

O/018/21

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3438687

BY HUAWEI TECHNOLOGIES CO., LTD

TO REGISTER:

MIND STUDIO

AS A TRADE MARK

IN CLASSES 9 & 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 419263

BY MINDS STUDIO LIMITED

Background and Pleadings

1. On 23 October 2019 Huawei Technologies Co., Ltd (“the applicant”) applied to register the trade mark Mind Studio in the UK. The application was accepted and published in the Trade Marks Journal on 8 November 2019 in respect of the following goods and services:

Class 9: *Computer software platforms for mobile devices for use in the creation, development and operation of software applications; software development tools for the creation of applications for mobile devices.*

Class 42: *Platform as a service (PAAS) services featuring computer software platforms for mobile devices for use in the creation, development and operation of software applications; software as a service (SAAS) services featuring software development tools for the creation of applications for mobile devices; computer software design and development; software engineering, namely, computer software design; debugging computer software for others; technical support being the repair and troubleshooting of computer software problems; computer software management services, namely, monitoring technical functions of computer network systems, and remote administration and management of software applications, remote software usage monitoring for technical and maintenance purposes; computer services, namely, providing online services to support mobile applications, namely, collecting analysing, diagnosing and reporting problems relating to mobile software applications for mobile analytics, data collection, data analysis, and data synchronization; computer software consulting services; information technology consultation in the field of web analytics.*

2. Minds Studio Limited (“the opponent”) opposed the application on the basis of Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier European Union Trade Mark (EUTM) no.

18018249 for the trade mark MINDS STUDIO which has an application date of 2 February 2019 and registration date of 18 May 2019.

3. The opponent's earlier mark is registered for the following services:

Class 41: *Education, entertainment and sport services; Education, entertainment and sports.*

Class 42: *Design services; IT services; Science and technology services; Testing, authentication and quality control.*

4. For the purpose of the opposition, however, the opponent relies on its services in class 42 only. In particular, the opposition under Section 5(1) is directed at the applicant's class 42 services only, with the opponent stating that it relies on "IT services". The oppositions under Sections 5(2)(a) and 5(2)(b) are directed at the application in its entirety with the opponent relying on all its services in class 42.

5. The opponent submits that there is a likelihood of confusion because the marks are identical or highly similar and the respective goods and services are identical or similar.

6. The applicant filed a defence and counterstatement denying the claims made.

7. The opponent is represented by Hansel Henson Limited¹ and the applicant is represented by Forresters IP LLP. Neither party filed evidence, although the applicant filed written submissions dated 22 October 2020. No hearing was requested, and no submissions were filed in lieu of a hearing. The decision is taken following a careful perusal of the papers.

DECISION

¹ The opponent was previously represented by Kemp Little LLP. Notice of new representation was received by the UKIPO 11 December 2020.

8. Sections 5(1) and 5(2) of the Act reads as follows:

“5 - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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

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

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

9. An earlier trade mark is defined in Section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

10. The opponent's mark qualifies as an earlier mark within the meaning of Section 6(1) of the Act because it has an earlier filing date than the contested application. The earlier mark completed its registration procedure less than five years before the application date of the contested mark and, as a result, is not subject to the proof of use provisions.

Sections 5(1) and 5(2)(a)

Identity of the marks

11. It is a prerequisite of Sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

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

12. In my view, the removal of the letter 'S' may go unnoticed by a significant proportion of the average consumers. For those consumers, the marks will be identical.

13. It is convenient to turn now to the opponent's claim under Section 5(2)(b), before considering my conclusions in relation to the claims under Sections 5(1) and 5(2)(a).

Section 5(2) – case law

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

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

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

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

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

15. The goods and services to be compared are as follows:

Applicant's goods and services	Opponent's services
<p><u>Class 9</u> <i>Computer software platforms for mobile devices for use in the creation, development and operation of software applications; software development tools for the creation of applications for mobile devices.</i></p> <p><u>Class 42:</u> <i>Platform as a service (PAAS) services featuring computer software platforms for mobile devices for use in the creation, development and operation of software applications; software as a service (SAAS) services featuring software</i></p>	<p><u>Class 42:</u> <i>Design services; IT services; Science and technology services; Testing, authentication and quality control.</i></p>

development tools for the creation of applications for mobile devices; computer software design and development; software engineering, namely, computer software design; debugging computer software for others; technical support being the repair and troubleshooting of computer software problems; computer software management services, namely, monitoring technical functions of computer network systems, and remote administration and management of software applications, remote software usage monitoring for technical and maintenance purposes; computer services, namely, providing online services to support mobile applications, namely, collecting analysing, diagnosing and reporting problems relating to mobile software applications for mobile analytics, data collection, data analysis, and data synchronization; computer software consulting services; information technology consultation in the field of web analytics.

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, 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”.

17. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.”

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

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

19. I also note the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated 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."

20. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

21. 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.”*

22. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the GC stated that “complementary” means:

“...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”.

Class 42

23. The opponent’s IT services are concerned with the use of computers. The term “IT” is identified by the *Collins English Dictionary* as an abbreviation for the words ‘Information Technology’. The same dictionary defines “Information Technology” as “the theory and practice of using computers to store and analyse information”.² This is how I understand the term and, more importantly is, in my view, how the average consumer will understand the term. Since the opponent’s IT services are not limited

² <https://www.collinsdictionary.com/dictionary/english/information-technology> [accessed 15 December 2020]

in any way, they include all of the services in class 42 of the application, which are a sub-set of “IT services”. These services are identical under the *Meric* principle.

24. Even if I am wrong in this finding, there will be overlap in users, trade channels, nature and purpose and a degree of complementarity between the services. Consequently, I consider these services to be highly similar.

Class 9

25. The applicant submits that there is no similarity between the applicant’s goods in class 9 and the services of the opponent. In particular, the applicant claims that the opponent’s services target the general public that require IT support, whilst the applicant’s goods and services are used in a very specific and sophisticated area, namely that of AI processors, and are directed at open source developers. The applicant also argues that “many services in the IT and telecommunication industries clearly depend on software or computer-aided software in order to be rendered” but that “this should not, however, lead to the automatic conclusion that software is similar to goods/services that use software to function successfully.”

26. The contested goods in class 9 are “Computer software platforms for mobile devices for use in the creation, development and operation of software applications; software development tools for the creation of applications for mobile devices”. I have already found that the opponent’s IT services encompass all of the applicant’s services, including “platform as a service (PAAS) services” and “software as a service (SAAS) services” featuring the same goods in class 9 which the applicant seeks to register. Although I accept that goods and services have different nature, the opponent’s services and the applicant’s goods would target the same public through the same channels and be complementary, 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. Alternatively, if the opponent’s IT services do not include all of the services listed in the class 42 specification of the application, it would still include other IT services which are complementary to the goods at issue, such as for example, IT consultancy services directly related to the computer software platforms and the software

development tools which the applicant seeks to register. These goods and services are similar to a medium degree.

Average consumer and the purchasing act

27. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J 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.”

28. Most of the goods and services listed in the applicant's specification are clearly directed to software developers, IT professionals and business users, although some of the services will also be of interest to member of the general public, for example, technical support being the repair and troubleshooting of computer software problems. The goods and services are likely to be self-selected from websites, advertisements and signage, so visual considerations are likely to dominate the selection process. That said, as such goods and services may also be the subject of, for example, word-of-mouth recommendations or oral requests, aural considerations must not be forgotten.

29. The opponent has not commented on the average consumer or the level of attention that s/he will display. The applicant submits that the average consumer of the goods in class 9 and services in class 42 will pay a high level of attention during the selection process.

30. The cost of the goods and services are likely to vary dependent on the service and goods provided. Computer software design services may potentially cost more than services to repair existing software in its own right. However, as most of the goods and services are directed at software developers, IT professionals and business users (whose purchasing process I expect to be more considered than for members of the public at large), I also find that the level of attention is by and large above normal.

Comparison of marks

31. As noted above, I consider the marks to be identical. However, as Section 5(2)(b) only requires there to be similarity between the marks, I will undertake a full comparison of the marks in the event that I am wrong in finding that they are identical. The respective trade marks are shown below:

MINDS STUDIO	MIND STUDIO
Earlier trade mark	Contested trade mark

32. 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.”

33. 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.

34. The opponent’s mark consists of the words “MINDS STUDIO” and the applicant’s mark consists of the words “MIND STUDIO”. There are no other elements to contribute to the overall impression of the marks.

35. Visually, the applicant’s mark is reproduced entirely in the opponent’s mark. The only point of visual difference between the marks is the addition of the letter ‘S’ at the end of the first word in opponent’s mark. I consider the marks to be visually highly similar.

36. Aurally, the opponent’s mark will be pronounced MINDS STU-DEE-O and the applicant’s mark will be pronounced MIND STU-DEE-O. The only point of aural difference between them is the slightly different pronunciation of the first syllable. I consider these marks to be aurally highly similar.

37. Conceptually, the words MIND and STUDIO, convey the same meaning in both marks. The only difference will be that the word MIND in the opponent’s mark is plural. I consider the marks to be conceptually highly similar.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C- 108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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).”

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

40. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use and has not filed evidence to support such a claim. I have, therefore, only the inherent position to consider. The earlier mark consists of the word MINDS STUDIO. MINDS and STUDIO are ordinary dictionary words. However, they have no connection, neither separately nor in combination, to the services for which the mark is registered. Consequently, I consider the opponent’s mark to be inherently distinctive to at least a medium degree.

Likelihood of confusion

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. 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 and services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

42. I have found the marks to be either identical or visually, aurally and conceptually highly similar. I have identified the average consumer to be mostly a software developer, an IT professional or a business user who will select the goods and services primarily by visual means (although I do not discount an aural component). I have concluded that an above normal degree of attention will be paid during the purchasing process. I have found the earlier mark to have at least a medium degree of distinctive character. I had found the contested services in class 42 to be identical and the goods in class 9 to be similar to a medium degree to the opponent's services.

43. Taking all of the above factors into account, in particular the fact that the marks are either identical or visually, aurally and conceptually similar to a high degree and the principle of imperfect recollection, I consider that the marks will be misremembered or mistakenly recalled as each other, even when an above normal (or even high) degree of attention is applied. I consider that this will be the case

even for the goods that are similar to a medium degree. I consider there to be a likelihood of direct confusion.

44. The opposition under Section 5(2)(b) succeeds.

Sections 5(1) and 5(2)(a)

45. Inasmuch as the applicant's mark is identical with the earlier mark, the likelihood of confusion technically falls to be determined under Sections 5(1) or 5(2). If I am correct in my assessment of the identity of marks, the opposition also succeeds under Section 5(1) in respect of the applicant's services in class 42 (which I found to be identical) and under Section 5(2)(a) in relation to the applicant's goods in class 9 (which I found to be similar).

Conclusion

46. The opposition is successful in its entirety and the application is refused.

Costs

47. As the opponent has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £400 as a contribution towards its costs. This sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
Considering the applicant's written submission:	£100
Official fee:	£100
Total	£400

48. I therefore order Huawei Technologies Co., Ltd to pay Minds Studio Limited the sum of £400. 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 11th day of January 2021

A Klass

For the Registrar,

the Comptroller - General