

**O/602/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3233412 BY DONGXIA DATONG (BEIJING)  
MANAGEMENT AND CONSULTING CO. LTD TO REGISTER AS A TRADE MARK**

The image shows the trade mark 'ofo' in a bold, lowercase, sans-serif font. The letters are dark grey or black. The 'o' is a simple circle, the 'f' is a vertical stem with a horizontal top bar, and the second 'o' is a simple circle. The letters are spaced out and centered on the page.

**FOR GOODS AND SERVICES IN CLASSES 12, 35, 38, 39 AND 42**

**AND**

**THE OPPOSITION THERETO (NO. 410672) BY NOKIA TECHNOLOGIES OY**

## BACKGROUND AND PLEADINGS

1. On 25 May 2017 Dongxia Datong (Beijing) Management and Consulting Co. Ltd (“the Applicant”) applied to register as a UK trade mark (under Application No. 3233412) the figurative mark shown on the front page of this decision, for goods in Class 12 and for services in Classes 35, 38, 39 and 42, as set out in the table at the **annex** at the end of this decision. The application was published for opposition purposes on 18 August 2017.
2. Nokia Technologies Oy (“the Opponent”) filed an opposition directed at part of the application, namely, in relation to all of the services applied for in **Class 38**:

*Communications by telephone; Message sending; Providing access to databases; Providing user access to global computer networks; Providing online forums; Streaming of data; Communications by computer terminals; Providing internet chatrooms; Transmission of electronic mail; Electronic bulletin board services [telecommunications services]; Satellite transmission; Paging services [radio, telephone or other means of electronic communication]*

And in relation to some of the services applied for in **Class 42, namely**:

*Technical research; Creating and maintaining web sites for others; Software as a service [SaaS]; Computer software design; Maintenance of computer software; Providing search engines for the internet; Industrial design; Conversion of data or documents from physical to electronic media; Conversion of computer programs and data, other than physical conversion; Computer programming; Consultancy in the design and development of computer hardware*

3. The grounds of opposition were based originally on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), but the Opponent subsequently withdrew its sections 5(3) and 5(4)(a) grounds. Consequently, the opposition proceeds based only on the grounds set out **section 5(2)(b) of the Act**, the Opponent relying on its ownership of the European Union Trade Mark (EUTM) registration **14414106** for the word mark “OZO”, filed on 27 July 2015 and registered on 13 July 2016. The Opponent relies on all goods and services registered under its mark, which are as follows:

**The Opponent's goods and services under EUTM 14414106**

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

**Class 41:** *Audio, video and images editing and production services.*

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

4. The Opponent claims that the parties' marks are similar since they comprise of 3 letters and differ only in the middle letter. It claims that the Applicant's contested services are identical and/or similar to goods and services for which the Opponent's mark is registered and that consequently there exists the likelihood of confusion on the part of the relevant public, which includes a likelihood of association.

5. The Applicant filed a notice of defence and counterstatement, denying that registration of its mark would conflict with section 5(2)(b). I note the following points:
- It **denies** in particular that the relevant public will think its services emanate from the Opponent or from an undertaking economically linked with the Opponent.
  - It **denies** that any of its applied-for services in **Class 38** are either are identical or similar to any of the goods and/or services covered by the Opponent's mark.
  - It also **denies** any identity or similarity in respect of certain of its applied-for services in **Class 42**, namely "*Creating and maintaining web sites for others;*" and "*Providing search engines for the internet;*
  - It **admits** that certain of its applied-for services in **Class 42**, namely: "*Technical research; Software as a service [SaaS]; Computer software design*" are **identical** to the Opponent's services in the same class.
  - In relation to certain other of its applied-for services in **Class 42** - namely: "*Maintenance of computer software; Industrial design; Conversion of data or documents from physical to electronic media; Conversion of computer programs and data, other than physical conversion; Computer programming; Consultancy in the design and development of computer hardware*" - it **admits** that there is "**some similarity**" with some of the goods / services on which the Opponent relies.
  - It claims that the letter "Z" in the Opponent's mark, instead of a letter "F", creates a very different overall impression between the two marks, with there being distinct visual, aural and conceptual differences enabling the consumer to distinguish between the marks. It claims that the level of similarity is insufficient to create a likelihood of confusion – even where the services applied-for are held to be identical or similar to the goods/services covered by the Opponent's mark.
  - Explaining its own mark, it states that "the Applicant selected the mark OFO" as a mark for bicycle-related goods and services, as the overall appearance of the mark "ofO" resembles a bicycle (i.e. the letters "o" on each side of the mark resemble bicycle wheels, and the letter "f" resembles the bicycle frame). Also the letter "f" with the arc at the top and the short line in the middle resembles the body outline of a cyclist. These specific

design features create a unique overall impression that is more than just a simple combination of three letters. The mark indicates the Applicant's core business of bicycle rental, with visual prompts."

- It claims that the nature and expense of the goods / services at issue will lead the average consumer to pay an above average degree of attention and that their visual means of selection will be most important.

### **Papers filed and representation**

6. Both the Opponent and the Applicant filed submissions during the evidence rounds; the Applicant also filed a "fall-back position" in the form of limited specifications to be considered only in the event that the decision in these proceedings should find to any extent in favour of the Opponent. Neither side filed evidence. Osborne Clarke LLP acts for Nokia in these proceedings; the Applicant is represented by Ashfords LLP. Neither party requested an oral hearing and I take this decision based on a careful reading of the papers filed.

### **My approach in this decision**

7. This partial opposition is directed against only a selection of the services applied for, including specified services in Class 42, which the Applicant admits in its counterstatement to be identical to services of the Opponent in the same class. In these circumstances I find it procedurally efficient to make my decision based initially only on assessing the likelihood of confusion in relation to those Class 42 services, since if they are identical and if I find no likelihood of confusion, there can be little benefit in considering the other goods and services.

### **DECISION**

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

*"... 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.”*

9. The mark on which the Opponent relies is an earlier trade mark<sup>1</sup> for these purposes and is not subject to proof of use<sup>2</sup>, so the Opponent is able to rely for these proceedings on all its claimed goods and services without having to show that it has used it mark.
10. I bear in mind the relevant principles from decisions<sup>3</sup> of the EU courts and will refer to those principles as appropriate.

### **Comparison of the goods and services**

11. Among the Applicant’s services in Class 42 are “*Technical research; Software as a service [SaaS]; Computer software design*” which are contested by the Opponent and which the Applicant admits are identical to services in Class 42 on which the Opponent relies. I note in particular the Opponent’s services included in my table below:

<b>Applicant’s services in Class 42, admitted to be identical</b>	<b>Services of the Opponent in Class 42</b>
<i>Technical research</i>	<p><i>technological</i> analysis, <i>research</i>, development, support, technical troubleshooting and consultancy services in the field of audio, imaging, video, digital media, multimedia, virtual reality and presence capture technologies;</p> <p>Audio, video, imaging, digital media, multimedia and virtual reality technology services and <i>research</i> and design relating thereto;</p>

<sup>1</sup> See section 6(1) of the Act.

<sup>2</sup> See section 6A of the Act.

<sup>3</sup> *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; *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P.

<i>Software as a service [SaaS]</i>	<i>software as a service [SaaS] exclusively for use in relation to audio, imaging, video, digital media, multimedia, virtual reality and presence capture software and hardware;</i>
<i>Computer software design</i>	<i>design, engineering and development of audio, imaging, video, digital media, multimedia and virtual reality hardware and software</i>

12. It is clear from the above table that the Opponent has protection in Class 42 for services in terms that are either literally identical or else equivalent to the Applicant's relevant services in that class. It is also clear from case law such as *Meric*<sup>4</sup> that goods or services can be considered as identical when the goods or services designated by the earlier mark are included in a more general category designated by the trade mark application or vice versa. Taking account of the principle expressed in *Meric* **I find that the parties' services in Class 42 listed in the table in the above paragraph are identical.**

#### **The average consumer and the purchasing process**

13. It is necessary to determine who is the average consumer for the respective goods / services and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question<sup>5</sup>. In *Hearst Holdings Inc*,<sup>6</sup> 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 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 word "average" denotes that the person is typical... ."*

<sup>4</sup> See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05. The judgment in *Meric* related to goods, but its principle at paragraph 29 is equally applicable in respect of services.

<sup>5</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

<sup>6</sup> *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)

14. I have found identity between respective services of the parties in Class 42. Those services in Class 42 essentially involve the provision of software (as a service) and research and design services relating to software. (I remind myself, however, that the parties have a wider range of goods / services at issue than those services that the Applicant admits to be identical.) The Applicant submits that that the average consumer “will include both experts (with specialist knowledge) and ordinary members of the public, with no specialist knowledge.” The Opponent makes no submission on who is the average consumer, but challenges the Applicant’s submission that the nature and expense of the goods/services in issue mean that the average consumer will pay an above average degree of attention. (The implication of a greater degree of care paid by the average consumer in the purchasing processing is that it tends to reduce the likelihood of confusion, favouring the Applicant.) The Opponent submits that the price of the goods/services at issue varies and it cannot be said that they are exclusively expensive and that overall, the level of attention will be normal.
15. Considering the particular services for which I have found identity, software design and research services strike me as somewhat specialist services, for whom the average consumer will be businesses, and which would be relatively costly and would elicit an above average degree of attention in selection of provider. The term “software as a service [SaaS]” is not explained in the submissions, but as I understand it<sup>7</sup>, it is a category of cloud computing that removes the need for the user to install and run applications on their own computers. Such a service will be of particular interest to businesses, but since SaaS could presumably include provision such as online email services, the average consumer could include members of the public. I therefore find that the average consumer will include both business customers and the public at large, although I find that even members of the public may still pay an above ordinary level of attention when selecting such services. However, when I deal with likelihood of confusion below, I will consider an assessment based on the wider range of goods / services and on the possibility that the level of attention would be no more than normal.
16. The average consumer will see the marks used in advertising and branding, where a consumer will search the internet to select the services or see promotional materials etc. Therefore, I consider the purchase to be a primarily visual one, but aural considerations may

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<sup>7</sup> See, for example, explanation of SaaS given at <https://azure.microsoft.com/en-gb/overview/what-is-saas/>

also play a part, such as on the basis of word of mouth recommendations, so I also take into account the aural impact of the marks in the assessment.

### Comparison of the marks

17. It is clear from *Sabel*<sup>8</sup> 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 the marks, bearing in mind their distinctive and dominant components. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<b>The Opponent's earlier trade mark:</b>	OZO
<b>The Applicant's contested trade mark:</b>	ofo

18. The overall impression of the Opponent's mark is that it is simply the word "ozo", which appears to be an invented word, without a meaning in the English language.
19. The overall impression of the Applicant's mark is that it is the word "ofo", which again appears to be an invented word, without a meaning in the English language. One is also struck by a degree of stylisation. I note the submissions as to a loose evocation of a bicycle, but I find that that will not be immediately striking to the average consumer, especially in the context of the contested services. The word is dominant in the overall impression, but the stylistic embellishments are not negligible.

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<sup>8</sup> *Sabel BV v Puma AG*, Case C-251/95

### *Visual similarity*

20. Both marks involve only three letters and start and end with the letter “O”. They differ in their middle letters. The Opponent’s earlier trade mark happens to be shown in upper case, whereas the stylised letters of Applicant’s mark appear to be in lower case; however, that visual difference created by the Opponent’s mark being presented in upper case may be disregarded for the purposes of assessing visual similarity, since it is well established that fair and notional use of a word mark would allow the mark to be presented in lower case<sup>9</sup>.
21. The Opponent submits that “the ‘double Os’ in a short 3-letter word are striking and this gives the signs a significant degree of visual similarity.” The Opponent also submits that the difference of one letter is “not material”, whereas the Applicant submits that “being such short words, the average consumer would easily be able to perceive the visual differences between the marks. The letter ‘f’ is quite clearly visually different from the letter ‘Z’.”
22. I find that there is a clear visual overlap in that two of the three letters of the marks are the same and in the same positions. However, I find the difference in the middle letter in the marks is plain to see. They are different letters and the letter “f” extends above the letters “o” either side of it. No ordinary and fair notional use of the letter “Z” in the Opponent’s mark would stand it proud of its neighbouring Os, since that would impact on the distinctive character of the mark<sup>10</sup>.
23. I also note other differences between the Applicant’s stylised mark and the earlier word mark arising from the stylisation of the text in the Applicant’s mark. The stylisation is quite subtle, but I find that it contributes to the distinctive character and overall impression of the mark, giving rise to a further visual difference. Overall, I find the marks to be **visually similar to a degree that is, at most, between low and medium.**

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<sup>9</sup> See the ruling of Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14 (at paragraph 21).

<sup>10</sup> See the ruling of the CJEU in *Sadas SA, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-346/04 4 November 2005 at paragraph 47.

*Aural similarity*

24. The Opponent submits that “each sign will be pronounced as two syllables” – presumably OH-FOH (or possibly OV-O) and OH-ZOH (or possibly OZ-OH) – and submits that aurally they “are highly similar” because their pronunciation “coincides in the sound of the two Os, one at the beginning and one at the end” and “while the middle letters are not the same, they are similar because they are both softly pronounced within each sign and would be overwhelmed by the beginnings and ends of the signs and play no significant part in the pronunciation of the signs.”
25. The Applicant submits that from an aural perspective the second letters of the marks in this case “*play a significant role in the pronunciation of the marks/signs as a whole. Quite clearly, the letter 'f' sounds completely different to the letter 'Z' when spoken, creating a perceptible difference in the pronunciation of the second syllable of each mark/sign (and thus the pronunciation of each mark/sign overall).*”
26. I disagree with Opponent’s submission that the middle letters play no significant part in the pronunciation of the signs. I find that the marks will be pronounced differently and the average consumer will be able to distinguish OH-FOH (or OV-O) from OH-ZOH (or OZ-OH). The marks are aurally similar to **a degree that is, at most, between low and medium.**

*Conceptual similarity*

27. The Opponent submits that each sign is an invented word in English “and therefore a conceptual comparison cannot be made.” The Applicant’s submissions agree that the marks/signs in question are comprised of invented words, adding further that the words are meaningless in English, and “thus there is no conceptual similarity between the marks/signs”. The Applicant makes no direct submission as to the potential conceptual difference arising from its claim of a figurative evocation of a bicycle (explained in its counterstatement) and I anyway find that that figurative evocation is subtle is likely to go unnoticed by the average consumer (especially in relation to the contested services). In the circumstances, I find that there is **no conceptual similarity between the marks, but that that finding is neutral** in its effect.

## **Distinctive character of earlier trade mark**

28. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*<sup>11</sup> the Court of Justice of the European Union 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 .....*

*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).”*

29. The Opponent's trade mark is an invented word, with no descriptive or allusive message. It is **inherently distinctive to a good degree**. The level of inherent distinctiveness of a trade mark may be enhanced through use in the UK, but since no evidence was filed in these proceedings, I only have inherent distinctive character to consider.

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<sup>11</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

## Conclusion as to likelihood of confusion

30. I now turn to consider the likelihood of confusion between the parties' marks if they were used in relation to the respective services. I make a global assessment of the likelihood of confusion, taking account of all relevant factors.
31. I take due account of some interdependence<sup>12</sup> between the relevant factors, including that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the good/services. I have found that at least some of the contested services in Class 42 are identical to services on which the Opponent relies. I have also found that the Opponent's earlier mark is inherently distinctive to a good degree. Such considerations favour the Opponent. However, I have found that the purchasing process will involve primarily visual considerations of the marks, which I have assessed to be visually similar to a degree that is, at most, between low and medium. I have also found the marks to be aurally similar again only to a degree that is, at most, between low and medium. In comparing the marks from a conceptual perspective, my findings are neutral.
32. Despite the level of similarity that arises from the shared letters, I dismiss the Opponent's submission that the difference of one letter is not material - the difference in middle letter is striking in the overall impression of the Applicant's mark, especially as the letter "f" in the figurative mark protrudes clearly above the letters o. The parties' marks look and sound different from one another. Whilst the average consumer may hold in mind an imperfect picture of the marks, s/he is deemed reasonably well informed and reasonably circumspect and observant, I find that the average consumer will readily distinguish between the marks and will not directly mistake one mark for the other, especially if paying an above ordinary level of attention when selecting such services. No likelihood of confusion arises and there will be no association between the marks and no risk that the public might believe that the respective goods come from the same or economically-linked undertakings.
33. **Therefore, the opposition fails**, based largely on my analysis of the marks. My assessment of likelihood of confusion was founded on identical services in Class 42 and on a level of attention that may be above ordinary. However, I would reach the same finding even if the level of attention paid by the average consumer were no more than normal or

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<sup>12</sup> See paragraph 17 of the judgment in Canon Case C-39/97.

ordinary. In the circumstances, the Opponent could therefore have no greater prospect of success were I to compare the Applicant's contested services in Class 38.

### **Costs**

34. The Applicant has successfully defended the opposition and is entitled to a contribution towards its costs. My assessment of a contribution towards the cost of the proceedings is based on the guidance in Tribunal Practice Notice 2/2016 and I award the sum of £500, calculated as follows:

Considering the statement of grounds and preparing a counterstatement:	£200
Considering the other side's submissions and preparing own submissions	£300
<b>Total:</b>	<b>£500</b>

35. I therefore order Nokia Technologies Oy to pay Dongxia Datong (Beijing) Management and Consulting Co. Ltd the sum of £500 (five hundred pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25<sup>th</sup> day of September 2018**

Matthew Williams  
**For the Registrar**

## Annex

<b>The goods and services under Application No. 3233412 (only partially opposed)</b>	
<b>Class</b>	
12	Bicycles; Direction indicators for bicycles; Electric bicycles; Motor cars; Pushchairs; Bicycle tyres; Vehicle seats; Electric vehicles; Pumps for bicycle tyres; Non-skid devices for vehicle tyres.
35	Rental of advertising space; On-line advertising on a computer network; Pay per click advertising; Providing business information via a web site; Provision of commercial and business contact information; Provision of an on-line marketplace for buyers and sellers of goods and services; Sales promotion for others; Updating and maintenance of data in computer databases; Sponsorship search; Personnel management consultancy; Advertising; Publicity.
38	Communications by telephone; Message sending; Providing access to databases; Providing user access to global computer networks; Providing online forums; Streaming of data; Communications by computer terminals; Providing internet chatrooms; Transmission of electronic mail; Electronic bulletin board services [telecommunications services]; Satellite transmission; Paging services [radio, telephone or other means of electronic communication].
39	Car sharing services; Bicycle rental; Vehicle rental; Passenger transport; Taxi transport; Piloting; Car parking; Rental of warehouses; Courier services [messages or merchandise]; Providing driving directions for travel purposes.
42	Technical research; Creating and maintaining web sites for others; Software as a service [SaaS]; Computer software design; Maintenance of computer software; Providing search engines for the internet; Vehicle roadworthiness testing; Industrial design; Conversion of data or documents from physical to electronic media; Conversion of computer programs and data, other than physical conversion; Computer programming; Consultancy in the design and development of computer hardware.