

O/0274/23

# INTERIM DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3760624

BY CHENG HSUN LEE

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 9

AND

AN OPPOSITION THERETO UNDER NUMBER 433617

BY ROBERTS RADIO LIMITED

## BACKGROUND AND PLEADINGS

1. On 1 March 2022, Cheng Hsun Lee (“the applicant”) applied to register the mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 18 March 2022 and registration is sought for the following goods:<sup>1</sup>

*Class 9: Loudspeakers; audio loudspeaker systems; audio timers; audio speakers; music headphones; earphones for smartphones; headphones; speakers; loud speakers; earbuds; wireless headphones; noise cancelling headphones; protective glasses; 3D spectacles, none of the aforesaid goods being musical instrument speaker cabinets.*

2. On 18 May 2022, Roberts Radio Limited (“the opponent”) opposed the application in full, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The 5(3) and 5(4)(a) grounds were subsequently dropped. The opponent relies upon UK trade mark number 2536070, “REVIVAL”, which has a filing date of 13 January 2010, a registration date of 21 May 2010 and is registered for the following goods (all of which are relied upon for this opposition):

*Class 9: Radios, portable radios, clock radios, radio receivers, digital radio receivers, audio hi-fi apparatus, televisions; apparatus for recording, transmission or reproduction of sound or images; attachments for music players; and all parts and fittings for the aforesaid goods.*

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are similar and the goods are identical or similar.

4. As a result of its earlier filing date, the mark relied upon by the opponent qualifies as an earlier mark for the purpose of section 6(1)(a) of the Act. In accordance with

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<sup>1</sup> This takes account of a change to the specification filed on Form TM21B on 21 July 2022 and recorded on the Register on 2 August 2022.

section 6A of the Act, the earlier is subject to proof of use and so the opponent made a statement of use in relation to all the goods in its specification.

5. The applicant filed a defence and counterstatement denying the ground of opposition on the basis of a lack of similarity between the marks and the goods. The applicant did not put the opponent to proof of use of the goods relied upon and so the opponent may rely upon its entire specification.

6. The applicant was, up until the main hearing, represented by Akash Kumar. The opponent is represented by Murgitroyd & Company. Neither party filed evidence in these proceedings. The opponent requested a hearing, which took place before me on 10 January 2023 and was attended by the applicant, representing himself, and Mr Alan Fiddes of Murgitroyd & Company for the opponent.

## **PRELIMINARY ISSUE**

7. At the hearing, the applicant asked Mr Fiddes to consider discussing the application with the potential outcome of removing some terms from the applicant's specification. Mr Fiddes' response was that a hearing is not the point at which parties usually negotiate settlements: it was his submission that the opponent was unlikely to consider negotiating at such a late stage in the proceedings. I advised both parties that I would not usually expect parties to begin negotiations following a main hearing but that if a joint request to stay the proceedings was made, I would consider it. No such request has been made and I therefore continue to issue a final decision in these proceedings.

## **DECISION**

### **Relevance of EU law**

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. This is why this decision continues to make reference to the trade mark case law of EU courts.

## Section 5(2)(b)

9. Sections 5(2)(b) and 5A of the Act state:

“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.”

## Relevant law

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

### The principles

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

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

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

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

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

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

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

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

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

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

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

### Comparison of goods

11. The competing goods are shown in the table below:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<i>Class 9: Radios, portable radios, clock radios, radio receivers, digital radio receivers, audio hi-fi apparatus, televisions; apparatus for recording, transmission or reproduction of sound or images; attachments for music players; and all parts and fittings for the aforesaid goods.</i>	<i>Class 9: Loudspeakers; audio loudspeaker systems; audio timers; audio speakers; music headphones; earphones for smartphones; headphones; speakers; loud speakers; earbuds; wireless headphones; noise cancelling headphones; protective glasses; 3D spectacles, none of the aforesaid goods being musical instrument speaker cabinets.</i>

12. At the hearing, the applicant made submissions regarding goods that are not listed in either party's specification. As submitted by Mr Fiddes, and subsequently explained by me, it is the goods that appear in the specification that are relevant to this decision rather than Class 9 goods as a whole.

13. As a preliminary point, I do not consider the limitation "*none of the aforesaid goods being musical instrument speaker cabinets*" in the applicant's specification to be

relevant to the comparison of the goods. Whilst it will therefore not be mentioned in the comparison below, the limitation may continue to apply if any goods proceed to registration.

14. In *Gérard Meric v OHIM*, the General Court (“GC”) confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):<sup>2</sup>

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

15. The opponent’s specification contains the term *apparatus for recording, transmission or reproduction of sound or images*. It is my view that this term would encompass the applicant’s: *loudspeakers; audio loudspeaker systems; audio timers; audio speakers; music headphones; earphones for smartphones; headphones; speakers; loud speakers; earbuds; wireless headphones; noise cancelling headphones* on the basis that these terms all constitute apparatus which transmit or reproduce sound. These goods are identical in accordance with *Meric*.

16. The applicant’s *protective glasses* are glasses which protect the user’s eyes against accidents. The applicant’s *3D spectacles* are spectacles which allow the user to watch visual content in three dimensions. Neither of these goods record, transmit or reproduce images and so they do not fall with the opponent’s *apparatus for recording, transmission or reproduction of sound or images*. Neither do I find any meaningful similarity with any of the goods in the opponent’s specification.

17. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods, there is no likelihood of confusion to be

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<sup>2</sup> Case T-133/05

considered. Consequently, the opposition has failed in relation to the following goods, which may proceed to registration:

Class 9 *Protective glasses; 3D spectacles, none of the aforesaid goods being musical instrument speaker cabinets.*<sup>3</sup>

### **The average consumer and the purchasing act**

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. The average consumer of the parties' goods is a member of the general public, who will consider, when selecting the goods, a range of factors including the suitability for their needs, the quality and aesthetics, the product's specification, as well as the price. The goods vary in price: some speakers are considerably more expensive than some headphones, for example, though, overall, the cost of the goods is not prohibitively expensive. I consider that the goods will be selected with an average level of care and attention.

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<sup>3</sup> I am conscious of the fact that the limitation is not a logical one in relation to the goods which are proceeding to registration. I will return to this point later in the decision.



20. The goods are likely to be purchased by self-selection from the shelves of retail stores, websites or catalogues. I consider the purchasing process to be mainly visual, however, given that word-of-mouth recommendations might be made and conversations with retail assistants might take place, I do not discount an aural component to the selection.

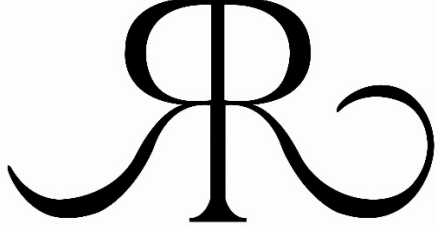
### **Comparison of marks**

21. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

22. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

23. The trade marks to be compared are as follows:

The earlier mark	The applicant's mark
<p>REVIVAL</p>	 <p>REVIVAL AUDIO</p>

24. The opponent argues that the dominant element of the Applicant's mark is the word 'REVIVAL', which will cause confusion amongst the relevant consumers. The applicant submits that the device element and the word 'AUDIO' in its mark cannot be ignored.

#### Overall impression

25. The earlier mark contains the one word 'REVIVAL', the overall impression thus lying in the word itself.

26. The applicant's mark is figurative and features a large device element, in black, which will either be seen as purely decorative or as two stylised letter 'R's positioned back to back. Underneath the device are the two words 'REVIVAL AUDIO' presented in black in a fairly standard font. Whilst the opponent submits that 'REVIVAL' is the dominant element, I bear in mind that in figurative marks, it is not the case that word elements must always be considered to be dominant.<sup>4</sup> Given the size of the device element in the mark, I consider it to be as dominant in the mark as the words 'REVIVAL AUDIO'. Given the descriptive or allusive nature of the word 'AUDIO' in relation to the relevant goods in the applicant's specification, it is the device and the word 'REVIVAL' which are the more distinctive elements in the mark.

#### Visual comparison

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<sup>4</sup> See *L&D SA v OHIM* [2008] E.T.M.R. 62 and *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253.

27. Visually, the marks coincide in the word 'REVIVAL', which is the entirety of the earlier mark. The device element and the word 'AUDIO' in the applicant's mark create clear visual differences. Taking everything into account and bearing in mind the dominant and distinctive elements of the marks, I find them to be visually similar to a medium degree.

#### Aural comparison

28. The word 'REVIVAL' will be pronounced identically in both marks. The additional word 'AUDIO' in the applicant's mark creates an aural difference. Even in circumstances where consumers see in the device element the letter 'R' or letters 'RR', my view is that this will not be articulated. The comparison is therefore between the earlier mark's three-syllable 'REVIVAL' and the applicant's six-syllable 'REVIVAL AUDIO'. Bearing in mind that the common word 'REVIVAL' is the first element in the articulation of the marks, I find a medium to high degree of aural similarity.

#### Conceptual comparison

29. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM*.<sup>5</sup> The assessment must be made from the point of view of the average consumer.

30. The concept immediately grasped by the average consumer for both marks is the ordinary meaning of the word 'REVIVAL' – the restoration or improvement of someone or something.<sup>6</sup> The word 'AUDIO' adds a slightly different meaning to the applicant's mark, i.e. something that is audio-related, but the two words 'REVIVAL' and 'AUDIO' do not combine to form a meaning different to the meanings of the words individually. The device element will convey no meaning or concept for consumers to immediately grasp. Overall, I find the marks to be conceptually similar to a medium to high degree.

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<sup>5</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

<sup>6</sup> See Cambridge English Dictionary and Collins English Dictionary.

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

31. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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

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

32. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

33. I have no evidence from the opponent from which to make an assessment as to an enhanced distinctive character and so I will assess only the inherent distinctive character of the earlier mark. ‘REVIVAL’ is an ordinary dictionary word but has no

meaning in relation to the goods for which it is registered. I consider the earlier mark to have a medium degree of inherent distinctive character.

### **Likelihood of confusion**

34. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*) from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, 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.

35. I have found the marks to be visually similar to a medium degree and aurally and conceptually similar to a medium to high degree. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who, paying an average degree of attention, selects the goods predominantly by visual means, though there may be an aural element to the purchase.

36. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis QC (as he then was), 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 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 recognised 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)."

37. I bear in mind that the applicant's mark contains the entirety of the earlier mark and that this shared element is at the beginning of the marks. I also remind myself that the beginnings of marks tend to have more visual and aural impact than the ends.<sup>7</sup> The additional word 'AUDIO' is either descriptive or allusive for the goods at issue resulting in the average consumer likely forgetting that it is part of the applicant's mark and imperfectly recalling the mark as 'REVIVAL'. Whilst there is an equally dominant device element in the applicant's mark, it has no meaning for consumers and will be

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<sup>7</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

seen as either decorative or the letter 'R' (or letters 'RR') for 'REVIVAL'. For these reasons, I consider it likely that consumers will recall both marks as 'REVIVAL' marks, misremembering the device element, which has no conceptual hook, and the 'AUDIO' element. There is a chance that consumers will mistake one mark for the other, resulting in direct confusion.

38. In case I am wrong in my finding of direct confusion, I will now consider whether there is a likelihood of indirect confusion. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

39. I consider it likely that, given the descriptive or allusive nature of the word 'AUDIO' in relation to the goods, consumers would expect the applicant's mark to be a sub-brand or brand extension of the earlier mark, offering a range of specifically audio-related goods. The device element, though dominant in the applicant's mark, will be seen as a decorative addition, i.e. a rebranding or an alternative way of the same undertaking presenting its mark. There is, therefore, a likelihood of indirect confusion.

## **FINAL POINT**

40. As indicated earlier in this decision, the limitation “*none of the aforesaid goods being musical instrument speaker cabinets*” is not a logical limitation in relation to the goods which are proceeding to registration (*protective glasses* and *3D spectacles*) and I do not consider it appropriate for the specification to read as such on the Register. I therefore propose removing the limitation from the applicant's specification. The applicant is allowed 14 days from the date of this interim decision to confirm to the Tribunal whether it has any objection to the limitation being removed. Either on receipt of the applicant's acceptance of the suggested specification or if no response is

received, I will issue a supplementary decision confirming the following interim conclusion.

## **INTERIM CONCLUSION**

41. The opposition under section 5(2)(b) partially succeeds and the application is refused for the following goods:

*Class 9 Loudspeakers; audio loudspeaker systems; audio timers; audio speakers; music headphones; earphones for smartphones; headphones; speakers; loud speakers; earbuds; wireless headphones; noise cancelling headphones.*

42. As per paragraph 17, the following goods will proceed to registration:

*Class 9 Protective glasses; 3D spectacles.*

## **COSTS**

43. The following costs award will be effective from the date of the supplementary decision.

44. The opponent has been successful for the most part and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £700, calculated as follows.

Official fee	£100
Preparing a statement and considering the other side's statement	£200
Preparing for and attending a hearing	£400
<b>Total</b>	<b>£700</b>



45. I therefore order Cheng Hsun Lee to pay Roberts Radio Limited the sum of £700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 14<sup>th</sup> day of March 2023**

**E FISHER (née VENABLES)**

**For the Registrar**