

O/183/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3362904

BY

SHENZHEN OPSO TECHNOLOGY CO., LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 9

**OPSO**

AND OPPOSITION THERETO (NO. 415742)

BY

GUANGDONG OPPO MOBILE TELECOMMUNICATIONS CORP. LTD.

## Background and Pleadings

1. Shenzhen OPSO Technology Co., Ltd (“The Applicant”) applied to register the trade mark “OPSO” on 21 December 2018 for goods in class 9, as listed below. It was accepted and published on 11 January 2019.

Class 9: Peripheral devices (Computer -); Computer software for processing digital images; Electrical adapters; Plugs, sockets and other contacts [electric connections]; Power adapters; Digital door locks; Uninterruptible electrical power supplies; Rechargeable batteries; Data synchronization cables; Downloadable software applications for mobile phones.

2. Guangdong OPPO Mobile Telecommunications Corp. Ltd<sup>1</sup> (“The Opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on its earlier EU and UK registered trade marks as outlined below:<sup>2</sup>

OPPO

EUTM no. 2730703

Filed: 11 June 2002

Registered: 22 February 2005

Priority date: 13 December 2001

Priority country: China

Relying on all goods and services in classes 9, 35, 37, 38, 41 and 42  
 (“Mark 2730”)

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<sup>1</sup> By way of assignment dated 27 March 2019 the proprietor of the marks, was assigned from Sky Capital Ltd to Guangdong OPPO Mobile Telecommunications Corp. Ltd.

<sup>2</sup> Whilst originally relying on mark no. 2625369, due to its registration date this mark was subject to the proof of use provisions in section 6A of the Act and the Applicant requested that the Opponent provide the necessary evidence of use. As the Opponent did not file any evidence, this mark was subsequently struck out from the pleadings.

oppo

EUTM no.11857562

Filed: 30 May 2013

Registered: 5 November 2015

Relying on all goods in classes 9 and 28

("Mark 1185")



EUTM no.17892988

Filed: 26 April 2018

Registered: 20 September 2018

Relying on all goods in class 9

("Mark 1789")

oppo

EUTM no. 17892993

Filed: 26 April 2018

Registered: 20 September 2018

Relying on all goods in class 9

("Mark 2993")



UK registration no. 3066498

Filed: 30 July 2014

Registered: 19 December 2014

Relying on all services in class 35

("Mark 3066")

3. The Opponent relies on all of its goods and services for which the marks are registered, claiming that there is a likelihood of confusion under section 5(2)(b) of the Act because the trade marks are similar and the Applicant's mark is to be registered for goods identical with or similar to the goods and services for which the earlier marks are protected.

4. The Applicant filed a defence and counterstatement denying the claims made. It denies that the marks are similar or that there is any identity or similarity between the goods and services.

5. Both parties are legally represented; the Opponent by Lincoln IP, the Applicant by Hanna Moore + Curley. Neither party filed evidence or submissions other than those submissions contained in their statement of grounds and counterstatement as filed within the original pleadings. Whilst I do not propose to summarise those submissions in full, I have taken them into account in reaching my decision and will refer to them where necessary. Neither party requested a hearing nor filed submissions in lieu. The decision is taken following a careful perusal of the papers.

## **Preliminary Issues**

6. The marks upon which the Opponent relies were originally registered in the name of Sky Capital Ltd, however by way of assignment dated 27 March 2019 (after the commencement of proceedings) all rights in those marks were assigned to Guangdong OPPO Mobile Telecommunications Corp. Ltd. The Opponent requested that its name within the proceedings be amended to reflect the assignment and this was granted by the Registry. Whilst this decision was initially challenged by the Applicant, this was not pursued following the Registry's confirmation that it would take the EUIPO registration as prima facie evidence of the validity of the assignment in the absence of evidence to the contrary. Upon receipt of assurances from Guangdong OPPO Mobile Telecommunications Corp. Ltd that they had had sight of all the forms and evidence filed in the opposition, that they stood by the grounds of opposition already pleaded and that they were aware and accepted any liability for costs (if applicable) they were subsequently substituted as the Opponent in suit.

## **Decision**

7. The opposition is based on section 5(2)(b) of the Act which states:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

8. In these proceedings, the Opponent is relying upon its UK and EU trade mark registrations, shown above, which qualify as earlier marks under section 6 of the Act because each was applied for at an earlier date than the Applicant's contested mark. As earlier marks 1185, 1789, 2993 and 3066 have been registered for less than five

years at the date the application was filed they are not subject to the proof of use provisions contained in section 6A of the Act. In relation to mark 2730, whilst this mark would ordinarily be subject to the proof of use provisions, the Applicant did not require the Opponent to demonstrate use of this mark. Consequently, the Opponent is entitled to rely upon all the goods and services for which the marks are registered, without having to establish genuine use.

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

The principles:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

## Comparison of goods and services

10. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

11. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.



12. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

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

13. In addition, I take note of the decision in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03, in which the GC stated:

“69. Next, the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to ‘computers’ and ‘computer programs’ (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today’s high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software”.

14. The respective goods and services are set out as follows:

Applicant's Goods	Opponent's Goods and Services
<p>Class 9: Peripheral devices (Computer - ); Computer software for processing digital images; Electrical adapters; Plugs, sockets and other contacts [electric connections]; Power adapters; Digital door locks; Uninterruptible electrical power supplies; Rechargeable batteries; Data synchronization cables; Downloadable software applications for mobile phones.</p>	<p><u>EUTM 2730703</u></p> <p>Class 9: Computers; electronic pocket translators; video disc player; power amplifiers; cabinets for loudspeakers; speech reread apparatus; telephone apparatus; incoming call displays; television apparatus; games adapted for use with television receivers only; (audio) CD players, radio's, loudspeakers, cassette players, video tape players, MP3 players; computer software not related to intellectual property rights and mobile telephones; phonograph records, compact discs and pre-recorded audio tapes; re-writable and recordable optical discs; pre-recorded video tapes and video discs; blank compact discs, audio tapes and video tapes; audio conferencing equipment comprised of headphones, wire and wireless microphones, audio mixers and accessories therefor; video cameras and accessories therefor, video monitors and accessories therefor; video conferencing systems comprised of video monitors, video cameras, video controllers, cabinets, microphones and accessories</p>

	<p>therefor, video projectors and accessories therefor, large screen video display units and accessories therefor; video printers, video camera housings, camcorders.</p> <p>Class 35: Advertising; publicity; shop window dressing; personnel management consultation; relocation services for businesses; office machines and equipment rental; systematisation of information into computer databases, all not related to intellectual property right; distribution of promotional items; organisation of exhibitions for commercial or advertising purposes; business consultation and mediation in buying and selling of electronic apparatus and instruments, computer hardware and software, all aforementioned goods not related to intellectual property rights, telecommunication apparatus and instruments.</p> <p>Class 37: Construction information; construction; heating apparatus installation and repair; electric and electronic appliance installation, maintenance and repair; photographic apparatus repair; dry cleaning; telephone installation and repair, installation, repair, maintenance services</p>
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	<p>related to computer hardware and telecommunication apparatus and instruments.</p> <p>Class 38: Television broadcasting, information about telecommunication; telecommunication (information about); message sending; communication by telephone; mobile telephone communication; paging services; satellite transmission; electronic mail; computer aided transmission of messages and images.</p> <p>Class 41: Education information; educational services and teaching, all not related to intellectual property rights; organisation of competitions (education or entertainment); lending libraries; publication of texts (other than publicity texts); rental of show scenery; amusements; production and performance of television and theatrical programmes, films and video; rental of films and videos; rental of radio and television sets; photography and photographic reporting.</p> <p>Class 42: Computer software design, all not related to intellectual property rights; photography; photographic reporting; rental of vending machines; mechanical research especially with regard to</p>
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	<p>electric and electronic apparatus; architectural consultation; design and development services related to electronic apparatus and instruments, computer hardware, telecommunication apparatus and instruments; design and development services related to computer software, not related to intellectual property rights.</p>
	<p><u>EUTM 11857562</u></p> <p>Class 9: Computers; electronic pocket translators; video disc player; power amplifiers; cabinets for loudspeakers; speech reread apparatus; telephone apparatus; incoming call displays; television apparatus; (audio) CD players, radio's, loudspeakers, cassette players, video tape players, MP3 players; computer software not related to intellectual property rights and mobile telephones; phonograph records, compact discs and pre-recorded audio tapes; re-writable and recordable optical discs; pre-recorded video tapes and video discs; blank compact discs, audio tapes and video tapes; audio conferencing equipment comprised of headphones, wire and wireless microphones, audio mixers and accessories therefor; video cameras and</p>

	<p>accessories therefor, video monitors and accessories therefor; video conferencing systems comprised of video monitors, video cameras, video controllers, cabinets, microphones and accessories therefor, video projectors and accessories therefor, large screen video display units and accessories therefor; video printers, video camera housings, camcorders; computer game programs; phototelegraphy apparatus; portable telephones; satellite navigational apparatus; switchboards; sound transmitting apparatus; headphones players; DVD-portable media players; cameras (photography); flashlights (photography); wires (telephone-); plugs, sockets and other contacts (electric connections); connections, electric alarms batteries, electric battery chargers; none of the foregoing being in respect of sporting goods.</p> <p>Class 28: Games (not in respect of sporting activities) adapted for use with television receivers only.</p>
	<p><u>EUTM No.17892988</u></p> <p>Class 9: Smartwatches; Wearable smart phones; Downloadable mobile</p>

	<p>applications; pedometers; Facial recognition apparatus; cell phones; Smartphones in the shape of a watch; Cell phone covers; Stands adapted for mobile phones; Display screen protectors in the nature of films for mobile phones; DVD players; earphones; portable media players; cameras [photography]; USB cables for cellphones; Touch screens; Rechargeable batteries; batteries, electric; chargers for electric batteries; Wireless speakers; Smart glasses.</p>
	<p><u>EUTM No. 17892993</u></p> <p>Class 9: Smartwatches; Wearable smart phones; Downloadable mobile applications; pedometers; Facial recognition apparatus; cell phones; Smartphones in the shape of a watch; Cell phone covers; Stands adapted for mobile phones; Display screen protectors in the nature of films for mobile phones; DVD players; earphones; portable media players; cameras [photography]; USB cables for cellphones; Touch screens; Rechargeable batteries; batteries, electric; chargers for electric batteries; Wireless speakers; Smart glasses.</p>

	<p><u>UKTM 3066498</u></p> <p>Class 35: Online advertising services on computer communications networks; presentation of goods on communication media, for retail purposes; sale promotion for others; online and offline retail services connected with the sale of portable mobile communication devices and domestic electronic equipment, and software and accessories therefore; online merchandise display services.</p>
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15. The Opponent submits that:

“In relation to goods in class 9 each good in the contested application is covered by either an identical or highly similar good or service of the opponent’s various earlier registrations. Otherwise the Applicant’s goods are considered similar because they relate to complementary goods/services and would be sold or distributed through common trade channels.

Goods and services are either identical or highly similar. Resulting in a likelihood of confusion.”

16. The Applicant responds and denies that there is any similarity between the respective goods and services submitting as follows:

“The Applicant’s goods are of such a nature and are used in an entirely different manner to the services of the UK TM 2625369 that the average consumer



would not be confused. On the whole the goods are in the nature of computer hardware and software and peripherals. In contrast the Opponent's 2625 mark are phones and telecommunications devices which serve an entirely different purpose and are completely different in nature to the goods of the Application. The goods and services as outlined in its table are not complementary and would not be used in such a way that the services of the UK TM would be necessary to support the proper use and function of the goods."

17. In relation to understanding what terms used in specifications mean or cover, the case-law directs us to construe words used in a specification, with reference to how the products are regarded for the purposes of the trade<sup>3</sup> and that words should be given their natural meaning within the context in which they are used and not given an unnaturally narrow meaning<sup>4</sup>. Mr Justice Floyd stated in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), that:

"... 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."

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<sup>3</sup> *British Sugar PLC v James Robertson* 1996 R.P.C. 281

<sup>4</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

18. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

19. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

20. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>5</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>6</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>7</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the

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<sup>5</sup> Case C-411/13P

<sup>6</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>7</sup> Case C-398/07P

consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

21. Whilst the Opponent has provided a table setting out those goods and services it considers to be identical or similar to those of the Applicant, neither it nor the Applicant has not sought to explain their respective terms. I must consider the terms therefore from the perspective of the ordinary meaning attributed to them by the average consumer.

#### Peripheral devices (Computer -)

22. A peripheral computer device is normally an ancillary device which attaches externally to a computer or something which is used in connection with a computer. The goods as specified below, can clearly all be construed as peripherals and as such are identical according to the principles in *Meric*.

Mark 2730

Class 9: *audio conferencing equipment comprised of headphones, wire and wireless microphones, audio mixers and accessories therefor; video monitors and accessories therefor; video conferencing systems comprised of video monitors, video controllers, microphones and accessories therefor, video projectors and accessories therefor, video printers.*

Mark 1185

Class 9: *audio conferencing equipment comprised of headphones, wire and wireless microphones, audio mixers and accessories therefor; video monitors and accessories therefor; video conferencing systems comprised of video monitors, video cameras, video controllers, microphones and accessories therefor, video projectors and accessories therefor; video printers; headphones players; none of the foregoing being in respect of sporting goods.*

Mark 1789 and 2933

Class 9: *earphones; touch screens; Wireless speakers;*

Computer software for processing digital images

23. I consider these goods to be identical to *computer software not related to intellectual property rights and mobile telephones* in the Opponent's 2730 and 1185 marks according to *Meric* in so far as they are computer software products included in the Opponent's broader description. On the same basis the Applicant's goods would be identical to *downloadable mobile applications* in the Opponent's 1789 and 2993 marks as downloadable applications are software programmes which run on a variety of platforms which include those available on mobiles to enable the processing of digital images.

Downloadable software applications for mobile phones

24. I consider these goods to be identical to *downloadable mobile applications* in the Opponent's 1789 and 2993 marks and identical (according to *Meric*) to *computer game programmes* in the Opponent's 2730 and 1185 mark since applications for mobile phones would include downloadable games software.

Plugs, sockets and other contacts [electric connections]

25. These goods are self-evidently identical to *plugs, sockets and other contacts (electric connections)* in the Opponent's 1185 Mark.

Electrical adapters; Power adapters

26. These goods are identical according to *Meric* to *plugs, sockets and other contacts (electric connections)* in the Opponent's 1185 Mark. If I am wrong however in this assessment, then I consider that they are highly similar since electrical and power adapters allow connections between devices in the same way as sockets and plugs. They overlap in channels of trade, purpose, nature and users.

Uninterruptible electrical power supplies; Rechargeable batteries

27. An uninterruptible electrical power supply is a stored power source which provides emergency power to a unit when the main power source fails and is a continual power system similar to those stored in batteries. A battery is an enclosed cell which releases electrical charge and is an electrical source of power. Batteries store and harness energy/electricity and therefore I consider the Applicant's goods to be either self-

evidently identical or identical according to *Meric* to the Opponent's *rechargeable batteries; batteries, electric* in marks 1789 and 2993. If I am wrong in relation to the Applicant's *uninterruptible electrical power supplies* being identical then they are highly similar to the Opponent's *rechargeable batteries; batteries, electric* as they would share trade channels, purpose, use and end user.

#### Data synchronization cables

28. Data synchronization cables on an ordinary reading of the term are cables which allows the transfer of data between a mobile device and a computer, therefore I consider that they are identical to *wires (telephone-)* in the Opponent's 1185 mark and to *USB cables for cellphones* in the Opponent's 1789 and 2993 mark on the basis of the principles in *Meric*.

#### Digital door locks

29. Retail services concerning the sale of domestic electronic equipment would include electronic appliances and such goods as digital door locks. Whilst the contested goods and services would differ in nature and purpose the one being retailing services and the other being goods, I consider that they are complementary in so far as they share trade channels since the services are generally offered in the same places where the goods are offered for sale. Furthermore, the goods and the services target the same public. The Applicant's *digital door locks* are therefore similar to a medium degree to the Opponent's class 35 services for mark 3066 namely *online and offline retail services connected with the sale of portable mobile communication devices and domestic electronic equipment, and software and accessories therefore*.

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

30. When considering the opposing marks, I must determine first of all who the average consumer is for the goods and services and the purchasing process. The average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.<sup>8</sup>

31. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

32. The Opponent submits that the average consumer for the goods and services in question is likely to be a member of the general public since the goods are all consumer electronics, available at low prices, resulting in a lower than average degree of attention. This is denied by the Applicant who submits that due to the technical nature of the respective goods the average consumer is likely to pay far more attention in a purchasing decision than for goods of a less specialised and technical nature. In addition, it argues that the respective parties' goods and services are used in different fields with the Opponent's goods restricted to phones and telecommunications

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<sup>8</sup> *Lloyd Schuhfabrik Meyer*, case c- 342/97.

devices. The Opponent's marks however cover a much broader specification and I must assess the average consumer across the full range of its registered goods and services and not only those specific goods and services upon which the mark is being used.

33. I consider that the contested goods and services cover a broad range of information technology equipment and apparatus, from computer related items and information technology devices, to the software used to operate them and the provision of services to sell them in the market place. The average consumer will therefore include members of the general public who have an interest in computer-based gadgetry and technology, as well as specialist business purchasers requiring for example specific hardware or programmes to run their businesses. The purchasing process is likely to be primarily visual with consumers purchasing the goods from retail premises or their online equivalent and selecting the services through websites and internet search engines in order to locate the providers. I do not ignore the fact that an aural process may factor through recommendations or as a result of requests made to sales assistants.

34. I do not accept either party's representations regarding the level of attention being particularly low or at the highest level; to my mind taking into account the technological nature of the goods and services on offer for either category of consumer the level of attention will be higher than average but not considerably so as normal considerations such as price, reputation and suitability would apply.

### **Comparison of the marks**

35. 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.”

36. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

37. The respective trade marks are shown below:

Applicant's mark	Opponent's marks
OPSO	<p data-bbox="810 1391 963 1424"><u>2730 Mark</u></p> <p data-bbox="810 1503 903 1536">OPPO</p> <p data-bbox="810 1615 963 1648"><u>1185 Mark</u></p> 

	<p><u>1789 Mark</u></p>  <p><u>2993 Mark</u></p>  <p><u>3066 Mark</u></p> 
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## Overall Impression

### The Applicant's mark

38. The applied for mark consists of the four letters O, P, S and O presented in ordinary uppercase. There are no other elements to contribute to the mark and therefore the overall impression resides in the combination of these letters themselves.

### Earlier Mark 2730

39. Earlier Mark 2730 consists of the four letters O, P, P and O also in uppercase. The mark has no other elements and therefore the overall impression of the Opponent's 2730 mark resides in the letters themselves.

### Earlier Marks 1185, 1789, 2993 and 3066

40. The Opponent's 1185 and 3066 marks consist of the four letters o, p, p and o presented in a stylised font in lowercase. The stylisation makes a lesser contribution to the mark as a whole and therefore the overall impression of the mark is dominated by the four letters. The Opponent's 2993 mark consists of the same stylised letters as with marks 1185 and 3066 save that they are presented in green. Again, neither the colour nor the stylisation detracts from the mark essentially comprising of the letters o-p-p-o and it is these letters which are the dominant and distinctive elements of the mark and which play the greater role in the overall impression. The 1789 Mark is essentially the same as for the 1185 and 3066 marks save that the letters are presented in white on a green rectangular box. Little weight will be placed on the green box as it will be seen as acting as a background. Again, the dominant and distinctive element of the mark resides in the letters "o,p,p,o", the green box and stylisation playing a lesser role in the mark as a whole.

### **Visual comparison**

41. The Opponent submits that the marks should be taken as visually very highly similar, arguing that:

"Both consist of four letters containing the identical characters OP\*O in the same positions and differ only in relation to their third letters. It is submitted that the applicant's substitution of "S" for "P" as this third letter is not sufficient to alter the overall impression of the mark, such to prevent the visual similarity between the marks. Both marks are bookended by the letter "O", creating a symmetry which is a notable visual feature in both marks. Consumers generally tend to focus on the first element of the sign as the average consumer in the UK reads from left to right. Conversely consumers do not tend to place much focus on elements buried in the middle of a mark. Verbal elements of the signs

do not convey any semantic content to allow the relevant public to differentiate between them.

42. The Applicant denies any similarity based on the visual aspects of the marks submitting that:

“Contrary to the Opponent’s assertions the presence of the letter “s” is highly significant and serves to clearly distinguish the marks. The presence of the letter “s” suggests to the relevant consumer that the Applicant’s trade mark has a unique sound and that the emphasis should be placed on the letter “s” when the Applicant’s trade mark is pronounced. Put simply the presence of the letter “s” is a clear visual clue to the average consumer that its trade mark is different and seeks to distinguish the goods of the Application from those of other traders.”

43. Visually the marks coincide in the letter structure O, P \* O. The difference lies with the third letter, the Applicant’s mark comprising of the letter S as opposed to the letter P in the Opponent’s. Since notional and fair use, allows for trade marks registered as word marks to be used in any standard font or case,<sup>9</sup> nothing turns on the difference in casing between the marks which are likely to go unnoticed by the average consumer. Similarly, I do not place any great reliance on the colour difference between the marks because, despite being registered in black and white, the Applicant’s trade mark could be used in any colour including the same one as the Opponent.<sup>10</sup> This was confirmed by the GC in *La Superquimica v EUIPO* EU T:2018:668 which held:

“It should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which

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<sup>9</sup> *Bentley Motors Limited v Bentley* 1962 Limited BL O/159/17

<sup>10</sup> *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2014] C-252/12

the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type...”

44. In short marks it has been noted that differences are more noticeable, however since consumers pay more attention to the beginnings of marks than they do their endings<sup>11</sup> and both marks are of equal length, less dominance will be given to the one letter difference presented within the middle of the marks. I consider that the Applicant’s mark is similar to the Opponent’s 2730 mark to a medium to high degree. There is nothing remarkable about the graphic representation or colour of the lettering of the Opponent’s remaining marks which detract from the letters themselves and therefore I also consider that a medium degree of visual similarity exists between the Applicant’s mark and the Opponent’s remaining marks.

### **Aural Comparison**

45. The Opponent submits that:

“Both consist of two syllables one of which is the identical syllable “OP”. Furthermore, both OPSO and OPPO share the same vowel sequence, including the strong sound of the vowel O at the end of the marks. Both OPSO and OPPO would also be pronounced with the same rhythm and intonation and the difference in the third letter is entirely insufficient such as to mitigate the very high aural similarity between these two marks.”

46. The Applicant submits that:

“The strong phonetic sound within the Applicant’s mark derives from the presence of the letter “s” at the beginning of the second syllable. It is actually the strong phonetic characteristics of the letter “s” within the Applicant’s mark

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<sup>11</sup> *El Corte Ingles, SA v OHIM*, cases T-183/02 and T/184/02

that would militate against consumers pronouncing its mark with the same rhythm and intonation as the trade marks relied upon by the Opponent.”

47. Whilst I do not discount that some consumers may pronounce the marks phonetically, letter by letter as O-P-P-O and O-P-S-O, I consider that they are more likely to pronounce the respective marks as “OHP-OH” and “OHP-SOH”, with no pronunciation afforded to the stylisation and colour. Whilst aurally the consonants “s” and “p” have sounds that are entirely different I cannot discount the identity of the remaining letters. I find that as a result of the identical first syllable and the marks ending in an OH sound, the marks are aurally similar to a medium to high degree.

### **Conceptual comparison**

48. The Opponent submits that “conceptually neither OPSO nor OPPO have a meaning for the majority of the public in the UK. Since a conceptual comparison is not possible the conceptual aspect does not influence the assessment of the similarity of the signs.” The Applicant refutes this argument and although it stated that it intended to file evidence as to the meaning of its mark, no evidence was forthcoming. I am therefore left with two marks that consist of an arbitrary selection of letters. To my mind, I agree with the Opponent that the average consumer will not ascribe any meaning to the respective marks and they will therefore be regarded as invented. On the basis that the marks have no conceptual content to enable a conceptual comparison to be possible, they are conceptually neutral.

### **Distinctiveness of the earlier marks**

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU provided guidance on assessing a mark’s distinctive character, stating that:

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

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

50. Registered trademarks possess varying degrees of inherent distinctive character; descriptive words tend to have a low level of inherent distinctiveness, whereas invented words are regarded as possessing a high level of distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

51. Since no evidence was filed by the Opponent nor did it plead that the distinctive character of its mark has been enhanced through use, I only have the inherent position to consider. The distinctive character of all of the Opponent’s marks are dominated by

the letters OPPO, which is an invented word with no apparent link to the goods or services offered by the undertaking. The level of inherent distinctiveness for all the Opponent's marks will therefore be high. The stylisation, colour and green rectangular box used in marks 1185, 1789, 2993 and 3066 are unremarkable and contribute less to the distinctive qualities of these marks which I have already determined as high.

### **Likelihood of Confusion**

52. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods and services originate from the same or related source.

53. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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



54. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

55. I have identified the average consumer to be a member of the general public or business user selecting the goods and services via visual means but not discounting aural considerations. I have found the level of attention in the purchasing process to be slightly higher than average taking into account the technological nature of the goods and services. I consider that the marks are visually similar to a medium/medium to high degree and aurally similar to a medium to high degree. I found the conceptual comparison between the marks to be neutral. The Opponent's marks have a high degree of distinctive character as they will be regarded as invented words. I have found the Applicant's goods to vary from being identical to the Opponent's goods to being similar to a medium degree to the Opponent's retail services.

56. Taking into account these conclusions and bearing in mind the principle of imperfect recollection, when consumers come across the later mark in my view they are unlikely to recall precisely the difference with the middle letter "S" as opposed to the letter "P/p", given that the overlap in the remaining letters is 75% of the total number of letters and the marks share the same structure and letter pattern. I consider that the marks are likely to be mistakenly recalled each for the other.

57. In reaching this conclusion, I have considered the question of whether consumers would place greater weight on the shortness of the marks where a change of one letter

in a mark of only four letters long is more significant than a change in a longer mark. However, the visual comparison is just one element to be considered in the global assessment and each case must be determined on its own merits.<sup>12</sup> Despite the marks being short, the difference in the third letter and its position within the mark is such that it is not so noticeable that it would counteract the visual and aural similarities especially in the absence of a conceptual hook to assist in distinguishing between them and nothing to link the marks to the goods and services at issue. I am satisfied that consumers will mistake one mark for the other especially taking into account the predominantly visual purchasing process. Even with a one letter difference, I consider that there is sufficient commonality with the shared presence and structure of the remaining letters, for the marks to be imperfectly recalled causing a likelihood of direct confusion.

58. Taking into account the interdependency principle I consider that this would apply equally to the Applicant's goods that were only similar to a medium degree to the Opponent's retail services, as a result of the high distinctive character of the Opponent's earlier marks and the visual and aural similarities as already outlined.

## **Outcome**

59. The opposition under section 5(2)(b) of the Act succeeds in full. Subject to any successful appeal, the application is refused.

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<sup>12</sup> *Ella Shoes Ltd v Hachette Filipacchi Presse S.A.* Ian Purvis AP on Appeal O/277/12

## Costs

60. As the Opponent has been successful it is entitled to a contribution toward its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note 2 of 2016. Applying that guidance, I award costs to the Opponent on the following basis:

Preparing a notice of opposition

and reviewing the counterstatement: £200

Official fee: £100

**Total: £300**

61. I order Shenzhen Opso Technology Co., Ltd to pay Guangdong Oppo Mobile Telecommunications Corp. Ltd the sum of £300 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 19<sup>th</sup> day of March 2020

Leisa Davies

For the Registrar