

**O-028-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3196043**

**BY VIVO INTERNATIONAL LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 1, 2, 4, 7,8, 9, 21,  
27, 29, 30, 31, 32, 35, 36, 38, 40, 41 & 42:**

**VIVO.COM**

**AND**

**OPPOSITION THERETO (No. 408608) BY BBK COMMUNICATION  
TECHNOLOGY CO., LTD**

## **Background and pleadings**

1. The trade mark **VIVO.COM** was filed by Vivo International Limited (“the applicant”) on 10 November 2016. It was published for opposition purposes on 20 January 2017 for goods and services in various classes (as listed on the cover page of this decision). Registration is opposed by BBK Communication Technology Co., Ltd (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies on two International registrations, one of which designated the UK for protection, the other the EU. Neither has yet to achieve protection. Both earlier marks consist of the word **VIVO** (in a particular form of presentation). The opponent only opposes the registration of the mark in classes 9, 35, 38 & 42. At the hearing that took place before me, the opponent agreed that it was only necessary to focus on one of the earlier marks, because the specification of the other was narrower. In view of this, the alleged conflicting marks and the relevant goods/services can be seen in the attached table:

<b>Applicant’s mark</b>	<b>Opponent’s mark</b>
Application 3196043  <b>VIVO.COM</b>  Filed on 10/11/17 Published on 20/1/17  <b>Class 9:</b> Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying	International registration 1180032    Date of EU designation 20/6/2013 Status: Application received  <b>Class 9:</b> Computers; computer peripheral devices; notebook computers; electronic publications, downloadable; counters; apparatus to check franking; false coin detectors; ticket dispensers; electronic tags for goods; weighing apparatus and instruments; measures; electronic notice boards; surveying instruments; meteorological instruments;

electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

**Class 35:** Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; arranging of contracts for the purchase and sale of goods and services, for others; compilation of computer databases; office functions; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

**Class 38:** Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video

taximeters; pressure measuring apparatus; audiovisual teaching apparatus; high-frequency apparatus; probes for scientific purposes; microscopes; cables, electric; semi-conductors; printed circuits; conductors, electric; remote control apparatus; optical fibers, light conducting filaments; electric installations for the remote control of industrial operations; lightning conductors; electrolysers; fire extinguishers; radiological apparatus for industrial purposes; clothing for protection against accidents, irradiation and fire; theft prevention installations, electric; films, exposed; decorative magnets; socks, electrically heated; aerials; transmitters of electronic signals; transmitters of electronic signals; navigational instruments; telephone apparatus; portable telephones; transformers [electricity]; fluorescent screens; photo telegraphy apparatus; intercommunication apparatus.

and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

**Class 42:** Technical design and planning of telecommunications equipment; technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

2. As the earlier mark has yet to achieve protection, it is not subject to the requirement to show genuine use as per section 6A of the Act.

3. The applicant filed a counterstatement denying the grounds of opposition. It accepts that the goods in class 9 are “somewhat similar”, but denies that there is any similarity between the other goods/services. It denies that the marks are similar and denies that there is a likelihood of confusion. The counterstatement included more detailed submissions than this, submissions of which I have taken due regard.

4. Neither side filed evidence, but both filed written submissions instead. A hearing took place before me on 6 December 2017 at which the opponent was represented by Mr Michael Conway of Haseltine Lake. The applicant (who is unrepresented) did not attend the hearing, nor did it file any written submissions in lieu.

## **Section 5(2)(b)**

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

“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.”

6. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case 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.

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

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

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

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

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

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

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

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

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

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

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

## Comparison of goods/services

7. Goods/services may be considered identical if they fall within the ambit of a term in the competing specification (or vice versa) (I refer to this later as the “inclusion principle”), as per the guidance provided by the General Court (“GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“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 fur 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”.

8. In terms of similarity, when making a comparison, all relevant factors relating to the goods/services in question should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

9. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

10. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

11. I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE*, where he warned against applying too rigid a test:



“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

12. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [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.”

---

<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

13. In its counterstatement, the applicant, whilst accepting that some of the goods in class 9 were “somewhat similar”, stated that one must guard against finding similarity merely on the basis of similar language being used (reference is made to the judgment of the CJEU in Case T-336/03 – *Mobilix v Obelix*) and, further, that merely because the earlier mark has a far-ranging specification does not mean that everything in the same class should be found to be similar. It also made some specific points about particular clashes both in its statement of case and in its written submissions. Specific points were also made by the opponent in both its written submissions and at the hearing that took place before me. I will start my comparison with the applied for goods in class 9. Registration is sought for:

Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

the earlier mark covers:

Computers; computer peripheral devices; notebook computers; electronic publications, downloadable; counters; apparatus to check franking; false coin detectors; ticket dispensers; electronic tags for goods; weighing apparatus and instruments; measures; electronic notice boards; surveying instruments; meteorological instruments; taximeters; pressure measuring apparatus; audiovisual teaching apparatus; high-frequency apparatus; probes for scientific purposes; microscopes; cables, electric; semi-conductors; printed circuits; conductors, electric; remote control apparatus; optical fibers, light conducting filaments; electric installations for the remote control of industrial operations; lightning conductors; electrolyzers; fire extinguishers; radiological apparatus for industrial purposes; clothing for protection against accidents, irradiation and fire; theft prevention installations, electric; films, exposed; decorative magnets; socks, electrically heated; aerials; transmitters of electronic signals; transmitters of electronic signals; navigational instruments; telephone

apparatus; portable telephones; transformers [electricity]; fluorescent screens; photo telegraphy apparatus; intercommunication apparatus.

14. Mr Conway submitted that all of the applied for goods in class 9 (with the exception of batteries) were either identically worded to, or fell within the ambit of, terms in the earlier mark's specification. Whilst this submission is noted, I do not agree that it is as straightforward as that. I will, therefore, consider the specification term by term (albeit grouping them where possible):

#### Computer hardware

15. The earlier mark covers peripherals. I accept that computer hardware includes peripherals and, as such, the goods are identical on the inclusion principle. If they are not identical then they must be highly similar.

#### Computer software

16. Mr Conway submitted that such goods were peripherals and, as such, were identical on the inclusion principle. I do not agree. It would be a strain of the language to construe software as a peripheral. Nevertheless, I agree with Mr Conway that there is at least a medium degree of similarity to computers (which are covered by the earlier mark) because of the key complementary relationship that exists between them.

#### Computer peripherals; computer networking and data communications equipment; keyboards

17. As already stated, the earlier mark covers computer peripherals which is clearly identical to the equivalent term in the applicant's specification. Furthermore, the other items listed above can clearly be construed as peripherals and, as such, are identical on the inclusion principle.

### Electronic data processing equipment

18. The key type of such equipment is a computer, which are covered by the earlier mark's specification. As such, the goods are identical on the inclusion principle.

### Computer components and parts; micro processors

19. A computer component (and microprocessor) is an item used in the internals of a computer, whereas a peripheral is normally something attached to it. Therefore, I do not consider that these goods are identical. However, given the similarity in nature, purpose, trade channels and the complementary relationship that exists between them, I still consider the goods (computer components and peripherals) to be highly similar to each other. Computer components, for similar reasons, are also highly similar to the computers of the earlier mark.

### Electronic memory devices

20. An electronic memory device could be an external one, to be attached or connected to a computer. This would, therefore, fall within the ambit of the opponent's peripherals and the goods identical on the inclusion principle.

### Electronic control apparatus

21. The earlier mark covers "remote control apparatus" and is identical on the inclusion principle.

### Programmed-data-carrying electronic circuits

22. These fall within the ambit of, and thus identical to, the opponent's "printed circuits".

### Wires for communication

23. This terms falls within the opponent's intercommunication apparatus and is identical on the inclusion principle. It is also, essentially, the same as the opponent's cables and fibres covered by its specification.

### Electrodes

24. An electrode is an electrical conductor and, thus, falls within the ambit of, and is identical to, the opponent's "conductors, electric".

### Aerials; telephones

25. Aerials and telephones are covered specifically by the earlier mark and, therefore, are identical.

### Video films

26. The opponent's submissions focus on its "films, exposed". There is no reason why such films could not be video film. Hence, the goods are identical on the inclusion principle. Further, I consider that video films are also similar to electronic publications at least to a medium degree as both could provide electronic information relating to a particular field.

### Batteries

27. That then leaves batteries. I accept the opponent's submission that there is a key complementary relationship between a battery and the type of goods which they power, particularly where the battery forms an integral part of a device such as in a (portable) computer (as covered by the earlier mark). I consider the goods to be similar to a medium degree.

28. I now turn to the applied for services in class 35, which read:

Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; arranging of contracts for the purchase and sale of goods and services, for others; compilation of computer databases; office functions; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

29. The opponent's mark covers only the class 9 goods listed earlier. Again, I will go through the applicant's specification term by term:

Provision of information and advice to consumers regarding the selection of products and items to be purchased; demonstration of goods for promotional purposes

30. Mr Conway submitted that such terms should be treated in an analogous way to retail services (when compared to goods) and that there exists at least a moderate degree of similarity on a complementary basis. However, it is now a requirement that retail services be specified in connection with particular goods (see the *Praktiker Case C-418/02*) which at least enables a decision maker to ascertain whether the type of relationship between the goods and the retailing of them is of the type where the average consumer will understand a complementary relationship to exist. Such a requirement (to specify the goods) does not apply to the applied for terms. Thus, it appears to me that the above terms are not part-and-parcel of a retail service, or analogous thereto, and represent more middle-man services, independently providing consumer advice and demonstration of goods. Whilst this does not rule out similarity, I am not persuaded that that type of service is complementary (in the sense set out by the case-law) to any goods, let alone the goods on which Mr Conway relies in class 9. There is no similarity here.

Exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes

31. For similar reasons to that given above, which I think are even clearer with regard to these services, there is no similarity here.

Arranging of contracts for the purchase and sale of goods and services, for others

32. Again, I consider these to be middleman, broker type services, and are not analogous with retail services. There is no similarity here.

Compilation of computer databases

33. Mr Conway's submissions focused on the earlier mark's computers and electronic publications. The submission was based upon complementarity of the service (to the goods) given that it was for the computerisation of data. I am not persuaded that a complementary relationship exists. Whilst a computer is no doubt needed to create a database, it does not follow that the relationship between a computer and a database compilation service is such that the consumer would understand that the responsibility for those goods/services lies with the same undertaking. I see no better argument in relation to publications which, in my view, would not cover databases anyway.

Office functions; Employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

34. I see no obvious reason why such services should be held to be similar to any of the opponent's goods in class 9. No submissions were made at the hearing. The goods/services are not similar.

35. I next turn to the services in class 38 which read:

Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network;

transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

36. Although the opponent's mark covers only class 9 goods, Mr Conway highlighted that its specification covers "intercommunication apparatus" and various other specific pieces of communication equipment. He submitted it was not uncommon for service providers to offer their own equipment to facilitate the use of the service, and vice versa. I agree with him that this not only creates a complementary relationship, but there is also a similarity in purpose and also trade channels. I consider this type of relationship to exist with all of the applied for services. There is a medium degree of similarity.

37. I finally consider the class 42 services which read:

Technical design and planning of telecommunications equipment; technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

38. Again, I will go through the applicant's specification term by term:

Technical design and planning of telecommunications equipment

39. Mr Conway submitted that for business to business services in this field, the consumer may require such technical services to develop a telecommunication infrastructure and that there would be some similarity with the opponent's intercommunication apparatus and that the latter will be used in conjunction with the former. I agree that both the goods and the services may be offered by the same undertaking as part of an overall communications solution and that this creates a



similarity in purpose, trade channels and a complementary relationship. I consider there to be a moderate (between low and medium) level of similarity here.

#### Technical research services

40. Mr Conway submitted that as the opponent's specification covered both telecommunications type goods and, also, certain scientific goods, some form of similarity existed. I do not agree. The services are for research. The only potential argument I can see would be based on some form of complementarity, but that type of relationship, absent evidence to the contrary, would not appear to be in play. There is no similarity here.

#### Computer software technical support services; Technical consultancy relating to the application and use of computer software

41. Mr Conway relied on the opponent's term "computers" because when a computer is sold, offered alongside will often be support and consultation relating to the use of the computer and the software thereon. I agree that this creates some similarity, but of only a low degree.

#### Technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

42. I see no obvious reason why such services should be held to be similar to any of the opponent's goods in class 9. No submissions were made at the hearing. The goods/services are not similar.

#### **Average consumer and the purchasing act**

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc*,

*Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

44. Where I have found similarity/identity, the goods are, generally speaking, used for computing purposes and the services for telecommunication or technical networking development. For the goods, the average consumer could be a member of the general public purchasing goods for home use, or, alternatively a business user, including IT specialists. The same applies to the class 38 services. However, in respect of the class 42 services, the average consumer is more likely to be a business user.

45. The goods and services are likely to be selected by predominantly visual means, through self-selection, websites and brochures/catalogues. However, this is the sort of area where the average consumer may speak to sales advisors/consultants regarding issues such as compatibility and performance, network requirements etc. Thus, the aural impacts of the marks also play a factor in the selection process. The goods/services will range in price but will include those which are not prohibitively expensive, so, in general, a normal level of care will be used in their selection. That said, the choice of a telecoms provider is likely to be reasonably well considered (greater than the norm), as will the choice of a service provider for the services in class 42.

### **Comparison of marks**

46. 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.”

47. 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. The marks I am comparing are:

**VIVO.COM** v **vivo**

48. In terms of overall impression, VIVO.COM consists of what will be perceived as a domain name. Although this creates a unit, within this, the VIVO element has greatest relative weight on account of .COM merely signifying the type of top level domain. In terms of the applied for mark, this consists of the word vivo presented in a particular but unremarkable font. The word itself is the aspect of the mark which has by far the greatest relative weight.

49. Visually, both marks begin with the letters VIVO/vivo. That one is in upper case and the other lower, makes little difference. This is not only because the applied for mark could, notionally, be used in both upper and lower case lettering, but also because there is little difference between the lower case letters (v/i/o) and their capitalised counterparts (V/I/O). Whilst the stylisation of the earlier mark also constitutes a difference, I agree with Mr Conway that its impact is minor. There is one

final difference, the addition of .COM in the applied for mark, which I also factor in. Weighing the similarities and differences, and bearing in mind the overall impressions of the marks, I consider there to be a reasonably high degree of visual similarity between the marks.

50. VIVO and vivo will be articulated in the same way in both marks. However, the earlier mark has the added two syllables DOT COM. Nevertheless, bearing in mind the overall impressions of the marks, and because VIVO will be the first part of the applicant's mark that will be heard, I still consider there to be a reasonably high degree of aural similarity.

51. I do not consider that the average consumer will form any conceptual meaning based upon the word VIVO/vivo. Thus, no conceptual similarity exists. I bear in mind that one mark will be perceived as a domain name, the other not, so creating some conceptual difference, albeit, not in my view a strong one.

### **Distinctive character of the earlier mark**

52. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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).”

53. No use of the earlier mark has been provided so I have only its inherent characteristics to consider. The word vivo has no meaning. It will be seen as an invented word and has, in my view, a high level of inherent distinctive character.

#### **Likelihood of confusion**

54. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

55. For the services which I have found no similarity, there can be no finding of a likelihood of confusion. Thus, I will say no more about them.

56. For the goods and the remaining services, I have found some of them to be identical or highly similar, but some have lower degrees of similarity. However, notwithstanding this, I consider there to be a likelihood of confusion in relation to all. The addition of .COM to a word of a high degree of distinctiveness may be something which is overlooked or forgotten given that the average consumer is so used to seeing brands used as part of a corresponding domain names. Even if the difference is noted, the average consumer is well used to associating (economically) the brand and the

domain name. This, coupled with the degree of similarity between the goods/service, leads me to conclude that the average consumer will, at the very least, assume all of the goods/services I have found to be similar or identical to be the responsibility of the same or an economically related undertaking.

## **Conclusion**

57. My final conclusion would, subject to what I say below, be that the opposition succeeds in relation to:

**Class 9:** Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

**Class 38:** Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

**Class 42:** Technical design and planning of telecommunications equipment; computer software technical support services; technical consultancy relating to the application and use of computer software;

but fails in relation to:

**Class 35:** Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or

advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; arranging of contracts for the purchase and sale of goods and services, for others; compilation of computer databases; office functions; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

**Class 42:** Technical research services; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

58. However, as the earlier mark on which this decision is based has yet to achieve protection, my decision is merely provisional. The outcome is, thus, dependant on the successful protection of the earlier mark. In view of this, I cannot yet set an appeal period until a final decision is confirmed.

59. The opponent is hereby directed to inform the tribunal when the earlier mark is either granted or refused protection. If it is granted protection, the goods for which protection has been granted must also be set out. I will then make a final decision based upon the status of the earlier mark.

60. In terms of costs, I will give a provisional decision now based upon the outcome as it currently stands. If some different outcome applies (due to the earlier mark being refused or being protected for less than it currently covers) I will revise my costs award. My provisional decision is that although both sides have achieved a measure of success, the opponent has been the more successful party and is, therefore, entitled to a contribution towards its costs, albeit a reduced one to reflect the partial nature of its success. My provisional assessment, based upon the published scale, and reduced accordingly, is set out below:

*Official fee - £100*

*Preparing a statement of case and considering the counterstatement - £150*

*Written submissions at evidence stage – £200*

*Attending the hearing - £250*

***Total - £700***

61. The period for paying such costs will be set when a final decision is issued.

**Dated this 12<sup>th</sup> day of January 2018**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**