

**O/0770/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3791812  
BY SHENZHEN YITIANXIA TECHNOLOGY CO., LTD**

**TO REGISTER:**

**YSKY**

**AS A TRADE MARK IN CLASS 9**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 435501 BY  
SKY LIMITED**

## BACKGROUND AND PLEADINGS

1. On 25 May 2022, Shenzhen Yitianxia Technology Co., Ltd (“the applicant”) applied to register **YSKY** as a trade mark in the United Kingdom in respect of the following goods:

### Class 9

*Adjustable desktop mounts for tablet computers; Audio speaker systems for vehicles; Strobe lights [warning beacons]; Rotating lights [signalling]; Battery chargers for mobile phones; Binoculars; Blank flash memory cards; Blank hard disks for computers; hard drives; Blank USB cards; Blank USB flash drives; Burglar alarms; Car stereos; Card reading equipment; Cases adapted for mobile phones; Cell phone battery chargers; Computer memory devices; Computer memory hardware; Computer memories; Computer peripheral devices; Computer peripheral equipment; Computer peripherals; USB flash drives; External computer hard drives; Flash card readers; Holders for cell phones; Memories for use with computers; Memory card readers; Microphones [for telecommunication apparatus]; Secure Digital [SD] Memory Cards; Stands adapted for mobile phones; USB cables; USB cables for cellphones; USB card readers; Wireless headsets for smartphones.*

2. On 10 August 2022, the application was opposed by Sky Limited (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the applied-for goods. The opponent is relying on the following marks:

UKTM No. 2534537 (a series of two marks)



Application date: 2 December 2009

Registration date: 15 April 2022

Relying on the following goods:

Class 9

*Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision) and teaching apparatus and instruments; amplifiers; speakers; wireless audio and/or audio visual devices; portable wireless audio and/or audio visual devices; computer hardware; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information; portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, images, text, signals, information and code; tapes, discs and wires, all being magnetic; cassettes and cartridges, all adapted for use with the aforesaid tapes; blank and pre-recorded audio and video cassettes, tapes and cartridges; compact discs; DVD discs; phonographic records; laser readable discs for recording sound or video; ROM cartridges, CD Roms, cards and discs, integrated circuit cards, memory carriers, recording media, all pre-recorded with computer video games and/or quizzes; encoded cards; smart cards; acoustic apparatus or instruments; data storage; sunglasses, leather cases for holding mobile phones; cases, containers, protective coverings and parts and fittings therefore, all for use with MP3 players, music storage devices, media storage devices and other consumer electronic devices; home and personal security apparatus; home and personal security devices; home and personal security alarms; electronic protection equipment, including fire detecting and alarm equipment, intruder and burglar alarm equipment and motion detecting equipment; readers; magnetic or encoded access control cards; multimedia cards, memory cards, flash memory cards, memory chips, memory sticks, plugs, plug-in cards, magnetic cards, SIM cards, telephone calling cards, headphones, headsets, portable and/or hand held electronic devices for receiving, storing, playing and transmitting data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data.*

Class 11

*Apparatus for controlling lighting; all the aforesaid including remote and computer apparatus and instruments; bicycle lights; parts and fittings for all the aforesaid goods.*

Class 12

*Lights for bicycles; fittings for attaching lights to bicycles; parts and fittings for all the aforesaid goods.*

UKTM No. 918003532

## **SKY X**

Application date: 20 December 2018

Registration date: 13 October 2020

Relying on the following goods:

### Class 9

*Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media; Anode batteries; Batteries, electric; Batteries, electric, for vehicles; Batteries for lighting; Battery boxes; Battery chargers; Battery jars; Beacons, luminous; Binoculars; Blinkers [signalling lights]; Cables, electric; Chargers for electric batteries; Computer memory devices; Computer peripheral devices; Encoded magnetic cards; Integrated circuits [smart cards]; Microphones; Personal stereos; Plugs, sockets and other contacts [electric connections]; Readers [data processing equipment]; Sirens; Stands for photographic apparatus; USB flash drives; Wires, electric; data storage apparatus and instruments, speakers; radios; wireless audio and/or audio visual devices; computer hardware; blank and pre-recorded audio and video cassettes, tapes and cartridges; compact discs; DVD discs; phonographic records; laser readable discs for recording sound or video; covers for personal digital assistants [PDAs]; covers for tablet computers; home and personal security alarms; electronic protection equipment, including fire detecting and alarm equipment, intruder and burglar alarm equipment and motion detecting equipment; card readers; magnetic card readers; smart card readers; magnetic or encoded access control cards; multimedia cards, memory cards, flash memory cards, memory chips, data storage media devices, plugs, plug-in cards, magnetic cards, SIM cards, telephone calling cards, headphones, headsets, portable and/or hand held electronic devices for receiving, storing, playing and transmitting data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data; computer hardware, peripherals and devices for portable media storage and digital media streaming; computer hardware for upload, storage, retrieval, download, transmission and delivery of digital content; Virtual reality headsets, helmets and viewers; earphones; head-mounted video displays; micro-displays, namely,*

*head mounted video displays and near eye video displays; parts and accessories for micro-display; headphones for home video game machines; microphones for home video game machines.*

3. These marks qualify as earlier marks under the provisions of sections 6(1) of the Act. Because they completed their registration procedures less than five years before the application date of the contested mark, the opponent is not required to have used them and so may rely on all the goods listed above.

4. The opponent claims that the contested mark is highly similar to the earlier marks and that “SKY” is the most memorable and important aspect of the contested mark. It also claims that the goods for which registration is sought are either identical or highly similar to goods covered by the earlier marks. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

5. The applicant filed a defence and counterstatement denying a likelihood of confusion between the contested mark and *“the Earlier Mark consisting of the word SKY in a figurative form”*. In particular, it argues that the marks are visually, aurally and conceptually different. It admits that the goods at issue are identical or similar. It does not explicitly deny a likelihood of confusion between the contested mark and the SKY X mark.

6. Neither party filed any evidence.

7. A hearing was not requested and both parties filed written submissions in lieu of a hearing on 23 March 2023. I make this decision after a careful consideration of these submissions and the statements made by both parties.

8. In these proceedings, the opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP and the applicant is represented by The Trade Marks Bureau.

## PROCEDURAL ISSUE

9. The applicant's written submissions in lieu of a hearing are drafted as if it had denied the likelihood of confusion between the contested mark and the SKY X mark. I considered that it was not open to me to proceed with my decision on the assumption that the section 5(2)(b) claim based on the SKY X mark was denied: see *SKYCLUB*, BL O/044/21, particularly paragraphs 23-29. Consequently, on 7 July 2023, the Registry invited the applicant to amend its defence pleadings. In my view, this invitation caused no prejudice to the opponent as it had addressed the opposition based on the SKY X mark in its own written submissions.

10. A revised notice of defence and counterstatement was filed on 12 July 2023.

## DECISION

11. Section 5(2)(b) of the Act is as follows:

“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.”

12. In considering this opposition, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel 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):<sup>1</sup>

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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;

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<sup>1</sup> 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, although the UK has left the EU.

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 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; and

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**

13. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These may include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... 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.”<sup>2</sup>

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<sup>2</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

14. The applicant has admitted that all the contested goods are either identical or similar to those of the opponent. I shall conduct my comparison to assess the degree of similarity, as this may be relevant later in my decision.

**Comparison with UKTM No. 2534537**

15. The applicant’s *Burglar alarms* are self-evidently identical to the opponent’s *Intruder and burglar alarm equipment*.

16. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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.”<sup>3</sup>

17. The following table shows the goods I find to be identical under this principle:

| <b>Contested goods</b>   | <b>Earlier goods</b>  |
|--|---|
| <i>Audio speaker systems for vehicles.</i>   | <i>Speakers.</i>  |
| <i>Strobe lights [warning beacons]; Rotating lights [signalling].</i>  | <i>... signalling ... apparatus and instruments.</i>        |
| <i>Binoculars.</i>   | <i>... optical ... apparatus and instruments.</i>           |
| <i>Blank flash memory cards; blank USB cards; Secure Digital [SD] Memory Cards.</i>  | <i>Memory cards.</i>  |
| <i>Blank hard disks for computers; hard drives; computer memory devices; computer memory hardware; computer memories; external computer hard drives.</i> | <i>Computer hardware.</i>                                   |
| <i>Blank USB flash drives; USB flash drives.</i>   | <i>Memory sticks.</i>                                       |
| <i>Car stereos.</i>  | <i>... sound reproducing ... apparatus and instruments.</i> |

<sup>3</sup> Paragraph 29.

| <b>Contested goods</b>  | <b>Earlier goods</b>  |
|---|---|
| <i>Card reading equipment; flash card readers; memory card readers; USB card readers.</i> | <i>Readers.</i>   |
| <i>Cases adapted for mobile phones; holders for cell phones.</i>                          | <i>Leather cases for holding mobile phones.</i>   |
| <i>Computer peripheral devices; Computer peripheral equipment; Computer peripherals.</i>  | <i>Computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information.</i>  |
| <i>Memories for use with computers.</i>   | <i>Memory cards, memory sticks.</i>   |
| <i>Microphones [for telecommunication apparatus].</i>                                     | <i>Acoustic apparatus or instruments.</i>   |
| <i>Wireless headsets for mobile phones.</i>   | <i>... headsets ... for receiving, storing, playing and transmitting data, voice, multimedia, audio, visual music, photographs, drawings, images, audiovisual, video, text, graphics or other data.</i> |

18. Turning to the remaining goods, I note that the opponent has made no specific submissions on the degree of similarity. I shall compare *Adjustable desktop mounts for tablet computers* and *Stands adapted for mobile phones* to *Cases, containers, protective coverings and parts and fittings therefore, all for use with MP3 players, music storage devices, media storage devices and other consumer electronic devices* in the opponent's specification. Both tablet computers and mobile phones are types of consumer electronic devices. The applicant's goods are intended to support these devices on a desk or other surface, enabling the user to see them in comfort. Goods that are covered by the opponent's specification of *containers* may include the applicant's goods and therefore be identical, but if I am wrong in this, I consider that they are highly similar, as they will be targeted towards the same users and share the same trade channels, their purpose and physical nature are similar.

19. The next goods I come to are *Battery chargers for mobile phones* and *cell phone battery chargers*. I shall compare these to the opponent's *... telecommunications ... apparatus and instruments*, which would include mobile phones (cell phones). Both are portable. The goods would be targeted towards the same users and distributed through the same trade channels. The purposes are different, as is the method of use. The goods are not in competition. Mobile phones are essential for the use of the applicant's goods, and there may be a degree of complementarity as mobile phone

businesses may also supply accessories to be used with the goods. Overall, I find there to be a medium degree of similarity.

20. The final goods to be considered are *USB cables* and *USB cables for cellphones*. These goods would be used with the opponent's *telecommunications ... apparatus and instruments*, targeted towards the same users and distributed through overlapping trade channels. The cables would be used to connect the equipment, for example, to a power source. There is some complementarity as the average consumer would expect a telecommunications equipment manufacturer to produce cables for use with such equipment. Overall, I find there to be a medium degree of similarity between the goods.

**Comparison with UKTM No. 918003532**

21. The following goods appear in both specifications: *Binoculars; Computer memory devices; Computer peripheral devices; USB flash drives*.

22. The following table shows the goods I find to be identical as they are synonyms:

| <b>Contested goods</b>   | <b>Earlier goods</b>                |
|--|-------------------------------------|
| <i>Computer memory hardware; Computer memories; Memories for use with computers.</i> | <i>Computer memory devices.</i>     |
| <i>Computer peripheral equipment; Computer peripherals.</i>                          | <i>Computer peripheral devices.</i> |

23. The following table shows the goods I find to be identical under the *Meric* principle:

| <b>Contested goods</b>  | <b>Earlier goods</b>  |
|---|---|
| <i>Audio speaker systems for vehicles.</i>  | <i>Speakers.</i>  |
| <i>Strobe lights [warning beacons].</i>   | <i>Beacons [luminous].</i>  |
| <i>Rotating lights [signalling].</i>  | <i>... signalling ... apparatus and instruments.</i>  |
| <i>Battery chargers for mobile phones; cell phone battery chargers.</i>             | <i>Battery chargers.</i>  |
| <i>Blank flash memory cards; blank USB cards; Secure Digital [SD] Memory Cards.</i> | <i>Memory cards ... for receiving storing, playing and transmitting data, voice, multimedia, audio, visual, music, photographs, drawings, images,</i> |

| <b>Contested goods</b>  | <b>Earlier goods</b>  |
|---|---|
|   | <i>audiovisual, video, text, graphics or other data.</i>  |
| <i>Blank hard disks for computers.</i>  | <i>Computer memory devices.</i>   |
| <i>Hard drives; external computer hard drives.</i>  | <i>Computer memory devices.</i>   |
| <i>Blank USB flash drives.</i>  | <i>USB flash drives.</i>  |
| <i>Burglar alarms.</i>  | <i>Home ... security alarms.</i>  |
| <i>Card reading equipment; flash card readers; memory card readers; USB card readers.</i> | <i>Card readers.</i>  |
| <i>Microphones [for telecommunication apparatus].</i>                                     | <i>Microphones.</i>   |
| <i>USB cables; USB cables for cellphones.</i>   | <i>Cables, electric.</i>  |
| <i>Wireless headsets for smartphones.</i>   | <i>... headsets ... for receiving, storing, playing and transmitting data, voice, multimedia, audio, visual music, photographs, drawings, images, audiovisual, video, text, graphics or other data.</i> |

24. The opponent submits that *Adjustable desktop mounts for tablet computers* are identical or similar to *Covers for digital assistants [PDAs]* and/or *Covers for tablet computers*. I shall compare the applicant's term with the second of these. Both goods are intended for use with tablet computers, although their primary purposes are different. The opponent's goods are used to protect the computer, while the applicant's are, as I have already found, used to support the device on a desktop or other surface. They will be targeted towards the same users and are likely to be sold through the same retail outlets and in fairly close proximity in larger shops. The physical nature and method of use of the goods are different. They are not in competition and are not complementary in a trade mark sense. I find that they are similar to a medium degree.

25. I shall compare *Cases adapted for mobile phones* and *Holders for cell phones* to *Covers for digital assistants [PDAs]* and *Covers for tablet computers*. The purpose of these goods is similar – to protect a hand-held electronic device – although I accept that the size of the device may be different. They are likely to be similar in physical nature and distributed through the same trade channels to similar users. The goods are not in competition or complementary. I find that they are similar to a medium degree.

26. The next goods are *Stands adapted for mobile phones*. The opponent invites me to make a comparison between these and *Covers for digital assistants [PDAs]* and *Covers for tablet computers*. However, I consider that a closer comparison is with *Stands for photographic apparatus*. This is because they both have a shared purpose or supporting the apparatus. Some of the goods covered by the applicant's term are similar in physical nature. This is particularly the case where they are intended to be used with a mobile phone as a camera. There are likely to be some shared trade channels and users. The goods are not in competition, nor are they complementary. I find that they are similar to a medium degree.

27. The final term is *Car stereos*. The opponent submits that these are identical or similar to *Personal stereos, radios and/or speakers*. *Car stereo* systems include radios and speakers. To the extent that the opponent's terms cover such goods intended for use in a car, they are identical. To the extent that the terms cover other types of radio or speakers, they are highly similar.

### **Average consumer and the purchasing process**

28. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) 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.”<sup>4</sup>

29. The applicant submits that the average consumer of the majority of the goods will be a member of the general public, but that some goods, such as burglar alarms or card reading equipment would be purchased by businesses. It submits that the cost of

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<sup>4</sup> Paragraph 60.

the goods will vary from low (for example, for a USB cable) to thousands of pounds for the card reading equipment. The frequency of purchase will also vary. The applicant submits that, even where the cost of a good is low, the consumer will still need to consider its suitability for their needs, ease of use and reliability. It therefore considers that at least a medium degree of attention would be paid by the average consumer, although where the goods are “*particularly technical in nature*”, such as burglar alarms, audio speaker systems for vehicles, card reading equipment and computer memory hardware, the degree of attention paid will be above medium.<sup>5</sup>

30. The opponent’s submissions are more brief. It argues that the average consumer is a member of the general public who will be paying “*no special degree of attention or care when selecting goods*”.<sup>6</sup>

31. I agree that in most cases the average consumer will be a member of the general public paying a medium degree of care when making a purchase. However, I also agree with the applicant that some of the goods will be bought by businesses. In my view, these are the signalling and warning equipment (such as *Strobe lights*) and card readers. The consumer here will be paying a higher than medium degree of attention, given the potential difficulties to their businesses that would be caused by choosing unreliable equipment. *Burglar alarms* will be purchased by both the general public and businesses. As these goods are intended to increase the security of premises, the average consumer, whether an individual or a business, will, in my view, be paying a fairly high degree of attention.

32. The goods are likely to be purchased from specialist retailers, either online or in a physical shop. The consumer may also order from catalogues and may have seen advertisements for the goods in question. It follows that the visual considerations will play an important role in the purchasing process, although for many of the goods the consumer may seek advice from sales staff or have received word-of-mouth recommendations. They may also order the goods by phone. Therefore, the aural element of the mark must also be taken into account.

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<sup>5</sup> Written submissions, paragraph 15.

<sup>6</sup> Written submissions, paragraph 21.


## Comparison of the marks

33. It is clear from *SABEL* (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 in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>7</sup>

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

35. The respective marks are shown below:

| Earlier marks   | Contested mark |
|---|----------------|
| UKTM No. 2534537<br> | YSKY           |

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<sup>7</sup> Paragraph 34.

| Earlier marks                    | Contested mark |
|----------------------------------|----------------|
| UKTM No. 918003532:<br><br>SKY X |                |

### **Comparison with UKTM No. 2534537**

36. The earlier series consists of two marks, each being the word “SKY” in lower case letters. The final letter “Y” is joined to the “K”. Each of the letters has a border round it and contains some white highlighting. The first of the marks is blue and the second pink. However, nothing turns on this difference so I shall from now on refer to these marks in the singular. The word “SKY” makes the greater contribution to the overall impression of the mark, with a lesser role played by the stylisation.

37. The contested mark is a word mark consisting of four letters. In *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, the GC held that such plain word marks protected the word or words contained therein, in whatever form, colour or typeface.<sup>8</sup> Fair use of this mark would not include its presentation in the stylisation used for UKTM No. 2534537.

38. The average consumer would not recognise “YSKY” as a word with any meaning. In *Usinor SA v OHIM*, Case T-189/05, the GC said that:

“... while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02, *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).”<sup>9</sup>

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<sup>8</sup> Paragraph 39.

<sup>9</sup> Paragraph 62.

39. In my view, the average consumer is likely to identify the word “SKY” at the end of the mark. The letter “Y” has no meaning in the context of the goods at issue. The overall impression lies in the juxtaposition of that word with the initial letter “Y”.

40. The applicant submits that the different beginnings of the marks are significant, as the average consumer pays more attention to the beginnings of marks than to the ends. I agree that this is a general tendency, given the fact that the English-speaking public reads from left to right. However, the case law does not present this as a hard and fast rule. In *Bristol Global Co Ltd v EUIPO*, Case T-194/14, the GC held that there was a likelihood of confusion between a slightly stylised AEROSTONE and the word mark STONE if both marks were used by different undertakings in relation to identical goods (and vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed.

41. While both marks contain the letters “S”, “K” and “Y”, there are some important points of visual difference: the initial “Y” in the contested mark and the stylisation in the earlier mark. Overall, I find that there is a low degree of visual similarity between the marks.

42. The earlier and contested marks would be pronounced as “SKAI” and “WAI-SKAI” respectively. In my view, the marks are aurally similar to a medium degree.

43. The opponent submits that there is no need for a conceptual comparison, as the contested mark has no recognisable concept. On the other hand, the applicant submits that the marks are conceptually different, as the earlier mark has a clear concept. I agree with the applicant that the earlier mark will bring to the mind of the average consumer *“the sky, a view from earth of the atmosphere and outerspace”*.<sup>10</sup> On this basis, there is a conceptual comparison that I need to make. I found that the average consumer would identify the word “SKY” at the end of the contested mark. In my view, there is at least a medium degree of conceptual similarity between the marks.

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<sup>10</sup> Applicant’s written submissions, paragraph 12.

### **Comparison with UKTM No. 918003532**

44. The earlier mark consists of the word “SKY” followed by the letter “X”. It is a plain word mark. The letter has no meaning in the context of the goods at issue. The verbal elements do not hang together as a unit, and it is my view that the word “SKY” is the more distinctive element and makes the greater contribution to the overall impression. The juxtaposition with the letter “X” plays a lesser role.

45. Visually, both marks are word marks consisting of four letters. In the case of the contested mark, these four letters make up a single word, while the earlier mark has a three-letter word and a single letter. The first three letters of the earlier mark are identical to the last three letters of the contested mark. The opponent submits that the placing of the X or Y at the end or beginning of the mark makes little difference and the average consumer will not pay any special attention to the precise position of the letter. I shall, if relevant, come back to this point later in my decision. The next point that the opponent makes is that the similarity between the marks is increased by the fact that the letter “Y” follows the letter “X”, giving the impression of being part of a series. However, in my view, this implies that the average consumer is undertaking the sort of analysis of the marks that the case law, particularly *SABEL*, says they will not do. Bearing in mind the overall impressions of the marks, I find that there is a low degree of visual similarity between them.

46. Aurally, the contested and earlier marks would be pronounced as “WAI-SKAI” and “SKAI-EKS” respectively. The number of syllables is the same and the second syllable of the contested mark is identical to the first of the earlier mark. I find that the marks are aurally similar to a low degree.

47. The addition of the letter “X” to the word “SKY” makes no difference to my assessment of the conceptual comparison between the marks. I adopt the findings I made in [paragraph 43](#) above.

### **Distinctive character of the earlier marks**

48. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

49. 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. The opponent has filed no evidence of use, so I only have the inherent distinctiveness of the marks to consider.

50. “SKY” is a common English word that does not allude to any characteristics of the goods which I found to be identical or similar to the contested goods. In the case of the stylised SKY mark, it is this word that makes the greater contribution to the overall impression of the mark, with a smaller role being played by the stylisation. The word itself has a medium degree of inherent distinctive character and the stylisation does not, in my view, raise this to any noticeable extent.

51. Turning now to the SKY X mark, I find that the letter X increases the medium degree inherent distinctive character of the mark very slightly.

### ***Conclusions on likelihood of confusion***

52. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

53. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

54. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."<sup>11</sup>

55. I shall consider first the opposition based on the stylised SKY marks. I found that:

- The goods were identical or similar to at least a medium degree;
- The average consumer was a member of the general public or a business who would be paying a medium or high degree of attention;
- The average consumer would identify the word "SKY" in the contested mark;
- The marks were visually similar to a low degree, aurally similar to a medium degree and conceptually similar to at least a medium degree;
- The earlier mark had a medium degree of distinctive character.

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<sup>11</sup> Paragraph 12.

56. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting as the Appointed Person, pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

57. It is the word “SKY” that gives the earlier mark its distinctive character and I found that the average consumer would recognise this in the contested mark. Nevertheless, they would not ignore the presence of the additional letter in the contested mark. In my view, the differences between these marks are such that, even bearing in mind the imperfect recollection of the average consumer, they will not be mistaken for one another. I find no likelihood of direct confusion.

58. Turning to indirect confusion, I remind myself that Arnold LJ said in *Liverpool Gin Distillery* that:

“As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] ‘a finding of 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.”<sup>12</sup>

59. I can see no reason why the average consumer would assume that the contested mark was another brand of the opponent. I have been provided with no evidence to say that the distinctive character of “SKY” has been enhanced to such a degree that no one else would be using it in a trade mark, and it does not seem to me that the addition of a letter at the beginning of a mark would be an obvious way of denoting a sub-brand or brand extension. At the most, it would, in my view, call to mind the earlier mark, but that is, as Mr James Mellor QC (as he then was) said in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, “*mere association*”, not confusion: see paragraph 81.3. I find no likelihood of indirect confusion.

60. I shall therefore move on to consider the opposition based on the SKY X mark. I found that:

- The goods were identical or similar to at least a medium degree;
- The average consumer was a member of the general public or a business who would be paying a medium or high degree of attention;
- The average consumer would identify the word “SKY” in the contested mark;
- The marks were visually similar to a low degree, aurally similar to a low degree and conceptually similar to at least a medium degree;
- The earlier mark had a slightly higher than medium degree of distinctive character.

61. The distinctive character of this mark lies in the word “SKY” with the letter “X”. Even taking into account the interdependency principle and imperfect recollection, I consider that the differences between the marks are sufficient for them not to be mistaken one for the other. I find no likelihood of direct confusion, and so will now deal with indirect confusion.

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<sup>12</sup> Paragraph 13.

62. The marks at issue here are “SKY” with an additional letter. The average consumer does not see the marks side by side and so I consider that they may not accurately remember whether the letter was at the beginning or the end of the mark. The change of a single letter is, in my view, likely to lead the average consumer to believe that the contested sign is a different sub-brand of the owner of the earlier SKY X mark where the goods are identical or similar to at least a medium degree. This includes all the contested goods. I find that the average consumer will believe that the goods come from economically connected undertakings and so be indirectly confused.

63. The opposition is successful.

## **OUTCOME**

64. The opposition has been successful and Application No. 3791812 is refused registration.

## **COSTS**

65. The opponent has been successful and under the circumstances is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice No. 2/2016. The applicant submitted that it had not been notified by the opponent of its intention to oppose the mark and that this should be taken into account in making an award of costs.

66. Tribunal Practice Notice 6/2008 deals with the need to provide reasonable notice of an opposition. It states that:

“Where an opposition is defended, the provision or otherwise of prior notice will not usually affect the award of costs at the conclusion of the proceedings, which will normally be based on the published scale of costs.”<sup>13</sup>

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<sup>13</sup> Paragraph 6.

67. I therefore make an award of costs to the opponent as follows:

*Preparing a statement and considering the other side's statement: £200*

*Preparing written submissions in lieu of a hearing: £300*

*Official fees: £100*

***TOTAL: £600***

68. I therefore order Shenzhen Yitianxia Technology Co., Ltd to pay Sky Limited the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 11th day of August 2023**

**Clare Boucher,  
For the Registrar,  
Comptroller-General**