O/1034/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3728759
BY SHENZHEN KEYIN TECHNOLOGY CO., LTD.

TO REGISTER THE TRADE MARK:

ambor

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 430094
BY LI JIAQI

Background and pleadings

1. On 3 December 2021, **Shenzhen Keyin Technology Co., Ltd.** ("**the applicant**") applied to register the trade mark displayed on the front cover of this decision in the UK, under number 3728759 ("**the contested application"**). The contested application was published in the Trade Marks Journal for opposition purposes on 17 December 2021. Registration is sought for the following goods:[1]

    Class 9: Earphones; Digital photo frames; Monitors [computer hardware]; Mouse [computer peripheral]; walkie-talkies; Batteries, electric; Microscopes; smartwatches; Dog whistles; Scales; Telemeters; eyeglasses; Tablet computers; Telescopes; Cell phones; Radios; Stands adapted for tablet computers; Cabinets for loudspeakers; Electric sockets; Camera covers; Laptop covers.

2. On 12 January 2022, Li Jiaqi ("**the opponent**") filed a notice of opposition. The opposition is brought under section 5(2)(b)[2] of the Trade Marks Act 1994 ("**the Act**") and is directed against all the goods in the contested application.

3. The opponent relies upon its UK trade mark number 3395727, **AMBOR**, ("the earlier mark"). The earlier mark was registered on 11 October 2019. For the purposes of the opposition, the opponent relies upon all of its registered goods which are as follows:

    Class 18: Backpacks; Handbags; Briefcases; Cases, of leather or leatherboard; Pocket wallets; Bags for sports; Trunks [luggage]; Shopping bags; School bags; Vanity cases, not fitted; Tool bags of leather, empty; Garment bags for travel; Key cases; Bags for climbers.

4. The earlier mark was filed on 30 April 2019, given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act.

[1] The applicant sought to restrict its goods by filing Form TM21B on 13 May 2022

[2] The opponent originally sought to rely upon additional grounds, namely, s.5(3) and s.5(4)(a). However, due to the opponent's failure to provide evidence these additional grounds were struck out by the registrar on 9 March 2023. Therefore, its claim is now based solely on s.5(2)(b).

However, as it had not been registered for more than five years at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods identified without having to demonstrate genuine use.

5. Its notice of opposition is minimal; however, the opponent appears to claim that the competing marks are similar and that the applied for goods are either identical or similar to those of the earlier mark, giving rise to a likelihood of confusion between the marks.

6. The applicant filed a counterstatement denying that the competing marks are similar, admitting instead that they are identical. The applicant highlights within its counterstatement that as the marks are identical rather than similar the opposition under section 5(2)(b) should be dismissed as the correct ground that the opposition should have been brought under is section 5(2)(a).[3] It also argues that the competing goods are dissimilar and denies that there exists a likelihood of confusion between the marks.

7. The applicant is professionally represented by The Trade Marks Bureau, whilst the opponent is represented by Anthony Gao**.** Neither party asked to be heard at an oral hearing, though the applicant chose to file written submissions in lieu of a hearing. This decision is taken following careful consideration of the papers before me.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

[3] Applicant's counterstatement paragraph 2

DECISION

Legislation

9. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (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."

10. Section 5A states:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

11. 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 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 the marks

12. 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 an average consumer."

13. The respective trade marks are shown below:

Earlier mark	Contested mark
AMBOR	**ambor**

14. The competing marks are both word-only marks which consist of the same single word AMBOR with no other elements to contribute to the overall impression. The only difference between the marks is that the earlier mark is presented in upper case whilst the applicant's mark is presented in lower case. It is well established

that registration of a word-only mark provides protection for the word itself, irrespective of whether it is presented in upper or lower case.[4]

15. Consequently, the respective marks are self-evidently identical marks, which is accepted by the applicant. As such, there appears to be a pleadings issue, and it follows that the opposition under section 5(2)(b) must fail as it requires similarity rather than identity between the competing marks. Nevertheless, I will continue to assess whether there is any similarity between the competing goods that would have led to a finding of a likelihood of confusion either under section 5(2)(b) if the marks had been similar, or under section 5(2)(a) if the opponent had relied on this ground which requires competing marks to be identical.

Comparison of goods

16. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
>
> (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

[4] *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14 paragraph 21.

17. All relevant factors relating to the services should be taken into account, which include, inter alia:[5]

• the physical nature of the goods or acts of service;

• their intended purpose;

• their method of use / uses;

• who the users of the goods or services are;

• the trade channels through which the goods or services reach the market;

• in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

• whether they are in competition with each other (taking into account how those in trade classify goods or services, for instance whether market research companies put them in the same or different sectors)

Or

• whether they are complementary to each other. Complementary signifying that "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 or services lies with the same undertaking".[6] Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[7]

18. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy

[5] See Canon, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the "Treat" case.
[6] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13
[7] *Kurt Hesse v OHIM*, Case C-50/15 P, se also *Sanco SA v OHIM*, Case T-249/11

and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the category of goods or services 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 or services in question.[8]

19. Furthermore, I bear in mind the approach in *Sky v Skykick,*[9] where Lord Justice Arnold set out the correct approach to interpreting broad and/or vague terms.

20. With these factors in mind, the competing goods to be compared are as set out in paragraphs 1 and 3.

Earphones; Digital photo frames; Monitors [computer hardware]; Mouse [computer peripheral]; walkie-talkies; Batteries, electric; Microscopes; smartwatches; Dog whistles; Scales; Telemeters; eyeglasses; Tablet computers; Telescopes; Cell phones; Radios; Stands adapted for tablet computers; Cabinets for loudspeakers; Electric sockets

21. The opponent's goods are all types of bags or cases that have no obvious similarity with the applied for goods in class 9 listed above. Consequently, I find that these goods are dissimilar.

Camera covers; Laptop covers.

22. Upon plain reading of the term, I am of the view that the applicant's goods are covers adapted for cameras or laptops, meaning that they are specifically shaped for goods the covers are protecting. In contrast, the opponent's term "cases, of leather or leatherboard", which I find to be the opponent's best case, does not include cases that are adapted for laptops or cameras. These items are expressly excluded in the explanatory notes for the Nice Classification guide regarding class 18 which states "*This Class does not include, in particular: […] bags and cases adapted to the product they are intended to contain, for example, bags adapted for*

[8] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
[9] [2020] EWHC 990, (Ch),

laptops, bags and cases for cameras and photographic equipment".[10] I will keep this in mind whilst assessing the similarity of the goods. In my view, the nature, method of use and intended purpose differ as camera and laptop covers are used specifically for goods for which they are adapted, primarily for protection of those goods. Whilst, on the other hand, leather cases are used for placing items inside to carry them from one place to another. The goods are likely to be found in different stores; the applicant's goods are likely to be found in stores selling cameras and laptops, whereas the opponent's leather cases are likely to be found in bag and luggage stores. Further, I have nothing before me to suggest that the goods are produced by the same undertakings, and although users may overlap, this is only to a general degree. The goods are not complementary, as one is not important or indispensable for the use of the other. Nor are they competitive as a leather case cannot be used in substitution for a laptop or camera cover as they have a different nature and intended purpose, i.e. to protect the goods rather than carry them around. As a result, I find that these goods are not similar.

23. Consequently, as a level of similarity is required between the competing goods in order for there to be a likelihood of confusion[11] under section 5(2)(b) of the Act, the opposition would fail irrespective of whether the competing marks were found to be identical or similar. As the requirement for similarity between the competing goods applies equally to section 5(2)(a), if the opposition had been brought under this section, it would have also failed.

CONCLUSION

24. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal, the application will proceed to registration.

[10]https://www.wipo.int/classifications/nice/nclpub/en/fr/?class_number=18&explanatory_notes=show&gors=&lang=en&menulang=en&notion=class_headings&version=20230101
[11] *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

COSTS

25. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the applicant the sum of **£500**, which I calculate as follows:

Considering the notice of opposition and filing a defence and counterstatement	£200
Preparing written submissions	£300

26. Accordingly, I hereby order **Li Jiaqi** to pay **Shenzhen Keyin Technology Co., Ltd.** the sum of **£500**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of November 2023

Sarah Wallace
For the Registrar