

O/0304/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK3896323
BY HANGZHOU GUANGLI TECHNOLOGY CO., LTD.
TO REGISTER THE TRADE MARK:**

ChatGlass

IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 441495
BY KINGFISHER DOMAINS LIMITED**

Background and pleadings

1. On 3 April 2024, HANGZHOU GUANGLI TECHNOLOGY CO., LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 21 April 2024 in class 9. The goods applied for are in Annex 1.

2. The application was partially opposed by Kingfisher Domains Limited (“the opponent”) on 21 June 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is aimed at the following goods:

Class 9: Downloadable mobile applications for retrieving and displaying health information; Downloadable mobile applications for measuring, tracking, analyzing, displaying, uploading, and transmitting data transmitted from the wearable electronic devices or the portable and wearable electronic wristbands and identification bracelets; Downloadable computer application software for mobile phones, namely, software for use in database management, use in electronic storage of data, use in receiving, processing, transmitting and displaying data; Downloadable mobile applications for downloading and reading electronic publications on portable electronic devices; Downloadable mobile applications for tracking, processing, storing, displaying, measuring and transmission of a user's fitness, exercise and workout data and information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, temperature, sleep patterns, changes in heart rate, blood oxygen, blood pressure, and software for providing rewards in the nature of earning and awarding of insurance coverage based on a user's activity; Downloadable pattern recognition software for identifying human faces; Downloadable mobile applications for the uploading, posting, displaying, tagging, blogging, sharing or providing of electronic media or information over communications networks or the Internet, for the transmission of text messages, multimedia messages, electronic mails; Downloadable computer software for providing users with information and analysis regarding their physical activity, fitness and general health; Downloadable computer software and mobile applications for voice,

speech and command recognition, for conversion of voice and speech to text, for processing voice, speech and commands and creating responses in the form of text or audio files, for the collection, identification, retrieving, editing, caching, processing, analysis, organizing, structuring, modifying, indexing, formatting, book marking, transmission, storage, management, sharing and access control of data and information, global positioning systems, cellular communication networks, for making, recording, analyzing, storing and retrieving measurements of distance, slope, speed, for navigation, for displaying maps and traffic information; Downloadable intelligent personal assistant software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programs; Home automation hubs comprised of voice-activated speakers, computer hardware, and recorded software for controlling networked devices in the internet of things (IoT), control and command of large and small appliances, operating internet-enabled and connected lighting apparatus and home security alarms; Downloadable mobile applications for use with mobile devices, namely, software for use in database management, for use as a spreadsheet, for word processing, for recording, collecting, organizing, storing, archiving, reproducing, searching, retrieving and displaying digital data in the field of shopping, purchasing, communication, product and service reviews, entertainment, health and fitness, lifestyle, media and video, music and audio, photography and social network; Intelligent personal assistant devices comprised of voice-activated speakers, computer hardware, and recorded software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programs; Computer hardware and recorded software systems for operating, managing, and controlling automated machine systems, smart homes, internet of things (IoT) enabled devices, security systems, alarms, detection systems;

Downloadable computer application software for mobile phones, portable media players, handheld computers, namely, software for operating, managing, and controlling automated machine systems, smart homes, internet of things (IoT) enabled devices, security systems, alarms, detection systems; Downloadable computer software for controlling the operation of audio and video devices; Smartglasses; Computers; Wearable activity trackers; Wireless communication devices; Wearable video display monitors; Smart rings; Smartwatches; Wearable computers; Computer chatbot software for simulating conversations; Smart speakers; Virtual assistant software; Personal digital assistants.

3. The opponent relies on the following trade mark:

UK3559442

GLASS

Filing date: 23 November 2020

Registration date: 11 November 2022

Relying upon some of the goods for which the earlier mark is protected, as follows:

Class 9: Software for recording, monitoring, storing, analysing and sharing data and providing feedback relating to personal fitness and performance in undertaking physical exercise; software for creating, accessing, collecting, editing organising, commenting on, modifying transmission, storage and sharing of audio, visual and/or audio visual content, data and information; software for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; software for browsing, streaming, viewing and/or organising news and current affairs content; software for movement, gesture, facial and voice detection and recognition; software for social networking; software for creating, managing, and interacting with an online community including enabling users to participate in shared viewing of content, discussions, polls, to give comments and receive feedback and

engage in social networking; software for converting voice commands into machine-executable commands; software for home automation control devices for controlling home automation systems, home security and home monitoring systems; home automation control devices for controlling home automation systems, home security and home monitoring systems; audio, visual and/or audio visual entertainment devices; audio, visual and/or audio visual content streaming devices; voice activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; software for the control of voice activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; wearable computer peripherals for playing video games; audio, visual and/or audio visual entertainment devices; cameras; wearable activity trackers; wireless local area network devices; personal video recorders; virtual reality entertainment software; smart watches; speakers; sound bars;

Class 35: retail store services featuring software provided via the internet allowing access to third party service providers of games, health, fitness and fashion products and facilitating the purchase of products from third party providers.

4. The opponent claims that the marks are similar particularly due to the applicant's mark wholly encompassing the earlier mark. They also claim that the goods and services at issue are identical or similar and this leads to a likelihood of confusion on the part of the relevant public.

5. The applicant filed a counterstatement in which it denies that there is a likelihood of confusion. It does admit that the goods at issue are identical/similar however, the marks are "dissimilar in appearance, connotation and commercial impression".

6. The applicant is represented by Limin Yu and the opponent is represented by Dentons UK and Middle East LLP.

7. Neither party filed evidence nor requested a hearing. The opponent provided submissions in lieu. This decision is therefore taken following careful consideration of the papers.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

9. Section 5(2)(b) is being relied upon and is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. 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 registered trade mark or international trade mark (UK) 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,

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Case law

12. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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) If 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

13. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

14. 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.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the 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 für Lernsysteme v OHI-M - 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".

16. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

17. Within the applicant's Form TM8 and at paragraph 3 of their counterstatement they state that:

"The applicant admits that, as shown by the Opponent in Annex 1, the goods covered by the Application are identical with and/or similar to those covered by the Opponent's earlier mark"

As the Applicant has admitted that the goods at issue are identical or similar as per the table set out in the Opponent's Annex 1 to their Form TM7, it is no longer open for me to make a different finding on the goods noted as identical. Where the goods have been found by the opponent to be 'similar', they have not identified to what level the goods are similar. I will therefore undertake an assessment on those goods. For ease, I am replicating the table from Annex 1 below, including my findings of the level of similarity where they are required:

Mark Applied For	Earlier Mark	Identical/Similar
<i>Class 9</i>		
Downloadable mobile applications for retrieving and displaying health information	Software for recording, monitoring, storing, analysing and sharing data and providing feedback relating to personal fitness and performance in undertaking physical exercise	Identical
Downloadable mobile applications for measuring, tracking, analyzing, displaying, uploading, and transmitting data transmitted from the wearable electronic wristbands and identification bracelets	Software for recording, monitoring, storing, analysing and sharing data and providing feedback relating to personal fitness and performance in undertaking physical exercise	Identical
Downloadable computer application software for mobile phones, namely, software for use in database management, use in electronic storage of data, use in receiving, processing, transmitting and displaying data	Software for recording, monitoring, storing, analysing and sharing data and providing feedback relating to personal fitness and performance in undertaking physical exercise; software for creating, accessing, collecting, editing, organising, commenting	Identical

	on, modifying, transmission, storage and sharing of audio, visual and/or audio visual content, data and information	
Downloadable mobile applications for downloading and reading electronic publications on portable electronic devices	Software for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; software for browsing, streaming, viewing and/or organising news and current affairs content	The opponent noted these goods as being similar. I consider that there is an overlap in nature and method of use. The users will overlap as will the trade channels. There could be some competition but they are not complementary and therefore I find the goods similar to a high degree.
Downloadable mobile applications for tracking, processing, storing, displaying, measuring and transmission of a user's fitness, exercise and workout data and information including time date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, temperature, sleep patterns, changes in	Software for recording, monitoring, storing, analysing and sharing data and providing feedback relating to personal fitness and performance in undertaking physical exercise	Identical

heart rate, blood oxygen, blood pressure, and software for providing rewards in the nature of earning and awarding of insurance coverage based on a user's activity		
Downloadable pattern recognition software for identifying human faces	Software for movement, gesture, facial and voice detection and recognition	Identical
Downloadable mobile applications for the uploading, posting, displaying, tagging, blogging, sharing or providing of electronic media or information over communications networks or the Internet, for the transmission of text messages, multimedia messages, electronic emails	Software for social networking; software for creating, managing, and interacting with an online community including enabling users to participate in shared viewing of content, discussions, polls, to give comments and receive feedback and engage in social networking; software for creating, accessing, , editing, organising, commenting on, modifying, transmission, storage and sharing of audio, visual and/or audio visual content, data and information	Identical
Downloadable computer software for providing	Software for recording, monitoring, storing,	Identical

<p>users with information and analysis regarding their physical activity, fitness and general health</p>	<p>analysing and sharing data and providing feedback relating to personal fitness and performance in undertaking physical exercise</p>	
<p>downloadable computer software and mobile applications for voice, speech and command recognition, for conversion of voice and speech to text, for processing voice, speech and commands and creating responses in the form of text or audio files, for the collection, identification, retrieving, editing, caching, processing, analysis, organizing, structuring, modifying, indexing, formatting, bookmarking, transmission, storage, management, sharing and access control of data and information, global positioning systems, cellular communication networks, for making, recording, analyzing, storing and retrieving</p>	<p>software for movement, gesture, facial and voice detection and recognition; Software for converting voice commands into machine-executable commands</p>	<p>Identical</p>

measurements of distance, slope, speed, for navigation, for displaying maps and traffic information		
downloadable intelligent personal assistant software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programmes	Software for movement, gesture, facial and voice detection and recognition; software for converting voice commands into machine-executable commands; Software for home automation control devices for controlling home automation systems, home security and home monitoring systems	Identical
home automation hubs comprised of voice-activated speakers, computer hardware, and recorded software for controlling networked devices in the Internet of Things (IoT), control and	home automation control devices for controlling home automation systems, home security and home monitoring systems; Software for home automation control devices for controlling	Identical

<p>command of large and small appliances, operating internet-enabled and connected lighting apparatus and home security alarms</p>	<p>home automation systems, home security and home monitoring systems</p>	
<p>downloadable mobile applications for use with mobile devices, namely, software for use in database management, for use as a spreadsheet, for word processing, for recording, collecting, organising, storing, archiving, reproducing, stretching, retrieving and displaying digital data in the field of shopping, purchasing, communication, product and service reviews, entertainment, health and fitness, lifestyle, media and video, music and audio, photography and social network</p>	<p>software for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; retail store services featuring software provided via the internet allowing access to third party service providers of games, health, fitness and fashion products and facilitating the purchase of products from third party providers (class 35)</p>	<p>The opponent noted these as 'identical/similar'. I assume that the opponent is accepting them as identical however, in the event that they are not, I find that there is an overlap in nature, users, trade channel and purpose and find them similar to at least a medium degree.</p>
<p>Intelligent personal assistant devices comprised of voice-activated speakers, computer hardware, and recorded software for</p>	<p>audio, visual and/or audiovisual entertainment devices; home automation control devices for controlling home automation systems,</p>	<p>Identical</p>

<p>voice recognition, natural language processing, searching the Internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programmes</p>	<p>home security and home monitoring systems; Audio, visual and/or audio visual content streaming devices; voice activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content</p>	
<p>computer hardware and recorded software systems for operating, managing, and controlling automated machine systems, smart homes, Internet of Things (IoT) enabled devices, security systems, alarms, detection systems</p>	<p>home automation control devices for controlling home automation systems, home security and home monitoring systems; Software for home automation control devices for controlling home automation systems, home security and home monitoring systems</p>	<p>identical</p>
<p>downloadable computer application software for mobile phones, portable media players, handheld</p>	<p>Software for home automation control devices for controlling home automation</p>	<p>identical</p>

computers, namely, software for operating, managing, and controlling automated machine systems, smart homes, Internet of Things (IoT) enabled devices, security systems, alarms, detection systems	systems, home security and home monitoring systems	
downloadable computer software for controlling the operation of audio and video devices	software for the controller voice activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content	identical
smartglasses	wearable computer peripherals for playing video games	identical
computers	audio, visual and/or audio visual entertainment devices; Cameras	The opponent has noted these goods as being similar. I consider that there is an overlapping user, purpose, nature and trade channels. The devices could be in competition however they are not complementary I therefore I find them similar to a high degree
wearable activity trackers	wearable activity trackers	identical
wireless communication devices	wireless local area network devices	identical

wearable video display monitors	personal video recorders; Virtual reality entertainment software; Wearable computer peripherals for playing video games	The opponent has noted these as identical/similar. I consider there to be an overlap in user, nature, trade channel and purpose with the opponent's 'wearable computer peripherals for playing video games'. They might be in competition but not complementary. I therefore find them similar to a high degree.
Smart rings	Smart watches	The opponent states these are similar. I consider that they differ in nature however, there is an overlap in purpose, user and trade channels. They could be in competition as someone might choose between a smart watch or smart ring. I therefore find them similar to a high degree.
Smart watches	Smart watches	Identical
Wearable computers	Wearable computer peripherals for playing video games	Identical
Computer chatbot software for simulating conversations	Software for converting voice commands into machine-executable	The opponent states these are similar. The goods are similar in nature

	commands; software for social networking	in so far as they are all software. There is an overlap in general user and potentially trade channels however, I find that the purpose differs. They are not in competition nor are they complementary. I therefore find them similar to a medium degree.
Smart speakers	Speakers; sound bars	Identical
Virtual assistant software	Software for movement, gesture, facial and voice detection and recognition; software for converting voice commands into machine-executable commands; software for home automation control devices for controlling home automation systems, home security and home monitoring systems	The opponent has stated these are similar. I consider there to be an overlap in nature, user and some overlap in perhaps purpose and trade channels. They are not in competition nor are they complementary. I therefore find them similar to a medium degree.
Personal digital assistants	Software for movement, gesture, facial and voice detection and recognition; software for converting voice commands into machine-executable commands; software for home automation control	The opponent has stated these are similar. I consider there to be an overlap in nature, user and some overlap in perhaps purpose and trade channels. They are not in competition nor are they

	devices for controlling home automation systems, home security and home monitoring systems	complementary. I therefore find them similar to a medium degree.
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Average consumer and the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

19. 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. (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer will likely consist of members of the general public (including horse owners/riders), not discounting that there may be professional or business consumers also. The goods could be sold through a range of retailers, be that specific or more general. The goods could also be selected online or through a catalogue. In physical premises, the goods will likely be displayed on shelves or racks where they can be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues where the consumer will select the goods having viewed an image displayed on a webpage or catalogue page.

21. The cost of those goods is likely to vary on the basis that some software goods are likely to be relatively inexpensive items whereas computers or home automation devices may be rather more expensive purchases (though I do not consider these extend to being very expensive). I consider the frequency of purchase to be fairly regular as items will need to be updated or contain new features. In selecting the goods, the average consumer will consider suitability, specification and features and I am of the view that they will likely pay a medium degree of attention.

Comparison of the marks

22. 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.”

23. 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.

24. The respective trade marks are shown below:

Contested mark	Earlier Mark
ChatGlass	GLASS

25. The earlier mark is a word mark consisting of the word GLASS, and therefore, the overall impression lies in that word.

26. The contested mark is two words Chat and Glass conjoined. The opponent submits that 'Glass' is the distinctive element of the applied for mark as 'Chat' has a "clear meaning in relation to the goods and services applied for [...] and is non-distinctive or, in the alternative, very weakly distinctive". I agree that for some of the goods which are likely to include a chat function or feature (whether between the consumer and the provider or as a form of social connection), this would be descriptive and therefore, for those goods, 'Glass' will be the dominant and distinctive element with 'Chat' playing a smaller role despite being placed first. For the other goods, 'Chat' would not be allusive or descriptive and therefore, the distinctiveness in the mark will lie in the juxtaposition of the two words 'Chat' and 'Glass'.

27. The opponent rightly points out that visually, the earlier mark is entirely contained within the contested mark. There are the further four letters at the beginning of the contested mark which have no equivalent in the earlier mark. I therefore consider the marks to be visually similar to no more than a medium degree.

28. Turning to the aural comparison, I consider that both 'Chat' and 'Glass' will be given their ordinary everyday pronunciations. Both marks share the 'Glass' element but the earlier mark will have 'Chat' spoken before it. I therefore consider them to be aurally similar to no more than a medium degree.

29. Conceptually, in relation to the contested mark, both elements 'Chat' and 'Glass' have several possible everyday meanings. I agree that in relation to some of the applied for goods, 'Chat' would likely mean a function as I have mentioned above in paragraph 26. For the 'Glass' element, the average consumer will likely assign the same meaning to both marks however, due to the extra conceptual content in the contested mark, I find them to be conceptually similar to no more than a medium degree.

Distinctive Character of the Earlier Mark

30. 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).”

31. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up 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 made of it. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier registration and therefore I must rely on its inherent distinctiveness.

32. The earlier registration is comprised of an ordinary dictionary word. The mark is not descriptive or allusive of the goods and services registered by the opponent. However, it is not an invented word which would usually attract the highest degree of distinctive character. Therefore, I find the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

33. 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 the goods 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 goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and 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.

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

- The opponent's mark consists of the word 'Glass' and that is where the overall impression lies. The contested mark consists of the words 'Chat' and 'Glass' combined. For some of the applicant's specification 'Chat' is descriptive of the goods applied for. In this case, 'Glass' is the dominant and distinctive element. Where 'Chat' is not allusive/descriptive, the distinctiveness of the mark lies in the juxtaposition of the two words.
- I have found the marks to be visually, aurally and conceptually similar to no more than a medium degree.
- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods at issue to be a combination of members of the general public as well as professionals/businesses. The purchasing process is likely to be predominantly visual.
- I have concluded that a medium degree of attention of attention will be paid during the purchasing process.
- The applicant accepted that the goods at issue are identical/similar. I have therefore found them to range between identical and similar to a medium degree.

35. Taking all of the above factors into account, including that the earlier mark is wholly encompassed within the contested mark, I consider that there is a likelihood of direct confusion, but only for the goods where 'Chat' is descriptive of the goods themselves. I consider that the word 'Chat' will be easily overlooked for these goods due to its descriptive nature. For all other goods, I find that, particularly due to the distinctiveness lying in the juxtaposition of the two words, (and even where there is identity and high similarity between the goods) and the fact that 'Chat' appears first in the contested mark (the beginning of a mark tending to have more visual and aural impact than the end)¹ there will be sufficient distance to offset any similarity of the marks and these goods will not be directly confused.

36. I will now turn to look at indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“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”).

37. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”²

38. For the sake of completeness, I will firstly consider indirect confusion for the goods where ‘Chat’ is descriptive of the goods themselves. In the event the average consumer does notice the differences between the marks, I consider that the addition of a term that is descriptive of those goods will likely be viewed as a brand extension

² Paragraph 12

by the average consumer. I therefore consider there to be a likelihood of indirect confusion.

39. For the remaining goods at issue, I consider that the common element between the marks – ‘Glass’ is not so strikingly distinctive that no other brand could use it. It is an ordinary dictionary word and, as established above, has a medium degree of inherent distinctiveness which has not been enhanced. Therefore, the first category is not satisfied.

40. Regarding the second category, the addition of ‘Chat’ is not an addition of a non-distinctive element for the remaining goods as it is not descriptive or allusive of them. It is also not a word that is frequently used to indicate sub-brands such as ‘LITE’ or ‘EXPRESS’ as per the examples provided by Mr Purvis. Consequently, the second category cannot be satisfied.

41. Lastly, looking at the example where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension, I do not consider that the addition of the word ‘Chat’ is a logical brand extension of the opponent’s mark, or vice versa, when being used on goods for which ‘Chat’ is not descriptive, particularly when that word is placed at the beginning of the mark. I can see no other reason why the average consumer might believe these undertakings are linked. I therefore do not consider that the third category is satisfied.

42. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant’s mark could be indirectly confused with the opponent’s. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the opponent’s mark is brought to mind when viewing the applicant’s mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion when the applicant’s mark is being used on goods for which ‘Chat’ is not descriptive.

Conclusion

43. The opposition is successful in relation to the following goods (subject to any appeal):

Class 9: Downloadable mobile applications for the uploading, posting, displaying, tagging, blogging, sharing or providing of electronic media or information over communications networks or the Internet, for the transmission of text messages, multimedia messages, electronic mails; Computer chatbot software for simulating conversations.

44. The opposition fails and registration may continue for the following goods (subject to any appeal):

Class 9: Downloadable mobile applications for retrieving and displaying health information; Downloadable mobile applications for measuring, tracking, analyzing, displaying, uploading, and transmitting data transmitted from the wearable electronic devices or the portable and wearable electronic wristbands and identification bracelets; Downloadable computer application software for mobile phones, namely, software for use in database management, use in electronic storage of data, use in receiving, processing, transmitting and displaying data; Downloadable mobile applications for downloading and reading electronic publications on portable electronic devices; Downloadable mobile applications for tracking, processing, storing, displaying, measuring and transmission of a user's fitness, exercise and workout data and information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, temperature, sleep patterns, changes in heart rate, blood oxygen, blood pressure, and software for providing rewards in the nature of earning and awarding of insurance coverage based on a user's activity; Downloadable pattern recognition software for identifying human faces; Downloadable computer software for providing users with information and analysis regarding their physical activity, fitness and general health;

Downloadable computer software and mobile applications for voice, speech and command recognition, for conversion of voice and speech to text, for processing voice, speech and commands and creating responses in the form of text or audio files, for the collection, identification, retrieving, editing, caching, processing, analysis, organizing, structuring, modifying, indexing, formatting, book marking, transmission, storage, management, sharing and access control of data and information, global positioning systems, cellular communication networks, for making, recording, analyzing, storing and retrieving measurements of distance, slope, speed, for navigation, for displaying maps and traffic information; Downloadable intelligent personal assistant software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programs; Home automation hubs comprised of voice-activated speakers, computer hardware, and recorded software for controlling networked devices in the internet of things (IoT), control and command of large and small appliances, operating internet-enabled and connected lighting apparatus and home security alarms; Downloadable mobile applications for use with mobile devices, namely, software for use in database management, for use as a spreadsheet, for word processing, for recording, collecting, organizing, storing, archiving, reproducing, searching, retrieving and displaying digital data in the field of shopping, purchasing, communication, product and service reviews, entertainment, health and fitness, lifestyle, media and video, music and audio, photography and social network; Intelligent personal assistant devices comprised of voice-activated speakers, computer hardware, and recorded software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programs; Computer hardware and recorded software systems for operating, managing, and controlling automated machine systems, smart homes, internet of things

(IoT) enabled devices, security systems, alarms, detection systems; Downloadable computer application software for mobile phones, portable media players, handheld computers, namely, software for operating, managing, and controlling automated machine systems, smart homes, internet of things (IoT) enabled devices, security systems, alarms, detection systems; Downloadable computer software for controlling the operation of audio and video devices; Smartglasses; Computers; Wearable activity trackers; Wireless communication devices; Wearable video display monitors; Smart rings; Smartwatches; Wearable computers; Smart speakers; Virtual assistant software; Personal digital assistants.

Costs

45. The applicant has the larger proportion of success in these proceedings and is therefore entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023. I award the applicant the sum of **£300**, calculated as follows:

Considering the Notice of opposition and preparing the counterstatement	£300
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Total	£300
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46. I therefore order Kingfisher Domains Limited to pay HANGZHOU GUANGLI TECHNOLOGY CO., LTD the sum of £300. This 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 31st day of March 2025

L Nicholas
For the Registrar

Annex 1:

Class 9: Downloadable mobile applications for retrieving and displaying health information; Downloadable mobile applications for measuring, tracking, analyzing, displaying, uploading, and transmitting data transmitted from the wearable electronic devices or the portable and wearable electronic wristbands and identification bracelets; Downloadable computer application software for mobile phones, namely, software for use in database management, use in electronic storage of data, use in receiving, processing, transmitting and displaying data; Downloadable mobile applications for downloading and reading electronic publications on portable electronic devices; Downloadable mobile applications for tracking, processing, storing, displaying, measuring and transmission of a user's fitness, exercise and workout data and information including time, date, heart rate, global positioning, direction, distance, altitude, speed, steps taken, calories burned, navigational information, temperature, sleep patterns, changes in heart rate, blood oxygen, blood pressure, and software for providing rewards in the nature of earning and awarding of insurance coverage based on a user's activity; Downloadable pattern recognition software for identifying human faces; Downloadable mobile applications for the uploading, posting, displaying, tagging, blogging, sharing or providing of electronic media or information over communications networks or the Internet, for the transmission of text messages, multimedia messages, electronic mails; Downloadable computer software for providing users with information and analysis regarding their physical activity, fitness and general health; Downloadable computer software and mobile applications for voice, speech and command recognition, for conversion of voice and speech to text, for processing voice, speech and commands and creating responses in the form of text or audio files, for the collection, identification, retrieving, editing, caching, processing, analysis, organizing, structuring, modifying, indexing, formatting, book marking, transmission, storage, management, sharing and access control of data and information, global positioning systems, cellular communication networks, for making, recording, analyzing, storing and retrieving measurements of distance, slope, speed, for navigation, for displaying maps and traffic information; Downloadable intelligent personal

assistant software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programs; Home automation hubs comprised of voice-activated speakers, computer hardware, and recorded software for controlling networked devices in the internet of things (IoT), control and command of large and small appliances, operating internet-enabled and connected lighting apparatus and home security alarms; Downloadable mobile applications for use with mobile devices, namely, software for use in database management, for use as a spreadsheet, for word processing, for recording, collecting, organizing, storing, archiving, reproducing, searching, retrieving and displaying digital data in the field of shopping, purchasing, communication, product and service reviews, entertainment, health and fitness, lifestyle, media and video, music and audio, photography and social network; Intelligent personal assistant devices comprised of voice-activated speakers, computer hardware, and recorded software for voice recognition, natural language processing, searching the internet for traffic and weather information, providing appointment reminders, control and command of internet-connected devices, control and command of large and small appliances, searching and controlling smart televisions and media content, and interacting with games and interactive television programs; Computer hardware and recorded software systems for operating, managing, and controlling automated machine systems, smart homes, internet of things (IoT) enabled devices, security systems, alarms, detection systems; Downloadable computer application software for mobile phones, portable media players, handheld computers, namely, software for operating, managing, and controlling automated machine systems, smart homes, internet of things (IoT) enabled devices, security systems, alarms, detection systems; Downloadable computer software for controlling the operation of audio and video devices; Smartglasses; Computers; Quantity indicators; Wearable activity trackers; Wireless communication devices; Wearable video display monitors; Swimming face masks; Masks for diving; Divers masks; Diving goggles; Swimming goggles; Spectacles; Optical lenses; Sports helmets;

Smart rings; Smartwatches; Safety goggles; Goggles for sports; Eyeglasses; Battery chargers; Pedometers; Wearable computers; Time recording apparatus; Glasses; Protective goggles; Computer chatbot software for simulating conversations; Smart speakers; Humanoid robots having communication and learning functions for assisting and entertaining people; Virtual assistant software; Personal digital assistants.