

BL O/0333/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 3672861
BY MUHAMMAD ALI
TO REGISTER THE TRADE MARK:**

SMARTX

IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 431102
BY ABUS AUGUST BREMICKER SÖHNE KG**

Background and Pleadings

1. On 24 July 2021, Muhammad Ali (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3672861 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 19 November 2021, in respect of goods in Class 9.¹

2. On 17 February 2022, ABUS August Bremicker Söhne KG (“the opponent”) filed a notice of opposition. The opposition is brought under sections 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods in the application.

3. The opponent relies upon the following United Kingdom Trade Mark (“UKTM”) and comparable UKTM:²

(i) UKTM no. 3730539 for the trade mark ‘SmartX’ which was applied for on 08 December 2021. However, the application has a priority date of 10 June 2021.³ The trade mark was entered in the register on 13 May 2022, in respect of goods and services in Classes 6, 9 and 42.⁴

(ii) UKTM no. 917879257 for the trade mark ‘SmartX’ which was applied for on 23 March 2018, and which was entered in the register on 09 August 2018, in respect of goods in Classes 6, 9 and 12.⁵

4. The opponent claims that the marks are identical and that the goods and services at issue are either identical or similar and as such there is a clear likelihood of confusion. In its counterstatement, the applicant denies that consumers will be confused on the basis that the respective marks and the goods and services at issue are not sufficiently similar.

¹ These will be listed in the goods and services comparison.

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 017879257 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

³ European Union Intellectual Property Office (EUIPO)(EM) 018489383

⁴ These will be listed in the goods and services comparison.

⁵ These will be listed in the goods and services comparison.

5. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. However, as they had not been registered for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier marks are registered without having to establish genuine use.

6. The opponent is represented by ip consult, whereas the applicant represents itself. Neither party filed evidence, but the opponent filed written submissions during the evidence rounds. Both parties were given the option of an oral hearing but neither requested to be heard on this matter. Only the opponent chose to file written submissions in lieu. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

7. 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. That is why this decision continues to refer to EU trade mark case law.

PRELIMINARY ISSUES

8. Both the applicant and opponent have raised points in their submissions that I intend to address as preliminary issues. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

Goods comparison and the target market

- In its counterstatement, the applicant states that its products in Class 9 are different to the opponent's products and that they target a different type of consumer market.

9. Differences between the goods currently provided by the parties, such as particular characteristics of the goods, including whether they are intended for bikes or not, etc., are irrelevant, except to the extent that those differences are apparent from each party's specification. Since the opponent's earlier mark is not subject to proof of use, it is entitled to protection in relation to all the goods for which it is registered. It is the goods relied upon by the opponent and the goods applied for by the applicant that I will be comparing later in this decision. The assessment I must make between the goods is a notional and objective assessment, rather than a subjective one.

10. Furthermore, marketing strategies, including the targeting of specific consumers, are temporary and may change over time. As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the goods at issue.

Previous UK IPO opposition decisions

- In its written submissions,⁶ the opponent states that:

“In the past, the UKIPO has ruled that the following marks of a similar textual composition are similar:

- a. Smart flex v SMARTFLEX (WO0000001580013) - gb-wo-1580013 on 28 Oct 2021.
- b. SMARTSENSE v SmartSense (UK00003497042) - O/589/21 ON 6 August 2021.
- c. Smartvest v SMARTVEST (UK00003104670) - O/043/17 on 3 Feb 2017.
- d. TWINKLE v twinkl (UK00003138122) - O/709/18 on 8 Nov 2018.”

⁶ Written submissions, dated 10th March 2023

11. Whilst it is noted that the UK Intellectual Property Office found the above marks to be similar, it has to be put forward that I am not bound by these previous first instance decisions. It is important to recall that decisions are made based on the facts of each individual case, i.e. the mark comparison, the goods and services comparison, and the fact that the average consumer and purchasing process may be different, resulting in a different likelihood of confusion assessment. Accordingly, decisions must be stringent and must not consist of the mere repetition of comparable decisions.

DECISION

Sections 5(2)(a) and (b)

12. Sections 5(2)(a) and (b) of the Act state that:

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

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

(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.

Relevant law

13. 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 marks

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

Opponent's marks UKTM 917879257 UKTM 3730539	Applicant's mark
SmartX	SMARTX 

15. With regard to the identity of the marks, in its counterstatement, the applicant states:

“I believe that my mark has a unique design which represents my brand with a designed X logo and on the other hand the opposing party has a registered name without any designs.

Therefore I disagree and don't believe it's identical or similar in any way with the mark I submitted.”

16. With regard to the identity of the marks, the opponent states:⁷

“The Opponent submits that the Contested and the Earlier Mark are identical. The test in assessing whether two trade marks are identical is set out in *LTJ Diffusion v Sadas*, where the court ruled that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark, or where, viewed as a whole, it contains differences so insignificant that they may [sic] unnoticed by an average consumer. Given the average consumer:

- a. reads marks from left to right;
- b. sees both words as composing the same amount of letters;
- c. reads and pronounces the words in the same way;

The differences between SMART~~X~~ and SmartX are so insignificant that they will go unnoticed by an average consumer.”

17. It is a prerequisite of section 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. The marks coincide insofar as they identically share the same first five letters, namely ‘Smart / SMART’. The marks differ in that the opponent’s mark contains a capital letter ‘X’ at the end of the mark, whereas the applicant’s mark contains a graphical device element at the end of the mark, that closely resembles a highly stylised letter ‘X’.

19. I bear in mind *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16 which states that whilst normal and fair use of word-only marks covers use in any normal

⁷ Written submissions, dated 10th March 2023

font, this does not extend to stylisation which goes beyond that. Taking this into account, whilst I acknowledge that the graphical device element present in the applicant's mark closely resembles a highly stylised letter 'X', I am of the view that this graphical element, does go beyond normal and fair use. Accordingly, contrary to the opponent's submissions, I do not consider the marks to be identical and so the opposition based on section 5(2)(a) must fail. I will, however, proceed to consider the section 5(2)(b) ground.

20. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

22. The opponent's mark consists solely of the word 'SmartX', presented in standard upper and lowercase letters with no additional stylisation. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

23. The applicant's mark consists of the letters 'SMART' presented in a standard uppercase font, followed by a graphical device element which closely resembles the letter 'X'. I find the word 'SMART' to be the most dominant element of the mark due

to its position and overall length in comparison to the device element. Furthermore, I keep in mind *Migros-Genossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”

24. Slightly less dominant is the device element present in the mark. However, this element still contributes to the overall impression of the mark.

Visual comparison

25. Visually the marks coincide insofar as they identically share the same first five letters, namely ‘Smart / SMART’. The marks differ in that the opponent’s mark contains a capital letter ‘X’ at the end of the mark, whereas the applicant’s mark contains a graphical device element at the end of the mark, that closely resembles the letter ‘X’. The fact that the marks at issue identically share the same first five letters is an important point of coincidence, being where consumers tend to focus⁸ as this position is generally considered to have more impact due to consumers in the UK reading from left to right. In making my visual comparison of the marks, I bear in mind that notional and fair use of the marks would include use in both upper and lower case,⁹ so letter case is irrelevant to the comparison. Overall, the marks are visually similar to a high degree.

Aural comparison

26. Aurally, the opponent’s mark will be pronounced as the dictionary word ‘Smart’ and the letter ‘X’, namely ‘Smart-X’. The applicant’s mark will also be pronounced as the dictionary word ‘SMART’, and as the device element at the end of the mark

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

⁹ *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

closely resembles the letter 'X', I am of the view that the mark will also be pronounced as 'SMART-X'. Accordingly, I find that the marks are aurally identical.

27. However, for consumers who perceive the device element in the applicant's mark purely as a figurative element rather than as a stylised representation of the letter 'X', they will pronounce the mark as 'SMART' as the figurative element will not be articulated. For consumers who do see the applicant's mark in this way, the marks are aurally similar to a high degree.

Conceptual comparison

28. 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* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

29. With regard to the opponent's mark, in my view, due to the use of the capital letters 'S' and 'X', the mark will be perceived as two separate elements, namely 'Smart-X'. The 'Smart' element of the mark will be understood according to its ordinary dictionary meaning, namely as a descriptor for something that is *neat* or *intelligent*.¹⁰ The letter 'X' in the mark will be understood as *the twenty-fourth letter of the English alphabet*.¹¹

30. The applicant's mark, comprising the standard uppercase letters 'SMART' combined with a device element resembling a highly stylised letter 'X', will be perceived in the same way as the opponent's mark. Therefore, the marks are conceptually identical.

31. However, for consumers who perceive the device element in the applicant's mark purely as a figurative element rather than as a stylised representation of the letter 'X', on seeing the word 'SMART', they will immediately think of the dictionary meaning of that word, and therefore, as the marks at issue share a concept with

¹⁰ www.collinsdictionary.com/dictionary/English/smart

¹¹ www.collinsdictionary.com/dictionary/English/x

regards to the word *smart*, I find the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade marks

32. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

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

34. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

35. With regard to the distinctive character of the earlier trade marks, the opponent states:¹²

“Since all the signs contain made up words, it is submitted they have at least a high degree of distinctive character. The higher the distinctive character of the marks, the likelier it is for the public to find for a likelihood of confusion.”

36. I am of the view that due to the capital letters ‘S’ and ‘X’ in the earlier marks they will likely be perceived as two separate words, namely ‘Smart-X’. As previously stated, the word *smart* is a common dictionary word with a recognisable meaning and the letter ‘X’ is the twenty-fourth letter of the English alphabet, and therefore will be readily understood by the average consumer. However, contrary to the opponent’s submissions, bearing in mind the nature of the goods at issue, I find that the term ‘smart’ plays an allusive role in relation to goods and services that function in an intelligent way. That said, I acknowledge that the ‘X’ at the end of the marks does add to their overall distinctiveness. Accordingly, as the inherent distinctiveness of the marks lies in the combination of the word ‘Smart’ and letter ‘X’ as a whole, I find that the marks have a medium degree of inherent distinctiveness.

Comparison of goods and services

37. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

¹² Written submissions, dated 10th March 2023

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

38. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

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

39. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

40. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

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

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

42. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

43. The competing goods and services are as follows:

Applicant's goods

Class 9

Mobile telephones; Mobile phones; Mobile phone covers; Mobile telephone covers; Mobile phone speakers; Mobile phone straps; Mobile telephone cases; Mobile data receivers; Mobile telephone batteries; Mobile phone cases; Mobile telecommunications handsets; Selfie sticks used as smartphone accessories; Mobile phone docking stations; Mobile phone battery chargers; Batteries for mobile phones; Headsets for mobile telephones; Chargers for mobile phones; Displays for mobile phones; Cases for mobile phones; Keyboards for mobile phones; Teeth protectors;

Overvoltage protectors; Surge protectors; Eye protectors; Protectors (Voltage surge -);Screens; Mobile phone display screen protectors in the nature of films; Voltage surge protectors; Display screen protectors in the nature of films for mobile phones; Visual display screens; Display screen filters; LED screen displays; Touch screen pens; Computer stylus; Stylus [light pens]; Leather cases for mobile phones; Cases adapted for mobile phones; Carrying cases for mobile phones; Protective cases for mobile phones; Carrying cases for mobile telephones; Carrying cases for mobile computers; Sunglass cases; Eyewear cases; Glasses cases; Phone cases; Laptop cases; Camera cases; Eyeglass cases; Fast chargers for mobile devices; Battery chargers for mobile phones; Chargers; USB chargers; Joystick chargers; Car charger; Portable chargers; Battery chargers; Mains chargers; Wireless chargers; Chargers for vaporizers; Battery compensation chargers; Wireless battery chargers; Electric-car charger; Electric battery chargers; Chargers for smartphones; Smartphone battery chargers; Solar battery chargers; Chargers for batteries; Cell phone battery chargers; Chargers for electronic cigarettes; Chargers for electronic smokers' articles; USB chargers for electronic cigarettes; Battery chargers for tablet computers; Battery chargers for laptop computers; Tempered glass screen protectors for smartphones; Glasses; Smart glasses; Waling glasses; Protective glasses; Dustproof glasses; Sports glasses; Magnifying glasses; Glasses frames; Headphones; Headphone consoles; Stereo headphones; Wireless headphones; Headphone amplifiers; Music headphones; Cases for headphones; In-ear headphones; Noise cancelling headphones; Ear pads for headphones; Headphones for smart phones; Adapter cables for headphones; Two-way plugs for headphones; Waterproof camera cases; Memory card cases; Waterproof smartphone cases; Cases for smartphones; Tablet computer cases; Wireless headsets for smart phones; Waterproof cases for smart phones; Encoded smart cards; Smart card readers.

Opponent's goods and services

UKTM 917879257

Class 6 Locks, Keys of metal, Keys, key blanks.

Class 9 Electric and electronic locks and parts therefor; Warning alarms other than for vehicles; Electric and electronic monitoring apparatus, in particular alarm systems and parts thereof (included in class 9).

Class 12 Alarm instruments for vehicles.

UKTM 3730539

Class 6 Goods of common metal included in class 6, Namely locks, Keys, key blanks, Fittings, Safety chains, Doors hinges, Lock cylinders, Built-in cylinders, Dummy cylinders, Door cylinders, Striking plates, Closing hasps, Door chains, Door and window bolts, Door and window locks and parts thereof; Ironmongery, small items of metal hardware; Non-electric cables and wires of common metal; Mechanical locking systems; Mechanical locking installations; Tanks of metal; Closures of metal for containers; Containers, Goods of metal, namely, Containers.

Class 9 Measuring, checking (supervision), signalling and life-saving apparatus and instruments; Electric and electronic locks; Electric and electronic keys; Electric and electronic monitoring apparatus; Electronic locking installations; Alarms; Access control installations; Locks comprising fingerprint readers; Locks comprising biometric fingerprint scanners; Wireless locks; Electric and electronic locking and unlocking systems; Electric and electronic door security devices; Access control cards [encoded or magnetic]; Electronic key cards; Smart cards; Digital signal processing apparatus; Digital keys; Software development kit [SDK]; Mobile apps; Cameras [photography]; Radiocommunication apparatus; Apparatus for recording, transmission or reproduction of data, sound or images for security purposes; Facial recognition apparatus; Vein pattern recognition apparatus; Gesture control apparatus; Speech recognition apparatus; Movement pattern recognition apparatus; Peepholes [magnifying lenses] for doors; Electronic speech and relay modules; Programming apparatus; Transmitters; electrical and electronic controllers; Contacts, electric; Electric cables and distributors; Integrated circuits; Data processing encoders; Data-processing equipment and computers; Monitors; Computer peripheral devices; Programs for data processing equipment; Software; Magnetic and voice-controlled encoders; Computer software applications,

downloadable; Downloadable software applications for mobile devices (smartphones, smart watches, tablet computers, laptop computers); Computer software for interpreting fingerprints or palm prints; software for electronic lock and access control device data transmission via a global computer network, by wireless telephone network, or by radio transmission; Software for downloading application programs and for remote programming, control, monitoring, and management of electronic locks and access control apparatus via global computer network, wireless telephone network or radio transmission; Computer application software for computers, mobile devices (smartphones, smartwatches, tablet computers, laptop computers), namely software for programming, controlling, monitoring and managing electronic locks and access control apparatus.

Class 42 Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; design and development of software for e-commerce platforms; Design and development of software in the field of mobile applications; Hosting computer sites [web sites]; Cloud computing; Cloud hosting provider services; Consultancy relating to locks, security and locking systems; Software as a service [SaaS]; Access Control as a Service (ACaaS); Application service provider [ASP], namely, hosting computer software applications of others; Providing application software using a communication network.

44. With regard to the similarity of the goods and services, in its counterstatement the applicant states the following:

“... the name opposing party holds with IPO has a list of different goods and services in Class 9 category and their registered name specifically targets the different types of consumer market and products related to Bikes such as Electric locks and Alarm and other Security products and services all mainly for Bikes.

When on the other hand I submitted the application for products related to Smartphone and Gadgets such as cases and covers and other wireless and wired accessories for Smartphone and Gadgets.

[...]

Therefore, I don't see any similarities whatsoever in my Mark with the opposing party Trademark Design or list of goods and service my marks represents [sic].”

45. With regard to the similarity of the goods and services, the opponent states the following:¹³

“It is submitted that the Contested Goods are highly similar to 257 and 539’s Goods and Services. They are identical, if not similar in nature, so are their end users and their method of use and that they are in competition.

[...]

We consider that the goods are identical because all of [sic] Contested Goods in red¹⁴ are either part of or are components of “electric and electronic monitoring apparatus, in particular alarm systems and parts” in the 257 Mark, and also they are identical to “Measuring, checking (supervision), signalling and life-saving apparatus and instruments; Apparatus for recording, transmission or reproduction of data, sound or images for security purposes” in the 539 Mark. They would be sold together in a retail location, used together in the normal course of operation and also complements each other.

The remaining Contested Goods are highly similar to the Contested Goods not in red¹⁵ of the in the 257 Mark and the 539 Mark. The Contested Goods relating to mobile phones are usually used in conjunction with alarm systems, alarm instruments and electric locks.

It is common feature now that phones are used together as a security device for cars, either to unlock, monitor or secure modern vehicles either via Bluetooth or internet connection.

¹³ Written submissions, dated 10th March 2023

¹⁴ Paragraph 29 - written submissions dated 10th March 2023

¹⁵ Paragraph 30 - written submissions dated 10th March 2023

It is also commonly expected that the remaining Contested Goods not in red,¹⁶ which covers a range of accessories such as covers, cases and styluses would be expected to be sold in retail locations either next to, or together with 257 and 539's Goods and Services. Mobile covers, speakers, carrying cases, headphones and smartphone accessories would be sold for example in IT hardware superstores such as Currys, John Lewis and Argos, where goods such as cameras, radiocommunication apparatus programming apparatus, transmitters, electrical and electronic controllers, integrated circuits (goods in the 539 Mark not in red¹⁷) are also sold.

Hence, the Contested Goods share the same end users of the Earlier Goods in a way that they both would be sold in the same retail location, either a security hardware shop or a general purpose IT shop. It is likely that a provider of locks, alarm apparatus would sell the Contested Goods as part of its retail operation. This creates an obvious overlap with the Earlier Goods and the average consumers are likely to come across both type of services in the same manner and assume that both undertakings operate in the same industry. Hence, there will be a likelihood of confusion among the average consumers.”

Mobile telephones; Mobile phones; Mobile telecommunications handsets

46. Generally speaking, the above contested goods are portable telephones predominately used to make and receive calls but may also have additional functions such as texting facilities, an alarm clock, calculator, camera and video camera, etc. Furthermore, *smartphone* versions of the contested goods also function as portable computer devices combining mobile telephone functions and computing functions in one unit via the use of software applications (apps). The opponent's goods in Class 9 of UKTM 3730539 include *mobile apps; downloadable software applications for mobile devices (smartphones, smart watches, tablet computers, laptop computers)*. These goods are used to operate smartphones (mobile phones) and execute specific tasks via the phone and therefore the application software for mobile devices plays an important role in the function of smartphones. Furthermore, the above contested

¹⁶ Paragraph 32 - written submissions dated 10th March 2023

¹⁷ Paragraph 32 - written submissions dated 10th March 2023

goods are broad terms which will include *smartphones*. Consequently, the contested goods and the opponent's *mobile apps; downloadable software applications for mobile devices (smartphones, smart watches, tablet computers, laptop computers)*, are dependent on one another for their operation. I therefore find them to be complementary. Furthermore, I am of the view that the goods can coincide in end users and producers. However, I acknowledge that the method of use and nature of the goods at issue are different, and that the places that the respective goods are purchased will sometimes differ on the basis that *mobile phones, etc.*, being tangible goods can be purchased in physical stores, whereas *mobile apps; downloadable software applications for mobile devices* being intangible goods will be purchased by downloading them online. Accordingly, I find that the competing goods are similar to a medium degree.

Mobile phone battery chargers; Chargers for mobile phones; Battery chargers for mobile phones; Joystick chargers; Chargers for vaporizers; Chargers for smartphones; Smartphone battery chargers; Cell phone battery chargers; Chargers for electronic cigarettes; Chargers for electronic smokers' articles; USB chargers for electronic cigarettes; Battery chargers for tablet computers; Battery chargers for laptop computers

47. The above contested goods are all various types of chargers for specific named devices. The primary function of the contested goods is to charge batteries and the electronic devices specifically mentioned above. It is noted that the opponent's goods in Class 9 in both its earlier marks do not include *chargers, batteries* or the electronic devices mentioned above. Accordingly, I find that the above contested goods have no points of similarity with the opponent's Class 9 goods contained in its earlier rights. Therefore, despite the opponent's submissions that the above contested goods relating to mobile phones are *usually* used in conjunction *with alarm systems, alarm instruments and electric locks*, I find this to be a very general overlap which is insufficient for a finding of similarity between the goods at issue. The goods at issue will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Furthermore, the goods are neither in competition nor are they complementary. The fact that both sets of goods may be found in the same retail outlet is not determinative since these stores

usually sell a vast range of totally different goods. It is highly unlikely that these goods would be found in the same location or aisle. Accordingly, I find that the contested Class 9 goods listed above are dissimilar to all the opponent's goods listed in Class 9 of its earlier rights. The same conclusion also applies to the opponent's remaining goods and services in Classes 6, 12 and 42, on the basis that they share no direct similarities with the above contested goods.

Fast chargers for mobile devices; Chargers; USB chargers; Portable chargers; Battery chargers; Electric battery chargers; Mains chargers; Wireless chargers; Battery compensation chargers; Wireless battery chargers; Solar battery chargers; Chargers for batteries; Car charger; Electric-car charger

48. The contested goods are all various types of chargers and battery chargers, that feasibly could be used to charge a wide variety of mobile devices and electronic goods, including some of the opponent's goods. That said, I do not find any obvious similarity between the contested goods and the opponent's goods other than the fact that the opponent's goods may need charging or require batteries. However, I consider this too superficial for a finding of similarity between the goods. Furthermore, the opponent has not provided any persuasive submissions in relation to the comparison between the competing goods beyond its suggestion that they are identical. The goods at issue will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Furthermore, the goods are neither in competition nor are they complementary. The fact that both sets of goods may be found in the same retail outlet is not determinative since these stores usually sell a vast range of totally different goods. It is highly unlikely that these goods would be found in the same location or aisle. Accordingly, I find that the contested Class 9 goods listed above are dissimilar to all the opponent's goods listed in Class 9 of its earlier rights. The same conclusion also applies to the opponent's remaining goods and services in Classes 6, 12 and 42, on the basis that they share no direct similarities with the above contested goods.

Encoded smart cards

49. The above contested goods have direct equivalents in the opponent's Class 9 specification of its earlier right UKTM 3730539, although the wording differs slightly namely, *access control cards [encoded or magnetic]* and *smart cards*. Accordingly, I find the competing goods are identical due to their near-identical wording.

Smart card readers

50. Smart cards are physical cards, often made from plastic that have an embedded integrated chip that can be used to store and process information and to control access to a physical location or to data, such as a key card used in hotels and offices, etc. The contested *smart card readers* are devices that read the data stored on a *smart card*. For example, smart card readers can be installed on door locks and electronic doors, in hotels and offices, etc., in order to read the details on a smart card for the purpose of allowing access to a particular room or area. Accordingly, I find that there is a complementary nature between the contested goods and the opponent's *access control cards [encoded or magnetic]; electronic key cards* and *smart cards* contained in Class 9 of its earlier right UKTM 3730539. Although the goods differ in their uses and methods of use, their users and trade channels can overlap. Additionally, the goods can be bought together on the same websites and in the same areas of physical stores. Accordingly, I find the goods at issue to be similar to a medium degree.

Mobile phone covers; Mobile telephone covers; Mobile telephone cases; Mobile phone cases; Cases for mobile phones; Leather cases for mobile phones; Cases adapted for mobile phones; Carrying cases for mobile phones; Protective cases for mobile phones; Carrying cases for mobile telephones; Phone cases; Waterproof smartphone cases; Cases for smartphones; Waterproof cases for smart phones; Carrying cases for mobile computers; Tablet computer cases; Laptop cases; Cases for headphones; Sunglass cases; Eyewear cases; Glasses cases; Eyeglass cases

51. The above contested goods are all covers and cases, specifically designed to protect mobile phones, mobile computers, tablets, laptops, headphones and eyewear. The opponent's goods do not include covers or cases, nor do they include mobile phones, mobile computers, tablets, laptops, headphones and eyewear. As

such, I can see no point of contact between the opponent's class 9 goods and the above contested goods. Not only does the nature and purpose of the goods at issue differ, but they are also unlikely to be sold in the same aisles of retail stores (and their online equivalents) and their trade channels and users are unlikely to overlap. Even if the goods at issue may be sold in the same stores or on the same websites, this is not enough to make the goods similar in a trade mark sense. Furthermore, I do not consider the goods to be complementary or in competition. Accordingly, I find the above goods to be dissimilar to all of the opponent's Class 9 goods in both its earlier marks. The same conclusion also applies to the opponent's remaining goods and services in Classes 6, 12 and 42, on the basis that they share no direct similarities with the above contested goods.

Camera cases; Waterproof camera cases

52. The above contested goods are cases specifically designed to protect cameras. The opponent's Class 9 goods contained in its earlier right UKTM 3730539, include *cameras*. Accordingly, given that the contested goods are dependent on the opponent's goods for their use, and that it is common for undertakings to offer for sale *cameras* and *camera cases*, I consider the competing goods to be complementary. While the nature and uses of the goods differ, the users will overlap. Additionally, the goods at issue are likely to be found under the same category online and in the same or adjacent aisles in physical stores. Overall, I find these goods to be similar to a medium degree.

Memory card cases

53. A memory card is an electronic data storage device used for storing digital information. These are commonly used in digital portable electronic devices, such as *cameras* contained in Class 9 of the opponent's earlier right UKTM 3730539. The above contested *memory card cases* are cases specifically designed to protect memory cards. That said, I do not find any obvious similarity between the contested goods and the opponent's *cameras*, other than the fact that as memory cards can be used in cameras there may be an overlap in users whereby consumers may buy the goods at issue in the same retail outlet or website. However, I consider this too

superficial for a finding of similarity between the goods at issue, which have a different nature, method of use and purpose and are neither complementary nor in competition. Furthermore, the opponent has not provided any persuasive submissions in relation to the comparison between the competing goods beyond its suggestion that they are similar. Accordingly, I find the above goods to be dissimilar to all of the opponent's Class 9 goods in both its earlier marks. The same conclusion also applies to the opponent's remaining goods and services in Classes 6, 12 and 42, on the basis that they share no direct similarities with the above contested goods.

Displays for mobile phones; Mobile phone display screen protectors in the nature of films; Display screen protectors in the nature of films for mobile phones

54. The contested *displays for mobile phones* is the screen at the front of a mobile phone, which is generally covered with a thin layer of protective, scratch-resistant glass in order to resist shattering, etc. The contested *screen protectors in the nature of films*, add an additional layer of protection to the mobile phone display (screen). The contested goods are specifically intended for use with mobile telephones. It is noted that the opponent's goods in Class 9 in both of its earlier rights do not include the above contested goods, nor do they include mobile telephones. Accordingly, I find that the contested goods have no points of similarity with the opponent's Class 9 goods in both its earlier marks. Furthermore, I am unable to agree with the opponent's submissions that the contested goods are either part of, or are components of *electric and electronic monitoring apparatus, in particular alarm systems and parts*. The contested goods are specifically intended for mobile telephones and not the opponent's *electric and electronic monitoring apparatus, in particular alarm systems*. Furthermore, I am not convinced that the goods at issue would be sold together or used together in the normal course of operation and therefore they do not complement each other. Even if the goods at issue are sold in the same retail location, as suggested, this is not determinative since these stores usually sell a vast range of totally different goods. It is highly unlikely that these goods would be found in the same location or aisle. Therefore, the goods at issue will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Furthermore, the goods are neither in competition nor are they complementary. Accordingly, I find that the contested

Class 9 goods listed above are dissimilar to all the opponent's goods in Class 9 contained in both its earlier rights. Furthermore, the same conclusion also applies to the opponent's remaining goods and services in Classes 6, 12 and 42, on the basis that they share no direct similarities with the above contested goods.

Visual display screens; LED screen displays; Screens; Visual display screens; Display screen filters; Touch screen pens; Computer stylus; Stylus [light pens]

55. The contested *visual display screens; LED screen displays; screens; visual display screens; display screen filters* are display devices for the presentation of text, images, or video, etc., transmitted electronically and can generally be found on a range of different electronic devices. The contested *touch screen pens; computer stylus; stylus [light pens]* are generally used in conjunction with visual display screens, allowing the user to point to displayed objects, etc., in a similar way to a touchscreen but with greater accuracy. The contested display screens and light pens are often found together on various types of electronic goods including security goods such as alarms and monitoring apparatus, etc. Accordingly, I find that the above contested goods share a degree of similarity with the applicant's *warning alarms other than for vehicles; Electric and electronic monitoring apparatus, in particular alarm systems and parts thereof*, found in Class 9 of the opponent's earlier right UKTM 917879257, and *electric and electronic monitoring apparatus; alarms; access control installations; movement pattern recognition apparatus* found in Class 9 of the opponent's earlier right UKTM no. 3730539, on the basis that the contested goods may be essential components in the opponent's goods and are dependent on the applicant's goods to function effectively. Since the opponent's goods are likely to have built-in visual display screens with accompanying light pens, etc., it is possible that over time, these screens or pens may need replacing, as such, it seems likely that the same undertaking will provide replacements. Accordingly, since the screens and pens, etc., may be required for the operation of the opponent's goods, I find the competing goods to be complementary. Whilst the nature and uses of the goods differ, the users will overlap. Overall, I find these goods to be similar to a low degree.

Mobile data receivers

56. Broadly speaking, the contested *mobile data receivers* receive data signals, such as radio waves, and converts them in to a useful form, such as voice and text messages to a mobile telephone. The opponent's earlier right, UKTM 3730539, contains *apparatus for transmission of data for security purposes* which permits the transmission of data by sending and receiving data via cables or wireless systems. Accordingly, I find that there are points of similarity between the competing goods since they are both concerned with data communication involving data transmission or reception. Therefore, although the competing goods may have a different nature, their purpose and distribution channels may overlap, and as such I find that they are similar to a low degree.

Overvoltage protectors; Surge protectors; Protectors (Voltage surge -); Voltage surge protectors

57. The contested goods protect electronic equipment from unwanted power surges or spikes on the basis that a small amount of voltage increase, etc., can cause damage to most electronic devices. Therefore, the contested goods are often installed alongside electrical devices or are incorporated therein. For example, *warning alarms other than for vehicles and electric and electronic monitoring apparatus, in particular alarm systems and parts thereof* included in Class 9 of the opponent's earlier rights, will often have built-in voltage surge protectors which on detection of an overcurrent (surge) will break the electrical circuit in order to prevent damage to the system or false alarm activation, etc. Accordingly, I find that these competing goods share a degree of similarity on the basis that the contested goods may be an essential component in the opponent's goods and therefore are dependent on the applicant's goods to function effectively. Since the opponent's goods are likely to have built-in *surge protectors*, it is possible that over time, these may need replacing, and as such, it seems likely that the same undertaking will provide replacements surge protectors. Accordingly, since the surge protectors at issue, may be required for the effective operation of the opponent's goods, I find the competing goods to be complementary. Whilst the nature and uses of the goods differ, the users will overlap. Overall, I find these goods to be similar to a low degree.

Mobile phone speakers; Mobile phone straps; Selfie sticks used as smartphone accessories; Keyboards for mobile phones; Mobile phone docking stations; Mobile telephone batteries; Batteries for mobile phones; Headsets for mobile telephones; Headphones for smart phones; Headphones; Headphone consoles; Stereo headphones; Wireless headphones; Headphone amplifiers; Music headphones; In-ear headphones; Noise cancelling headphones; Ear pads for headphones; Adapter cables for headphones; Two-way plugs for headphones; Wireless headsets for smart phones; Tempered glass screen protectors for smartphones; Glasses; Smart glasses; Waling glasses; Protective glasses; Dustproof glasses; Sports glasses; Magnifying glasses; Glasses frames; Teeth protectors; Eye protectors

58. I do not find any obvious similarity between the applicant's remaining Class 9 goods, listed above, and the opponent's Class 9 goods contained in its earlier rights. Even if the goods at issue are sold in the same retail location, this is not persuasive since these stores usually sell a vast range of totally different goods and it is highly unlikely that these goods would be found in the same location or aisle. Moreover, I find that the goods at issue will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Furthermore, the goods are neither in competition nor are they complementary. Moreover, the opponent has not provided any persuasive submissions in relation to the comparison between the competing goods beyond its suggestion that they are identical or similar. Accordingly, I find that the above contested goods are dissimilar to all the opponent's Class 9 goods in both its earlier rights. The same conclusion also applies to the opponent's remaining goods and services in Classes 6, 12 and 42, on the basis that they share no direct similarities with the above contested goods.

59. Similarity of goods is essential for a finding of a likelihood of confusion.¹⁸ As a consequence, the opposition fails with respect of the following goods:

Class 9 Mobile phone battery chargers; Chargers for mobile phones; Battery chargers for mobile phones; Joystick chargers; Chargers for vaporizers; Chargers

¹⁸ *Waterford Wedgwood plc v OHIM*, Case C-398/07 P, CJEU

for smartphones; Smartphone battery chargers; Cell phone battery chargers; Chargers for electronic cigarettes; Chargers for electronic smokers' articles; USB chargers for electronic cigarettes; Battery chargers for tablet computers; Battery chargers for laptop computers; Fast chargers for mobile devices; Chargers; USB chargers; Portable chargers; Battery chargers; Electric battery chargers; Mains chargers; Wireless chargers; Battery compensation chargers; Wireless battery chargers; Solar battery chargers; Chargers for batteries; Car charger; Electric-car charger; Mobile phone covers; Mobile telephone covers; Mobile telephone cases; Mobile phone cases; Cases for mobile phones; Leather cases for mobile phones; Cases adapted for mobile phones; Carrying cases for mobile phones; Protective cases for mobile phones; Carrying cases for mobile telephones; Phone cases; Waterproof smartphone cases; Cases for smartphones; Waterproof cases for smart phones; Carrying cases for mobile computers; Tablet computer cases; Laptop cases; Cases for headphones; Sunglass cases; Eyewear cases; Glasses cases; Eyeglass cases; Memory card cases; Displays for mobile phones; Mobile phone display screen protectors in the nature of films; Display screen protectors in the nature of films for mobile phones; Mobile phone speakers; Mobile phone straps; Selfie sticks used as smartphone accessories; Keyboards for mobile phones; Mobile phone docking stations; Mobile telephone batteries; Batteries for mobile phones; Headsets for mobile telephones; Headphones for smart phones; Headphones; Headphone consoles; Stereo headphones; Wireless headphones; Headphone amplifiers; Music headphones; In-ear headphones; Noise cancelling headphones; Ear pads for headphones; Adapter cables for headphones; Two-way plugs for headphones; Wireless headsets for smart phones; Tempered glass screen protectors for smartphones; Glasses; Smart glasses; Waling glasses; Protective glasses; Dustproof glasses; Sports glasses; Magnifying glasses; Glasses frames; Teeth protectors; Eye protectors.

The average consumer and the nature of the purchasing act

60. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

61. 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.”

62. The average consumer of the goods at issue is likely to include members of the general public as well as business and professional users. These purchases are likely to vary from fairly frequent to infrequent, depending on the nature of the goods being purchased. The goods will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers’ physical premises, the goods will be displayed on shelves and in cabinets. A similar process will apply when the goods are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Given the goods at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods, the average consumer is likely to pay at least a medium degree of attention.

Likelihood of confusion

63. 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 I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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.

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

65. Earlier in the decision I found the goods at issue to vary from being identical to dissimilar. I have identified the average consumer to include a member of the general public, business or professional, who, paying at least a medium degree of attention, will select the goods predominantly by visual means, although I do not discount an aural component. The contested mark and the opponent's marks are visually similar to a very high degree, either aurally identical or aurally similar to a high degree and either conceptually identical or conceptually similar to a medium degree. I have found the opponent's marks to be inherently distinctive to a medium degree.

66. Although under section 5(2)(a) I found the marks at issue to not be identical, they are visually similar to a very high degree, aurally identical or aurally similar to a high degree and either conceptually identical or conceptually similar, on the basis that the marks identically share the same first five letters, namely 'Smart / SMART' with the only difference being that the opponent's marks contain a capital letter 'X' at the end of the mark, whereas the contested mark contains a graphical device element at the end that closely resembles the letter 'X'. The fact that the marks at issue identically share the same first five letters is an important point of coincidence, being where

consumers tend to focus.¹⁹ Accordingly, I am of the view that the average consumer is likely to remember the marks at issue as 'Smart-X' marks and either overlook or misremember the stylisation in the final letter 'X' in the contested mark. As such, I am of the view that a significant proportion of consumers will mistake one trade mark for the other despite some of the goods being similar to only a low degree, and therefore, I find that there is a likelihood of direct confusion. Furthermore, even if consumers notice the stylistic difference of the 'X', they will put it down to a re-branding rather than the marks originating from different undertakings and so there is also a likelihood of indirect confusion.

Conclusion

67. The opposition under section 5(2)(b) has been partially successful. The application is refused for the following goods:

Class 9 Mobile telephones; Mobile phones; Mobile telecommunications handsets; Encoded smart cards; Smart card readers; Camera cases; Waterproof camera cases; Visual display screens; LED screen displays; Screens; Visual display screens; Display screen filters; Touch screen pens; Computer stylus; Stylus [light pens]; Mobile data receivers; Overvoltage protectors; Surge protectors; Protectors (Voltage surge -); Voltage surge protectors.

68. The opposition fails under Section 5(2)(b) for the following goods which can proceed to registration:

Class 9 Mobile phone battery chargers; Chargers for mobile phones; Battery chargers for mobile phones; Joystick chargers; Chargers for vaporizers; Chargers for smartphones; Smartphone battery chargers; Cell phone battery chargers; Chargers for electronic cigarettes; Chargers for electronic smokers' articles; USB chargers for electronic cigarettes; Battery chargers for tablet computers; Battery chargers for laptop computers; Fast chargers for mobile devices; Chargers; USB chargers; Portable chargers; Battery chargers; Electric battery chargers; Mains

¹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

chargers; Wireless chargers; Battery compensation chargers; Wireless battery chargers; Solar battery chargers; Chargers for batteries; Car charger; Electric-car charger; Mobile phone covers; Mobile telephone covers; Mobile telephone cases; Mobile phone cases; Cases for mobile phones; Leather cases for mobile phones; Cases adapted for mobile phones; Carrying cases for mobile phones; Protective cases for mobile phones; Carrying cases for mobile telephones; Phone cases; Waterproof smartphone cases; Cases for smartphones; Waterproof cases for smart phones; Carrying cases for mobile computers; Tablet computer cases; Laptop cases; Cases for headphones; Sunglass cases; Eyewear cases; Glasses cases; Eyeglass cases; Memory card cases; Displays for mobile phones; Mobile phone display screen protectors in the nature of films; Display screen protectors in the nature of films for mobile phones; Mobile phone speakers; Mobile phone straps; Selfie sticks used as smartphone accessories; Keyboards for mobile phones; Mobile phone docking stations; Mobile telephone batteries; Batteries for mobile phones; Headsets for mobile telephones; Headphones for smart phones; Headphones; Headphone consoles; Stereo headphones; Wireless headphones; Headphone amplifiers; Music headphones; In-ear headphones; Noise cancelling headphones; Ear pads for headphones; Adapter cables for headphones; Two-way plugs for headphones; Wireless headsets for smart phones; Tempered glass screen protectors for smartphones; Glasses; Smart glasses; Waling glasses; Protective glasses; Dustproof glasses; Sports glasses; Magnifying glasses; Glasses frames; Teeth protectors; Eye protectors.

Costs

69. On balance, I consider that both parties have achieved a relatively equal level of success in these proceedings. In the circumstances, I do not consider it appropriate to make a costs award in favour of either party. Therefore, I order both parties to bear their own costs in these proceedings.

Dated this 5th day of March 2023

Sam Congreve
For the Registrar