

O-115-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3357870

BY NEWTECH STORE LIMITED

TO REGISTER:

S922X

AS A TRADE MARK IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415763

BY SUPERVIEW DIGITAL LTD

BACKGROUND & PLEADINGS

1. On 3 December 2018, Newtech Store Limited (“the applicant”) applied to register **S922X** as a trade mark for the goods shown in paragraph 9 below. The application was published for opposition purposes on 14 December 2018.

2. On 14 March 2019, the application was opposed in full by Superview Digital Ltd (“the opponent”) which at that stage was unrepresented. Although the opposition was originally based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in its written submissions dated 16 August 2019, the opponent, who by this stage had professional representation, indicated that it no longer intended to pursue its objections based upon sections 5(1) and 5(2)(a) of the Act.

3. In its Notice of opposition, the opponent indicates that it relies upon all the goods (shown in paragraph 9 below) in UK trade mark registration no. 3203697 for the trade mark **S912**. This trade mark was applied for on 22 December 2016 and was entered in the register on 21 April 2017. In its Notice of opposition, the opponent stated:

“We been using the Trademark S912 since late 2016 for Android streaming clients and settop boxes. We spent huge amount of money on S912 Brand to make this popular. The S922X is very similar to our Trademark S912 which will cause confusion to our customer since the products and services are exactly same as we are using for S912. This Trademark not only damage the reputation of our company but also greatly impact on our products. We actively using S912 and we have number of products in UK market since 2016.”

4. The applicant filed a counterstatement which consists of a denial of the grounds upon which the opposition was originally based.

5. In these proceedings, the opponent is now represented by The Trade Marks Bureau; the applicant is represented by Sanderana. Although neither party filed evidence, both filed written submissions during the evidence rounds. While neither

party requested a hearing, the opponent elected to file written submissions in lieu of attendance. I shall keep all of these written submissions in mind, referring to them to the extent I consider it necessary.

DECISION

6. The opposition is now based solely upon section 5(2)(b) of the Act which 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.

5A 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.”

7. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the dates on which the opponent’s trade mark was entered in the register and the filing date of the application for registration, the earlier trade mark is not subject to the proof of use provisions contained in section 6A of the Act.

Case law

8. The following principles are gleaned from the decisions of the courts of the European Union 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*

Klijnsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles:

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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;

(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

9. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 9 - Internet Streaming Device.	Class 9 - Broadband wireless equipment; Mini PCs; Central processing units; video streaming devices; Central processing units [processors]; Central processing units for processing information, data, sound or images; Juke boxes; Set-top boxes; Minicomputers; Portable media players; Sound transmitting apparatus; Digital media streaming devices; TV sets,,

	including high-definition and Quad core sets; Readers for online media.
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10. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

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

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

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

15. In its counterstatement, the applicant stated:

“4.12 It is agreed that the goods protected by the Registration: *'Internet streaming device'* are similar to the following applied for goods in the Application: *'video streaming devices'* and *'digital media streaming devices'*

4.13 It is denied that there is any similarity between the remaining claimed goods...”.

16. In its written submission filed during the evidence rounds, the opponent contends:

“6...that the Goods covered by the contested application are identical and similar to the Goods covered by the earlier mark.

7. An internet streaming device is what connects a television or home theatre to the Internet and allows the user to stream video, movies, television shows and music from online services. The devices consist of low power consumption processors or SoC (System on Chip) and are most commonly either based on MIPS (Microprocessor without Interlocked Pipelined Stages or ARM (Advanced RISC Machine) architecture processors combined with integrated Digital Signal Processing, Graphics Processing Unit in a System on Chip (or a Multi-processor system on chip) package. They also include RAM (Read Access Memory) memory and some type of built-up flash memory.

8. Subsequently, all of the Goods covered by the contested application are either identical or highly similar to the Goods covered by the earlier mark.”

17. In its written submissions, the applicant stated:

“4. It is submitted that the specification is unjustifiably broad and is not sufficiently clarified in order for there to be no doubt as to the scope of protection intended to be conferred by the Registration. To grant the

specification a wide interpretation would be unfair and would provide the Opponent with an unfair monopoly which would be contrary to the public interest. This is because the term 'Internet Streaming Devices' can encompass a wide range of goods which are not always related to one another, for example, the term can encompass Televisions, Computers, Laptops, Games Consoles, Set-top boxes. On the other hand, the term could encompass stand-alone devices with the ability to stream from the internet. All of the aforementioned products have the capacity to stream from the Internet however they are not always considered identical or similar and differ in many of their characteristics. In the context of the Advocate General's recent view in *Sky vs Skykick* case (2018] EWHC 155. the above argument should be taken into account when deciding the Opposition.”

18. In its submissions filed in lieu of a hearing, the opponent responded to the above in the following terms:

“3. The Opponent refutes this claim. The Opponents specification is clear that the product covered by the Class 09 specification is a device to enable consumers to stream content from the Internet to other devices. The Nice classification system also includes similar terms such as 'video streaming devices; media streaming software and digital media streaming devices'. The Opponents specification therefore is clear and precise as set out in IP TRANSLATOR.

4. The *Skykick* Case which the Applicant refers to is not on all fours with this opposition case. The *Skykick* Case concerns the terms 'computer software', 'telecommunication services and 'Internet portal services'. It is agreed in the *Skykick* and other previous cases such as *Mercury Communications Ltd v Mercury Inter-Active (UK) Ltd* [1995] FSR 850 that 'computer software' is overly broad and "unjustified and contrary to the public interest because it confers on the proprietor a monopoly of immense breadth which cannot be justified by any legitimate commercial interests of the proprietor". The

Opponents specification is so far away from 'computer software, telecommunication services and internet portal services' that the *Skykick Case* has no relevance to these proceedings.”

19. Insofar as the *Skykick* case is concerned, the opponent’s position is to be preferred. In my view, the term “Internet streaming device” is not overly broad and, having applied the guidance in *YouView* and *Beautimatic*, I agree that it will be understood by the average consumer in the manner explained by the opponent in paragraph 16 above. While I agree that “Televisions, Computers, Laptops, Games Consoles, Set-top boxes” identified in the applicant’s submissions all have the capacity to stream content from the Internet, they would be referred to by those names and not as Internet streaming devices.

20. Having described its goods, in its submissions filed during the evidence rounds, the opponent states:

“8. Subsequently, all of the Goods covered by the contested application are either identical or highly similar to the Goods covered by the earlier mark.”

21. However, as the opponent provides no further explanation as to why that might be the case, I shall have to reach my own conclusions based upon my own understanding of the various terms in the competing specifications. In *Separode Trade Mark* BL O-399-10, the Appointed Person, stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

That is the approach I intend to adopt.

Video streaming devices; digital media streaming devices

22. As I mentioned earlier, in its counterstatement the applicant admits these goods are “similar” to those of the opponent. As in my view they are simply alternative ways of describing the same commercial article, they are to be regarded as identical.

Broadband wireless equipment; Set-top boxes

23. Given the obvious overlap in, at least, the users, nature, intended purpose, method of use and trade channels, the above named goods are, in my view, similar to the opponent’s goods to a fairly high degree.

Mini PCs; Juke boxes; Minicomputers; Portable media players; Sound transmitting apparatus; TV sets, including high-definition and Quad core sets; Readers for online media

24. While the above goods may share similarities with the opponent’s goods in terms of, inter alia, their users, physical nature and channels of trade and while all of these goods may have the ability to stream content from the Internet as one of the functions they perform, crucially, in my view, that is not their primary intended purpose. Rather, they are computers, juke boxes, media players, apparatus for transmitting sound, televisions and readers. In addition, there is, in my view, no meaningful degree of either competition or, in the sense outlined in the case law mentioned above, complementarity between the above goods and those of the opponent. Weighing the relative importance of the similarities and differences I have identified, results in what I consider to be a fairly low degree of similarity.

Central processing units; Central processing units [processors]; Central processing units for processing information, data, sound or images

25. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods

containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

26. The comments in the above case are, in my view, equally applicable to these proceedings. The fact that both parties’ goods are likely to incorporate central processing units that perform operations on various items of data does not make such goods similar to the finished article of which they may form a part.

27. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

28. Having found that there is no similarity between the opponent’s goods and the applicant’s: “Central processing units; Central processing units [processors]; Central processing units for processing information, data, sound or images”, there can be no likelihood of confusion and the opposition to these goods fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods I have found to be identical or similar. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

30. In its submissions filed during the evidence rounds, the opponent states:

“10. The average consumer will be the general public seeking to purchase a device to enable them to connect their television or home theatre to the internet to enable the user to stream content (sic) from the internet to their television or home theatre. The relevant consumer of these goods will either make their purchase either visually or aurally from a retail store or electronic retail website; visually or aurally by mail order or aurally by telephone.”

31. In its counterstatement, the applicant stated:

“4.14 In the present case, the goods and services assumed to be similar are directed at the public at large (e.g. streaming devices). The level of attention paid by the average consumer is expected to be rather high, as the price of streaming devices can be high, averaging around £25-£60, these devices are infrequently obtained for a specific purpose and the nature of these goods is quite specialized.”

32. In its written submissions, the applicant further stated:

“6...however the high level of attention paid by consumers of the Class 09 goods claimed by both the Application and Registration mark, which are only

to be purchased infrequently and have a relatively high price point...For this reason, it is submitted that the consumer selecting goods with more than an average degree of attention...”

33. I agree with the parties that the average consumer of the goods I have found to be identical or similar i.e. video streaming devices; digital media streaming devices; broadband wireless equipment; set-top boxes; Mini PCs; Juke boxes; Minicomputers; Portable media players; Sound transmitting apparatus; TV sets, including high-definition and Quad core sets; Readers for online media, is a member of the general public.

34. In my experience, such goods are most likely to be obtained by self-selection from bricks-and-mortar retail outlets, online or via catalogues. While aural considerations must be kept in mind (in the form of requests to sales assistants, orders placed by telephone and word-of-mouth recommendations), visual consideration are nonetheless likely to dominate the selection process.

35. As to the degree of care the average consumer will display when selecting such goods, my own experience as a member of the general public informs me that while the cost of such goods can vary considerably, they are, as the applicant suggests, likely to be fairly expensive and infrequent purchases. Bearing that in mind and as the average consumer will also need to satisfy themselves that, for example, the item in question contains the features they require and is compatible with existing hardware and software, I agree with the applicant that they are likely to pay a fairly high degree of attention to the selection of such goods.

Comparison of trade marks

36. 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

37. It would be wrong, therefore, artificially to dissect the trade 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 they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
S912	S922X

38. A good deal of the parties' competing submissions are directed at this aspect of the case. While I do not intend to record these submissions here, for the avoidance of doubt, I have borne them all in mind in reaching the conclusions that follow.

39. The opponent's trade mark consists of the letter "S" presented in upper case followed by the numerals "9-1-2" presented in a conventional manner. As no part of the opponent's trade mark is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the trade mark as whole.

40. The applicant's trade mark also consists of the letter "S" presented in upper case albeit followed by the numerals "9-2-2" presented in a conventional manner and followed by an upper case letter "X ". Like the opponent's trade mark, as no part of the applicant's trade mark is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the trade mark as whole.

Visual similarity

41. The applicant's trade mark consists of five characters whereas the opponent's trade marks contains only four. Both trade marks begin with a letter "S" followed by the numeral "9" and contain the numeral "2" in the fourth character position. The applicant's trade mark has the numeral "2" in the third character position (as opposed to a numeral "1" in the opponent's trade mark) and a letter "X" in the fifth character position. Weighing the similarities and differences results in what I regard as a medium degree of similarity between the competing trade marks.

Aural similarity

42. The opponent's trade mark is most likely to be referred to as either "S-nine-one-two" or "S-nine hundred and twelve", whereas the applicant's trade mark is most likely to be referred to as either "S-nine-two-two-X" or "S-nine hundred and twenty two-X." Despite the various differences, the fact that the competing trade marks both begin "S-nine" or "S-nine-hundred" and also contain the word "two" in the same position results in a medium degree of aural similarity between them.

Conceptual similarity

43. As neither trade mark is likely to convey any concrete message to the average consumer, the conceptual position is neutral.

Distinctive character of the earlier trade mark

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings -

Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

45. Although the opponent indicated in its Notice of opposition that it had used its earlier trade mark since 2016, as it has filed no evidence in support of this assertion, I have only its inherent characteristics to consider. As there is nothing to suggest that the opponent's trade mark is either descriptive of or non-distinctive for the goods for which it is registered, it is, in my view, possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

46. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. 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 and must instead rely upon the imperfect picture of them he has retained in his mind.

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

48. Earlier in this decision I concluded that:

- the applicant's: "video streaming devices; digital media streaming devices" are to be regarded as identical to the opponent's goods;

- the applicant's: "Broadband wireless equipment; Set-top boxes" are similar to the opponent's goods to a fairly high degree;
- the applicant's: "Mini PCs; Juke boxes; Minicomputers; Portable media players; Sound transmitting apparatus; TV sets, including high-definition and Quad core sets; Readers for online media", are similar to the opponent's goods to a fairly low degree;
- the average consumer of the identical/similar goods mentioned is a member of the general public who, whilst not forgetting aural considerations, will select such goods by predominantly visual means whilst paying a fairly high degree of attention during that process;
- the competing trade marks
- are visually and aurally similar to a medium degree and conceptually neutral;
- the earlier trade mark is possessed of a medium degree of inherent distinctive character.

49. Some of the applicant's goods are identical or similar to a fairly high degree to the opponent's goods. Those are points in the opponent's favour. The fact that the average consumer will pay a fairly high degree of attention during the selection process (making him/her less prone to the effects of imperfect recollection) is a point in the applicant's favour. The various differences between the competing trade marks I have identified earlier are, in my view, likely to be sufficient to avoid the average consumer mistaking one trade mark for the other i.e. there will be no direct confusion. Having reached that conclusion in relation to goods which are identical/similar to a fairly high degree, it follows that it also applies to goods which are only similar to a fairly low degree.

50. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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.”

51. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

52. In its submissions filed during the evidence rounds, the opponent states:

“14...Subsequently, consumers will wrongly assume that the applicant’s goods bearing the mark S922X are a natural extension or a more updated or upgraded version of the opponent’s S912 goods.”

53. In relation to those goods I have found to be identical/similar to a fairly high degree, that submission has considerable force. Applying the thought process suggested by Mr Purvis, having noticed that the applicant’s trade mark is different from the opponent’s trade mark, the average consumer will then note that both trade marks begin with the letter “S” followed by numerals in the range nine hundred i.e. “912”/“922”. Although the applicant’s trade mark also contains the letter “X” at the end of the trade mark, even an average consumer paying a fairly high degree of attention during the selection process is likely, in my view, to assume, for example, that the S922X trade mark represents an update to the S912 trade mark. That will

result in a likelihood of indirect confusion and the opposition to those goods I have found to be identical/similar to a fairly high degree succeeds accordingly.

54. That leaves the goods in the application which I have concluded are only similar to a fairly low degree to be considered. When viewed from the perspective of a consumer paying a fairly high degree of attention during the selection process, the distance between the competing goods combined with the various differences between the competing trade marks is, in my view, sufficient to avoid such a consumer concluding that the applicant's goods are those of the opponent or an undertaking related to the opponent. There is, in my view, no likelihood of indirect confusion and the opposition to the named goods fails accordingly.

Overall conclusion

55. The opposition has succeeded in relation to:

Video streaming devices; digital media streaming devices; Broadband wireless equipment; Set-top boxes.

And failed in relation to:

Mini PCs; Central processing units; Central processing units [processors]; Central processing units for processing information, data, sound or images; Juke boxes; Minicomputers; Portable media players; Sound transmitting apparatus; TV sets, including high-definition and Quad core sets; Readers for online media.

Costs

56. Although both parties have achieved a measure of success, the applicant has been more successful than the opponent. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. At the conclusion of the evidence rounds, the tribunal wrote to Sanderana. In that letter, dated 13 November 2019, the tribunal stated:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party...

If there is to be a “decision from the papers” this should be provided by **11 December 2019**.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded...”

57. In an email dated 3 December 2019, Sanderana completed the cost pro-forma that had been sent to it. However, in an email dated 4 December 2019, the opponent stated:

“A Tribunal Cost Pro Forma application is only required from a party not professionally represented in proceedings. Subsequently, the completion of the Tribunal Cost Pro Forma application is not necessary as the Applicant is professionally represented.”

58. As in the email accompanying the applicant’s costs pro-forma it is stated: “SANDERANA is an IP Consultancy operated by Amandeep Rana who is regulated by the Intellectual Property Regulation Board”, the opponent is clearly correct.

59. Bearing the above in mind and making a “rough and ready” reduction to the amount I would have otherwise awarded to the applicant to reflect the measure of the opponent’s success, I award costs to the applicant on the following basis:

Reviewing the Notice of opposition and preparing the counterstatement:	£200
Written submissions:	£100
Total:	£300

60. I order Superview Digital Ltd to pay to Newtech Store Limited the sum of **£300**. 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 24th day of February 2020

C J BOWEN

For the Registrar