

O/492/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003421379 AND UK00003449381
BY GUANGDONG OPPO MOBILE TELECOMMUNICATIONS CORP., LTD
TO REGISTER THE TRADE MARKS:



IN CLASSES 14, 36, 37, 38, 42 AND 45

AND

OPPO Care

IN CLASSES 36 AND 37

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 419370 AND 419766

BY

ZURICH INSURANCE MOBILE SOLUTIONS AG

BACKGROUND AND PLEADINGS

1. On the 14 August 2019, GuangDong OPPO Mobile Telecommunications Corp., Ltd. (“the applicant”) applied to register the following trade mark in the UK:



(The First Application)

2. The First Application was published for opposition purposes on 1 November 2019. Registration is sought for the following goods and services:

Class 14 Jewellery boxes; Bracelets [jewellery, jewelry (Am.)]; Rings [jewellery, jewelry (Am.)]; Necklaces [jewellery, jewelry (Am.)]; Wristwatches; Chronometers; Watch bands; Clocks and watches, electric; key chains [split rings with trinket or decorative fob]; Sports watches.

Class 36 Insurance brokerage; Financial management; Financial consultancy; Hire-purchase financing; Financial information; Financial analysis; Online banking; Processing of credit card payments; Providing rebates at participating establishments of others through use of a membership card; Processing of debit card payments; Exchanging money; Electronic funds transfer; Capital investment; Real estate management; Providing financial information via a web site; Online real-time currency trading; Financing services; Loans [financing]; Banking; Brokerage; Surety services; Charitable fund raising; Fiduciary.

Class 37 Repair information; Installation, maintenance and repair of computer hardware; Interference suppression in electrical apparatus; Photographic apparatus repair; Telephone installation and repair; Repair or maintenance of amusement machines and apparatus; Repair of sports equipment; Machinery installation; Repair of musical instruments;

Repair of toys or dolls; Repair of game machines and apparatus; Upholstering; Maintenance and repair of consumer electric appliances; Vehicle battery charging.

Class 38 Radio broadcasting; Wireless broadcasting; Television broadcasting; Telephone services; Communications by cellular phones; Providing online forums; Wireless digital messaging services; Streaming of data; Providing access to databases; Communications by computer terminals; Computer aided transmission of messages and images; Providing telecommunications connections to a global computer network; Providing internet chatrooms; Providing on-line chat rooms for social networking; Message sending; Information about telecommunication; Video-on-demand transmission.

Class 42 Technical research; Design and development of multimedia products; Telecommunications technology consultancy; Chemical analysis; Biological research; Meteorological information; Design of telephones; Dress designing; Computer software design; Rental of computer software; Conversion of data or documents from physical to electronic media; Providing search engines for the internet; Off-site data backup; Electronic data storage; unlocking of mobile phones; data encryption services; Design and development of software in the field of mobile applications; Cloud computing; Design and development of virtual reality software.

Class 45 Monitoring of burglar and security alarms; On-line social networking services; leasing of internet domain names; Tracking of stolen property; Chaperoning; Rental of watches; Dating services; Rental of jewelry.

3. On the 5 December 2019, the applicant applied to register the following trade mark in the UK:

OPPO Care

(The Second Application)

4. The Second Application was published for opposition purposes on 13 December 2019. Registration is sought for the following services:

Class 36 Insurance brokerage; Insurance underwriting; Insurance information; Accident insurance underwriting; Insurance consultancy; Financial evaluation [insurance, banking, real estate]; Repair costs evaluation [financial appraisal]; Real estate management; Surety services; Lending against security; Trusteeship.

Class 37 Electric appliance installation and repair; Office machines and equipment installation, maintenance and repair; Machinery installation, maintenance and repair; Installation, maintenance and repair of computer hardware; Photographic apparatus repair; Clock and watch repair; Telephone installation and repair; Repair and maintenance of smartphones; Repair of tablet computers, computer peripheral devices, smartwatches, smartglasses, humanoid robots with artificial intelligence, wearable computers, cell phones, wireless earplug, camcorders, virtual reality headsets, cameras [photography], batteries, electric, Chargers for electric batteries, rechargeable batteries, joysticks for use with computers, other than for video games, Toys, apparatus for games, robot vacuum cleaner, security camera and parts thereof.

5. The First Application was partially opposed by Zurich Insurance Mobile Solutions AG (“the opponent”) on 31 January 2020. The Second Application was partially opposed on the 10 March 2020. The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following international trade mark (“the IR”):

doppo

International trade mark no. 1478039

International registration date 21 May 2019

Date of designation 21 May 2019

Date of protection granted in UK 12 December 2019

Priority date claimed 28 March 2019

Relying upon all goods and services for which the earlier mark is registered, namely:

Class 9 Computer software; application software; application software for mobiles; downloadable computer software applications; data processing programs; artificial intelligence software; embedded operating software.

Class 36 Insurance underwriting, financial affairs.

Class 42 Scientific and technological services as well as research and design services relating thereto; industrial analysis and research services; cloud computing; providing temporary use of online non-downloadable operating software for accessing cloud computing network as well as use thereof; advice related to energy saving; energy auditing; technical consultancy in connection with energy-saving measures; services provided by technological consultants in the field of energy production and use; environmental protection-related research; advisory services with respect to analysis, development, design and remote monitoring of computer systems and computer communication; hosting of platforms on the Internet; provision of temporary use of on-line applications and software tools; electronic data storage; provision of information relating to technological research; computer-aided industrial and scientific analysis of data; hosting of software applications for others; hosting of interactive applications; provision of temporary use of non-downloadable software applications accessible via a Web site.

6. The opponent claims that there is a likelihood of confusion because of the high level of visual and aural similarity combined with near identity of the goods and services. The opponent is opposing some of the services for which the applicant seeks protection in the First and Second Applications. The oppositions are directed against the following services:

First Application:

Class 36 Insurance brokerage; Financial management; Financial consultancy; Hire-purchase financing; Financial information; Financial analysis; Online banking; Processing of credit card payments; Providing rebates at participating establishments of others through use of a membership card; Processing of debit card payments; Exchanging money; Electronic funds transfer; Capital investment; Real estate management; Providing financial information via a web site; Online real-time currency trading; Financing services; Loans [financing]; Banking; Brokerage; Surety services; Charitable fund raising; Fiduciary.

Class 42 Technical research; Design and development of multimedia products; Telecommunications technology consultancy; Chemical analysis; Biological research; Meteorological information; Design of telephones; Dress designing; Computer software design; Rental of computer software; Conversion of data or documents from physical to electronic media; Providing search engines for the internet; Off-site data backup; Electronic data storage; unlocking of mobile phones; data encryption services; Design and development of software in the field of mobile applications; Cloud computing; Design and development of virtual reality software.

Second Application:

Class 36 Insurance brokerage; Insurance underwriting; Insurance information; Accident insurance underwriting; Insurance consultancy; Financial evaluation [insurance, banking, real estate]; Repair costs evaluation

[financial appraisal]; Real estate management; Surety services; Lending against security; Trusteeship.

7. The applicant filed counterstatements denying the claims made.

8. The opponent's request for the proceedings to be consolidated was granted on the 22 January 2021.

9. The opponent is represented by Withers LLP and the applicant is represented by Urquhart-Dykes & Lord LLP. Neither party filed evidence nor requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

10. Although the UK has left the EU, section 6(3)(a) of the European (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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

PRELIMINARY ISSUES

11. A suspension request had been made on the 9 February 2021 by the opponent because they submitted that their mark was registered for the wrong services by WIPO, which was consequently rectified on their register, but not ours.

12. On 19 February 2021, the Registry wrote to the opponent and stated:

“The Hearing Officer has advised that it is the tribunal's understanding that, even if the International Bureau advises the UK IPO that the earlier trade mark should have been registered for different goods and services, any such request for an extension would be treated as a new request for designation. The provisions in this regard are at Schedule 5, section 1 of the Trade Marks (International Registration) Order 2008.

Given the interplay between the date of designation and the date of application for the contested mark, it appears that the opponent will be unable to rely on any services contained in a fresh designation in the present opposition. **It is, therefore, the preliminary view of the tribunal that the request for suspension should be refused.**

[...]

However, if you disagree with the Registry's preliminary view, a provisional Case Management Conference has been booked for Wednesday 10 March 2021 at 10.30 a.m."

13. The tribunal received correspondence from the opponent on 2 March 2021 to confirm that they did not wish to proceed with the CMC.

14. I will, therefore, proceed and compare the services that are on the UK IPO's register.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) reads as follows:

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

(a)...

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

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

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

17. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s marks pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) case law

18. 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 great 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

19. The competing goods and services are as follows:

Opponent's goods and services	Applicant's services
<u>Class 9</u> Computer software; application software; application software for mobiles; downloadable computer software applications; data processing programs; artificial intelligence software; embedded operating software.	The First Application <u>Class 36</u> Insurance brokerage; Financial management; Financial consultancy; Hire-purchase financing; Financial information; Financial analysis; Online banking; Processing of credit card payments; Providing rebates at participating establishments of others through use of a membership card; Processing of debit card payments; Exchanging money; Electronic funds transfer; Capital investment; Real estate management; Providing financial
<u>Class 36</u> Insurance underwriting, financial affairs.	
<u>Class 42</u> Scientific and technological services as well as research and design services	

relating thereto; industrial analysis and research services; cloud computing; providing temporary use of online non-downloadable operating software for accessing cloud computing network as well as use thereof; advice related to energy saving; energy auditing; technical consultancy in connection with energy-saving measures; services provided by technological consultants in the field of energy production and use; environmental protection-related research; advisory services with respect to analysis, development, design and remote monitoring of computer systems and computer communication; hosting of platforms on the Internet; provision of temporary use of on-line applications and software tools; electronic data storage; provision of information relating to technological research; computer-aided industrial and scientific analysis of data; hosting of software applications for others; hosting of interactive applications; provision of temporary use of non-downloadable software applications accessible via a Web site.

information via a web site; Online real-time currency trading; Financing services; Loans [financing]; Banking; Brokerage; Surety services; Charitable fund raising; Fiduciary.

Class 42

Technical research; Design and development of multimedia products; Telecommunications technology consultancy; Chemical analysis; Biological research; Meteorological information; Design of telephones; Dress designing; Computer software design; Rental of computer software; Conversion of data or documents from physical to electronic media; Providing search engines for the internet; Off-site data backup; Electronic data storage; unlocking of mobile phones; data encryption services; Design and development of software in the field of mobile applications; Cloud computing; Design and development of virtual reality software.

The Second Application

Class 36

Insurance brokerage; Insurance underwriting; Insurance information; Accident insurance underwriting; Insurance consultancy; Financial

	evaluation [insurance, banking, real estate]; Repair costs evaluation [financial appraisal]; Real estate management; Surety services; Lending against security; Trusteeship.
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20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

21. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

22. 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.”

23. 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.”

24. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the 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.”

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“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 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 the responsibility for those goods lies with the same undertaking.”

26. 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.” 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.”

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.”

The First Application

27. In its Form TM8, the applicant admits that their services in class 36 and 42 are similar to an average degree to the broad terms for which the earlier trade mark is registered in class 36 and 42. However, as the opponent has pleaded that the services are highly similar or identical, I will still undertake a full comparison of the opponent's and applicant's services.

Class 36

28. "Financial management; financial consultancy", "hire-purchase financing", "financial information", "financial analysis", "online banking", "processing of credit card payments", "processing of debit card payments", "exchanging money", "electronic funds transfer", "capital investment", "providing financial information via a web site", "online real-time currency trading", "financing services", "loans [financing]", "banking", "brokerage", "surety services" and "fiduciary" in the applicant's specification fall within the broader category of "financial affairs" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

29. I consider that the applicant's "insurance brokerage" is highly similar to the opponent's "insurance underwriting". They are both services often provided by businesses that specialise in insurance services which will be used by the general public and businesses. Consequently, I consider the services overlap in nature, trade channels and user. However, they differ in method of use and purpose as a broker will advise and sell the insurance policy, whereas an underwriter will assess the risk of insuring that person, and therefore decides whether the company should provide the insurance coverage. They are not in competition; however, they are complementary. Taking the above into account, I consider the services to be similar to a high degree.

30. In light of the applicant's admission, I find the following terms to be similar to no more than an average degree:

Providing rebates at participating establishments of others through use of a membership card; Real estate management; Charitable fund raising.

Class 42

31. "Cloud computing" and "electronic data storage" appears identically in both the opponent's and applicant's specifications.

32. "Biological research", "chemical analysis", "meteorological information", "technical research", "design and development of multimedia products", "computer software design", "design of telephones", "design and development of software in the file of mobile applications" and "design and development of virtual reality software" in the applicant's specification fall within the broader category of "scientific and technological services as well as research and design services relating thereto" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

33. In light of the applicant's admission, I find the following terms to be similar to no more than an average degree:

Telecommunications technology consultancy; Dress designing; Rental of computer software; Conversion of data or documents from physical to electronic media; Providing search engines for the internet; Off-site data backup; Unlocking of mobile phones; Data encryption services.

The Second Application

Class 36

34. In its Form TM8, the applicant admits that all their terms in class 36, apart from real estate management, are similar to those for which the earlier trade mark is registered. However, as the applicant has not commented upon the degree to which it accepts the services are similar, I must still undertake a full comparison.

35. "Insurance underwriting" appears identically in both the opponent's and applicant's specifications.

36. “Accident insurance underwriting” in the applicant’s specification falls within the broader category of “insurance underwriting” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

37. The same comparison and findings apply to “insurance brokerage” in the applicant’s specification as set out in paragraph 29 above.

38. “Insurance information” and “insurance consultancy” in the applicant’s specification both describe a type of financial service and will, therefore fall within the broader category of “financial affairs” in the opponent’s specification. These services will be identical under the principle outlined in *Meric*. Even if I am wrong in this finding, the services will overlap in trade channels, users, method of use, nature, and purpose. I consider that they will be highly similar.

39. “Financial evaluation [insurance, banking, real estate]”, “repair costs evaluation [financial appraisal]”, “surety services”, “lending against security” and “trusteeship” in the applicant’s specification fall within the broader category of “financial affairs” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

40. The applicant submits that “real estate management” in their specification is dissimilar to the services for which the earlier mark is registered. I note that this is contradictory to the applicant’s position in relation to the First Application. I certainly do not consider that the similarity between these services is any higher than “average” as pleaded by the applicant in relation to the First Application. Consequently, as nothing turns on this finding, I will proceed on that basis.

The average consumer and the nature of the purchasing act

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

42. The average consumer of the class 36 services will include both members of the general public and specialists of the financial sector. The terms covered by the parties’ specifications are broad and would include a range of financial and technological services from insurance underwriting to online banking or processing of credit card payments. The latter two examples are likely to attract a low cost or be free of charge. They are, therefore, likely to attract a lower level of attention than the former example (i.e. insurance underwriting). However, even for those low cost/free of charge services, various factors will still be taken into account such as consumer service standards, interest rates and security. I consider that the risks such as financial fraud and serious financial consequences of mistakes being made even for the low cost/free of charge services, will result in a high degree of attention being paid. For services that attract a higher cost and/or are used less frequently and/or are used by professional users, I consider a high degree of attention will be paid.

43. The average consumer of the class 42 services will be businesses and professionals; however, I do not discount that it could also include members of the general public. The cost of the services in question is likely to vary. The majority of the services will be purchased relatively infrequently. The average consumer will take various factors into consideration such as the cost, type of services offered and the suitability of those services to the consumer’s needs. I also note that these are technical in nature. Therefore, the level of attention paid during the purchasing process will be higher than medium.

44. All the services are likely to be selected from specialist retailers, websites, advertisements, and signs on a physical outlet. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or through word-of-mouth recommendations.

Comparison of the trade marks

45. 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 the trade 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.”

46. 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.

47. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
	 (the First Application)  (the Second Application)

Overall Impression

48. The opponent's mark consists of the word 'doppo' presented in a thick font. I consider the word doppo to play a greater role in the overall impression of the mark, with the font playing a lesser role.

49. The First Application consists of the word 'oppo' in an oval-shaped font. I consider the word oppo to play a greater role in the overall impression of the mark, with the font playing a lesser role.

50. The Second Application consists of the words OPPO Care. I consider that the overall impression lies in the combination of both of these words.

Visual Comparison

The Opponent's Mark and the First Application

51. Visually, as submitted by the opponent, the marks coincide in the fact that the First Application, 'oppo', is entirely replicated in the opponent's mark. However, the marks are in different fonts and the opponent's mark begins with the letter 'd'. Given the importance of the first letter in a trade mark, together with the fact that the competing trade marks are both relatively short, I consider the marks to be visually similar to a fairly low degree.

The Opponent's Mark and the Second Application

52. Visually, the same comparison applies as set out above, however, the Second Application contains the additional word 'Care'. It is not in a stylised font, however, as it is a word only mark, it could be used in any typeface. I consider the marks are visually similar to a low degree.

Aural Comparison

The Opponent's Mark and the First Application

53. The opponent's mark will be pronounced as DOP-POH, and the First Application will be pronounced as OP-POH. The differing first letters, D and O, create an aural differentiation between the two. As the marks share the same four letters in the same order; O, P, P and O, there is inevitably some similarity. However, given the different pronunciations of the start of each mark I consider any aural similarity to be fairly low.

The Opponent's Mark and the Second Application

54. The same comparison applies as set out above. However, the Second Application includes the word 'Care' which has no counterpart in the applicant's mark and, therefore, creates another point of aural difference. Taking the above into account, I consider the marks to be aurally similar to a low degree.

Conceptual Comparison

The Opponent's Mark and the First Application

55. In my view, both marks will be viewed as invented words which would be attributed no particular meaning. I consider the marks to be conceptually neutral.

The Opponent's Mark and the Second Application

56. The Second Application also includes the word 'Care' which is an ordinary dictionary word which will be given its ordinary meaning. The opponent submits that care is wholly descriptive and laudatory which results in it being non-distinctive for the applicant's services. I do not consider that the word care is descriptive of the services, however, even if I am wrong in this finding, I still consider that the addition of the word 'care' acts as a conceptual point of difference between the marks.

Distinctive character of the earlier trade mark

57. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

58. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

59. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

60. The word doppio is an invented word which is neither allusive nor descriptive in relation to the goods and services for which the mark is registered. Therefore, I consider the opponent's mark to be inherently distinctive to a high degree.

Likelihood of confusion

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

62. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the opponent's mark and the First Application to be visually and aurally similar to a fairly low degree.
- I have found the opponent's mark and the Second Application to be visually and aurally similar to a low degree.
- I have found the words DOPPO/OPPO in the respective marks to be conceptually neutral, with the addition of the word CARE in the Second Application acting as a point of conceptual difference.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the class 36 services to be members of the general public and specialists in the financial sector, who will select the services primarily by visual means, although I do not discount an aural component.
- I have identified the average consumer for the class 42 services to be members of the general public, businesses, and professionals, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a high degree of attention will be paid during the purchasing process for the class 36 services.
- I have concluded that a higher than medium degree of attention will be paid during the purchasing process for the class 42 services.
- I have found the parties' services to vary from being similar to a medium degree, to identical.

63. I recognise that the word 'doppo' is highly distinctive which is a factor in favour of the opponent. The fact that some of the competing services are similar to at least a medium degree (and in some cases are identical) is also a factor in favour of the opponent.

64. However, for the reasons as set out above, I consider that the average consumer will pay at least a higher than medium degree of attention during the purchasing process. In many cases, the level of attention paid will be high. Consequently, the average consumer is less prone to the effects of imperfect recollection. In the First Application, I also bear in mind that, where the length of the parties' marks are short,

the differences are more likely to be noticed.¹ Therefore, the different beginning letters, D and O, will be noticed by the average consumer. In the Second Application, I do not consider that the word 'Care' will go unnoticed by the average consumer. Therefore, taking all of the factors above into account, I am satisfied that there is no likelihood of direct confusion.

65. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by 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.”

66. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant's trade marks were connected with the opponent, simply because the opponent's trade mark also contains 'oppo' within their 'doppo' trade mark. They are not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

¹ Case T-274/09 *Deutsche Bahn v OHIM* EU:T:2011:451, [78] (ICE/IC4)

CONCLUSION

67. The opposition is unsuccessful, and the First and Second Applications may proceed to registration.

COSTS

68. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filing written submissions	£350
Total	£550

69. I therefore order Zurich Insurance Mobile Solutions AG to pay Guangdong OPPO Mobile Telecommunications Corp., Ltd. the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of June 2021

L FAYTER

For the Registrar