

O/0134/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3571763
BY SHENZHEN HONOR ELECTRONIC CO., LTD
TO REGISTER THE FOLLOWING TRADE MARK:**



honoto

IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 424780
BY HONOR DEVICE CO., LTD.**

Background and pleadings

1. On 23 December 2020, Shenzhen Honor Electronic Co., Ltd (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3571763 (“the contested mark”). Details of the application were published for opposition purposes on 5 March 2021. Registration is sought for the following goods:

Class 9: Moveable sockets; electric sockets; power adapters; smart rings; data processing apparatus; card reading equipment; computer terminals; protective films adapted for smartphones; mobile phone holders for vehicles; cell phone cases; dashboard cameras; holders for cell phones; integrated circuits; smartwatches; integrated circuit cards; memory card readers; biometric scanners; flash memory card adapters; couplers [data processing equipment]; car antennas; electronic controls for electric motors, namely electronic power controllers.

2. Honor Device Co., Ltd. (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies upon the following trade marks:

The logo for Honor, featuring the word "honor" in a stylized, lowercase, blue font. The letters are rounded and connected at the top, with a distinctive shape for the 'o' and 'n'.

EUTM no. 17933668

Filing date: 24 July 2018

Registration date: 22 June 2020

¹ I note that the name of the opponent was originally given in the Form TM7 filed on 3 June 2021 as Huawei Technologies Co., Ltd. However, by email dated 29 June 2021, the opponent’s representatives advised that ownership of the earlier marks had been assigned to the opponent. The opponent’s representatives provided confirmation from the EUIPO that the assignment of the first, second and third earlier marks to the opponent was recorded on 17 May 2021. Moreover, the opponent’s representatives provided a copy of a Form TM16 filed at the Registry on 17 May 2021 which concerned the assignment of the fourth earlier mark to the opponent. I note that the assignment was confirmed in a letter from the Registry dated 19 June 2021. In its email, the opponent’s representatives confirmed that the opponent was continuing with the opposition in place of Huawei Technologies Co., Ltd. Attached to its email was an amended Form TM7 which reflected this.

("the first earlier mark")

HONOR

EUTM no. 16266876

Filing date: 19 January 2017

Registration date: 28 December 2017

("the second earlier mark")

HONOR GO

EUTM no. 18154517

Filing date: 18 November 2019

Registration date: 11 June 2020

Priority date: 6 June 2019 (China)

("the third earlier mark")

HONOR GO

UKTM no. 3445062

Filing date: 18 November 2019

Registration date: 7 February 2020

Priority date: 6 June 2019 (China)

("the fourth earlier mark")

3. The earlier marks are registered for a wide range of goods and services covering multiple classes. However, for the purposes of the opposition, the opponent only relies upon the goods in class 9 of its registrations. These are set out in full in the annex to this decision.

4. Given the respective filing dates, the opponent's marks are earlier marks in accordance with section 6 of the Act.² As they had not completed their respective registration processes more than five years before the filing date of the contested

² Although the UK has left the EU and the transition period has now expired, EUTMs, such as the first, second and third earlier marks, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

mark, they are not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods identified, without having to demonstrate genuine use.

5. In its notice of opposition, the opponent contends that the contested mark is similar to each of its earlier marks. It also argues that the parties' goods are identical and similar. Based upon these factors, it submits that there is a likelihood of confusion.

6. Following an initial cooling off period, the applicant filed a counterstatement denying the ground of opposition. The applicant denies that the competing trade marks are similar and that the parties' goods are identical or similar. It also disputes the existence of a likelihood of confusion.

7. Both parties are professionally represented; the opponent by Forrester IP LLP and the applicant by Trademarkit LLP. Neither party filed evidence in these proceedings, nor did they request an oral hearing. Only the applicant elected to file written submissions in lieu of attendance, though I note that the opponent filed written submissions during the evidence rounds. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

Preliminary remarks

9. In its written submissions, the applicant attempts to give evidence as to the background of the company and activities conducted in connection with the 'HONOTO' brand. It also provides a list of its UK trade mark registrations and highlights that some predate the marks relied upon by the opponent in these proceedings. It provides details of the parties' registrations in other countries in an appendix and argues that the marks have coexisted for a number of years. In addition, the applicant has included

an extract from a decision of the Intellectual Property Office of China from previous proceedings involving the parties.

10. Firstly, I must clarify that the mere existence of the applicant's other registrations, even those which have an earlier filing date than the opponent's registrations, will have no bearing on the outcome of these proceedings. Section 72 of the Act stipulates that registration shall be taken as *prima facie* evidence of the validity of a registered mark. Section 5(2) of the Act turns upon whether the 'attacker' has an earlier trade mark compared to the mark under 'attack', as defined by section 6 of the Act. Whether the applicant has other registrations that predate those upon which the 'attacker' relies cannot affect the outcome of the case in relation to these grounds. The position was explained in *PepsiCo, Inc v OHIM*, Case T-269/02:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

11. The viability of a defence including claims that the applicant for registration has a registered trade mark that predates the trade mark upon which the 'attacker' relies for grounds under section 5(2) of the Act was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, Case BL O/211/09. Ms Carboni rejected the defence as being wrong in law. Therefore, if the applicant of the mark under 'attack' has earlier marks which could be used to invalidate the trade marks relied upon by the 'attacker', and the applicant wishes to invoke those earlier marks, the proper course is to apply to invalidate the 'attacker's' mark.³

12. As I understand it, the applicant has not sought to invalidate any of the opponent's registrations on the basis of its claim to even earlier trade marks. Consequently, the opponent's trade marks must be regarded as validly registered marks. In this situation, the law requires priority to be determined according to the filing dates of the applications for registration. The applicant's prior marks are separate property rights which are not linked to the contested mark. This means that, for the purposes of this opposition, the opponent's marks have priority. The likelihood of confusion between the marks in suit only, based on their notional use throughout the UK, will be enough to justify the refusal of the contested mark.

13. Secondly, I note that peaceful coexistence (or honest concurrent use) was not specifically pleaded by the applicant in these proceedings. Given that the issue was not mentioned until the final written submissions stage, the opponent has not been afforded a fair opportunity to respond to it. Moreover, rule 64 of the Trade Marks Rules 2008 prescribes that written evidence must be filed in the form of a witness statement, affidavit, statutory declaration, or in any other form which would be admissible in proceedings before the courts. As the 'evidence' which goes to this issue was not provided in the proper format, it would not be appropriate to attach any weight to it. In any event, whilst it is settled law that a long period of honest concurrent use may defeat a claim of confusion,⁴ circumstances that give rise to this defence must be

³ Tribunal Practice Notice 4/2009 refers.

⁴ *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, and *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch)

exceptional.⁵ I would need to be satisfied that the parties have traded in circumstances where the relevant public has been exposed to the competing marks and has been able to differentiate between them without confusion as to the trade origin of the goods. Put simply, I am not. The 'evidence' filed by the parties in this case is extremely limited. The opponent has filed none, whereas the applicant has provided no evidence whatsoever that the contested mark has ever been used in the UK. There is a distinct lack of evidence demonstrating that the competing marks have ever come into conflict. The existence of other registrations owned by the parties is not sufficient for this purpose. There is no evidence that any of those registrations were on the market, and their mere existence does not show, for example, that the parties' goods were made available to consumers through the same trade channels or present in circumstances where they would be viewed alongside one another. The materials before me are insufficient to establish that there had been peaceful coexistence between the competing marks; I am not satisfied that confusion would be avoided because of honest concurrent use. The applicant's 'defence', such as it is, is dismissed.

14. Finally, whilst I note that the Intellectual Property Office of China may have rejected an opposition against an application for 'HONOTO ELECTRONICS' on the basis that the marks should not cause confusion if used on similar goods, it suffices to say that this is not relevant to the present proceedings. It is well established that prior decisions of other national offices are not binding on the Registrar. Further, I do not consider it persuasive; this is particularly the case because the mark under 'attack' in that case was different to the contested mark, and a copy of the decision has not been provided so I am unable to ascertain what earlier right(s) the opponent relied upon in those proceedings, what goods or services were at issue, or whether any evidence was taken into account.

My approach

15. As noted above, none of the earlier marks is subject to proof of use. Moreover, the second earlier mark is clearly more similar to the contested mark than the other earlier marks, given the additional elements present in the latter. I will, therefore, proceed to

⁵ *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09

determine the opponent's claim on the basis of the second earlier mark only, returning to consider the other earlier marks if it becomes necessary to do so.

Decision

The law

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

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

[...]

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

there exists a likelihood of confusion 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.”

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

18. In its written submissions, the applicant admits that the parties' goods are similar. However, some of the contested goods, e.g. 'smart rings' and 'biometric scanners', are clearly identical to the goods of the second earlier mark, e.g. 'smart rings' and 'devices for the verification of finger prints, palm prints or hand prints; face recognition devices'. Therefore, I will proceed on the basis that all of the goods at issue in these proceedings are identical. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

The average consumer and the nature of the purchasing act

19. 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 (as he then was) 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."

20. 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 in question.⁶

21. Due to the nature of the goods at issue in these proceedings, consumers are likely to include both members of the general public and business or professional users.

22. In respect of the general public, the frequency at which the goods are purchased will vary. This is equally true of their cost. For example, mobile phone applications are likely to be frequent, low-cost purchases, whereas cameras or data processing apparatus (such as computers) are likely to be purchased occasionally and attract a significantly higher outlay. Members of the general public are likely to consider factors such as cost, suitability, features and compatibility with other electronic items when selecting the goods, albeit that some will require a more considered thought process. Although the level of attention of the general public may vary depending on the particular product being purchased, it is my view that, overall, such consumers will demonstrate a medium level of attention during the purchasing process. The goods will be purchased from retailers, electronics stores, their online equivalents, or other online outlets such as 'app stores'. In these circumstances, the purchasing process will be predominantly visual in nature. Nevertheless, I do not discount aural considerations entirely in the form of word-of-mouth recommendations or discussions with sales assistants.

23. As for business or professional users, the goods are likely to be more frequent purchases for the ongoing technological needs of the business. Again, their cost will vary between cheaper items such as electric sockets and more expensive items such as data processing apparatus or humanoid robots with artificial intelligence. In addition to the factors considered by the general public, business or professional users will wish to ensure that they are selecting goods which are aligned with the needs of the business. Further, they will be aware of the potentially negative implications of selecting unsuitable or unreliable products. The level of attention of these consumers is also likely to vary depending on the particular product being purchased. However,

⁶ *Lloyd Schuhfabrik Meyer, Case C-342/97*

overall, I find that business or professional users will demonstrate a higher than medium level of attention during the purchasing process. Business or professional users will purchase the goods from suppliers, trade specialists, electronic retailers, or their online equivalents, after viewing information on shelves, in brochures or on webpages. As such, it is considered that the purchasing process will be mainly visual in nature, though I do not discount aural considerations entirely as it is possible that such consumers will wish to discuss the goods with sales representatives.

Distinctive character of the earlier mark

24. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the Court of Justice of the European Union (“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 *WindsurfingChiemsee*, paragraph 51).”

25. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

26. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use; accordingly, I have only the inherent position to consider.

27. The second earlier mark is in word-only format and comprises the word 'HONOR'. As there are no other elements in the mark, its distinctive character rests in the word itself. The word 'HONOR' is defined in the dictionary as the US spelling of 'honour', meaning, *inter alia*, a quality that combines respect, being proud, and honesty.⁷ Although this spelling is used in the US, it is my view that it will be readily understood by consumers in the UK. Alternatively, consumers in the UK may not immediately perceive the difference in spelling and (erroneously) see it as the word 'HONOUR'. In either scenario, the mark will be understood in accordance with the dictionary meaning. The mark is neither descriptive nor allusive of the goods for which it is registered. The opponent has submitted that its mark does not display any more than an average degree of distinctiveness. I agree: the second earlier mark possesses a medium level of inherent distinctive character.

Comparison of trade marks

28. 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


⁷ <https://dictionary.cambridge.org/dictionary/english/honor>
<https://dictionary.cambridge.org/dictionary/english/honour>

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.”

29. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

30. The competing trade marks are as follows:

The second earlier mark	The contested mark
HONOR	

Overall impressions

31. The second earlier mark consists of the plain word ‘HONOR’ with no other elements. The overall impression lies in the word itself.

32. The contested mark is figurative and comprises the word ‘honoto’ above a curved line device (which, in combination with the two letter ‘o’s, may be perceived as a smiley face). The overall impression of the mark is dominated by the word ‘honoto’. The

curved line device is likely to be perceived as decorative (even if it is seen as a smiley face); as such, whilst still contributing, it plays a lesser role in the overall impression.

Visual comparison

33. I agree with the opponent that the competing marks are visually similar in that they share four identical letters, i.e. 'HONO'/'hono', in the same order. This similarity appears at the beginning of the marks, a position which is generally considered to have more impact.⁸ The difference in letter case is not significant, since the registration of word-only marks (such as the second earlier mark) provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.⁹ The competing marks are visually different insofar as they have different endings and the contested mark contains an additional letter. As the applicant has highlighted, the verbal element in the contested mark is longer than the second earlier mark. Further, the contested mark employs a curved line device, an element which, whether or not seen as a smiley face, is not replicated in the second earlier mark. Although I have found that the device plays a lesser role in the overall impression, it will not be entirely overlooked. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparison

34. I agree with the applicant that the first letter in the second earlier mark is unlikely to be articulated, in accordance with the ordinary pronunciation of the word 'HONOR'/'HONOUR'. The mark consists of a two-syllable word, i.e. "ON-OR". The contested mark comprises a three-syllable word, i.e. "HO-NO-TO". The competing marks aurally coincide in the similar sounds of the 'ONO'/'ono' sequences, though differ in all other respects. Overall, I find that there is between a low and medium degree of aural similarity between the competing marks. If the first letter of the contested mark is not articulated, leading to a pronunciation of "OH-NO-TO", the

⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁹ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

competing marks will be more aurally similar, though to no more than a medium degree.

Conceptual comparison

35. As noted above, the second earlier mark will be understood in accordance with the dictionary meaning of the word 'HONOUR' (whether that be as the US spelling of this word or mistakenly as the word itself). I agree with the applicant that the contested mark does not have any obvious meaning but, rather, appears to be an invented word. As the second earlier mark conveys a clear concept which is not reproduced by the contested mark, there is no conceptual overlap; the competing marks are conceptually dissimilar.

Likelihood of confusion

36. 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. One such factor 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 mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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.

37. 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.

38. Having proceeded on the basis that the applicant's goods are identical to those of the second earlier mark, I further concluded that:

- Relevant consumers of the goods at issue will include members of the general public and business or professional users;
- Although I accepted that the level of attention of both groups of relevant consumers may vary, overall, the general public will demonstrate a medium level of attention when selecting the goods and business or professional users will demonstrate a higher than medium level of attention;
- The purchasing process for the goods will be predominantly visual in nature, though I have not excluded aural considerations;
- The second earlier mark possess a medium level of inherent distinctive character;
- The overall impression of the second earlier mark lies in the word 'HONOR', being the only element of the mark;
- The overall impression of the contested mark is dominated by the word 'honoto', while the device plays a lesser role;
- The second earlier mark and the contested mark are visually similar to a medium degree, aurally similar to a medium degree (at best) and conceptually dissimilar.

39. I acknowledge that the competing marks share four identical letters, and that they appear in the same order at the beginning of the marks. Nevertheless, there are differences between the marks which are not negligible. The contested mark contains a curved line device, which has no counterpart in the second earlier mark. Although I have found that this element plays a lesser role in the former, I do not believe it will be entirely overlooked. Perhaps more pertinently, the respective endings of the

competing marks are entirely different. Although the beginnings of marks do tend to have more impact, the fact that two marks have similar beginnings is not necessarily decisive.¹⁰ It is my view that the different endings of the competing marks will not be overlooked or misremembered but will, in this case, enable the consumer to differentiate between them. This is particularly the case, given that the competing marks as wholes are conceptually dissimilar; the second earlier mark will be perceived, in its entirety, as the US spelling of the word 'HONOUR', or this word itself, and will convey its meaning. Conversely, the word 'honoto' in the contested mark will be perceived as an invented word with no discernible meaning. Where the meaning of at least one of the two marks at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those marks may counteract the visual and phonetic similarities between them.¹¹ Although I accept that conceptual differences do not always overcome visual and aural similarities, I certainly consider that to be the case here. Finally, despite there being no special test for 'short' marks,¹² the second earlier mark is relatively short, comprising only five characters. Due to the relative brevity of the marks, consumers are more likely to notice the differences between them.¹³ Taking all the above factors into account, it is my view that the aforementioned differences between the competing marks are likely to be sufficient for consumers – even when paying no more than a medium level of attention during the purchasing process – to distinguish between them and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to identical goods.

40. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

¹⁰ *CureVac GmbH v OHIM*, T-80/08

¹¹ *The Picasso Estate v OHIM*, Case C-361/04 P, paragraph 20

¹² *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraphs 38 and 43

¹³ Case T-274/09 *Deutsche Bahn v OHIM*, paragraph 78, and Case T-304/10 *dm-drogerie markt v OHIM*, paragraph 42

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

41. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.¹⁴

¹⁴ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

However, indirect confusion has its limits. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹⁵ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.¹⁶

42. Applying these principles, I do not believe that consumers, having noticed the differences between the competing marks, will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licencing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared string ‘HONO’/‘hono’. This part of the second earlier mark is not so strikingly distinctive that consumers would assume that only the opponent would be using it in a trade mark. In any event, consumers would not dissect the second earlier mark and separate this string from the mark as a whole. This would involve a level of analysis not typically conducted by consumers upon immediate perception of trade marks. Moreover, the differences between the competing marks are not simply adding or removing non-distinctive elements. Nor are the differences consistent with any logical brand extensions with which consumers would be familiar. Although the addition of a curved line (or smiley face) device may be indicative of the use of a variant mark with an additional decorative element, I can see no reason why an undertaking would dissect the word ‘HONOR’ – which forms a singular word with a clear, recognisable meaning – and add two other letters, resulting in an invented word with no meaning. Whilst indirect confusion is not limited to the categories outlined in *L.A. Sugar*, to my mind, there is no other basis for concluding that consumers would assume an economic connection between the parties, even when demonstrating no more than a medium level of attention during the purchasing process. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion between the competing marks, even in relation to goods that are identical.

¹⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁶ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

43. I should add that, although these conclusions have been reached on the basis of the second earlier mark only, the other earlier marks do not take the opponent's case any further. This is because they are less similar to the contested mark, a factor which points further away – rather than towards – there being a likelihood of confusion.

Conclusion

44. The opposition under section 5(2)(b) of the Act has been unsuccessful. Subject to any successful appeal, the application will proceed to registration in the UK.

Costs

45. As the applicant has been successful, it is entitled to a contribution towards its costs. Based upon the scale published in Tribunal Practice Notice 2/2016, I award the applicant the sum of **£500**. This sum is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£200
Preparing written submissions	£300
Total	£500

46. I therefore order Honor Device Co., Ltd. to pay Shenzhen Honor Electronic Co., Ltd the sum of **£500**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings (subject to any order made by the appellate tribunal).

Dated this 7th day of February 2023

James Hopkins
For the Registrar

Annex

Goods of the first earlier mark relied upon

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 vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; 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 equipments for accessing internet, ADSL (Asymmetric Digital Subscriber Line) broadband accessing terminal devices and equipments, 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, 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 exchanges; cable communication apparatus; apparatus for communication and navigation not included on other classes; 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; phototelegraphy apparatus; electronic notice boards; sound reproduction apparatus; lightning arresters; transparencies (photography); electrically heated vests; digital photo frames; batteries; household access network apparatus; microphones; earphone; electronic audible apparatus with books; household internet terminal device for making phone calls, accessing internet and viewing videos; handheld ebook 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 division boxes; cable side terminal

block; exchange side terminal block; protective unit; 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; 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 parks or parking lots; 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; 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; 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-); 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 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 Story Machine; Smart Camera; Smart Rear View Mirror; Car Charger; Smart Outlet; Smoke Alarm; Natural Gas Alarm; Wireless personal area network; Hygrometer; Smart Walkie Talkie; Kitchen Electronic scales; household body fat scales; jewelry-type communication equipment; car holders for phone; e-book readers; learning machines; video monitors; head-mounted video displays; car TVs; electricity and electronic video surveillance Equipment; liquid crystal projectors; self-stickers 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 for Accompanying; Intelligent Switch (Electrical); Humanoid Robot with Artificial Intelligence for Sweeping; Sleep Button; Smart Photo Printer; Mobile phones with style (decoration).

Goods of the second earlier mark relied upon

Class 9: Security tokens [encryption devices]; black boxes [data recorders]; interactive touch screen terminals; electronic interactive whiteboards; humanoid robots with artificial intelligence; electronic sheet music, downloadable; electric and electronic effects units for musical instruments; audio interfaces; equalizers [audio apparatus] / equalisers [audio apparatus]; subwoofers; virtual reality headsets; audio mixers; thermal imaging cameras; needles for surveying compasses; infrared detectors; digital weather stations; thermo-hygrometers; pressure indicators; biochips; safety restraints, other than for vehicle seats and sports equipment; electronic access control systems for interlocking doors; charging stations for electric vehicles; batteries for electronic cigarettes; smart rings; devices for the verification of finger prints, palm prints or hand prints; Face recognition devices; application software for mobile phones; car video recorders; set top boxes; cameras [photography]; gas testing instruments; Panoramic cameras; air analysis apparatus; hygrometers; speed checking apparatus for vehicles; connected bracelets [measuring instruments]; mirrors [optics]; USB cables; scales; bathroom scales; baby scales; scales with body mass analyzers; parts and fittings for all the aforesaid goods.

Goods of the third earlier mark relied upon

Class 9: 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 memories; integrated circuit cards (smart cards); transponders; cabinets for loudspeakers; network communication apparatus; modems; sleeves for laptops; electric batteries; chargers for electric batteries; mobile power source

(rechargeable batteries); tablet computers; covers for tablet computers; stands adapted for tablet computers; flat panel displays; flexible flat panel displays for computers; laptop computers; notebook computers; bags adapted for laptops; headphones; earphones; virtual reality headsets; digital video recorder for vehicles; 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; scales; 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 identifier; human face recognition devices; stored program controlled telephone switching apparatus; radios; air analysis apparatus; materials for electricity mains (wires, cables); video screens; integrated circuits; electronic chips; thermal imaging cameras; bathroom scales; scales with body mass analyzers; 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 for creating and editing music and sound; downloadable graphics for mobile phones; wearable computers; telecommunication apparatus in the form of jewellery; selfie sticks for mobile phones; security surveillance robots; wearable video display monitors; selfie lenses; laboratory robots; teaching robots; USB data lines or data cables; USB data lines or data cables for mobile phones; downloadable mobile phone software applications; holders for mobile phones; touch screens; television apparatus; electric plugs; electric sockets; intercoms; digital door locks; alarm central units; sensors; downloadable emoticons for mobile phones; operating system programs; liquid crystal displays (LCD) with large screens; electronic diaries; liquid crystal displays (LCD); electronic pens; video image printers; portable digital electronic scales; wrist-mounted smartphones; television apparatus for vehicles; computer styluses; computer programs, downloadable; computer chatbot software for simulating conversation;

touch screen pens; web cameras; video projectors; pocket projectors; memory cards; network routers; body fat scales for household purposes.

Goods of the fourth earlier mark relied upon

Class 9: 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 memories; integrated circuit cards (smart cards); transponders; cabinets for loudspeakers; network communication apparatus; modems; sleeves for laptops; electric batteries; chargers for electric batteries; mobile power source (rechargeable batteries); tablet computers; covers for tablet computers; stands adapted for tablet computers; flat panel displays; flexible flat panel displays for computers; laptop computers; notebook computers; bags adapted for laptops; headphones; earphones; virtual reality headsets; digital video recorder for vehicles; 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; scales; 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 identifier; human face recognition devices; stored program controlled telephone switching apparatus; radios; air analysis apparatus; materials for electricity mains (wires, cables); video screens; integrated circuits; electronic chips; thermal imaging cameras; bathroom scales; scales with body mass analyzers; 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 for creating and editing music and sound; downloadable graphics for mobile phones; wearable

computers; telecommunication apparatus in the form of jewellery; selfie sticks for mobile phones; security surveillance robots; wearable video display monitors; selfie lenses; laboratory robots; teaching robots; USB data lines or data cables; USB data lines or data cables for mobile phones; downloadable mobile phone software applications; holders for mobile phones; touch screens; television apparatus; electric plugs; electric sockets; intercoms; digital door locks; alarm central units; sensors; downloadable emoticons for mobile phones; operating system programs; liquid crystal displays (LCD) with large screens; electronic diaries; liquid crystal displays (LCD); electronic pens; video image printers; portable digital electronic scales; wrist-mounted smartphones; television apparatus for vehicles; computer styluses; computer programs, downloadable; computer chatbot software for simulating conversation; touch screen pens; web cameras; video projectors; pocket projectors; memory cards; network routers; body fat scales for household purposes.