

**O/0520/23**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**  
**TRADE MARK APPLICATION NO 3719111 BY**  
**BEIJING CHJ INFORMATION TECHNOLOGY CO., LTD**  
**TO REGISTER:**

**METAUNIVERSE**

**IN CLASSES 7, 9, 12, 37 & 42**

**AND**

**TWO OPPOSITIONS THERETO**  
**UNDER NOS. 432280 & 432281**  
**BY**  
**METAMATERIAL INC.**

## BACKGROUND & PLEADINGS

1. Beijing Chj Information Technology Co., Ltd (“**the applicant**”) applied to register the mark shown on the front page of this decision in the United Kingdom. The application was filed on 8 November 2021 and was published on 4 February 2022. As the contested specification is voluminous, the relevant goods and services in Classes 7, 9, 12, 37 and 42 for the purposes of these proceedings are reproduced in the Annex at the end of this decision.
2. These consolidated opposition proceedings concern two opponents that are related companies. The oppositions are as follows:

### Opposition no. 432280

3. Metamaterial Inc. (“**the first opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following series of two UK trade marks registrations:

<b>Trade Mark no.</b>	UK00003646816
<b>Series of two Trade Mark</b>	
<b>Goods &amp; Services Relied Upon</b>	<b>Classes 1, 9, 10, 11, 12, 35 &amp; 44</b>
<b>Relevant Dates</b>	Filing date: 25 May 2021
	Date of entry in the register: 24 December 2021

4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent's earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
  
5. For the purpose of this opposition, the opponent, as shown above, relies on all goods and services of the series of marks, while opposing some goods and services as shown later in the decision.

Opposition no. 432281

6. Metacontinental Inc. ("**the second opponent**") opposes the application on the basis of Section 5(2)(b) of the Act. The second opponent is the proprietor of the following UK trade mark registration:

<b>Trade Mark no.</b>	UK00003488682
<b>Trade Mark</b>	META
<b>Goods Relied Upon</b>	Class 12
<b>Relevant Dates</b>	Filing date: 11 May 2020
	Date of entry in the register: 25 February 2022

7. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent's earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
  
8. For the purpose of this opposition, the opponent, as shown above, relies on all goods and services of the earlier mark, while opposing some goods and all the services as shown later in this decision.

### The Applicant's Defences

9. The applicant filed notices of defence in each case.
10. In relation to the opposition no. 432280, the applicant with its counterstatement denied the opponent's claims in relation to the competing marks stating that "the Applicant's mark with the Opponent's mark, it is denied that the marks are visually, aurally or conceptually similar. The differences between the marks would be clear to the average consumer, and would not be interpreted as a brand extension or evolution." Further, in terms of the competing goods, the applicant admits similarity in relation to part of the Class 12 goods denying any identity or similarity for the rest of the goods and services between the competing specifications.
11. In relation to the opposition no. 432281, the applicant denies any similarity between the competing marks. Further, the applicant denies identity or similarity in relation to the same goods in the same terms as in the preceding paragraph.

### Papers Filed and Representation

12. Only the opponent filed evidence in these proceedings, which will not be summarised but will be referred to as and where appropriate during this decision.
13. No hearing was requested but both parties filed written submissions in lieu and so this decision is taken following a careful perusal of the papers.
14. In these proceedings, the applicant is represented by Handsome I.P. Ltd and the opponents by Kilburn & Strode LLP.
15. 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 Trade Marks Act relied on 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.

## **EVIDENCE**

### **Opponent's Witness Statement**

16. Only the opponents filed evidence in these proceedings. It consists of a witness statement, dated 30 September 2022, of Rachel Harrison a senior associate and trade mark attorney at Kilburn & Strobe LLP, who is the legal representative of the opponents, introducing 3 Exhibits. As per the witness statement the evidence consists of extracts from the *shop.bmw.co.uk* website.
17. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## **DECISION**

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

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

“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”.

19. The principles considered in these oppositions stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd*

*Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the goods and services at issue**

20. 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.

(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.”

21. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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 complementary.”

22. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;  
(b) The respective users of the respective goods or services;  
(c) The physical nature of the goods or acts of service;  
(d) The respective trade channels through which the goods or services reach the market;  
(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;  
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

23. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

24. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

25. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

26. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

27. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast

range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

28. In *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 the Court of Appeal (CoA) decided that “the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.”

29. In *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the Class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where “*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.*”

Opposition no. 432280

30. The competing goods and services to be compared are shown in the following table:

<b>Opponent’s goods and services</b>	<b>Applicant’s goods and services</b>
<b>Class 1:</b> Transparent conductive film; lithographic film; holographic film; transparent conductive film for	

anti-icing and de-icing purposes for use on, or within, automotive, aerospace and marine vehicles; transparent conductive film for anti-icing and de-icing purposes for use on, or within, windscreens and windows for automotive, aerospace and marine vehicles; transparent conductive film for anti-fogging and de-fogging purposes for use on, or within, automotive, aerospace and marine vehicles; transparent conductive film for anti-icing and de-icing purposes for use on, or within, windscreens and windows for automotive, aerospace and marine vehicles; transparent conductive film for use in the creation of touch sensor functions for displays within automotive, aerospace and marine vehicles; transparent conductive film for use in medical devices and apparatus to aid the detection and diagnosis of medical conditions; transparent conductive film for electromagnetic shielding; transparent conductive film for reflection of mobile network signal; transparent conductive film for use on protective glasses, visors and goggles; lithographic film for anti-icing and de-icing purposes for use on, or within, automotive, aerospace and marine vehicles; lithographic film for anti-icing and de-icing purposes for use on, or within, windscreens and windows for automotive, aerospace and marine vehicles; lithographic film for anti-fogging and de-fogging purposes for use on, or within, automotive, aerospace and marine vehicles; lithographic film for anti-icing and de-icing purposes for use on, or within, windscreens and windows for automotive, aerospace and marine vehicles; lithographic film for use in the creation of touch sensor functions for displays within automotive, aerospace and marine

<p>vehicles; lithographic film for use in medical devices and apparatus to aid the detection and diagnosis of medical conditions; lithographic film for electromagnetic interference (EMI) shielding; lithographic film for reflection of mobile network signal; lithographic film for use on protective goggles and visors.</p>	
	<p><b>Class 7:</b> Machines for lifting vehicles; vehicle trolley jacks [machines]; tyre building machines; carburetors; dynamos; pneumatic controls for machines, motors and engines; bearings for vehicles; vehicle washing installations; starters for motors and engines.</p>
<p><b>Class 9:</b> Holographic filters; dielectric optical metamaterial filters; optical filters; optical deflectors; filters for optical devices, instruments and apparatus; optical filters for screens and displays; optical filters for interactive video walls, architecture and smart windows; filters for augmented reality systems; filters for displays and cameras; optical filters to provide protection against electromagnetic radiation; optical filters to provide protection against lasers and bright lights; transparent antennas for use in telecommunication apparatus; transparent antennas for use in automotive, aerospace and marine vehicles; eyewear; protective eyewear, visors, goggles and screens; optical sensors; periscopes; night vision goggles and devices; mobile application software for use with blood glucose monitors; mobile application software for the collection and analysis of data relating to blood glucose levels; mobile application software for the calculation and forecasting of trends in blood glucose levels.</p>	<p><b>Class 9:</b> Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Wearable computers; personal digital assistants [PDAs]; thin client computers; computer programmes [programs], recorded; smartwatches; smartglasses; wearable video display monitors; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; car antennas; navigation apparatus for vehicles [on-board computers]; car televisions; car audio equipment; dashboard cameras; rearview cameras for vehicles; tire-pressure monitoring system (TPMS) indicators; tire</p>

	<p>tread depth gauges; tyre pressure gauges; voltage regulators for vehicles; electronic control unit for automobiles; voltage stabilizing power supplies; eyeglasses; batteries, electric; rechargeable power batteries for electric vehicles; battery charging devices for motor vehicles; chargers for electric batteries; mobile power source (rechargeable batteries); accumulators, electric, for vehicles; speed checking apparatus for vehicles; protection devices for personal use against accidents; vehicle breakdown warning triangles; data processing apparatus; computer software applications, downloadable; parking meters; equipment for communication network.</p>
<p><b>Class 10:</b> Blood glucose monitors; non-invasive blood glucose monitors.</p>	
<p><b>Class 11:</b> Headlights for automotive, aerospace and marine vehicles; headlights for automotive, aerospace and marine vehicles featuring anti-icing and de-icing properties; headlights for automotive, aerospace and marine vehicles featuring anti-fogging and de-fogging properties.</p>	
<p><b>Class 12:</b> Windscreens and windows for automotive, aerospace and marine vehicles; automotive glass; mirrors for automotive, aerospace and marine vehicles; windscreens and windows for automotive, aerospace and marine vehicles featuring anti-icing and de-icing properties; windows for vehicles featuring anti-icing and de-icing properties; automotive glass featuring anti-icing and de-icing properties; mirrors for automotive, aerospace and marine vehicles featuring anti-icing and de-icing</p>	<p><b>Class 12:</b> Vehicles; apparatus for locomotion by land, air or water; Electric vehicles; locomotives; vehicles for locomotion by land, air, water or rail; remote control vehicles, other than toys; electric cars; robotic cars; automobiles; automobile bodies; automobile chassis; anti-theft devices for automobiles; shock absorbers for automobiles; automotive upholstery; brake pads for automobiles; ski carriers for cars; automotive engine; cigar lighters for automobiles; safety harnesses</p>

<p>properties; windows for automotive, aerospace and marine vehicles featuring anti-icing and de-icing properties; mirrors for automotive, aerospace and marine vehicles featuring anti-fogging and de-fogging properties; windows for automotive, aerospace and marine vehicles featuring anti-fogging and de-fogging properties; automotive glass.</p>	<p>for automobile seats; driverless cars [autonomous cars]; self-driving cars; cars; pushchairs; repair outfits for inner tubes; tyres for vehicle wheels; safety seats for children, for vehicles; suspension shock absorbers for vehicles; aeronautical apparatus, machines and appliances; aeroplanes; air bags [safety devices for automobiles]; air cushion vehicles; air pumps [vehicle accessories]; air vehicles; aircraft; all-terrain vehicles; ambulances anti-skid chains; armoured vehicles; automobile chains; automobile hoods; axles for vehicles; bicycles; bicycle bells; bicycle brakes; bicycle chains; bicycle cranks; bicycle frames; bicycle handlebars; bicycle kickstands; bicycle motors; bicycle mudguards; bicycle pedals; bicycle saddles; bicycle trailers; bicycle tires; bicycle wheels; electric bicycles; boats; bodies for vehicles; brakes for vehicles; bumpers for automobiles; camping cars; motor homes; caravans; motor cars; hydraulic circuits for vehicles; civilian drones; clutches for land vehicles; couplings for land vehicles; crankcases for land vehicle components, other than for engines; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; motors for land vehicles; forklift trucks; gear boxes for land vehicles; gearing for land vehicles; gears for bicycles; golf carts [vehicles]; head-rests for vehicle seats; helicopters; hoods for vehicles; horns for vehicles; hot air balloons; hub caps; hubs for bicycle wheels; hubs for vehicle wheels; jet engines for land vehicles; locomotives;</p>
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	<p>lorries; trucks; luggage carriers for vehicles; mobility scooters; mopeds; motor coaches; motorcycle chains; motorcycle engines; motorcycle frames; motorcycle handlebars; motorcycle kickstands; motorcycle saddles; motorcycles; mudguards; baby carriages; pumps for bicycle tires; remote control vehicles, other than toys; bicycle wheel rims; vehicle wheel rims; robotic cars; safety belts for vehicle seats; seat covers for vehicles; security harness for vehicle seats; side cars; signal arms for vehicles; space vehicles; spare wheel covers; sports cars; tractors; trailers [vehicles]; transmission chains for land vehicles; transmission shafts for land vehicles; transmissions for land vehicles; tricycles; two-wheeled trolleys; luggage trucks; vans [vehicles]; vehicle bumpers; vehicle chassis; vehicle seats; vehicle suspension springs; vehicle wheels; electric vehicles; Sunroofs for automobiles; anti-glare devices for vehicles; rearview mirrors; headlight wipers; side view mirrors for vehicles; windows for vehicles; windscreens; windshield wipers.</p>
<p><b>Class 35:</b> Cloud-based data management system for the storage and consolidation of data relating to diabetes and the monitoring of blood glucose levels.</p>	
	<p><b>Class 37:</b> Installation of parts for vehicles; vehicle repair; Providing information relating to repairs; upholstering; rebuilding engines that have been worn or partially destroyed; vehicle service stations [refuelling and maintenance]; maintenance and repair of land vehicles; vehicle maintenance; vehicle battery charging; anti-rust treatment for</p>

	vehicles; vehicle breakdown repair services; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; charging of electric vehicles; rustproofing; retreading of tyres; vulcanization of tyres [repair]; repair of rubber tires; spraying and coating service.
	<b>Class 42:</b> Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Technical research; quality control; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; calibration (measuring); vehicle roadworthiness testing; styling (industrial design); design of interior decor; computer programming; mechanical research.
<b>Class 44:</b> Medical advice relating to diabetes and blood glucose monitoring; healthcare services relating to diabetes and blood glucose monitoring.	

31. The opponent provided lengthy submissions as to the identity or similarity between the competing goods and services, which I have taken into account. However, I will refer to them wherever it is deemed necessary.
  
32. As mentioned in the beginning of this decision, in its counterstatements and submissions, the applicant explicitly admitted similarity for part of the goods in Class 12, namely “*sunroofs for automobiles; anti-glare devices for vehicles; rearview mirrors; side view mirrors for vehicles; windows for vehicles; windscreens*”. However, with its submissions, it denies similarity

or identity for the rest of the competing terms. I note that the applicant made lengthy submissions which I have considered but I do not propose to reproduce here. Nevertheless, the applicant highlights in its submissions the following:

“10. We note that the Opponents have filed exhibits RJH1, RJH2 and RJH3 to demonstrate that certain goods and services are sold by the same undertakings, via the same trading channels. These exhibits are all taken from the website of BMW, who are one of the largest automotive manufacturers in the world. It is not denied that BMW does offer the goods and services shown in the exhibits.

11. However, the exhibits show no evidence of the offering of the types of services listed in the Applicant's Class 42; viz. Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Technical research; quality control; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; calibration (measuring); styling (industrial design); design of interior decor; computer programming; mechanical research.

12. Accordingly, it is submitted that the Opponents have failed to demonstrate that the average consumer would expect to find the services (apart from perhaps "vehicle roadworthiness testing") listed in the Applicant's Class 42 also offered by the same undertaking as the goods and services listed in other classes.

13. Furthermore, although it may be reasonable to suppose that a company which sells vehicles would also be expected to sell vehicle spares and accessories, it would be unreasonable to expect a company that sells windscreen replacement services, or brake pads, to also sell vehicles. In other words, it is not always possible, or

reasonable, to state that the average consumer would expect a single point of origin for a wide variety of goods and services.

14. Further still, it is submitted that it is incorrect for the Opponent to broaden-out its registered goods and services to any extent desired on the basis that BMW offers many different goods and service at a single point of sale, especially where no evidence has been submitted that BMW offers most of the goods and services listed in the present Application.”

33. While I have considered the opponent’s evidence, I agree with the applicant’s submissions that this is of little, if any, relevance to these proceedings as the goods shown in the evidence are a wide range of goods, predominantly consisting of car parts, sold from a third party (BMW) that is not pertinent to this case. Moreover, it would be inappropriate to base my evaluation on how the goods are sold by a single trader.
34. In addition, for the avoidance of doubt, pursuant to Section 60A(1) of the Act, goods and services are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.
35. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.<sup>1</sup>

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<sup>1</sup> *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

## **Class 7**

Machines for lifting vehicles; vehicle trolley jacks [machines]; tyre building machines; carburetors; dynamos; pneumatic controls for machines, motors and engines; bearings for vehicles; vehicle washing installations; starters for motors and engines.

36. The opponent submits that the contested goods “are all similar to the vehicle and automotive related goods protected under Classes 12, 11, 9, and 1 of the Opponents’ Earlier Registrations.” I note that the contested goods in Class 7 are not everyday goods. In the absence of evidence and specific submissions providing points of similarity, I can see no obvious similarity between the goods in the competing specifications. Taking into account the relevant Classes under which the competing goods are registered or applied for,<sup>2</sup> I consider that the nature, purpose, method of use and trade channels will differ. Even though the users may overlap at a general level between the above contested goods and the opponent’s Class 12 goods, this overlap is superficial and insufficient to find any similarity. As a result, I find them to be dissimilar.

## **Class 9**

Eyeglasses

37. The opponent’s term “eyewear” in the same Class is a broad term and covers the contested goods. I find them to be identical based on *Meric*.

Smart glasses; wearable video display monitors; Wearable computers; smartwatches

38. The opponent submits that the contested terms “are either identical or highly similar to the Class 9 goods *eyewear; protective eyewear, visors,*

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<sup>2</sup> See *Altecnic Ltd’s Trade Mark Application*.

*goggles and screens; night vision goggles and devices* protected under the Earlier Registration No. UK00003646816, as they are the same in nature (eyewear), serve the same purpose, are offered by the same undertakings and aimed at the same consumers.” I disagree with the opponent’s submissions. In the absence of evidence, although the competing goods may share the same general nature and method of use (being worn on the head), they do not serve the same purpose. The contested goods are wearables with smart and advanced features such as hands-free voice assistance, cellular communication, or video capabilities, whilst the opponent’s goods are designed to protect or enhance the wearer’s vision. Furthermore, they do not share users or trade channels, and there is no degree of competition or complementarity. The above factors are insufficient to find similarity, and any similarity between the respective goods is merely superficial.

39. The contested goods “*smartwatches*” are a step further apart from the opponent’s goods compared to those of the previous paragraph. This is because they are explicitly intended for the wrists, not the head. As a result, they differ in the method of use, nature, purpose, and trade channels, and are not in competition or complementary. I find them to be dissimilar.

#### *Car antennas*

40. The contested term is a broad term that encapsulates the opponent’s “*transparent antennas for use in automotive, aerospace and marine vehicles*”. Therefore, I find them to be identical based on *Meric*.

#### *Computer programmes [programs], recorded; computer software applications, downloadable; [...] computer software [...]*

41. The contested goods are broad terms covering the opponent’s goods “*mobile application software for use with blood glucose monitors; mobile application software for the collection and analysis of data relating to blood*

*glucose levels; mobile application software for the calculation and forecasting of trends in blood glucose levels*". Thus, they are Meric identical, or else, they are highly similar sharing the same nature, purpose, method of use, users, and trade channels.

*[...] photographic, cinematographic, audiovisual, optical, [...] apparatus and instruments*

42. The contested goods are broad terms that could readily cover the opponent's "*optical filters; optical deflectors; filters for optical devices, instruments and apparatus; optical filters for screens and displays*". Thus, I find them to be identical as per Meric.

43. If I am wrong in the above finding, I consider that the opponent's goods "*optical filters; optical deflectors; filters for optical devices, instruments and apparatus*" are highly similar to the contested goods. This is due to the potential for complementarity, such as the use of optical filters or devices with cameras, video cameras, or camcorders for photography or cinematography. The nature, purpose, method of use, users, and trade channels will overlap. Thus, I find highly similarity between the goods.

*Apparatus and instruments for [...] processing [...] data; data processing apparatus*

44. I consider that closest comparable term from the opponent's specification is the term "*mobile application software for the collection and analysis of data relating to blood glucose levels*". Even if they differ in nature (tangible and intangible), both have the same general purpose (processing of data). Such data processing programs include data relating to the field of blood glucose levels, so it is not as though the limitation in the opponent's specification avoids this potential point of similarity. This is because the competing goods are aimed at data processing functions. Also, there could be an overlap in users and trade channels. In light of the above, it is

considered that there is a medium degree of similarity between the respective goods.

Car audio equipment; car televisions; dashboard cameras; rearview cameras for vehicles; voltage regulators for vehicles; vehicle breakdown warning triangles; tire tread depth gauges; tire-pressure monitoring system (TPMS) indicators; tyre pressure gauges; speed checking apparatus for vehicles; navigation apparatus for vehicles [on-board computers]

45. The contested goods are all car- or vehicle-specific items. The closest comparable terms from the opponent's specification are the goods in Class 12, such as "Windscreens and windows for automotive [...]; mirrors for automotive". The trade channels for the competing goods coincide as they would be sold in automotive shops (retail or online). To that extent, the users would overlap too. However, the competing goods differ in nature, purpose and method of use. However, I do not consider that they are complementary or in competition. I find that the goods are similar to a low degree.

Batteries, electric; battery charging devices for motor vehicles; chargers for electric batteries; mobile power source (rechargeable batteries); rechargeable power batteries for electric vehicles; inverters [electricity]; electronic control unit for automobiles; accumulators, electric, for vehicles; voltage stabilizing power supplies; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity

46. The contested goods contain broad terms, such as batteries, which can cover car batteries and other power-related goods. Following the same approach in the preceding paragraph, I find that the contested goods will share the same trade channels and users as the opponent's in Class 12 goods. They will, however, differ in nature, purpose, and method of use, having no degree of complementarity or competition. I find the competing goods to be similar to a low degree

Scientific, research, navigation, surveying, [...] weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media [...] blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; [...] computer peripheral devices; apparatus and instruments for recording, transmitting, reproducing or processing sound, images [...] diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; thin client computers; telecommunication apparatus in the form of jewellery; cases for smartphones; covers for smartphones; security surveillance robots; audio- and video-receivers; plugs, sockets and other contacts (electric connection); terminals [electricity]; animated cartoons; sound recording carriers; protection devices for personal use against accidents; equipment for communication network

47. As for the rest of the contested goods in Class 9, I do not consider that there is any similarity between the competing specifications. Despite the opponent's submissions that the Class 9 goods are complementary, I fail to see how this is the case. Even if the contested goods in Class 9 are used together with the opponent's goods, these are not deemed complementary in the sense that one is indispensable to the other. The opponent also refers me to the evidence, where it is shown, for example, that BMW not only sells car parts but also smartwatches. I do not consider that this is relevant as my analysis is conducted on a notional basis and not how the goods are actually traded. Further, the example of a single trader, who in this case is a very large and well-known company, does not establish convergence in the market at such a level that would justify a finding of complementarity and, to that extent, a finding of similarity. Considering the differences in nature, purpose, trade channels, method of use, and users between the competing specifications, I conclude that they are dissimilar.

## **Class 12**

Sunroofs for automobiles; anti-glare devices for vehicles; rearview mirrors; side view mirrors for vehicles; windows for vehicles; windscreens

48. As explained earlier in this decision, the applicant admits similarity for the above contested terms. That said, I will need to assess the degree of similarity between the competing goods.
49. The contested terms “*windows for vehicles; windscreens*” are identical to the opponent’s “*Windscreens and windows for automotive, aerospace and marine vehicles*” as they are identically worded or ostensibly the same.
50. As for the rest of the contested terms, they will be covered by the opponent’s broad terms “*windows for automotive; automotive glass; mirrors for automotive; windscreens and windows for automotive*”. Thus, I find them to be identical as per *Meric*.
51. Vehicles; air cushion vehicles; air vehicles; aircraft; armoured vehicles; automobiles; camping cars; caravans; cars; driverless cars [autonomous cars]; electric cars; electric vehicles; helicopters; hot air balloons; locomotives; lorries; motor cars; motor coaches; motor homes; robotic cars; robotic cars; self-driving cars; side cars; vans [vehicles]; sports cars; tractors; trucks; space vehicles; vehicles for locomotion by land, air, water or rail; ambulances; Golf carts [vehicles]; mobility scooters; mopeds; motorcycles; tricycles; trailers [vehicles]; boats; forklift trucks
52. The contested goods in question are vehicles and their sub-categories. I consider that the closest comparable terms from the opponent’s specification are “*Windscreens and windows for automotive, aerospace and marine vehicles; automotive glass; mirrors for automotive, aerospace and marine vehicles*”. These goods are not only used together but are also indispensable to each other, creating a complementary relationship. This is because the earlier vehicle parts/components, such as mirrors and

windows, are required for the proper use of the final products, i.e. vehicles. Although the competing goods differ in purpose, method of use, and nature, they could be manufactured by the same undertakings, target the same users, and could be sold as spare parts. In addition, they could share the same trade channels. Taking into account all the above factors, I find that they are similar to at least a medium degree.

Air bags [safety devices for automobiles]; air pumps [vehicle accessories]; anti-skid chains; aeronautical apparatus, machines and appliances; aeroplanes; apparatus for locomotion by land, air or water; all-terrain vehicles; automobile bodies; automobile chains; automobile chassis; automobile hoods; anti-theft devices for automobiles; anti-glare devices for vehicles; automotive engine; automotive upholstery; axles for vehicles; bodies for vehicles; brake pads for automobiles; brakes for vehicles; bumpers for automobiles; cigar lighters for automobiles; clutches for land vehicles; couplings for land vehicles; crankcases for land vehicle components, other than for engines; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; gear boxes for land vehicles; gearing for land vehicles; headlight wipers; head-rests for vehicle seats; hoods for vehicles; horns for vehicles; hub caps; hubs for bicycle wheels; hubs for vehicle wheels; hydraulic circuits for vehicles; jet engines for land vehicles; luggage carriers for vehicles; luggage trucks; motorcycle chains; motorcycle engines; motorcycle frames; motorcycle handlebars; motorcycle kickstands; motorcycle saddles; motors for land vehicles; safety belts for vehicle seats; safety harnesses for automobile seats; safety seats for children, for vehicles; seat covers for vehicles; security harness for vehicle seats; shock absorbers for automobiles; signal arms for vehicles; ski carriers for cars; vehicle bumpers; vehicle chassis; vehicle seats; vehicle suspension springs; vehicle wheel rims; vehicle wheels; windshield wipers; transmission chains for land vehicles; transmission shafts for land vehicles; transmissions for land vehicles; spare wheel covers; suspension shock absorbers for vehicles; tyres for vehicle wheels

53. The contested goods are a wide range of vehicle parts and/or components. I consider these to be similar to the opponent's goods "*windows for automotive; automotive glass; mirrors for automotive; windscreens and windows for automotive*" in Class 12. The competing goods share the same trade channels as they would be sold by the same outlets, such as e-shops for car spare parts, potentially in close proximity to each other. In this regard, I consider that they also share the same users. However, I do not consider that they share the same nature, purpose, manufacturers, and method of use. Also, there is no degree of complementarity or competition. Even if the competing goods are used together on a vehicle, they are not deemed indispensable to each other for a complementary relationship to be established. I find the respective goods to be similar to a low degree.

*Electric bicycles; bicycle bells; bicycle brakes; bicycle chains; bicycle cranks; bicycle frames; bicycle handlebars; bicycle kickstands; bicycle motors; bicycle mudguards; bicycle pedals; bicycle saddles; bicycle tires; bicycle trailers; bicycle wheel rims; bicycle wheels; gears for bicycles; mudguards; pumps for bicycle tires; repair outfits for inner tubes; bicycles*

54. The contested goods are largely bicycles and their parts/components or accessories. I do not consider that there are any goods or services in the earlier specification that are closely comparable with the contested goods. This is because the goods, for example, in Classes 11 and 12 of the earlier mark are all specific to automotive, aerospace and marine vehicles with bicycles not falling under that category of vehicles. Although the general users may overlap, this is not a sufficient factor by itself to find similarity. The competing goods differ in nature, purpose, method of use and trade channels. I do not consider that there is any degree of complementarity and competition. I find the respective goods to be dissimilar.

Two-wheeled trolleys; civilian drones; remote control vehicles, other than toys; remote control vehicles, other than toys; pushchairs; baby carriages

55. There is no meaningful similarity between the contested and the earlier specifications. The competing specifications differ in nature, purpose, users, method of use, and trade channels. Thus, I consider them to be dissimilar.

### **Class 37**

Installation of parts for vehicles; vehicle repair; Providing information relating to repairs; vehicle service stations [refuelling and maintenance]; maintenance and repair of land vehicles; vehicle maintenance; vehicle battery charging; anti-rust treatment for vehicles; vehicle breakdown repair services

56. The contested services relate to the repair and maintenance of vehicles provided by professionals in the field of the motor industry. I consider that the earlier goods in Classes 11 and 12 are the closest comparable ones. The nature and purpose of the earlier goods and the contested services differ. Although the installation and repair services may include the installation of the opponent's earlier goods, such as mirrors and windows, the earlier goods are usually produced by different manufacturers, which are known to the general public. Whilst manufacturers of cars usually provide related repair services, the earlier goods in Class 12 do not include vehicles but cover only specific parts of vehicles and there is no evidence that the competing goods and services are usually provided by the same providers. Thus, it is my view that the consumers will not consider that they are offered by the same undertakings. Against this background, I find that the respective goods and services are dissimilar.

Rebuilding engines that have been worn or partially destroyed; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; charging of electric vehicles; rustproofing; retreading of tyres; vulcanization of tyres [repair]; repair of rubber tires; spraying and coating service; upholstery

57. Following the same approach in the previous paragraph, there is no obvious similarity between the goods and services in the competing specifications. Thus, the contested services are dissimilar to the earlier specification.

### **Class 42**

Design and development of computer [...] software; providing information on computer technology and programming via a web site; computer programming; Scientific and technological services and research and design relating thereto

58. These are all broad terms in relation to information technology services, such as computer software development and programming. I consider that the closest comparable terms in the opponent's specification are "mobile application software for use with blood glucose monitors; mobile application software for the collection and analysis of data relating to blood glucose levels; mobile application software for the calculation and forecasting of trends in blood glucose levels" in Class 9. The competing goods and services have different nature, purpose, method of use, users, and trade channels. There is no complementary relationship between the competing goods and services as the goods would not be indispensable for the use of the services, or vice versa. I find that they are dissimilar.

Design and development of computer hardware [...]; industrial analysis, industrial research and industrial design services; quality control and authentication services; Technical research; quality control; conversion of data or documents from physical to electronic media; calibration (measuring); vehicle roadworthiness testing; styling (industrial design); design of interior decor; mechanical research

59. These are all specialist services conducted by experts in the field. I do not see any meaningful similarity between the competing specifications. Even when considering the earlier goods, particularly those in Classes 11 and 12, the nature, purpose, method of use, users, and trade channels will be different. It would be wrong to consider that the consumers of those earlier goods would believe that the same undertakings would offer the contested services, including those in relation to vehicles. Thus, I find them to be dissimilar.
60. The likelihood of confusion does not arise in relation to the application's goods and services in Classes 7, 9, 12, 37 and 42 which are dissimilar to the goods and services of the series of earlier marks.<sup>3</sup> **The opposition cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

**Class 7:** Machines for lifting vehicles; vehicle trolley jacks [machines]; tyre building machines; carburetors; dynamos; pneumatic controls for machines, motors and engines; bearings for vehicles; vehicle washing installations; starters for motors and engines.

**Class 9:** Smart glasses; wearable video display monitors; Wearable computers; smartwatches; Scientific, research, navigation, surveying, [...] weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing

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<sup>3</sup> Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

sound, images or data; recorded and downloadable media [...] blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; [...] computer peripheral devices; apparatus and instruments for recording, transmitting, reproducing or processing sound, images [...] diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; thin client computers; telecommunication apparatus in the form of jewellery; cases for smartphones; covers for smartphones; security surveillance robots; audio- and video-receivers; plugs, sockets and other contacts (electric connection); terminals [electricity]; animated cartoons; sound recording carriers; protection devices for personal use against accidents; equipment for communication network

**Class 12:** Electric bicycles; Bicycle bells; bicycle brakes; bicycle chains; bicycle cranks; bicycle frames; bicycle handlebars; bicycle kickstands; bicycle motors; bicycle mudguards; bicycle pedals; bicycle saddles; bicycle tires; bicycle trailers; bicycle wheel rims; bicycle wheels; gears for bicycles; mudguards; pumps for bicycle tires; repair outfits for inner tubes; bicycles; Two-wheeled trolleys; civilian drones; remote control vehicles, other than toys; remote control vehicles, other than toys; pushchairs; baby carriages

**Class 37:** Installation of parts for vehicles; vehicle repair; Providing information relating to repairs; vehicle service stations [refuelling and maintenance]; maintenance and repair of land vehicles; vehicle maintenance; vehicle battery charging; anti-rust treatment for vehicles; vehicle breakdown repair services; Rebuilding engines that have been worn or partially destroyed; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; charging of electric vehicles; rustproofing; retreading of tyres; vulcanization of tyres [repair]; repair of rubber tires; spraying and coating service; upholstering

**Class 42:** Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Technical research; quality control; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; calibration (measuring); vehicle roadworthiness testing; styling (industrial design); design of interior decor; computer programming; mechanical research.

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61. The competing goods and services to be compared are shown in the following table:

<b>Opponent's goods</b>	<b>Applicant's goods and services</b>
	<p><b>Class 7:</b> Machines for lifting vehicles; vehicle trolley jacks [machines]; tyre building machines; carburetors; dynamos; pneumatic controls for machines, motors and engines; bearings for vehicles; vehicle washing installations; starters for motors and engines.</p>
	<p><b>Class 9:</b> Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; car antennas; navigation apparatus for vehicles [on-board computers]; car televisions; car audio equipment; dashboard cameras; rearview cameras for vehicles; tire-pressure monitoring system (TPMS) indicators; tire tread depth gauges; tyre pressure gauges; voltage regulators for vehicles; electronic control unit for automobiles; voltage</p>

	<p>stabilizing power supplies; eyeglasses; batteries, electric; rechargeable power batteries for electric vehicles; battery charging devices for motor vehicles; chargers for electric batteries; mobile power source (rechargeable batteries); accumulators, electric, for vehicles; speed checking apparatus for vehicles; protection devices for personal use against accidents; vehicle breakdown warning triangles; computer software applications, downloadable; parking meters; equipment for communication network.</p>
<p><b>Class 12:</b> Windscreens, windshields and windows for automotive, aerospace and marine vehicles; automotive glass; headlights for automotive, aerospace and marine vehicles; mirrors for automotive, aerospace and marine vehicles; windscreens, windshields and windows for automotive, aerospace and marine vehicles featuring anti-icing and de-icing properties; automotive glass featuring anti-icing and de-icing properties; headlights for automotive, aerospace and marine vehicles featuring anti-icing and de-icing properties; mirrors for automotive, aerospace and marine vehicles featuring anti-icing and de-icing properties; headlights for automotive, aerospace and marine vehicles featuring anti-fogging and de-fogging properties; mirrors for automotive, aerospace and marine vehicles featuring anti-fogging and de-fogging properties; windscreens, windshields and windows for automotive, aerospace and marine vehicles featuring anti-fogging and de-fogging properties.</p>	<p><b>Class 12:</b> Vehicles; apparatus for locomotion by land, air or water; Electric vehicles; locomotives; vehicles for locomotion by land, air, water or rail; remote control vehicles, other than toys; electric cars; robotic cars; automobiles; automobile bodies; automobile chassis; anti-theft devices for automobiles; shock absorbers for automobiles; automotive upholstery; brake pads for automobiles; ski carriers for cars; automotive engine; cigar lighters for automobiles; safety harnesses for automobile seats; driverless cars [autonomous cars]; self-driving cars; cars; pushchairs; repair outfits for inner tubes; tyres for vehicle wheels; safety seats for children, for vehicles; suspension shock absorbers for vehicles; aeronautical apparatus, machines and appliances; aeroplanes; air bags [safety devices for automobiles]; air cushion vehicles; air pumps [vehicle accessories]; air vehicles; aircraft; all-terrain vehicles; ambulancesanti-skid chains; armoured vehicles; automobile chains; automobile</p>

	hoods; axles for vehicles; bicycles; bicycle bells; bicycle brakes; bicycle chains; bicycle cranks; bicycle frames; bicycle handlebars; bicycle kickstands; bicycle motors; bicycle mudguards; bicycle pedals; bicycle saddles; bicycle trailers; bicycle tires; bicycle wheels; electric bicycles; boats; bodies for vehicles; brakes for vehicles; bumpers for automobiles; camping cars; motor homes; caravans; motor cars; hydraulic circuits for vehicles; civilian drones; clutches for land vehicles; couplings for land vehicles; crankcases for land vehicle components, other than for engines; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; motors for land vehicles; forklift trucks; gear boxes for land vehicles; gearing for land vehicles; gears for bicycles; golf carts [vehicles]; head-rests for vehicle seats; helicopters; hoods for vehicles; horns for vehicles; hot air balloons; hub caps; hubs for bicycle wheels; hubs for vehicle wheels; jet engines for land vehicles; locomotives; lorries; trucks; luggage carriers for vehicles; mobility scooters; mopeds; motor coaches; motorcycle chains; motorcycle engines; motorcycle frames; motorcycle handlebars; motorcycle kickstands; motorcycle saddles; motorcycles; mudguards; baby carriages; pumps for bicycle tires; remote control vehicles, other than toys; bicycle wheel rims; vehicle wheel rims; robotic cars; safety belts for vehicle seats; seat covers for vehicles; security harness for vehicle seats; side cars; signal arms for vehicles; space vehicles;
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	<p>spare wheel covers; sports cars; tractors; trailers [vehicles]; transmission chains for land vehicles; transmission shafts for land vehicles; transmissions for land vehicles; tricycles; two-wheeled; Sunroofs for automobiles; anti-glare devices for vehicles; rearview mirrors; headlight wipers; side view mirrors for vehicles; windows for vehicles; windscreens; windshield wipers</p>
	<p><b>Class 37:</b> Installation of parts for vehicles; vehicle repair; Providing information relating to repairs; upholstering; rebuilding engines that have been worn or partially destroyed; vehicle service stations [refuelling and maintenance]; maintenance and repair of land vehicles; vehicle maintenance; vehicle battery charging; anti-rust treatment for vehicles; vehicle breakdown repair services; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; charging of electric vehicles; rustproofing; retreading of tyres; vulcanization of tyres [repair]; repair of rubber tires; spraying and coating service.</p>
	<p><b>Class 42:</b> Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Technical research; quality control; calibration (measuring); vehicle roadworthiness testing; styling (industrial design); design of interior decor; computer programming; mechanical research.</p>

62. In the cases where there is an overlap between this opposition and opposition no. 432280, I will adopt the same findings as in my prior assessment for the latter opposition.

### **Class 7**

63. For the contested goods in Class 7, I adopt the same findings as in paragraph 36 of this decision.

### **Class 9**

64. Car antennas; car televisions; car audio equipment; dashboard cameras; rearview cameras for vehicles; tire-pressure monitoring system (TPMS) indicators; tire tread depth gauges; tyre pressure gauges; speed checking apparatus for vehicles; vehicle breakdown warning triangles; batteries, electric; rechargeable power batteries for electric vehicles; battery charging devices for motor vehicles; chargers for electric batteries; mobile power source (rechargeable batteries); accumulators, electric, for vehicles; voltage regulators for vehicles; electronic control unit for automobiles; voltage stabilizing power supplies

65. The same findings as in paragraphs 40, and 45-46 of this decision apply to the above contested goods.

Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; eyeglasses; protection devices for personal use against accidents; computer software applications, downloadable; parking meters; equipment for communication network

66. As for the rest of the Class 9 contested goods, there is no obvious similarity between the competing goods in the competing specifications. The nature,

purpose, method of use, and trade channels will be different. Thus, I find them to be dissimilar.

### **Class 12**

67. I adopt the same findings as in paragraphs 48-55 of this decision.

### **Class 37**

68. I adopt the same findings as in paragraphs 56-57 of this decision.

### **Class 42**

69. I do not consider that there is any similarity between the earlier goods in Class 12 and the contested services. They differ in nature, purpose, method of use, users, and trade channels. There is no degree of complementarity or competition. I find them to be dissimilar.

70. The likelihood of confusion does not arise in relation to the application's goods and services in Classes 7, 9, 12, 37 and 42 which are dissimilar to the goods and services of the series of earlier marks.<sup>4</sup> **The opposition cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

**Class 7:** Machines for lifting vehicles; vehicle trolley jacks [machines]; tyre building machines; carburetors; dynamos; pneumatic controls for machines, motors and engines; bearings for vehicles; vehicle washing installations; starters for motors and engines.

**Class 9:** Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; eyeglasses; protection devices for

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<sup>4</sup> Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

personal use against accidents; computer software applications, downloadable; parking meters; equipment for communication network.

**Class 12:** Electric bicycles; Bicycle bells; bicycle brakes; bicycle chains; bicycle cranks; bicycle frames; bicycle handlebars; bicycle kickstands; bicycle motors; bicycle mudguards; bicycle pedals; bicycle saddles; bicycle tires; bicycle trailers; bicycle wheel rims; bicycle wheels; gears for bicycles; mudguards; pumps for bicycle tires; repair outfits for inner tubes; bicycles; Two-wheeled trolleys; civilian drones; remote control vehicles, other than toys; remote control vehicles, other than toys; pushchairs; baby carriages.

**Class 37:** Installation of parts for vehicles; vehicle repair; Providing information relating to repairs; vehicle service stations [refuelling and maintenance]; maintenance and repair of land vehicles; vehicle maintenance; vehicle battery charging; anti-rust treatment for vehicles; vehicle breakdown repair services; Rebuilding engines that have been worn or partially destroyed; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; charging of electric vehicles; rustproofing; retreading of tyres; vulcanization of tyres [repair]; repair of rubber tires; spraying and coating service; upholstering.

**Class 42:** Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Technical research; quality control; calibration (measuring); vehicle roadworthiness testing; styling (industrial design); design of interior decor; computer programming; mechanical research.

### **Average Consumer and the Purchasing Act**

71. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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.”

72. The opponent submits that:

“The average consumer of the Opponents’ and Applicant’s goods and services is the public at large who is likely to pay an average level of attention, as well as mechanics. The level of attention will vary depending on the goods and services in question. Many of the goods in question (e.g. spare parts, apps, accessories, etc.) range in price from a few pounds sterling to a few hundred pounds sterling. The level of attention will be no higher than average.”

73. The applicant claims that:

“The goods and services opposed in the Applicant’s mark broadly relate to scientific goods and services, and goods and services related to vehicles. The goods and services of the Opponent’s mark broadly relate to conductive film, displays and eyewear, blood glucose monitoring, windows and mirrors. The repute and quality of the large majority of these goods and services would be an important consideration for the average consumer, since the performance of the

goods and services would likely have an impact on the average consumer's health and safety. Such consumers of these goods and services would therefore have a higher than-average level of attention concerning their undertaking of origin. Accordingly, the average consumer would pay more attention to a mark under which these goods and services are offered and would have a greater ability to discern the differences between the Opponent's mark and the Applicant's mark, and thus distinguish between the two different origins of the goods and services, thus negating any likelihood of confusion."

74. The average consumer for the given goods is likely to be either a member of the general public or a business/professional user. In either case, the goods will most likely be the subject of self-selection from catalogues, websites, specialist outlets, specialist suppliers or their online equivalents. This suggests that the selection of such goods will predominantly be made on a visual basis, though aural considerations cannot be ignored as advice may be sought by the purchaser or offered by a trader. The cost of the goods ranges from low, such as vehicle breakdown warning triangles, to those of very high value, such as vehicles. Even for those at the inexpensive end of the scale, the average consumer may examine the product to ensure that they select the correct type and that it is fit for purpose. For expensive goods, consumers may consider factors such as quality, longevity, compatibility, and cost when selecting, for example, machinery, vehicles, and parts of the nature already specified, to ensure that safety, quality, and specific requirements are met. Consequently, the degree of attention paid will vary from average, for the low cost goods, to very high for the most expensive goods, such as vehicles.

### **Comparison of Trade Marks**

75. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that

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

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

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

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77. The marks to be compared are:

Applicant's Mark	Opponent's Marks
<p>METAUNIVERSE</p>	

### *Overall Impression*

78. The applicant's mark is the conjoined word mark "METAUNIVERSE" presented in upper case and standard typeface. Registration of a word mark protects the word itself.<sup>5</sup> The overall impression of the mark lies in the conjoined words, with neither word component dominating the other.
79. In relation to the opponent's series of marks, they are two versions with black font and white background, and vice versa, of the word elements "META" and "Go Beyond.". The former word appears at the top stylised and in upper case under which the latter words, "Go Beyond.", are presented significantly smaller in size. I consider that the word element "META" will be the dominant element having the greatest weight in the overall impression due to its prominent size and position in the mark. As for the word elements "Go Beyond.", they will contribute to the overall impression, but less weight will be afforded to them.

### *Visual comparison*

80. Bearing in mind that the beginnings of words tend to have more impact than the ends, the competing marks share the common element "META". There are, though, various visual differences between the marks. In particular, the applicant's mark contains the word component "-UNIVERSE" and the opponent's mark contains the words "Go Beyond." for which there are no counterparts in the competing marks. I consider that the stylisation of the opponent's marks would create another point of difference between the marks, although it is not a particularly striking one. Taking into account the above factors, including the overall impression of the competing marks, I find that the degree of visual similarity is low.

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<sup>5</sup> See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

*Aural comparison*

81. The applicant's mark is five syllables long, which will be articulated as "MET-UH-YOO-NEE-VUHRS". The opponent's series of marks contains two verbal elements, which will be pronounced as "MET-UH" and "GOH-BEE-YOND", and is five syllables long. The competing marks share the common verbal element "MET-UH". However, there are no phonetic counterparts for the rest of the word elements in the competing marks. I find that there is a low degree of aural similarity.

*Conceptual comparison*

82. The applicant claims that:

"It is submitted that the conceptual meaning of the Applicant's mark lies in its conceptual similarity to the word "Metaverse", a term first coined by the US author Neal Stephenson in his 1992 book "Snow Crash" which describes a virtual world in which avatars may interact. Accordingly, the conceptual meaning of the Applicant's mark is an allusion to a virtual universe. The average consumer would not artificially dissect the Applicant's mark, and therefore the first "META" part of the word "METAVERSE" would not be read or understood in isolation.

Due to its clearly separate components, the dominant conceptual meaning of the Opponent's mark is the word "META", which may be defined as "concerned with cultural conventions rather than with reality" or "self-referential". Due to the location and presentation of the words "Go Beyond.", this component is likely to be understood as a laudatory tagline.

Accordingly, the Application mark and the Opponent's mark are conceptually dissimilar."

83. The opponent contends that:

**“Conceptually**, the marks all share the distinctive META element. UNIVERSE in the Application Mark necessarily refers back to META and does not change conceptual meaning of the mark. To the extent that the relevant public even pays attention to this element, it will simply be understood to mean “the universe of META” or “the world of META”, or “META on a global/universal scale”. The marks are therefore conceptually identical. If they are not identical, they are near identical, as the Application Mark will simply be understood as a larger more global version, or extension, of the Opponents’ Earlier META Marks (META which goes beyond the original META).

Contrary to the claims of the Applicant, the average consumer will not read the Application Mark as METAVERSE, as this is not the mark applied for. Even if they did, the above points still stand, as META is the dominant and distinctive element and conceptually there is no difference.

The overall impressions created by both marks are highly similar.”

84. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>6</sup>
85. The common word element “META” is a dictionary word. When it is used as a prefix conveys the idea of change or being “outside the normal limits of something”<sup>7</sup>. In this regard, it is my view that the contested word mark “METAUNIVERSE” is likely to be interpreted as a whole to mean a universe that surpasses the existing boundaries. However, this is not the case with the earlier mark. The dominant word “META” would create an abstract concept in the mind of the consumers that would have a self-referential connotation<sup>8</sup>. Further, I concur with the applicant’s claim that the phrase “Go Beyond” could be perceived as a laudatory tagline,

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<sup>6</sup> *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R. 29.

<sup>7</sup> *Ibid.*

<sup>8</sup> See <https://dictionary.cambridge.org/dictionary/english/meta>.

indicating to consumers that the products and services are of exceptional quality. Taking into account all the above and the marks as a whole, including the overall impressions, I find a low degree of conceptual similarity between the marks based on the common element.

Opposition no. 432281

86. The marks to be compared are:

<b>Applicant's Mark</b>	<b>Opponent's Mark</b>
METAUNIVERSE	META

*Overall Impression*

87. For the contested mark, I adopt the same analysis as in my paragraph 78.

88. The opponent's mark is the single word "META" presented in upper case. Registration of a word mark protects the word itself. The overall impression of the mark lies in the word itself.

*Visual comparison*

89. The earlier mark is four letters long, and the contested is twelve. Bearing in mind that the beginnings of words tend to have more impact than the ends, the competing marks share the first four letters "META". However, there is a difference stemming from the word component "-UNIVERSE" in the contested mark for which there is no counterpart in the earlier mark. Taking into account the above factors, including the overall impression of the competing marks, I find that the degree of visual similarity is low.

*Aural comparison*

90. The applicant's mark is five syllables long, which will be articulated as "MET-UH-YOO-NEE-VUHRS", whereas the opponent's mark, "MET-UH", is two syllables long. The competing marks share the first two syllables

“MET-UH”, but they differ in the rest. I find that there is a low degree of aural similarity.

### *Conceptual comparison*

91. In terms of the conceptual analysis, I adopt the same findings in relation to the definition of the word elements as advanced in paragraphs 84-85 of this decision. Thus, taking into account all the above and the marks as a whole, including the overall impressions, I find a low degree of conceptual similarity between the marks based on the common element.

### **DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARKS**

92. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

93. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
94. Although the opponents filed evidence, this was not relevant to the use of its marks and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the opponent’s marks to consider.
95. In relation to opposition no. 432281, the opponent’s mark is the word “META” with the meaning identified earlier in this decision. As the mark is comprised of one plain word, its distinctiveness lies in the word itself. The earlier mark has no real suggestive or allusive significance in relation to the goods for which it is registered. I find that the degree of inherent distinctiveness will be medium.
96. In relation to opposition no. 432280, the opponent’s series of marks contain the word elements “META” and “Go Beyond.”. The average consumer will be familiar with these words. I note that the words “Go Beyond.” will be seen as a laudatory tagline potentially being suggestive of the quality of the registered goods and services. That said, the dominant and stylised word element “META” will elevate the inherent distinctiveness of the mark having no suggestive meaning in relation to the goods and services. Consequently, I consider that the earlier series of marks as a whole are inherently distinctive to a medium degree or slightly above medium but not materially so.

## LIKELIHOOD OF CONFUSION

97. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>9</sup> It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>10</sup>
98. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
99. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark,

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<sup>9</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

<sup>10</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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.”

100. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a

different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

101. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

102. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper

basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

103. Earlier in this decision I have concluded that:

- the goods at issue range from identical to dissimilar;
- the average consumer for the given goods will be a member of the general public or business users/professionals. The selection process is predominantly visual without discounting aural considerations. The level of attention paid will range from average to very high degree of attention based on the cost of the goods;
- re oppositions 432280 and 432281, the competing marks are: visually, aurally, and conceptually similar to a low degree;
- with regard to opposition no. 432280, the earlier mark is inherently distinctive to a medium degree or slightly above medium but not materially so; and, as to opposition no. 432281, the opponent’s mark will be inherently distinctive to a medium degree.

#### Opposition no. 432280

104. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion for identical goods. Notwithstanding the principle of imperfect recollection and the shared common element “META”, the average consumer would not overlook the presence/absence of the word components “-UNIVERSE” and “Go Beyond.” in the competing marks. Therefore, the average consumer will not mistakenly recall or misremember the competing marks as each other.

105. Even if the average consumer recalls the points of similarity between the marks, such as that they contain the word element/component “META”, I still consider the marks would not be indirectly confused. Sitting as the

Appointed Person in *Eden Chocolat*,<sup>11</sup> James Mellor QC (as he then was) stated:

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining<sup>12</sup> in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

In light of the guidance above, the conjoined words in the contested mark form a cohesive whole. The overall impression lies within the conjunction of the word components of the mark. Thus, the average consumer will not consider the competing marks as variants or sub-brands of each other nor that the goods and services in question are from the same or economically linked undertakings merely on the use of the common word component “META”. In addition, the visual, aural, and conceptual differences coupled with the degree of attention will be sufficient to enable the average consumer to distinguish between the marks. Thus, I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse them. Consequently, I find that there is no likelihood of indirect confusion. This finding extends to the goods that I found to be similar to any degree.

#### Opposition no. 432281

106. Weighing up all the factors, I am satisfied that there is no likelihood of direct confusion for identical goods. Similarly, in this case, there are sufficient

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<sup>11</sup> Case BL O/547/17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017).

<sup>12</sup> In *L.A. Sugar*.

differences between the marks (META v METAUNIVERSE) to guard against the average consumer mistaking one mark for the other, even where the goods are identical. I find that there is no likelihood of direct confusion.

107. Turning to indirect confusion, there is no likelihood of indirect confusion for the respective identical goods. I note that the overall impression lies within the conjunction of the word elements in the contested mark “METAUNIVERSE”. Although they share the common word element “META”, the addition of the word component “-UNIVERSE” in the contested mark creates a different overall meaning. Notwithstanding the shared common element, the average consumer will not consider the respective marks as variants or sub-brands as the word component “-UNIVERSE” does not represent an obvious brand extension or sub-brand. In addition, I consider that the word “META” is not an uncommon word that the average consumer would assume that only one undertaking would be using it. Therefore, I find that the average consumer would not assume a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings. I, therefore, find there is no likelihood of indirect confusion between the earlier marks and the contested mark. This finding extends to the competing goods with any degree of similarity.

## **OUTCOME**

108. Both of the oppositions have been unsuccessful. **There is no likelihood of confusion. The oppositions on the basis of the claims under Section 5(2)(b) fail.** Therefore, subject to appeal, the application can proceed to registration.

## **COSTS**

109. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Considering the other side's statement and preparing a counterstatement	<b>£350</b>
Preparing for and filing submissions	<b>£350</b>
Total	<b>£700</b>

110. I, therefore, order Metamaterial Inc. and Metacontinental Inc., being jointly and severally liable, to pay Beijing Chj Information Technology Co., Ltd the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5th day of June 2023**

**Dr Stylianos Alexandridis**  
**For the Registrar,**  
**The Comptroller General**

## **ANNEX 1 – APPLICANT’S SPECIFICATION**

**Class 7:** Machines for lifting vehicles; vehicle trolley jacks [machines]; tyre building machines; carburetors; dynamos; pneumatic controls for machines, motors and engines; bearings for vehicles; vehicle washing installations; starters for motors and engines.

**Class 9:** Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Wearable computers; personal digital assistants [PDAs]; thin client computers; computer programmes [programs], recorded; smartwatches; smartglasses; wearable video display monitors; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; car antennas; navigation apparatus for vehicles [on-board computers]; car televisions; car audio equipment; dashboard cameras; rearview cameras for vehicles; tire-pressure monitoring system (TPMS) indicators; tire tread depth gauges; tyre pressure gauges; voltage regulators for vehicles; electronic control unit for automobiles; voltage stabilizing power supplies; eyeglasses; batteries, electric; rechargeable power batteries for electric vehicles; battery charging devices for motor vehicles; chargers for electric batteries; mobile power source (rechargeable batteries); accumulators, electric, for vehicles; speed checking apparatus for vehicles; protection devices for personal use against accidents; vehicle breakdown warning triangles; data processing apparatus; computer software applications, downloadable; parking meters; equipment for communication network.

**Class 12:** Vehicles; apparatus for locomotion by land, air or water; Electric vehicles; locomotives; vehicles for locomotion by land, air,

water or rail; remote control vehicles, other than toys; electric cars; robotic cars; automobiles; automobile bodies; automobile chassis; anti-theft devices for automobiles; shock absorbers for automobiles; automotive upholstery; brake pads for automobiles; ski carriers for cars; automotive engine; cigar lighters for automobiles; safety harnesses for automobile seats; driverless cars [autonomous cars]; self-driving cars; cars; pushchairs; repair outfits for inner tubes; tyres for vehicle wheels; safety seats for children, for vehicles; suspension shock absorbers for vehicles; aeronautical apparatus, machines and appliances; aeroplanes; air bags [safety devices for automobiles]; air cushion vehicles; air pumps [vehicle accessories]; air vehicles; aircraft; all-terrain vehicles; ambulances; anti-skid chains; armoured vehicles; automobile chains; automobile hoods; axles for vehicles; bicycles; bicycle bells; bicycle brakes; bicycle chains; bicycle cranks; bicycle frames; bicycle handlebars; bicycle kickstands; bicycle motors; bicycle mudguards; bicycle pedals; bicycle saddles; bicycle trailers; bicycle tires; bicycle wheels; electric bicycles; boats; bodies for vehicles; brakes for vehicles; bumpers for automobiles; camping cars; motor homes; caravans; motor cars; hydraulic circuits for vehicles; civilian drones; clutches for land vehicles; couplings for land vehicles; crankcases for land vehicle components, other than for engines; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; motors for land vehicles; forklift trucks; gear boxes for land vehicles; gearing for land vehicles; gears for bicycles; golf carts [vehicles]; head-rests for vehicle seats; helicopters; hoods for vehicles; horns for vehicles; hot air balloons; hub caps; hubs for bicycle wheels; hubs for vehicle wheels; jet engines for land vehicles; locomotives; lorries; trucks; luggage carriers for vehicles; mobility scooters; mopeds; motor coaches; motorcycle chains; motorcycle engines; motorcycle frames; motorcycle handlebars; motorcycle kickstands; motorcycle saddles; motorcycles; mudguards; baby carriages; pumps for bicycle tires; remote control vehicles, other than toys; bicycle wheel rims; vehicle wheel rims; robotic cars; safety belts for vehicle seats; seat covers for vehicles; security harness for vehicle

seats; side cars; signal arms for vehicles; space vehicles; spare wheel covers; sports cars; tractors; trailers [vehicles]; transmission chains for land vehicles; transmission shafts for land vehicles; transmissions for land vehicles; tricycles; two-wheeled trolleys; luggage trucks; vans [vehicles]; vehicle bumpers; vehicle chassis; vehicle seats; vehicle suspension springs; vehicle wheels; electric vehicles; Sunroofs for automobiles; anti-glare devices for vehicles; rearview mirrors; headlight wipers; side view mirrors for vehicles; windows for vehicles; windscreens; windshield wipers.

**Class 37:** Installation of parts for vehicles; vehicle repair; Providing information relating to repairs; upholstering; rebuilding engines that have been worn or partially destroyed; vehicle service stations [refuelling and maintenance]; maintenance and repair of land vehicles; vehicle maintenance; vehicle battery charging; anti-rust treatment for vehicles; vehicle breakdown repair services; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; charging of electric vehicles; rustproofing; retreading of tyres; vulcanization of tyres [repair]; repair of rubber tires; spraying and coating service.

**Class 42:** Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Technical research; quality control; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; calibration (measuring); vehicle roadworthiness testing; styling (industrial design); design of interior decor; computer programming; mechanical research.