

O-1098-23

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. UK0003821643

DZOFILM

IN THE NAME OF SHENZHEN DONGZHENG OPTICAL TECHNOLOGY CO., LTD

AND

AN OPPOSITION UNDER NO. 436740

BY NOKIA TECHNOLOGIES OY

Background and pleadings

1. On 19 August 2022, Shenzhen Dongzheng Optical Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 2 September 2022 for a number of goods and services in Classes 9 and 35.
2. Nokia Technologies Oy (“the opponent”) filed a notice of opposition on 7 October 2022 on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in Class 9 covered by the application. The goods in Class 9 are listed below:

Class 9 Lenses for cameras; Cinematographic cameras; Editing appliances for cinematographic films; Camcorders; Bags for cameras and photographic equipment; Enlarging apparatus [photography]; Cameras; Cases especially made for photographic apparatus and instruments; Lens filters [for cameras]; Viewfinders [for cameras]; Self-timers [for cameras]; Diaphragms [photography]; Camera filters; Optical lenses; Magnifying glasses; Instruments containing eyepieces; Optical mirrors; Optical apparatus and instruments; Optical glasses; Electronic control sensors for motors; Semiconductor devices; Electronic chips; Light dimmers [regulators], electric; Telescopes; Integrated circuits; Optical goods.

3. For its claim, the opponent relies upon all the goods and services covered by the below-mentioned international registration designating the UK.

Mark: **OZO**

Registration No. WO0000001293287

Registration date: 10 December 2015

Designation date: 9 January 2019

Goods and services:

Class 9 Photographic, cinematographic and optical apparatus and instruments; apparatus for recording, capturing, storing, processing, editing, displaying, transmission, reproduction and play back of sound or images; digital and optical recording media; audio, video, imaging, virtual-reality and presence-capture software; cameras; audio, video, imaging, virtual-reality and presence-capture sensors; head-mounted displays; spectacles (optics); downloadable sound and image files; audio, video and images encoder/decoder (codec); computer programs and software, namely algorithms for the compression, decompression, encoding, decoding and processing of audio, video and imaging data; electronic publications; chips [integrated circuits]; microprocessors; parts, fittings and accessories of all the aforementioned goods.

Class 41 Audio, video and images editing and production services; rental of audio, video, digital media and multimedia hardware.

Class 42 Audio, video, imaging, digital media, multimedia and virtual reality technology services and research relating thereto; engineering and development of audio, imaging, video, digital media, multimedia and virtual reality hardware and software; technological analysis, research, development, support, technical troubleshooting and consultancy services in the field of audio, imaging, video, digital media, multimedia, virtual reality and presence capture technologies; data encoding and decoding services; software as a service [SaaS]; platform-as-a-service (PaaS); rental of virtual reality software and hardware; rental of audio, imaging, video, digital media, multimedia, virtual reality and presence capture software; rental of scientific and technological imaging and presence capture hardware.

4. The opponent claims that its earlier mark is similar to the applicant's mark and its goods and services are identical or similar to the applicant's goods, with the result that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the grounds of opposition.
6. The applicant is represented by Dhang Group Co.,Ltd and the opponent is represented by Osborne Clarke LLP. The applicant filed evidence but it was not admitted into the proceedings as the evidence was unsupported by a witness statement/statutory declaration/affidavit.¹ No hearing was requested and only the opponent filed submissions in lieu. This decision is taken after careful reading of all the papers filed by the parties.
7. Although the UK has left the European Union (“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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Section 5(2)(b)

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

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

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

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

Case law

9. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-*

¹ Registry’s letter dated 4 May 2023.

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 C3/03, Medion AG v Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L.Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles:

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

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

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

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods

10. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

11. In *Gérard Meric v OHIM*, the General Court held that 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 - and vice versa.²

12. I will first compare the applicant's goods with the opponent's goods in Class 9 and return to the comparison of the applicant's goods with the opponent's services only if necessary.

Applicant's goods	Opponent's goods
<p><u>Class 9</u></p> <p>Lenses for cameras; Cinematographic cameras; Editing appliances for cinematographic films; Camcorders; Bags for cameras and photographic equipment; Enlarging apparatus [photography]; Cameras; Cases especially made for photographic apparatus and instruments; Lens filters [for cameras]; Viewfinders [for cameras]; Self-timers [for cameras]; Diaphragms[photography]; Camera filters; Optical lenses; Magnifying glasses; Instruments containing eyepieces; Optical mirrors; Optical apparatus and instruments; Optical glasses; Electronic control sensors for motors; Semiconductor devices;</p>	<p><u>Class 9</u></p> <p>Photographic, cinematographic and optical apparatus and instruments; apparatus for recording, capturing, storing, processing, editing, displaying, transmission, reproduction and play back of sound or images; digital and optical recording media; audio, video, imaging, virtual-reality and presence-capture software; cameras; audio, video, imaging, virtual-reality and presence-capture sensors; head-mounted displays; spectacles (optics); downloadable sound and image files; audio, video and images encoder/decoder (codec); computer programs and software, namely algorithms for the compression, decompression,</p>

² case T-133/05

<p>Electronic chips; Light dimmers [regulators], electric; Telescopes; Integrated circuits; Optical goods.</p>	<p>encoding, decoding and processing of audio, video and imaging data; electronic publications; chips [integrated circuits]; microprocessors; parts, fittings and accessories of all the aforementioned goods.</p>
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13. The term 'cameras' and 'optical apparatus and instruments' are identically contained in both parties' specifications.
14. 'Electronic chips' and 'integrated circuits' in the application are different ways of referring to 'chips [integrated circuits]' in the opponent's specification. The conflicting goods are identical.
15. 'Cinematographic cameras' in the applicant's specification falls within the broad category of 'cameras' in the opponent's specification. Both terms are identical under the *Meric* principle.
16. 'Editing appliances for cinematographic films' in the application is identical to 'apparatus for editing' under the principles outlined in *Meric*.
17. 'Lenses for cameras; enlarging apparatus [photography]; lens filters [for cameras]; viewfinders [for cameras]; self-timers [for cameras]; diaphragms [photography], in the applicant's specification fall within the broad category of parts and fittings of cameras in the opponent's specification.
18. 'Electronic control sensors for motors' and 'semiconductor devices' in the applicant's specification include sensors for camera motors and semiconductor sensors used in cameras. These goods fall within the broad category of parts and fittings of cameras in the opponent's specification and are, therefore, identical under the *Meric* principle.
19. 'Optical lenses; optical mirrors; optical glasses; telescopes; optical goods; magnifying glasses; instruments containing eyepieces' in the applicant's specification are various types of optical apparatus and instruments contained

in the opponent's specification. The conflicting goods are identical under the *Meric* principle.

20. The applicant's 'camera filters; light dimmers [regulators], electric; bags for cameras and photographic equipment; cases especially made for photographic apparatus and instruments' are accessories of cameras covered by the opponent's specification. The conflicting goods are identical under *Meric* principle.

21. 'Camcorders' in the applicant's specification falls within the broad categories of 'photographic, cinematographic and optical apparatus and instruments; apparatus for recording, capturing, storing, processing, editing, displaying, transmission, reproduction and play back of sound or images' in the opponent's specification. The conflicting goods are, therefore, identical under the *Meric* principle.

The average consumer and the nature of the purchasing act

22. I will proceed to determine who the average consumer is for the respective parties' goods discussed above.

23. 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".

24. The average consumer of the respective parties' goods is likely to be professional users and the general public. The purchases are likely to be fairly infrequent. The goods will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. Visual considerations are likely to dominate the selection process for the goods. There may be aural considerations when the choice is made further to references or recommendations. The price of the goods will vary depending on their nature and type. For example, professional cameras are likely to be more expensive than camera accessories such as camera bags. When selecting the goods, the average consumer in both categories is likely to pay at least a medium degree of attention.

Distinctive character of the earlier mark

25. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 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).”

26. Invented words usually have the highest degree of inherent distinctive character, while words which are allusive of the goods have the lowest. Although, distinctiveness can be enhanced through the use made of the mark, the opponent did not file evidence, so I only have the inherent position to consider. The earlier mark is a word-only mark for OZO. The mark appears to be a random combination of three letters and is not allusive of the opponent’s goods. I find that the opponent’s mark is inherently distinctive to a medium degree.

Comparison of marks

27. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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.”

28. 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.

29. The respective trade marks are shown below:

Opponent's mark	Applicant's mark
OZO	DZOFILM

30. The opponent's mark is a word-only mark for 'OZO'. The overall impression and the distinctiveness of the mark lies in the word itself.

31. The applicant submits that the initial letters (O/D) in the respective marks are different.³ The opponent, on the other hand, contends that the first part of the applicant's mark will be viewed as either 'OZO' or 'DZO' as the stylisation of the first letter resembles both the letter 'O' and the letter 'D'.⁴ I agree with the opponent that the first letter in the applicant's mark appears in more than one way. Due to the trimmed edge and the angular representation, I think the average consumer is likely to see the first letter as a 'D' or an 'O'. Although the third letter also has a trimmed edge, I think, the average consumer is likely to see it as a letter 'O'. In my view, a significant proportion (although not all) of the average consumer is likely to see the wording as 'OZOFILM', therefore I shall proceed with my visual, aural and conceptual comparison on that basis. The mark consists of the letters 'OZO' and 'FILM', which will be readily identifiable. The word FILM means a roll used in cameras to take photographs or a moving picture recorded using a camera.⁵ In respect of cameras and goods related to films, the word is non-distinctive. However, given that the word 'FILM' is

³ The counterstatement.

⁴ The opponent's submissions, para 14.

⁵ <https://www.collinsdictionary.com/dictionary/english/film> accessed on 9 November 2023.

presented in the same size and stylisation as the letters 'OZO', I am of the view that the word 'FILM' makes roughly an equal contribution to the overall impression the mark as the letters 'OZO'. The stylisation plays a lesser role in the overall impression of the mark.

32. In terms of visual similarity, both marks coincide in the letters 'OZO' and that 'OZO' forms the first three letters of the applicant's mark. I note here that the identity/similarity at the beginning of the marks is likely to have a great impact on the average consumer.⁶ The difference between the marks is introduced by the stylisation of the letters and the word 'FILM' in the applicant's mark. Considering these factors, I find that the marks are visually similar to a medium degree.

33. Aurally, in both marks, the letters 'O', 'Z' and 'O' will be pronounced conventionally. The aural difference between the marks is introduced by the word 'FILM' which does not have a counterpart in the opponent's mark. Given that both marks coincide in the pronunciation of the letters 'OZO', which is at the beginning of the marks, I find that the marks are aurally similar to a medium degree.

34. In a conceptual comparison, the opponent submits that neither mark have a meaning.⁷ The applicant, however, contends that the origin of the applicant's mark has a meaning and is based on the applicant's name – Dongzheng Optical – the letters 'DZ' being the abbreviation of the word Dongzheng and the letter 'O' stands for the word optical. While the applicant's mark may have been coined from the applicant's name, in a conceptual comparison, I must assess whether the respective marks convey a clear and specific meaning which can be grasped immediately by the average consumer.⁸ In that respect, I do not think that neither the opponent's mark nor the first part of the applicant's mark renders a conceptual meaning to the average consumer as it appears to have

⁶ *El Cortes Inglés v OHIM - González Cabello and Iberia Lineas Aéreas de España* (MUNDICOR) [2004] ER

⁷ The opponent's submissions, para 17.

⁸ *The Picasso Estate v OHIM*, Case C361/04 P

no discernible meaning. The applicant's mark, however, contains the word 'FILM'. Given its presence, I find that the marks are conceptually dissimilar.

Likelihood of confusion

35. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the goods (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

36. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related).

37. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, 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)”.

38. I have found the respective marks to be visually and aurally similar to a medium degree and conceptually dissimilar. I also found that the goods will be selected primarily by visual means, with a medium degree of attention by the general public and the professionals. The goods are identical. I also concluded that the inherent distinctiveness of the earlier mark is medium. I also found that a significant proportion of the average consumers are likely to see the first three letters in the applicant’s mark as ‘OZO’.

39. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,⁹ Kitchin L.J. considered the relationship between the average consumer and the likelihood of confusion. He concluded that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant portion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement.”

40. Although this was in the context of infringement, the same approach is appropriate under s.5(2).¹⁰

41. I find that the average consumer paying a medium degree of attention to the purchase of identical goods is likely to misremember the difference between the marks. The word ‘FILM’ being non-distinctive in the context of goods such as cameras and those related to films, in imperfect recollection, the average consumer may not recall that word. As a significant number of the average consumers are likely to see the first three letters in the applicant’s mark as ‘OZO’, which is identical to the opponent’s mark, they are likely to mistake one mark for the other leading to a likelihood of direct confusion.

42. Even if the average consumer recalls the word ‘FILM’ in the applicant’s mark, I think that there is a likelihood of indirect confusion. The average consumer is likely to think that the undertakings selling identical goods under the trade mark consisting of or containing the mark ‘OZO’ are related or that the applicant’s mark is a sub-brand of the opponent. I conclude that there is a likelihood of direct and indirect confusion.

Conclusion

⁹ [2016] EWCA Civ 41, at paragraph 349(v)

¹⁰ See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 498 (Ch), Mann J.

43. The opposition has been successful. The application is refused in respect of the applied-for goods in Class 9 only, and shall proceed to registration in relation to the uncontested services in Class 35.

Costs

44. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I award costs to the opponent on the following basis:

Preparing a statement of case and Considering other side’s statement:	£200
Filing written submissions:	£300
Official fee:	£100
Total:	£600

45. I order Shenzhen Dongzheng Optical Technology Co., Ltd to pay Nokia Technologies Oy the sum of £600. 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 20th day of November 2023

**Karol Thomas
For the Registrar
The Comptroller-General**