

O-346-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3123682
BY TECNO TELECOM (HK) LIMITED
TO REGISTER THE TRADE MARK**

TECNO
mobile

IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 405846 BY PDJ (SHELF 7) LIMITED**

BACKGROUND

1. On 24 August 2015 Tecno Telecom (HK) Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The specification has been subject to amendment after filing and now reads as follows:

Class 9: Batteries, electric; Chargers for electric batteries; Cabinets for loudspeakers; Hands free kits for phones; Connections for electric lines; Computer memory devices; Headphones; Video screens; Quantity indicators; Inductors [electricity]; Electric installations for the remote control of industrial operations; Signalling panels, luminous or mechanical; Wafers for integrated circuits; all of the aforesaid being for use with mobile telephones, smartphones or other telecommunications equipment; Mobile telephones; Cabinets for loudspeakers.

2. The application was accepted and published for opposition purposes on 16 October 2015.

3. The application is opposed in full by PDJ (Shelf 7) Limited (“the opponent”) under Section 5(2)(b) of Trade Marks Act 1994 (“the Act”), for the purpose of which it relies upon European Union Trade Mark (“EUTM”) registration no. 10118107 for the mark TECNO which has a filing date of 12 July 2011 and a registration date of 06 September 2013. The opponent relies upon all the goods and services for which the mark is registered, namely:

Class 9: Photographic apparatus and instruments except printers and parts of printers; magnetic and optical data carriers being parts or accessories for photographic apparatus; cameras; batteries and recharges for photographic apparatus; video tapes and audio tapes all relating to photographic apparatus and equipment; camera bags and cases; parts and fittings for all the aforesaid goods except for printers and/or computer printers; none of the aforesaid goods being electrical assemblies of high, medium or low voltage.

Class 36: Insurance services; provision of warranties and/or guarantees.

Class 37: Installation, service, maintenance and/or repair of communications apparatus, equipment and accessories, telecommunications apparatus, equipment and accessories, and paging apparatus and equipment; installation, service, maintenance and/or repair of computer hardware and computer firmware; provision of information relating to installation, service, maintenance and/or repair of communications apparatus, equipment and accessories, computer apparatus, equipment and accessories, telecommunications apparatus and accessories, paging apparatus and equipment; installation, service repair and/or maintenance services for consumer electronic products; installation, service, repair and/or maintenance services for photographic apparatus, equipment and accessories; all the aforementioned services limited to the photographic sector.

4. The significance of the dates mentioned above is that (1) the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the applicant's mark.

5. The opponent claims that the marks are similar and that the respective goods and services are identical or similar, so that there is a likelihood of confusion. The applicant filed a counterstatement in which it denies the grounds of opposition.

6. In these proceedings the applicant is represented by Groom Wilkes and Wright LLP; the opponent is represented by Gill Jennings & Every LLP.

7. Neither side filed any evidence. Neither side requested a hearing. Only the opponent filed written submissions. I will, if necessary, refer to these submissions later in this decision.

DECISION

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

“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.”

Section 5(2)(b) - case-law

9. 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 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10. In comparing the respective specifications, all the relevant factors should be taken into account. 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 that:

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

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 that:

"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 *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v 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”.

16. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

17. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

18. The parties’ goods and services are as follows:

Applicant's goods	Opponent's goods and services
<p>Class 9: Batteries, electric; Chargers for electric batteries; Cabinets for loudspeakers; Hands free kits for phones; Connections for electric lines; Computer memory devices; Headphones; Video screens; Quantity indicators; Inductors [electricity]; Electric installations for the remote control of industrial operations; Signalling panels, luminous or mechanical; Wafers for integrated circuits; all of the aforesaid being for use with mobile telephones, smartphones or other telecommunications equipment; Mobile telephones; Cabinets for loudspeakers.</p>	<p>Class 9: Photographic apparatus and instruments except printers and parts of printers; magnetic and optical data carriers being parts or accessories for photographic apparatus; cameras; batteries and recharges for photographic apparatus; video tapes and audio tapes all relating to photographic apparatus and equipment; camera bags and cases; parts and fittings for all the aforesaid goods except for printers and/or computer printers; none of the aforesaid goods being electrical assemblies of high, medium or low voltage.</p> <p>Class 36: Insurance services; provision of warranties and/or guarantees.</p> <p>Class 37: Installation, service, maintenance and/or repair of communications apparatus, equipment and accessories, telecommunications apparatus, equipment and accessories, and paging apparatus and equipment; installation, service, maintenance and/or repair of computer hardware and computer firmware; provision of information relating to installation, service, maintenance and/or repair of communications apparatus, equipment and accessories, computer apparatus, equipment and accessories,</p>

	<p>telecommunications apparatus and accessories, paging apparatus and equipment; installation, service repair and/or maintenance services for consumer electronic products; installation, service, repair and/or maintenance services for photographic apparatus, equipment and accessories; all the aforementioned services limited to the photographic sector.</p>
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19. Apart from *cabinets for loudspeakers* and *mobile telephones*, all the goods in the applicant’s specification (in class 9) are subject to the effects of the limitation *all of the aforesaid being for use with mobile telephones, smartphones or other telecommunications equipment*. Whilst some of the limited goods render the limitation slightly odd, nothing turns on this point. Likewise, the exclusion *none of the aforesaid goods being electrical assemblies of high, medium or low voltage* in opponent’s specification (in class 9) does nothing to materially affect matters, because it does not create any difference.

20. The opponent claims that the respective goods are similar because they are all electronic goods. It also claims that *mobile telephones* are similar to *cameras* because they can be used to take photographs. Further, it submits that the applied for goods are similar to the opponent’s services because “the services are ancillary services (and therefore complementary) that the public would expect to receive when purchasing class 9 goods on the high street. For example, electronics companies will often offer insurance, warranty, repair etc services in connection with their products.”

21. As to the argument that the parties’ goods are similar because they belong to a very broad category of products, namely electronic products, this is not enough to consider the products to be similar in a trade mark sense. It is apparent from the case-law in *Canon* that for goods to be similar there must be some similarity of users, uses, nature, purpose, method of use and trade channels and/or some level of

competition or complementary. Bearing those factors in mind, I shall begin with comparing *mobile telephones* and *cameras*.

Mobile telephones

22. Whilst the applied for *mobile telephones* are purchased, primarily, as a communication tool, I accept that they combine many functions including being a photographic apparatus. The same dictionary definition of *camera* acknowledges the fact that mobile telephones have built-in video camera functions:

Camera¹: (countable noun) A camera is a piece of equipment that is used for taking photographs, making films, or producing television pictures. Many cameras are now included as part of other digital devices such as phones and tablets.

23. Though a camera is not the same thing with a mobile telephone, they are both devices that produce digital images (particularly mobile phones which are smart phones). In *Apple Inc v Swatch AG*², Mr John Baldwin QC sitting as a Deputy Judge of the High Court, provided some guidance on the assessment of the similarity based on the nature of the essential/incidental features of the goods. He stated:

“21. Shorn of its opaqueness because of the different types of goods involved, the Hearing Officer's conclusion is that there is a high degree of similarity between, for example, wireless communication devices on the one hand and horological and chronometric apparatus and instruments on the other, and a medium degree of similarity between, for example, cameras and radios on the one hand and horological and chronometric apparatus and instruments on the other because of the functionality, appearance and method of use of smart watches. I find this conclusion very difficult to accept and, if right, would, it seems to me, have far reaching consequences in the context of registrability of trade marks. I do not think it is right. I think an error has arisen because the hearing officer took into account an incidental attribute of a device (that it can

¹ Collins Online English Dictionary, accessed on 24.05.2018

² [2017] EWHC 713 (Ch)

be used to tell the time) which for other reasons falls within the specification of goods for which the Applicant seeks registration, thus condemning all such devices even though they do not have that incidental characteristic.

22. The matter can be tested by considering the Hearing Officer's conclusion in relation to security devices. He did not accept that a smart watch was a security device or that security is a recognised feature of smart watches or that the goods are normally complementary. As a result he saw no similarity between security devices and the opponent's goods in class 14. However, consider the position if the ever innovative Apple introduces a rape alarm feature into a smart watch, or introduces a feature which enables a smart watch to liaise/interact with a user's domestic burglar alarm system. Is there now, contrary to the conclusion of the Hearing Officer, a high or medium degree of similarity between security devices and chronometers? In my judgment there is not. The basic facts have not changed sufficiently.

23. In these circumstances I must revisit the issue of similarity of goods and I do so following the principles in Canon, Case C-39/97. I was not shown the evidence filed on this opposition but it is evident from the Hearing Office's summary that the opponent was relying on the multiple attributes of a smart watch to support the submission which found favour with the Hearing Officer and which I have rejected.

24. I have considered the respective specifications and, inter alia, the nature of the goods, their intended purpose and method of use and whether they are in competition with each other or complementary and my conclusion with respect to similarity of goods is that, for those goods where the Hearing Officer found a high or medium degree of similarity, there is only a low degree of similarity.”

24. I find that there is some level of similarity between *mobile telephones* and *cameras* because a camera is a recognised, and for many users an important, feature of mobile telephones. The goods have the same uses, although I place no significant weight on this factor because they are general consumer goods. The

purpose and method of use, are to some extent, overlapping and some consumers may actually purchase a mobile phone instead of a camera to have an all in one device. The goods can be bought together in the same shop or the same area of a department store. **These goods are similar to a low degree.**

Batteries, electric; Chargers for electric batteries.

25. As noted above, these goods are subject to the limitation *all being for use with mobile telephones, smartphones or other telecommunications equipment*. Although these goods and the opponent's *batteries and recharges for photographic apparatus* are not identical, they have a similar purpose and method of use as they are both batteries and (re)chargers for electronic (albeit different) devices and are sold through similar trade channels. **These goods are similar to a medium degree.**

Computer memory devices

26. The applied for *computer memory devices* are devices capable of storing information, including photos. The opponent's *magnetic and optical data carriers being parts or accessories for photographic apparatus* are storage media for use with photographic apparatus. Although the limitation comes in, it does nothing to distinguish the goods because a memory device for a phone could actually be compatible with a camera, so the goods could be one and the same thing. **These goods are identical.**

Connections for electric lines; Inductors [electricity]; Wafers for integrated circuits.

27. *Connections for electric lines* consist of, inter alia, plugs and sockets. *Inductors [electricity]* and *wafers for integrated circuits* are electronic parts and components. Irrespective of the limitation, I cannot see how these goods are similar to any of the opponent's goods in class 9. Although the opponent's goods cover *parts and fittings* for photographic equipment, when the words are given their natural meaning (see *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and*

Another [2000] FSR 267), I am unconvinced that these goods would be perceived as parts or fittings of the opponent's goods. **These goods are not similar.**

Electric installations for the remote control of industrial operations; quantity indicators; signalling panels, luminous or mechanical

28. *Electric installations for the remote control of industrial operations* are electric installations used for process control in industrial applications. *Quantitative Indicators* are measuring devices designed to determine a quantity under observation. *Signalling panels, luminous or mechanical* are items that give warnings or transmit information such as, for example, neon panels. These goods have no obvious similarity with the goods covered by the earlier mark. I see no reason for concluding that such goods are similar to anything covered by the earlier mark, and no evidence/submission has been provided/made to the contrary. **There is no similarity here.**

Video screens

29. A video screen is essentially a screen for displaying videos. A video screen is a video screen regardless of whether it is used with a phone or a camera, and it seems to me that the goods cover monitors which could be used together with photo apparatus. Although the nature of the competing goods may differ, the users may be the same and the goods are complementary. **These goods are similar to a low degree.**

Hands free kits for phones

30. The contested *hands free kits for phones* are kits used for hands-free communications. Though I found that there is a low degree of similarity between the applied for *mobile telephones* and the opponent's *cameras*, these goods are effectively a further step away from the opponent's goods in class 9 and there is no real similarity in terms of uses, users, nature, purpose and methods of use. Even if the goods may be sold in the same shops, this is not enough to make the goods similar in a trade mark sense and I consider that the type of complementary and

competitive relationship I have described above between *cameras* and *mobile telephones* does not exist here. **These goods are not similar.**

Cabinets for loudspeakers (listed twice); Headphones;

31. Irrespective of the limitation, these goods are not used in combination with photographic apparatus and there is no evidence or submission to the contrary. The users, uses, purpose, methods of use and trade channels do not coincide and the goods are neither complementary nor in competition. **There is no similarity here.**

32. In relation to the applied for goods which I found are not similar to any of the opponent's goods in class 9, namely *cabinets for loudspeakers (listed twice); hands free kits for phones; connections for electric lines; headphones; quantity indicators; inductors [electricity]; electric installations for the remote control of industrial operations; signalling panels, luminous or mechanical and wafers for integrated circuits*, I will consider if there is any similarity with the opponent's services.

33. As to the similarity with the class 36 *insurance services; provision of warranties and/or guarantees* covered by the earlier mark, the opponent's argument is that the public would expect to receive these services when purchasing class 9 goods on the high street. Whilst it may be the case that manufacturers of goods may issue purchasers with a warranty/guarantee promising to repair or replace the goods if necessary, this is not a service provided for others separately to the offering of the goods themselves. Companies who provide insurance services and provision of warranties and/or guarantees do so on a discrete basis which does not, in my view, create a complementary relationship of the type envisaged by the case-law. There is no similarity here.

34. Finally, the opponent's installation, maintenance and/or repair services are all limited to the photographic sector so would not include services associated with the applied for goods listed above.

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

“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.”

36. Accordingly, for a claim under Section 5(2)(b) to succeed, there must be at least a degree of similarity of goods and/or services. Having concluded that there is no similarity between the opponent’s goods and services and the applicant’s:

Class 9: *cabinets for loudspeakers (listed twice); hands free kits for phones; connections for electric lines; headphones; quantity indicators; inductors [electricity]; electric installations for the remote control of industrial operations; signalling panels, luminous or mechanical; wafers for integrated circuits.*

37. I conclude that there is no likelihood of confusion and the opposition in relation to these goods under Section 5(2)(b) fails accordingly.

The average consumer and the nature of the purchasing act

38. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected 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.”

39. The parties’ goods in class 9 are mobiles telephones, photographic equipment and items used with these goods. The average consumer is either a member of the general public or a professional photographer. Whilst I accept that the degree of attention may vary depending on the cost and technical features of the goods, the average consumers will pay at least an average level of attention during the selection process. The goods will be perused through media such as brochures, websites, shops etc. This suggests a selection process that is more visual than aural. I do not, however, ignore the aural impact of the marks as sales advisors could be involved given the technical nature of the goods.

Distinctive character of earlier mark

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

41. The opponent has not claimed that the earlier mark has an enhanced distinctive character through use and has filed no evidence in this regard. I therefore have only the inherent position to consider. The earlier mark consists of the word TECNO. The opponent submits that the word TECNO is an invented word and has a normal degree of distinctive character. The applicant made no submissions on the point.

42. Although the word itself is invented, the mark is likely to be suggestive of technology. I consider that the mark has a below average (but above low) degree of inherent distinctive character.

Comparison of marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by 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.”

44. 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 them. The marks to be compared are:

Application	Earlier mark
 The logo for TECNO Mobile, featuring the word 'TECNO' in a bold, sans-serif font above the word 'Mobile' in a smaller, lowercase sans-serif font.	TECNO

Overall impression

45. The application consists of the word 'TECNO' presented in a slightly stylised font, with the word 'mobile' underneath. The opponent submits:

“The dominant and distinctive element of the contested mark is the word “tecno”, as the word “mobile” is anyway descriptive of most if not all of the goods of the contested mark (being, or being for use with mobile phones or otherwise being portable or “mobile”) and therefore devoid of distinctiveness.”

46. I agree with the opponent. The goods concerned are *batteries, electric; chargers for electric batteries; computer memory devices; video screens and mobile telephones*. The word 'mobile' means, inter alia, relating to mobile phones, handheld computers, and similar technology. It has therefore an obvious and direct meaning in relation to the relevant goods and it appears in a smaller font. Consequently, the word 'TECNO' is the dominant and distinctive element of the marks and will garner more focus in the overall impression.

47. The earlier mark consists exclusively of the word 'TECNO'. As this is the only component of the earlier mark, it is the only thing that contributes to its overall impression.

Visual and aural similarity

48. The marks differ in that the applicant's mark contains the word 'mobile'. However, the marks are similar in that the word 'TECNO' is common to both as it comprises the opponent's mark and the first word of the mark in suit. Though the applied for mark uses a slightly stylised font, it is far from remarkable. In my view, and bearing in mind the overall impression, the marks are visually and aurally similar to a reasonably high degree.

Conceptual similarity

49. As far as the conceptual similarity is concerned, the average consumer is likely to perceive the word 'TECNO' in the earlier mark as invented, albeit, allusive of technology. I consider that broadly the same applies to the earlier mark. The marks are conceptually similar to a high degree.

Likelihood of confusion

50. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

51. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

52. Earlier in my decision, I found that the goods are similar to various degree. The goods will be selected visually (although I do not discount aural considerations) with at least an average degree of attention. The marks are visually and aurally similar to a reasonably high degree and conceptually similar to a high degree. The earlier mark has a below average (but above low) degree of distinctive character. The respective marks share the word ‘TECNO’ (which comprises all of one of the marks, and the dominant element of the other). Bearing all of these factors in mind, and having regard to the relative weight of the word ‘mobile’ in the context of the applied for goods, it seems to me that the differences between the marks are not sufficient to avoid the likelihood of direct confusion where identical goods are involved. Where the similarity of the goods is less pronounced, there will still be confusion, i.e. indirect confusion, as the consumer will still assume that the goods are the responsibility of the same undertaking or undertakings with economic connections. **There is a likelihood of confusion, either direct or indirect.**

53. In reaching this conclusion, I have placed no weight on the opponent’s submission (and material filed in support of that submission) that “the way the applicant uses its TECNO brand in the UK serves to emphasise the photographic function of its products” and that this would, in turn, increase the likelihood of confusion. The information provided by the opponent is inadmissible and it should

have been filed as evidence. In any event, marketing considerations have no bearing when it comes to assessing the likelihood of confusion³.

54. For the sake of completeness, I should say that I would have reached the same conclusion, had I found that the marks were conceptually neutral. Had that been the case, I would also have found that the earlier mark, which consists of the word TECNO understood as an invented word with no concept attached, had a high degree of distinctive character.

Conclusion

55. The opposition succeeds in relation to:

Batteries, electric; Chargers for electric batteries; Computer memory devices; Video screens; Mobile telephones.

And fails in relation to:

Cabinets for loudspeakers (listed twice); hands free kits for phones; connections for electric lines; headphones; quantity indicators; inductors [electricity]; electric installations for the remote control of industrial operations; signalling panels, luminous or mechanical; wafers for integrated circuits.

56. As both parties have achieved a measure of success it is appropriate that the parties bear their own costs.

Dated this day 7th June 2018

Teresa Perks

For the Registrar

The Comptroller – General

³ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

