I am wrong, "X4" and "X45" would be plausible brand variations of "X" brand smart phones, tablet computers, and so on, such that I would make a finding of a likelihood of indirect confusion.

Party A's "X14" mark

104. Party B's word mark is "X4", this letter and number being the only things that contribute to the overall impression.
105. Party A's word mark is "X14", the letter and number or numbers being the only things that contribute to the overall impression.

106. Visually, the marks only differ to the extent that Party A's mark has one additional character, a "1". Either side of the "1" are the characters "X" and "4" which constitute Party B's mark. The marks are highly similar visually.
107. Aurally, Party B's mark is "EX FORE" and Party A's mark is "EX FORE-TEEN", or "EX WUN FORE". In the former scenario, Party B's mark is phonetically identical to the first two parts of Party A's mark, Party A's mark having a third part which is different. In the latter scenario, Party B's mark is identical in the first and third element. In either scenario, the respective marks are highly similar aurally.
108. Conceptually, the two marks consist of the letter "X" followed by the numbers "4" or "14"/"1,4". The marks do not give rise to a particular concept and would be perceived as a random letter with a random number or numbers, the combinations thereof not having a specific meaning. The marks are conceptually neutral.

Distinctive character of the earlier mark

109. The earlier mark "X14" is not suggestive or allusive of the goods for which the mark is registered. The characters that make up the mark form neither invented nor dictionary words. However, they are simply a letter and a number or numbers. While numerals and letter/number combinations are accepted as trade marks provided that they appear sufficiently random to individualise the goods/services of one undertaking, they are not particularly distinctive. As such, I consider the earlier mark to be of low to medium distinctive character.

Comparison of the goods

110. The respective goods and the comparison are the same as set out in paragraphs 52 to 64.

The average consumer and the nature of the purchasing act

111. See paragraphs 66 to 68.

Likelihood of confusion

112. When compared with Party B's mark, I have found Party A's mark to be highly similar visually and aurally and I have found the marks to be conceptually neutral. The goods are either identical, highly similar, or of medium similarity. The average consumer, a member of the public, will pay a medium level of attention when purchasing the goods, with visual considerations predominating. The earlier mark is of a low to medium level of inherent distinctiveness.

113. The marks only differ to the extent that Party A's mark has one additional character, a "1". Either side of the "1" are the characters "X" and "4" which constitute Party B's mark. I consider that this is a case where direct confusion is likely on the basis of the principle of imperfect recollection. Imperfect recollection is emphasised in this case given the conceptual neutrality that exists between the marks, with the consequence that neither provides a conceptual hook on which to base future recall. This, together with the closeness of the marks as I have assessed them and the fact that the goods are identical, highly similar, or of medium similarity, leads me to the conclusion that there is a likelihood of direct confusion.

114. If I am wrong, "X4" and "X14" would be plausible brand variations of "X" brand smart phones, tablet computers, and so on, such that I would make a finding of a likelihood of indirect confusion.

115. As the applicant has been successful based on my analysis of the "X45" and "X14" marks, I do not need to consider the cancellation application under the other earlier marks.

Conclusion

116. Party A's cancellation application has been successful. Subject to appeal, the contested registration will be declared invalid in its entirety.

Overall conclusion

117. Party A's cancellation applications have been successful. Subject to appeal, the contested registrations - UK00918227155 and UK00918227159 - will be declared invalid in their entirety.

Costs

118. Party A has been the successful party in this case. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to Party A as below, noting that its statements were detailed.

Preparing statements and considering the other side's statements, 2 x £400:	£800
Preparation of submissions:	£300
Official fees, 2 x £200:	£400
Total:	£1500

119. I order VIVO MOBILE COMMUNICATION CO., LTD ("Party B") to pay Honor Device Co., Ltd. ("Party A") £1500. 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 7th day of October 2022

JOHN WILLIAMS

For the Registrar