

**BL O/645/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3383455**

**BY**

**JINGYI HUANG**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 09:**

**SOUNDCUBE**

**AND**

**OPPOSITION THERETO (NO. 417488)**

**BY**

**GROUPE CANAL+**

## **Background and pleadings**

1. Jingyi Huang (hereafter “the applicant”) applied to register the trade mark:

### **SOUNDCUBE**

in the UK on 14 March 2019. It was accepted and published in the Trade Marks Journal on 31 May 2019, in respect of a wide range of goods in class 09.

2. During the procedural rounds of this opposition case, the applicant reduced the scope of its specification of goods. The opponent however, confirmed that despite the specification limitation by the applicant, the opposition proceedings were not withdrawn.
3. The application now stands only in respect of the following goods:

**Class 09:** Walkie-talkies; chargers; batteries; antennas; earpieces; programming cables.

4. GROUPE CANAL+ (hereafter “the opponent”) opposes all of the goods in the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act).
5. The opposition is based on earlier European Union Trade Mark (EUTM) 8699291.
6. The EUTM was filed on 19 November 2009 and registered on 27 May 2010 for a range of goods and services in classes 09, 35, 38, 41 and 42, however the opponent relies only on goods in class 09, namely:

**Class 09:** Decoders; Remote controls; antennas satellite dishes.

7. The EUTM is registered for the following mark:



8. 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) a European Union trade mark or international trade mark (EC) which has a date of application 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.”

9. The trade mark upon which the opponent relies for the purposes of this opposition qualifies as an earlier trade mark under the above provisions. As the earlier trade mark had been registered for more than five years at the date the application was filed, it is subject to the proof of use provisions contained in section 6A of the Act.

10. The opponent claims that when considering the overall impression of the marks, it is clear that the contested ‘SOUNDCUBE’ mark is closely similar visually, aurally and conceptually to the earlier mark. It adds that the word ‘CUBE’ is contained in both marks and is the distinctive element of the contested mark as the word ‘SOUND’ lacks distinctive character. The opponent also states that the element ‘LE’ in the earlier mark means ‘the’ in French and is also non-distinctive, and adds that the ‘+’ device element in its earlier mark has some distinctive character however the lack of a device element in the contested mark means that the consumer’s attention will be drawn to the verbal elements. That being the case, the opponent claims that the element ‘SOUNDCUBE’ could be seen as a variation or sub-brand of its earlier ‘LE CUBE’ brand, given the proximity of the goods.

11. The opponent also states that the goods at issue are all in class 09 and are either identical or similar. It states that they will likely have the same trade channels, be sold and marketed in the same manner and have the same users. The opponent claims therefore, that there exists a real likelihood of confusion including a likelihood

of association on the part of the public, taking into account the principles of imperfect recollection and the fact that the minor differences between the marks are likely to go unnoticed by the relevant consumer.

12. In its counterstatement, the applicant denies that the marks are similar or that confusion would arise. It states that the earlier mark will be widely understood to mean 'THE CUBE', which it says is a literal translation of the French language. It also claims that due to the colours claimed in the earlier mark, the word 'CUBE' will not be the dominant or distinctive part of the earlier mark, as claimed by the opponent, but rather, it will be the black square and white '+' symbol that will attract the consumer's attention most. As the contested mark contains no figurative element and comprises a single word element, the applicant claims that the dominant and distinctive aspect of its mark lies in the totality of the word 'SOUNDCUBE' and not in the 'CUBE' element, as has been claimed by the opponent.

13. The applicant also claims that there is a very small degree of aural and visual similarity between the marks in so far as they both contain the word 'CUBE', however, it states that this element is 'rather diluted' in relation to electronic consumer goods of the kind claimed under both marks. In this respect, the applicant states that there are more than 600 marks registered in the UK in class 09 which contain the word 'CUBE'. The applicant also states that it is usual practice to consider that the beginning of a mark is likely to be remembered more clearly than the rest of the mark. In this regard the applicant notes that the earlier mark begins with the figurative '+' element, followed by the word 'LE' and states that neither of these elements are present in its mark.

14. The applicant claims that the goods at issue should not be considered identical or highly similar and states that similarity should not be adduced simply because the goods at issue all appear in the same class under the Nice Classification.

15. The applicant also puts the opponent to proof of use of the earlier mark relied upon for the purposes of the opposition.

16. The opponent provided evidence by way of a Witness Statement of Clement Hellich Praquin accompanied by 19 exhibits.

17. In his witness statement Mr Praquin states that he is the Corporate General Counsel for Canal+, a position he has held since 2016. He adds that the opponent is a leader in the European Union in the provision of premium content and themed networks, including television stations and film and television services. Mr Praquin states that the opponent's 'LE CUBE' offering was launched in November 2008 and permits consumers of film and television stations to access such services via a set-top box, which works as a decoder alongside a remote control and satellite dish.

18. Key information established by the exhibits provided under Mr Praquin's witness statement includes:

- Use of the earlier mark in France and Poland, as well as other French speaking territories.
- In France almost 25% of all households are a subscriber of the opponent.
- 6.1 Million individual subscribers in France as at 31 December 2014, with 3.454 billion euros in turnover.
- Some of the evidence is presented in English, however, it appears that the mark has not been used, to any great extent at least, in the UK.

19. For the sake of procedural economy, I will not conduct a detailed assessment of the opponent's evidence of use at this stage. I will make an assumption based on the brief comments above, that the earlier mark has been put to genuine use during the relevant period of time but will return to this issue later in my decision if I find it necessary.

20. No hearing was requested but the opponent filed written submissions in lieu which I will not summarise here but will refer to where necessary throughout this decision, which is taken following a careful perusal of the papers.

21. Throughout the proceedings the applicant has been represented by Sanderana. The opponent has been represented by D Young & Co LLP.

## DECISION

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

“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.”

23. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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**

24. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

25. 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.

26. The goods to be compared are the following:

Earlier EUTM	Contested application
<b>Class 09:</b> Decoders; Remote controls; antennas satellite dishes.	<b>Class 09:</b> Walkie-talkies; chargers; batteries; antennas; earpieces; programming cables.

27. The opponent's 'decoders' are electronic devices used to breakdown and analyse a signal of some kind, converting it into information. In the context of the opponent's field of interest, these goods will be integral in the provision of television programming services, as a tool used to receive signals via e.g. satellite dishes, converting that signal into visual content. The earlier 'remote controls' are goods that can be used by the consumer to operate electronic equipment such as a television decoder or satellite television box remotely rather than engaging directly with that piece of equipment. The earlier 'antennas satellite dishes' is somewhat ambiguous and may be considered to be the antenna used in combination with a satellite dish, in order to receive a satellite signal into a residence or other structure, thereby providing visual information in the form of e.g. television entertainment programmes.
28. The applicant's 'Walkie-talkies' are portable radio communications devices that allow the user to communicate with another holder of a walkie-talkie which is set to the same frequency and is in a relatively close proximity. None of the earlier goods of the opponent can be said to be similar to these goods. They do not share use, nature or channels of trade. Neither can they be said to be complementary or in competition with each other. These goods are dissimilar.
29. The applicant's 'chargers' are devices used to charge the batteries of electronic apparatus such as a mobile telephone or an MP3 music player. They may also be used to charge rechargeable batteries. The opponent's 'decoders' and 'remote-controls' may require batteries in order to function or may themselves be chargeable, if they have a built-in battery, however this, in and of itself, does not suffice to ensure that these goods are similar to any degree. These goods do not share use, nature or purpose, or channels of trade and they cannot be said to be in competition. Whilst they may be used together in certain circumstances, this is not sufficient to find a level of complementarity, in the sense that one is important or indispensable in the use of the other. The earlier 'antennas satellite dishes' can be said to be even further removed from the applicant's 'chargers'. These goods are dissimilar.
30. The applicant's 'batteries' are a source of energy often required by certain electronic equipment or apparatus in order to function. The earlier 'decoders' and 'remote controls' are goods that may require a battery to function, although it is quite likely that a decoder will be hard wired. The earlier 'antennas satellite dishes' are unlikely

to require a battery and will more likely be wired directly to a mains energy source. It cannot be said that a piece of equipment that requires a battery in order to function is automatically similar to a battery. In this instance, I find that the nature, purpose, end-use and channels of trade are different. Whilst the users of a remote control or a decoder may also be users of batteries, this does not suffice to find a level of similarity between those goods. It cannot be said, either, that these goods are in competition or are complementary.

31. Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13 that:

“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.”

32. The consumer of a remote control or decoder may appreciate that a battery is required in order for those goods to function, however it is unlikely that the same consumer would expect the producer of such goods to also produce batteries. These goods are dissimilar.

33. The applicant’s ‘antennas’ are goods that are used to intercept and receive radio, television and satellite signals. These goods may share nature, use, end-user and channels of trade with the earlier ‘antennas satellite dishes’. These goods are identical.

34. The applicant’s ‘earpieces’ are goods that are inserted into or placed over the user’s ears and which transmit or reproduce sound in a similar fashion to headphones, but in a more discreet manner. These goods do not share use, nature or channels of trade with any of the opponent’s earlier goods. Neither can they be said to be complementary to, or in competition with, the earlier goods. These goods are dissimilar.

35. The applicant’s ‘programming cables’ are cables that act as a conduit between items of electronic equipment such as a satellite dish, decoder or television for example. These goods allow two or more pieces of electronic apparatus to engage with each other. These goods may be integral in the effectiveness of e.g. a decoder box

working in tandem with a television set. Whilst these goods may not share nature or purpose, they may share channels of trade, being potentially an ancillary product required for the use of decoders or antennas satellite dishes. They can also be said to be complementary, in the sense that a decoder for example, may not function as intended without the appropriate cable required to link that product to e.g. a television set. Therefore, I find that the applicant's 'programming cables' are similar to a low degree to the earlier 'decoders' and 'antennas satellite dishes'.

36. In conclusion, I have found the applicant's 'Walkie-talkies; chargers; batteries; earpieces' to be dissimilar goods. The applicant's 'programming cables' are similar to a low degree. The applicant's 'antennas' are identical goods.

### **Average consumer and the purchasing act**

37. For the purpose of assessing the likelihood of confusion, 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: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

38. 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 average consumer of the goods at issue will predominantly be the general public but could also be a professional consumer e.g. an undertaking or individual trading in the installation of satellite dishes and antennas as well as associated hardware and peripherals such as decoders and programming cables.

40. The selection of such goods will largely be a visual process in traditional retail outlets or from websites online, however I do not ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone.
41. The average consumer will pay a medium degree of attention during the purchase of goods such as walkie-talkies, batteries and remote controls. The professional consumer is likely to pay a slightly higher degree of attention and awareness in the selection of goods such as antennas and programming cables, however this will not be the very highest level of attention.

### **Comparison of marks**

42. 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 the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

43. 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.
44. The respective trade marks are shown below:

Earlier EUTM	Contested mark
	<p data-bbox="1027 412 1305 454" style="text-align: center;"><b>SOUNDCUBE</b></p>

45. The applicant's mark comprises solely the word 'SOUNDCUBE' in a standard typeface. The average consumer will recognise that the mark is made up of two words, namely 'SOUND' and 'CUBE' presented together as a single entity. Neither word can be said to be more dominant or eye-catching than the other and, as they are presented as a single unit, the overall impression of the applicant's mark lies in its totality.

46. The earlier mark comprises a figurative element of a white '+' symbol placed on a black square background, with the words 'LE CUBE' presented directly to the right of it, in fairly standard capital grey typeface. The figurative element is slightly larger in size than the word elements and is presented at the left hand side of the mark which may suggest that it will be perceived first, as the average consumer tends to read or interpret signs such as this, on a left to right basis. The words 'LE CUBE' are however, of a significant size within the mark. Neither element can be said to be the more dominant or distinctive element and they can be said to play a roughly equal role in the earlier mark. Consequently, the overall impression of the earlier mark lies in its totality.

**Visual similarity**

47. Visually, the respective marks are similar inasmuch as they share the word 'CUBE'. The marks differ in the figurative '+' element and the word 'LE' of the earlier mark, which have no counterpart in the applicant's mark; and in the word 'SOUND' of the contested mark, which has no counterpart in the opponent's mark. From a purely visual perspective these marks are considered to be similar to only a low degree.

### **Aural similarity**

48. The figurative '+' element in the earlier mark will not be articulated. The opponent's mark will therefore be pronounced in two syllables as *LAY/KYOOB*. The applicant's mark will also be articulated in two syllables, as *SOUND/KYOOB*. The marks share the same second syllable but differ entirely in the initial parts of the marks. These marks are aurally similar to no more than a medium degree.

### **Conceptual similarity**

49. The shared element 'CUBE' can be defined in two clear ways. A cube *'is a solid object with six square surfaces which are all the same size'*. *'The cube of a number is another number that is produced by multiplying the first number by itself twice. For example, the cube of 2 is 8'*.<sup>1</sup>

50. The word element 'LE' in the opponent's mark has been accepted by both parties as being a French word that will generally be understood to translate into the English word 'The'.

51. The word 'SOUND' of the applicant's mark can be defined as *'something that you hear'*. *'Energy that travels in waves through air, water, or other substances, and can be heard'*.<sup>2</sup>

52. The figurative '+' element in the opponent's mark is likely to be perceived as a 'plus' sign which indicates an addition to something. Therefore, the opponent's mark is likely to be perceived as an enhanced cube, being a six-sided object with additional features or benefits. Notwithstanding the conjoining of the words 'SOUND' and 'CUBE', the applicant's mark will be perceived as a six-sided object that in some way is likely to transmit or produce sound.

53. As both marks share the concept of a cube, they can be said to be similar conceptually, however the additional concept of sound, which is introduced in the contested mark, serves to set them apart. The marks at issue are considered to be conceptually similar to a medium degree.

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<sup>1</sup> <https://www.collinsdictionary.com/dictionary/english/cube>

<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/sound>

54. In conclusion, the marks have been found to be visually similar to a low degree; aurally similar to no more than a medium degree and conceptually similar to a medium degree.

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

55. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

56. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

57. The word ‘LE’ is a French word that is translated into English as the word ‘The’. This is a point agreed on by both parties. The word ‘CUBE’ is a fairly common English word which will be readily understood by the average member of the UK public. Neither of the words in the earlier mark can be said to have a clear or obvious link to the goods at issue and the combination of the two words creates a somewhat abstract expression that conveys the notion of a solid six-sided object. The figurative ‘+’ element is also distinctive to some degree and has no clear connection to the goods at issue but may be perceived as indicating something with an enhanced functionality or capability. Due to the combination of the French and English words and the distinctive figurative element, the earlier mark can be said to be inherently distinctive to at least a medium degree.

58. The opponent has claimed that the earlier mark has acquired an enhanced degree of distinctive character because of the use made of it. Whilst I have accepted that the evidence provided by the opponent supports a claim of genuine use, I note that the UK consumer has not been exposed to the earlier mark, or at least not to the extent that an enhanced degree of distinctive character can be claimed for the purposes of this matter.

### **Likelihood of Confusion**

59. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them

must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

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

61. I have already found that:

- the goods at issue are identical; similar to a low degree and dissimilar;
- the marks are visually similar to a low degree; aurally similar to no more than a medium degree and conceptually similar to a medium degree;
- the average consumer will more likely be a member of the general public but may also be a professional;
- the average consumer will pay a medium degree of attention when selecting the goods, however a professional consumer is likely to pay a slightly higher level of attention in respect of some of the goods at issue;
- the visual and aural assessments are both important, but the visual impact of the marks may be said to carry the greater weight;
- the earlier mark has at least a medium degree of inherent distinctiveness, but a claim of enhanced distinctiveness has been rejected.

62. Taking all of the aforesaid into account, I find that direct confusion will not occur. The visual and aural differences between the opponent's earlier mark and the applicant's contested mark are not minor and will not go unnoticed. Notwithstanding the opponent's reference to the matter of imperfect recollection, which I have considered fully, I conclude that the relevant public is unlikely to mistake one mark for the other.

63. Having found no likelihood of direct confusion, I go on to consider the matter in respect of indirect confusion.

64. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

65. These examples are not exhaustive but provide helpful focus.

66. I do not find it likely that the average consumer, previously exposed to one of the marks at issue would, in the event that they then encounter the other mark, perceive that mark to be part of the same brand family, simply because of the shared element ‘CUBE’. The consumer who is aware of the opponent’s earlier mark will not expect that the opponent would, in the natural course of trade, and in an attempt to evolve their brand, remove the figurative ‘+’ element from it’s earlier mark, along with the word ‘LE’ and replace those elements with the word ‘SOUND’, in the process

conjoining the elements 'SOUND' and 'CUBE' in a way that was not previously done with the elements 'LE' and 'CUBE'. I think it quite unlikely that the average consumer, paying at least a medium degree of attention, would perceive the applicant's mark to be a brand variant or sub-brand of the 'LE CUBE' mark.

67. The word 'SOUND' in the applicant's mark may suggest that the goods will, in some way, produce or transmit sound. The opponent has stated that this will be the case. The opponent has also claimed that both 'LE' and 'SOUND' are non-distinctive and descriptive elements in the respective marks, whereas the common element 'CUBE' is the more distinctive aspect of the marks. I disagree with this assessment. I find in fact, that the addition of the French word 'LE' will create an unusual and memorable combination in the mind of the average UK consumer. I also conclude that the word 'SOUND', which I agree has an obvious meaning, will not be readily dismissed as non-distinctive or descriptive, as it will be perceived as part of a whole. The average consumer will not easily attach a precise meaning to the term 'SOUNDCUBE' and the mark will, at best, be considered to be allusive or suggestive, but not clearly descriptive.

68. The word 'CUBE' has some distinctiveness to it, as has been claimed, however, I find that the term is unlikely to be considered to be highly distinctive. That being the case, I do not accept the opponent's argument that because both marks share that one element, this is likely to result in confusion for those goods found to be identical or similar.

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

70. Even if the opponent's mark is brought to mind by the applicant's mark (which I feel is quite unlikely), I believe that indirect confusion will not occur.

71. I have come to these conclusions based on an assumption that the opponent has shown genuine use of its earlier mark. A more detailed assessment of the

opponent's evidence will not result in a different finding, as I have concluded that the marks will not be confused directly or indirectly.

**Conclusion**

72. As I have found that there is no likelihood of confusion, the opposition fails and, subject to appeal, the application may proceed to registration.

**Costs**

73. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. I take note of the fact that the applicant has made no submissions subsequent to its counterstatement, has not replied to the opponent's evidence or submissions, and has not filed any evidence.

74. I award costs to the applicant as follows:

Considering the statement of case and preparing the counterstatement.	£200
<u>Total</u>	<u>£200</u>

75. I therefore order GROUPE CANAL+ to pay Jingyi Huang the sum of £200. The above sum should 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 18th day of December 2020**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**