

O/215/21

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

IN THE MATTER OF TRADE MARK APPLICATION No. 3196043

BY

VIVO INTERNATIONAL LIMITED

TO REGISTER THE FOLLOWING TRADE MARK

VIVO.COM

IN CLASSES 1, 2, 4, 7, 8, 9, 21, 27, 29, 30, 31,32, 35, 36, 38, 40, 41 AND 42

AND OPPOSITION THERETO (No. 408608)

BY

VIVO MOBILE COMMUNICATION CO LTD

Background

1. Vivo International Limited (“the Applicant”) applied to register the trade mark **VIVO.COM** on 10 November 2016. It was published for opposition purposes on 20 January 2017 for goods and services in various classes (as listed on the cover page of this decision and as set out in full in Annex A attached hereto). The original opposition was issued by BBK Communication Technology Co Ltd now Vivo Mobile Communication Co Ltd¹ (“the Opponent”). It opposes the registration in part under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

2. The original opposition relied upon two International Registrations (“IR”), namely those numbered 1232891 and 1180032, one of which designated the UK for protection, the other the EU. Neither had, however, achieved protection. Both earlier marks consisted of the word **VIVO**. The opposition originally only opposed the registration of the mark in classes 9, 35, 38 & 42.

3. On 12 January 2018 a decision (“provisional decision”) in the above opposition proceedings was published under reference number BL O-028-18 by Mr Oliver Morris (“hearing officer”). Whilst upholding the opposition in part, that decision was provisional since the earlier marks relied upon had not yet attained protection.

4. On 16 June 2020 the registry was notified that the EUIPO and UKIPO had refused protection for both IRs (in respect of IR 1180032 on 1 October 2019 and in respect of IR 123891 on 30 August 2019).

¹ Effective from 4 October 2017 the two original IRs relied upon were transferred from the ownership of BBK Communication Technology Co Ltd to Vivo Mobile Communication Co Ltd. As a result, on 27 August 2020 and following confirmation that it would remain liable for all costs arising in the proceedings, Vivo Mobile Communication Co Ltd were substituted as the Opponent.

5. By that same letter dated 16 June 2020, Vivo Mobile Communication Co Ltd applied to amend the original pleadings to substitute the earlier IRs relied upon, with EU trade mark  numbered 9614579. The matter came before the tribunal for consideration and the Applicant's views were canvassed. The Applicant did not respond and therefore by letter dated the 27 August 2020 the hearing officer gave the following preliminary view:

“Request to amend pleadings

Having heard the opposition at an oral hearing on 6 December 2017 and a decision (albeit provisional) having been issued in January 2018 (BL O-028-18), the request to allow an amendment to the pleadings to add an new earlier mark, acquired by the Opponent only two years later, raises questions of natural justice and abuse of process.

Were this a situation in which the Opponent had largely lost on the basis of its original marks and then sought a second attempt on the basis of a different earlier mark, such would clearly be an objectionable abuse of process, since a claimant is expected to bring its best case at once and not to make piecemeal attacks. That is not quite the situation in the present case - the Opponent achieved the larger measure of success in the findings of the hearing officer in his provisional decision. However, that success was contingent on the Opponent having reliable earlier marks, whereas those marks have in fact since been refused protection and have not been granted to the Opponent.

Only in January 2020 did the Opponent acquire the new earlier mark on which it now seeks to rely. Article 2 of the Trade Marks (Relative Grounds) Order 2007 requires that an objection under section 5 (as in this case) must be raised by the proprietor of the earlier trade mark. While the Opponent is now the proprietor of the newly acquired earlier trade mark, the fact that it acquired the mark so late in these proceedings and the absence of an

account of the circumstances of the acquisition are factors to be weighed in considering whether there may be any suspicion of abuse of process.

On the other hand, there are also factors that favour allowing the request for amendment of proceedings. Section 4.1 of the Manual of Trade Marks Practice states that a request to amend (including by adding an earlier mark) will be considered on its merits and while whether to allow an amendment is a matter of discretion, the Tribunal will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties more quickly and at less cost. As noted in your letter of 16 June 2020, the Manual gives the following further guidance:

In making its decision the Tribunal will consider, in particular, any inconvenience or prejudice suffered by the other side, and whether the party seeking amendment could reasonably have been expected to have fully particularised their case at an earlier stage. In other words, a party seeking amendment will have to dispel any suspicion of abuse of process. If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.

We note that the earliest stage at which the Opponent could have requested amendment to the pleadings to invoke the new earlier mark would have been some time after 18 January 2020, since that was the effective date of transfer to the Opponent. We also note your various points made on your part arguing that there is no significant prejudice to the Applicant.

We note that if not identical, the new earlier mark – **vivo** - is at least very highly similar to the mark on which the provisional decision was made – **VIVO** and there is unlikely to be any material in the exercise of comparing the contested word mark (VIVO.COM). We also note that the new earlier mark is again not subject to proof of use.

[..]

Having considered matters in the round - including the exceptionally late stage of the proceedings, as well as the necessity to undertake a renewed comparison of the goods and services - the registry takes the view that if the new earlier mark and associated changes are permitted into the current opposition proceedings there is likely to be at least a degree of saving in terms of speed and cost, avoiding a multiplicity of proceedings. **The preliminary view is therefore to agree to the request to amend the pleadings to add the new earlier mark EUTM 9614579 and further to oppose the applied-for services in Class 36.**

This view is conditional on the following provisions:

- i. The Opponent is permitted one month - until **Monday 28 September 2020** - to file written submissions as to the similarity or otherwise of the goods and services now relied on under EUTM 9614579 and the contested goods and services (including those in Class 36).
- ii. This letter encloses again the amended pages of the Form TM7; the Applicant has already filed a Form TM8 in response to the original opposition and is not required to file another – however, **the Applicant is permitted two months from the receipt of any submissions from the Opponent (per (i) above) in which to file a new or amended counterstatement** should the Applicant wish to make submissions in particular as to the similarity or otherwise of the goods and services now relied on under EUTM 9614579 and the contested goods and services (including those in Class 36).
- iii. A decision will then be made from the papers. If the opposition succeeds, whether partially or fully, and if an award of costs is made in favour of the Opponent, any such award will be appropriately moderated to take into account the additional work attributable to responding to this late amendment of the pleadings.”

6. No challenge to the preliminary view was received from either party and consequently the Opponent's application to amend its pleadings was granted. The Opponent now relies on the following EUTM.²

The logo for the trade mark 'vivo' is displayed in a bold, lowercase, sans-serif font.

EUTM 9614579

Filed 21 December 2010 and registered 23 May 2014

Registered and relying upon goods and services in classes 9, 35, 36, 38, 41 and 42 as set out in fully in Annex B.

(“earlier mark 4579”)

7. By virtue of the amendment, the opposition now extends against the Applicant's goods and services in classes 9, 35, 36, 38, and 42. For the sake of clarity, no opposition is raised in relation to the Applicant's goods and services in classes 1, 2, 4, 7, 8, 21, 27, 29, 30, 31, 32, 40 and 41.

My Approach

8. In the provisional decision the Opponent relied only upon its goods in class 9, the terms of which differed to those now before me. The goods and services now relied upon, however, are wider in scope and therefore it appears pertinent for me to undertake a fresh comparison assessment of all the contested goods and services.

9. In relation to the mark comparison, earlier mark 4579 is virtually identical to the earlier IRs, save that it is presented in a slightly different font. In my view there is no material difference in the overall impressions of the respective marks, nor the visual,

² Although the UK has left the EU and the EUTM relied upon by the Opponent now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

aural and conceptual comparisons which would require me to undertake a fresh assessment. Equally the distinctive character assessment of earlier mark 4579 is also unlikely to differ to that originally made in the provisional decision. In essence, earlier mark 4579 is still the word Vivo and the original decision did not place great importance on the stylisation of the font such that it would materially affect the decision now before me. I also note that the Opponent was given the opportunity to file an amended TM8 and further submissions but chose not to do so. The Opponent's submissions regarding the identity/similarity of the goods and services are unchallenged by the Applicant, and in light of the decision in *Sky Club*³ the Applicant is therefore deemed to have accepted them. In relation to the average consumer assessment, however, since the goods and services as opposed and relied upon differ, a further analysis may still be required in this regard. On this basis I will undertake a fresh goods and services comparison assessment and consider any additional average consumer considerations that may arise as a result.

10. This decision is to be read in conjunction with the earlier provisional decision and I therefore do not intend to repeat the caselaw referred to therein.

Goods and services comparison

11. Whilst the Opponent has provided a table setting out those goods and services it considers to be identical or similar to those of the Applicant, it has not sought to explain its terms to any great degree. Even accepting that the Applicant has not challenged the Opponent's pleadings and is therefore deemed to have admitted them, it is not as simple as saying that all the terms are identical or similar as the comparison must be taken from the perspective of the ordinary meaning attributed to them by the average consumer.

12. The opposition is directed at the goods and services as set out below:

³ Para 24 O/044/21, Philip Johnson as the Appointed Person.

Applicant's goods and services	Opponent's goods and services
Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.	Class 9: Scientific, nautical, surveying, electrical, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Automatic vending machines and mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Software for computer; Fire-extinguishing apparatus.
Class 35: Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; arranging of contracts for the purchase and sale of goods and services, for others; compilation of computer databases; office functions; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.	Class 35: Advertising; Commercial business management in the field of telecommunications; Commercial administration in the field of telecommunications; Office functions.

Class 36: Financing services; management of investment funds; investment of funds; capital investment; investment advisory services relating to real estate; raising of capital; financial management and planning; brokerage; portfolio management; real estate affairs; real estate appraisal.	Class 36: Financial affairs; Monetary affairs; Real estate affairs; Information about telecommunication; rental of facsimile apparatus; rental of message sending apparatus; rental of modems; rental of telecommunication equipment; rental of telephones; sending apparatus (rental of message-); telecommunication (information about-).
Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services	Class 38: Communications and telecommunications, telecommunications by fixed and mobile telephones, telecommunications by satellite, providing telecommunication connections to the Internet or databases; Computer aided transmission of data, messages and images; Transmission of news and current affairs information; Providing chat-line services; Providing on-line access to exhibitions; provision and operation of electronic conferencing, discussion groups and chat rooms; Voice telephony; Telecommunications consultancy; Rental of telecommunication equipment; Providing access to search engines.

	Class 41: Education and instruction; Games services provided on-line from a computer network.
Class 42: Technical design and planning of telecommunications equipment; technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.	Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Telecommunication database services, namely enabling the consumer to download digital content from a network and server to his individual database; Authenticating works of art; cloud seeding; computer hardware (consultancy in the field of -); computer rental; conversion of data or documents from physical to electronic media; design services(packaging -); designing (dress -); designing (graphic arts -); dress designing; graphic arts designing; packaging design; rental (computer -); rental of computer software; rental of web servers; servers (rental of web -); software (rental of computer -); works of art (authenticating -).

13. I will consider each term in turn, grouping terms together where appropriate.⁴

Class 9

Computer software

14. The Applicant seeks registration for *computer software* which is clearly identical to the Opponent's *software for computer*.

Electronic data processing equipment; micro processors

15. Data processors and micro processors are electrically operated apparatus that collect, process and store data and therefore would include all computers since the essential function of a computer is to store data. As such these terms would be identical to the Opponent's *data processing equipment and computers* on the inclusion principle.

Computer hardware; computer components and parts; computer peripherals; computer networking and data communications equipment; keyboards; electronic control apparatus;

16. These goods are the physical components of a computer, ancillary devices which attach externally to a computer or are something which is used in connection with a computer and as such would be included in the Opponent's broader term *data processing equipment and computers* and thus are identical according to *Meric*.

Programmed-data-carrying electronic circuits; wires for communication;

17. Unlike hardware, which are the physical components of a computer, I consider that electronic circuits and wires are goods used in the internals of a computer/data processor. Therefore, rather than being identical to the Opponent's *data processing*

⁴ *Separode Trade Mark* BL O-399-10 (AP)

equipment and computers as submitted, in my view they will be regarded by consumers as parts and fittings of these goods. The contested goods therefore differ in nature, purpose and method of use however the trade channels would overlap and there may be a degree of complementary in so far as electronic circuits and wires would be important or essential to the workings of a computer. On this basis I consider that the Applicant's goods are similar to a low degree to the Opponent's *data processing equipment and computers*.

Electronic memory devices:

18. This term would include such things as floppy discs and hard drive disks used to store data and as such would be identical to the Opponent's *magnetic data carriers*.

Electrodes:

19. An electrode is an electric conductor through which electric currents flow and as with electronic circuits and wires would be regarded as an internal component being a part or fitting of an electronic device. Whilst not identical as submitted, I consider that an electrode would be similar to the Opponent's *electrical...apparatus and instruments* to a low degree, being complementary and may be provided by the same undertaking.

Video films:

20. The Opponent has submitted that these goods are identical to its *apparatus for recording, transmission or reproduction of sound or images*, however, I do not agree. I consider that this term would mean video film used to record images. I do not consider that the contested goods share the same purpose or nature, however, if used in this way there would be a complementary relationship between these goods and they would share trade channels and end user. On this basis I consider that the goods are similar to a low to medium degree.

Telephones and Aerials

21. A telephone is a voice transmitting device whereas an aerial is an apparatus by which signals are transmitted or received. Both would therefore be regarded as being included within the Opponent's *Apparatus for recording, transmission or reproduction of sound or images* and are therefore identical under *Meric*.

Batteries

22. A battery is an enclosed cell which releases electrical charge and is an electrical source of power. Taking the ordinary understanding of the term, I do not consider that the average consumer would regard a battery as identical or sharing a high degree of similarity with an electrical device; the purpose and nature of a battery would differ to the Opponent's *electrical ..apparatus and instruments*. However, where a battery is an integral part of the device, for example in a portable lap-top then they would be closely interlinked and would share trade channels and be directed towards the same end user. On this basis I consider that they are similar to a medium degree.

Class 35 Services

Office functions

23. The Opponent's specification includes the term *office functions* which is self-evidently identical.

Compilation of computer databases

24. These services would be undertaken by those in an office role and are therefore identical on the inclusion principles to the Opponent's *office functions*.

Employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

25. Whilst the Opponent submits that these services could include recruitment and employment agency services in the telecommunications sector so fall within *commercial administration in the field of telecommunications*, I do not agree. Those engaging the services of a third party to recruit staff would not consider these services as being provided by a business offering commercial administration services. The fact that a business recruits staff internally does not mean that it provides the service to an external enterprise. I do not consider that the applicant's services fall within the term *commercial administration in the field of telecommunications*. However, the Opponent's specification includes *commercial business management in the field of telecommunications* services which would include the implementing and managing of a business strategy which could include the recruitment of staff for example. On this basis I consider that the services are similar to a low degree.

Provision of information and advice to consumers regarding the selection of products and items to be purchased;

26. The Opponent submits that such terms are for the purpose of advertising or promotion and so are identical or closely similar to the Opponent's advertising services. Advertising imparts information as to a product in order to entice a consumer to purchase that product, whereas the provision of information and advice regarding the selection of products is an added value service to assist consumers. The term suggests an interactive component and an engagement with consumers that is absent in advertising. Therefore, they differ in method of use but will share the same purpose (of promoting goods and/or services) and may also share trade channels and may also be in competition. I conclude that they share a medium level of similarity.

Demonstration of goods for promotional purposes;

27. These services are one way to promote goods and therefore will be regarded as a sub-set of the Opponent's *advertising services* and are therefore identical applying the *Meric* criteria.

Exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes;

28. The Opponent submits that these services are identical or at minimum closely similar to the Opponent's *advertising* services. The arranging and facilitating of exhibitions to promote one's goods are the type of services undertaken by those in the commercial and advertising sector (including telecommunications). Whilst differing in nature the services would overlap in provider, purpose and relevant public. In my view these services are similar to a high degree to the Opponent's *advertising* and *commercial business management in the field of telecommunications*.

Arranging of contracts for the purchase and sale of goods and services, for others

29. These services are more akin to procurement services and therefore contrary to the Opponent's submissions I do not consider that they fall within the Opponent's *Commercial business management in the field of telecommunications*, however they may be similar to a low degree since those providers offering a commercial business management service may include the arranging of contracts for third parties as part of their remit. Whilst differing in nature, purpose and trade channels they may overlap in end user in so far as they are directed at the same consumer namely a business consumer.

Class 36

Real estate affairs

30. This term is included in both parties' specification and is self-evidently identical.

Investment advisory services relating to real estate; real estate appraisal.

31. The Opponent argues that these services are identical and all relate to real estate. I agree; they would all be included in the Opponent's broader term *Real estate affairs* and are identical according to *Meric*.

Financing services; management of investment funds; investment of funds; capital investment; raising of capital; financial management and planning; portfolio management;

32. The Opponent submits that all these services are identical to its *financial affairs* and *monetary affairs* services. I agree. Management and advice relating to investment opportunities would include the management of an investment portfolio and be the type of advice provided by those in the finance sector. I consider that these services would be included within the broader category *Financial affairs* and *Monetary affairs* and are identical on the inclusion principles.

Brokerage

33. Those providers offering brokerage services, organise and execute financial transactions on behalf of third parties and therefore would be identical on the inclusion principles to the Opponent's *financial affairs* services.

Class 38

34. The Opponent submits that all the services claimed in class 38 fall within the Opponent's telecommunication services protected by the registration. I agree. All the Applicant's services in this class relate to telecommunications and are covered by the Opponent's broad term *telecommunications* in class 38 and are identical.

Class 42

Technical design and planning of telecommunications equipment; technical research services;

35. These services are identical according to *Meric* to the Opponent's *Scientific and technological services and research and design relating thereto; Industrial analysis and research services* in class 42.

Computer software technical support services; technical consultancy relating to the application and use of computer software; creating and maintaining websites

36. These services are akin to support services for creating or maintaining a website or a software product. The expectation is that those who design, develop and rent hardware and software would also provide technical advice and support. Whilst not identical to the Opponent's specification in class 42. I consider that they would be similar to the Opponent's *design and development of computer hardware and software* services to a medium degree overlapping in provider, trade channels and target the same end user.

Graphic design services; technical assessments relating to design;

37. These services are identical according to *Meric* to the Opponent's *designing (graphic arts -); graphic arts designing* services.

Fashion design

38. This service is a broad term encompassing the Opponent's *designing (dress -); dress designing* services and therefore these terms are identical according to *Meric*.

Average consumer and purchasing process

39. The provisional decision made the following findings:

"43. 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. 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.”

44. Where I have found similarity/identity, the goods are, generally speaking, used for computing purposes and the services for telecommunication or technical networking development. For the goods, the average consumer could be a member of the general public purchasing goods for home use, or, alternatively a business user, including IT specialists. The same applies to the class 38 services. However, in respect of the class 42 services, the average consumer is more likely to be a business user.

45. The goods and services are likely to be selected by predominantly visual means, through self-selection, websites and brochures/catalogues. However, this is the sort of area where the average consumer may speak to sales advisors/consultants regarding issues such as compatibility and performance, network requirements etc. Thus, the aural impacts of the marks also play a factor in the selection process. The goods/services will range in price but will include those which are not prohibitively expensive, so, in general, a normal level of care will be used in their selection. That said, the choice of a telecoms provider is likely to be reasonably well considered (greater than the norm), as will the choice of a service provider for the services in class 42.”

40. Despite the broader specifications relied upon I consider that the assessment undertaken previously in relation to the average consumer of the goods and services in classes 9, 38 and 42 are broadly the same. Those same conclusions would therefore apply equally to the goods and services before me. In relation to the class 35 services, I consider the average consumer would be a business user and since choosing the right provider to complement a consumer’s vision is important, I consider

the selection process will be one that is also reasonably considered. The average consumer for the services in class 36 is likely to be both a member of the public and a business user. Since those purchasing property or seeking advice in relation to managing their finances are unlikely to undertake the decision lightly, I consider that a reasonably high considered approach would be taken in the selection of the service provider. Again, both aural and visual considerations would apply through word of mouth recommendations and via self-selection from websites and brochures.

Likelihood of confusion

41. In relation to the global assessment undertaken, the hearing officer, in the provisional decision, concluded as follows:

“55. For the services which I have found no similarity, there can be no finding of a likelihood of confusion. Thus, I will say no more about them.

56. For the goods and the remaining services, I have found some of them to be identical or highly similar, but some have lower degrees of similarity. However, notwithstanding this, I consider there to be a likelihood of confusion in relation to all. The addition of .COM to a word of a high degree of distinctiveness may be something which is overlooked or forgotten given that the average consumer is so used to seeing brands used as part of a corresponding domain names. Even if the difference is noted, the average consumer is well used to associating (economically) the brand and the domain name. This, coupled with the degree of similarity between the goods/service, leads me to conclude that the average consumer will, at the very least, assume all of the goods/services I have found to be similar or identical to be the responsibility of the same or an economically related undertaking.”

42. For clarity where the hearing officer refers to “the goods and the remaining services” these were in relation to all the Applicant’s goods in class 9 and its services as set out below:

Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

Class 42: Technical design and planning of telecommunications equipment; computer software technical support services; technical consultancy relating to the application and use of computer software.

43. In the provisional decision, the hearing officer, found a likelihood of confusion in respect of the goods and services originally under consideration, which he found to be identical or similar. This finding applied even for those goods and services that he determined to be similar only to a low degree. In the decision in suit, the specifications under consideration are different and are wider in scope to those originally relied upon. However, I have found that the contested goods and services in the decision before me, all to be equally identical and similar in varying degrees, and therefore following the same reasoning I come to the same conclusions, for the same reasons. I see no reason to interfere with the hearing officer's decision, other than extending it to apply to all the goods and services as now opposed. I conclude that there is a likelihood of confusion on the same basis. I concur with the hearing officer's previous findings that consumers are accustomed to seeing the addition of ".com" to a word, as a corresponding domain name to the original brand. Therefore, either the ".com" element of the contested mark will be overlooked or if the difference between vivo and vivo.com is noted it would merely lead consumers to conclude that the same or related undertaking would be responsible for both. Even factoring a high level of attention undertaken in the selection process for some of the services, this would not in my view counteract the highly distinctive character of earlier mark 4579.

Conclusion

44. Subject to any successful appeal, the opposition succeeds in full under section 5(2)(b) of the Act. The application is refused against those goods and services listed below:

Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

Class 35: Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; arranging of contracts for the purchase and sale of goods and services, for others; compilation of computer databases; office functions; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

Class 36: Financing services; management of investment funds; investment of funds; capital investment; investment advisory services relating to real estate; raising of capital; financial management and planning; brokerage; portfolio management; real estate affairs; real estate appraisal.

Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

Class 42: Technical design and planning of telecommunications equipment; technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

45. No opposition having been raised in relation to the following goods and services, those as set out below may proceed to registration:

Class 1: Chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing compositions; tempering substances; soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2. Paints; varnishes; lacquers; preservatives against rust; preservatives against deterioration of wood; colorants; mordants; raw natural resins.

Class 4: Industrial oils and greases, lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit); illuminants; candles and wicks for lighting.

Class 7: Robots; aeronautic engines; marine engines; machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.

Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors

Class 21: Household utensils; household containers; glassware for household purposes; tableware of porcelain; earthenware; bone china tableware [other than cutlery].

Class 27: Carpets; rugs; matting; linoleum for use on floors; non-textile wall hangings.

Class 29: Meat; poultry; game; meat extracts; preserved fruits; frozen fruits; dried fruits; cooked fruits; jellies; jams; compotes; eggs; milk; milk products; edible oils and fats; none of these goods being related to fish and seafood.

Class 30: Coffee; tea; cocoa; artificial coffee; rice; tapioca; sago; flour; preparations made from cereals; bread; confectionery; edible ices; sugar, honey, treacle; yeast; baking-powder; salt; mustard; vinegar; sauces [condiments]; spices; ice.

Class 31: Agricultural products not included in other classes; horticultural products not included in other classes; forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants; flowers; foodstuffs for animals; malt; none of these goods being related to fish or seafood.

Class 32: Beers; mineral waters; aerated waters; non-alcoholic beverages; fruit beverages and fruit juices; preparations for making beverages.

Class 40: Waste treatment; waste water treatment; treatment of waste materials; treatment of hazardous materials; treatment of chemical waste; recycling and waste treatment.

Class 41: Production of radio and television shows and programmes; film production services; education, teaching and training; entertainment services; presentation of movies; film distribution; provision of non-downloadable films and television programs via a video-on-demand service; arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

Costs

46. In terms of costs the provisional decision awarded costs to the Opponent on the basis that whilst both parties had achieved a measure of success, the Opponent was the more successful. The relevant paragraph set out the costs as follows:

“60. In terms of costs, I will give a provisional decision now based upon the outcome as it currently stands. If some different outcome applies (due to the earlier mark being refused or being protected for less than it currently covers) I will revise my costs award. My provisional decision is that although both sides have achieved a measure of success, the opponent has been the more successful party and is, therefore, entitled to a contribution towards its costs, albeit a reduced one to reflect the partial nature of its success. My provisional assessment, based upon the published scale, and reduced accordingly, is set out below:

<i>Official fee</i>	£100
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<i>Preparing a statement of case and considering the counterstatement</i>	£150
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<i>Written submissions at evidence stage</i>	£200
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<i>Attending the hearing</i>	£250
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<i>Total</i>	£700”
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47. However, following the amendment to the pleadings the Opponent has succeeded in full. Whilst the Opponent was directed to file amended submissions this was as a direct result of its application, the refusal of which would have resulted in its opposition failing in its entirety as the original IRs as relied upon failed to attain protection. In addition, the Opponent merely filed a table setting out which goods and services it considered to be identical/closely similar without further explanation. Weighing up these matters therefore, I consider it inappropriate to award any further costs to the Opponent since the filing of the additional submissions were to its benefit and did not assist greatly in my assessment.

48. I therefore order Vivo International Limited to pay Vivo Mobile Communication Co Ltd the sum of £700 to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this day of March 2021

Leisa Davies
For the Registrar

Annex A: Applicant's goods and services

Class 1: Chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing compositions; tempering substances; soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2. Paints; varnishes; lacquers; preservatives against rust; preservatives against deterioration of wood; colorants; mordants; raw natural resins.

Class 4: Industrial oils and greases, lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit); illuminants; candles and wicks for lighting.

Class 7: Robots; aeronautic engines; marine engines; machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.

Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors

Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

Class 21: Household utensils; household containers; glassware for household purposes; tableware of porcelain; earthenware; bone china tableware [other than cutlery].

Class 27: Carpets; rugs; matting; linoleum for use on floors; non-textile wall hangings.

Class 29: Meat; poultry; game; meat extracts; preserved fruits; frozen fruits; dried fruits; cooked fruits; jellies; jams; compotes; eggs; milk; milk products; edible oils and fats; none of these goods being related to fish and seafood.

Class 30: Coffee; tea; cocoa; artificial coffee; rice; tapioca; sago; flour; preparations made from cereals; bread; confectionery; edible ices; sugar, honey, treacle; yeast; baking-powder; salt; mustard; vinegar; sauces [condiments]; spices; ice.

Class 31: Agricultural products not included in other classes; horticultural products not included in other classes; forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants; flowers; foodstuffs for animals; malt; none of these goods being related to fish or seafood.

Class 32: Beers; mineral waters; aerated waters; non-alcoholic beverages; fruit beverages and fruit juices; preparations for making beverages.

Class 35: Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; arranging of contracts for the purchase and sale of goods and services, for others; compilation of computer databases; office functions; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

Class 36: Financing services; management of investment funds; investment of funds; capital investment; investment advisory services relating to real estate; raising of capital; financial management and planning; brokerage; portfolio management; real estate affairs; real estate appraisal.

Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

Class 40: Waste treatment; waste water treatment; treatment of waste materials; treatment of hazardous materials; treatment of chemical waste; recycling and waste treatment.

Class 41: Production of radio and television shows and programmes; film production services; education, teaching and training; entertainment services; presentation of movies; film distribution; provision of non-downloadable films and television programs

via a video-on-demand service; arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

Class 42: Technical design and planning of telecommunications equipment; technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

Annex B: Opponent's goods and services

Class 9: Scientific, nautical, surveying, electrical, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Automatic vending machines and mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Software for computer; Fire-extinguishing apparatus.

Class 35: Advertising; Commercial business management in the field of telecommunications; Commercial administration in the field of telecommunications; Office functions.

Class 36: Financial affairs; Monetary affairs; Real estate affairs; Information about telecommunication; rental of facsimile apparatus; rental of message sending apparatus; rental of modems; rental of telecommunication equipment; rental of telephones; sending apparatus (rental of message-); telecommunication (information about-).

Class 38: Communications and telecommunications, telecommunications by fixed and mobile telephones, telecommunications by satellite, providing telecommunication connections to the Internet or databases; Computer aided transmission of data, messages and images; Transmission of news and current affairs information; Providing chat-line services; Providing on-line access to exhibitions; provision and operation of electronic conferencing, discussion groups and chat rooms; Voice telephony; Telecommunications consultancy; Rental of telecommunication equipment; Providing access to search engines.

Class 41: Education and instruction; Games services provided on-line from a computer network.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Telecommunication database services, namely enabling the consumer to download digital content from a network and server to his

individual database; Authenticating works of art; cloud seeding; computer hardware (consultancy in the field of -); computer rental; conversion of data or documents from physical to electronic media; design services(packaging -); designing (dress -); designing (graphic arts -); dress designing; graphic arts designing; packaging design; rental (computer -); rental of computer software; rental of web servers; servers (rental of web -); software (rental of computer -); works of art (authenticating -).