

**O/123/18**

**TRADE MARKS ACT 1994**

**INTERNATIONAL TRADE MARK REGISTRATION NO. 1340015  
IN THE NAME OF XIAOMI SINGAPORE PTE LTD  
TO REGISTER THE TRADE MARK**

**MIHOME**

**IN CLASSES 7, 9, 11, 35 AND 42**

**AND**

**THE OPPOSITION THERETO UNDER NO. 600000691  
BY SANDAL PLC**

## Background and pleadings

1. Xiaomi Singapore Pte. Ltd (“the holder”) requested protection in the UK for international trade mark registration 1340015 on 14 November 2016. The trade mark concerned is:

# MIHOME

2. The international registration covers a wide range of goods and services in classes 7, 9, 11, 35 and 42. The request for protection was published in the UK *Trade Marks Journal* on 7 July 2017, following which it was opposed by Sandal Plc (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), using the fast track procedure. The opponent relies on the following earlier UK trade mark registration, registered for goods and services in classes 9, 11 and 37:

3076025

The logo for MiHome, featuring the word "Mi" in a bold, sans-serif font, followed by a vertical line, and then the word "Home" in a lighter, sans-serif font.

Filing date: 8 October 2014; date of completion of registration procedure: 7 August 2015.

3. The opponent claims that there is a likelihood of confusion owing to the high degree of similarity between the marks and identity or similarity between the goods and services. The holder denies the claim.

4. Both sides are professionally represented. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

5. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions which I have read and taken into account in making this decision.

## **Decision**

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

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

(a) ....

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

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

7. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik*

*Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly 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

8. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated, at paragraph 23 of its judgment:

“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.”

9. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...".

10. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

11. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

12. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court ("GC") stated that:

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

14. The competing specifications are:

Earlier mark	Later mark
	<p><i>Class 7: Agitators; mixers (machines); dishwashers; grinding machines; electric blenders; electric kitchen machines; electric fruit presses for household use; soybean reaping cutters (machines); industrial washing machines; washing machines for household purposes; washing machines incorporating drying facilities; ironing machines; industrial robots; knives (parts of machines); knife blades for electric knives; knife sharpeners (electric); mills (machines); industrial cleaning machines; electric cleaning machines; carpet cleaning machines; apparatus for the removal of dust from buildings; electric dust removing (cleaning) apparatus; dust removing</i></p>

Class 9: *Electric control apparatus, systems, devices and installations; programmable control apparatus; remote control apparatus; remote controlled, radio controlled and programmable sockets and extension leads; sockets; wireless controlled sockets and light switches; light switches; energy monitors; adapters; energy control devices; devices for measuring energy; energy regulators; computer software for use in meter reading, monitoring and reporting; apparatus, equipment and instruments for measuring energy efficiency: interactive computer software accessible on computers and via mobile telephones; mobile phone applications; wireless communication apparatus; mobile data communications apparatus; data transmitting apparatus; hubs for routers; convertor plugs; chargers; accumulators; batteries; radiator valves, being temperature monitoring and controlling valves; wireless controlled radiator valves being temperature monitoring and controlling valves.*

*installations for cleaning purposes; dust separators; dust filters and bags for vacuum cleaners; air filters being parts of engines; machines for manufacturing air filter elements; filters (parts of machines or engines); apparatus (machines) for filtering; filter presses; filters for industrial purposes; central vacuum cleaning apparatus.*

Class 9: *Computer storage apparatus; computer apparatus; computer programmes (programs), recorded; keyboards; computer operating programs, recorded; computer peripheral equipment; computer software; computer software (recorded); monitors (computer hardware); computer monitoring apparatus; computer monitoring instruments; computer mouse; data processing equipment; optical data media; optical disks; central processing units; scanners (data processing equipment); electronic cards; notebook computers; electronic publications (downloadable); computer programs (downloadable software); computer game software; downloadable ring tones for mobile phones; downloadable music files; downloadable image files; USB flash drives; portable computers; counters; time recording apparatus; electronic timers; detectors; photocopiers (photographic, electrostatic, thermic); mobile or portable fax machine; fax devices; scales; measuring apparatus and instruments; gauges; electronic bulletin board apparatus; telephone handsets; apparatus for navigation; navigational instruments; radiotelegraphy sets;*



*telegraphic apparatus; radio apparatus; radio receivers; radio control units; radios; telephones; video phones; satellite navigational apparatus; hands free kits for phones; global positioning system (GPS) apparatus; mobile phones for use in vehicles; cell phones; telephone sets; tape recorders; audio amplifiers; video receivers; headsets for telephones; headsets for use with computers; wireless headsets for smartphones; anti-dust headsets; loud speakers; apparatus for sound transmission; sound recording devices; recording devices for sound and image carriers; time clocks (time recording devices); speakers (audio equipment); cameras; portable media players; video recording apparatus; video cameras; cameras (photography); slide projectors; photographic projectors for slides; photographic slides; slide framing apparatus; slide projection lenses; slide film mounts; pressure gauges; dynamometers; optical instruments, other than for medical use; stereoscopes; video monitors; remote control apparatus; electronic measuring devices for telephone lines; automatic test instruments for monitoring telephone lines; electric wires; silicon wafers; semi-conductors; sensor apparatus, other than for medical use; electric control apparatus; electrical anti-theft devices, other than for vehicles; anti-theft warning devices; burglar alarms; optical glasses; glasses adapted to protect the eyes; sunglasses; batteries; battery chargers; vehicle batteries; animated cartoons; regulated power supply apparatus; on-off*

*Class 11: Apparatus and installations for heating and lighting; lamps; LED lighting; radiator valves.*

*sensors; light regulators (dimmers), electric; plugs, sockets and other contacts (electric connections); temperature indicators; electric sensors; meters; instruments for measuring pressure; simulators for driving or control of vehicles.*

*Class 11: Electric lamps; lighting lamps; lighting apparatus and installations; lighting devices for showcases; lampshades; flashlights; safety lamps; lighting installations for air vehicles; vehicle lighting apparatus; motor vehicle lamps; lamps; electric cookers; cooking apparatus and installations; electric pressure cookers; electric kettles; water heaters; freezers; refrigerators; refrigeration installations; refrigeration units; refrigerator deodorizing units; pocket torches, electric; toasters; air purification apparatus; air conditioning apparatus; air filtration installations; air cooling apparatus; air dryers; air-conditioning fans; clothes dryers; dryers for the hands using a warm air drying stream; drying apparatus; electric heaters; water filter apparatus; gas purification apparatus; ionizers for the treatment of air or water; machines for the processing (purification) of sewage; apparatus for water purification; fabric steamers; heaters for heating irons; ventilating fans; axial fans; air humidifier; electric heating apparatus; automatic faucets; water distributing apparatus (automatic); water installations (automatic); automatic flushing installations for urinals; toilet stool units with a washing water squirter; toilets with washing functions;*

*Class 37: Installation maintenance and repair of apparatus for heating and lighting; installation of heating and lighting control apparatus; installation of communications networks instruments; information, advisory and consultancy services relating to the foregoing.*

*automatic watering installations; bathroom fixtures; bathroom installations; bath fittings; portable electric heater; lighters; electric hair dryers; drying apparatus and installations.*

*Class 35: Advertising; advertising agency services; online advertising on a computer network; presentation of goods on communication media, for retail purposes; placing of advertisements; preparation of advertisements; cost analysis; business information agency services; business management and organization consultancy; market analysis; business evaluation services; business research; provision of business information; arranging exhibitions for commercial purposes; arranging exhibitions for advertising purposes; commercial information and advice for consumers (consumer advice shop); provision of assistance (business) in the establishment of franchises; administration of the business affairs of franchises; import and export agencies; on-line trading services in which seller posts products to be auctioned and bidding is done via the Internet marketing; arranging and concluding commercial transactions for others; computer file management; data processing; compilation of information into computer databases; database management; data retrieval; accounting; account auditing; sponsorship search.*

*Class 42: Technical research; biotechnology research; research and development of new*

	<p><i>products for others; scientific research and development; scientific laboratory services; quality control; building and structural inspection services (engineering, quality assessment, and surveying services); calibration (measuring); measurement services; meteorological information; material testing; mechanical research; industrial design; packaging design; interior design; fashion design; computer programming; computer software consultancy; updating of computer software; providing information, including online, about design and development of computer hardware and software; rental and maintenance of computer software; rental of computer hardware; rental of computers; recovery of computer data; development of computer system; advisory services relating to computer system analysis; computer systems integration services; computer systems design; copying of computer software; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; installation of computer software; rental of web servers; rental of a database server (to third parties); computer virus protection services; provision of Internet search engines; digitization of documents (scanning); monitoring of computer systems by remote access; product quality evaluation; quality control of goods; graphic art design.</i></p>
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### Class 7 goods

15. The opponent submits that the holder's class 7 goods are similar to its class 11 goods because such goods are commonly sold alongside each other and share distribution channels, being 'white goods'. This is rather like saying that goods sold in a supermarket are similar because they share channels of trade. It is too high a level of generality. None of the goods in class 7 share nature or purpose with any of the earlier goods or services, and they are not complementary or in competition.

16. The opponent submits that the class 7 goods are similar to its computer software (class 9) on the basis that they are increasingly integrated with software. The opponent submits that manufacturers of appliances produce and offer integrated software. Firstly, there is no evidence of this. Secondly, the opponent's submission would mean that software is similar to cars, because cars contain software. Even if a manufacturer of white goods makes software to put in its white goods, it is not offering software to the consumer. There is no similarity here<sup>1</sup>. The opponent also submits that its *adapters; chargers* and *batteries* are similar to some of the holder's class 7 goods, in particular those which are standalone or portable, such as cordless vacuum cleaners, because they are indispensable for their functioning. It submits that they are sold alongside one another. There is no evidence that is so; in my experience, they are sold as part and parcel of the appliance.

17. I find that the goods in class 7 are not similar to the opponents' goods and services.

### Class 9 goods

18. The holder's *computer programmes (programs), recorded; computer operating programs, recorded; computer software; computer software (recorded); computer programs (downloadable software)* are identical to the opponent's 'computer software for use in meter reading, monitoring and reporting'.

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<sup>1</sup> See In *Les Editions Albert René v OHIM*, Case T-336/03, and *Commercy AG v OHIM* Case T-316/07.

19. The holder's *computer game software* is identical to the opponent's 'interactive computer software accessible on computers and via mobile telephones.'

20. The holder's *counters; measuring apparatus and instruments; gauges; dynamometers; meters;* are identical to the opponent's 'devices for measuring energy' and 'computer software for use in meter reading, monitoring and reporting.' *Time recording apparatus; electronic timers; time clocks (time recording devices); detectors; electric sensors; sensor apparatus, other than for medical use; temperature indicators; pressure gauges; instruments for measuring pressure; on-off sensors* are similar to a good degree to the opponent's 'devices for measuring energy', 'energy control devices' and 'computer software for use in meter reading, monitoring and reporting'. The holder's goods are parts of such devices, and share the nature and purpose of sensing and controlling. They will share similar distribution channels. The holder's *measuring devices for telephone lines; automatic test instruments for monitoring telephone lines* are similar in nature to 'computer software for use in meter reading, monitoring and reporting' as the goods will incorporate measuring functionality in order for meters to be read and monitored. They are also likely to share distribution channels. They are moderately similar.

21. The holder's *electric control apparatus; remote control apparatus; simulators for driving or control of vehicles* are identical to the opponent's 'electric control apparatus'.

22. The holder's *batteries; battery chargers; vehicle batteries* are identical to the opponent's 'chargers' and 'batteries'.

23. The holder's *regulated power supply apparatus; light regulators (dimmers), electric; plugs, sockets* are identical to the opponent's 'wireless controlled sockets and light switches' and 'converter plugs'.

24. The holder's *computer storage apparatus; computer apparatus; keyboards; computer peripheral equipment; monitors (computer hardware); computer monitoring apparatus; computer monitoring instruments; computer mouse; data processing*

*equipment; optical data media; optical disks; central processing units; scanners (data processing equipment); electronic cards; notebook computers; USB flash drives; portable computers* are all computer hardware. Although nature and purpose differ, computer software and hardware are highly complementary to one another, and it is common for computers, peripherals and software to share channels of trade. These goods share a moderate level of similarity.

25. The opponent has cover for mobile phone applications. It is common to access different types of media via applications. There is a degree of shared trade channels with the holder's *electronic publications (downloadable); downloadable ring tones for mobile phones; downloadable music files; downloadable image files*. There is a low degree of similarity between these goods.

26. The holder's *mobile or portable fax machine; fax devices; electronic bulletin board apparatus* are covered by, and are therefore identical to, the opponent's 'mobile data communications apparatus; data transmitting apparatus.' The opponent's goods are also moderately similar to the holder's *photocopiers (photographic, electrostatic, thermic)*. They are not identical because the average consumer would not describe a photocopier as data transmitting apparatus. However, modern photocopiers have fax and scanning functionality, so there is some similarity in purpose and method of use with data transmitting apparatus.

27. The opponent's 'wireless communication apparatus' is a wide term. It covers the holder's *telephone handsets; apparatus for navigation; navigational instruments; radiotelegraphy sets; telegraphic apparatus; radio apparatus; radio receivers; radios; telephones; video phones; satellite navigational apparatus; radio control units; wireless headsets for smartphones hands free kits for phones; global positioning system (GPS) apparatus; mobile phones for use in vehicles; cell phones; telephone sets; headsets for telephones; headsets for use with computers; anti-dust headsets*. 'Communication' implies a two-way process. The holder's *video receivers, tape recorders; audio amplifiers; loud speakers; apparatus for sound transmission; sound recording devices; recording devices for sound and image carriers; speakers (audio equipment); portable media players; video recording apparatus; stereoscopes; video*

*monitors*; are all used in communication, without being the complete means for effecting communication. They are similar to the opponent's 'wireless communication apparatus' because they share similar nature, purpose, methods of use, are complementary to communications apparatus and share trade channels.

28. The opponent submits that the holder's *electrical anti-theft devices, other than for vehicles; anti-theft warning devices; burglar alarms* are highly similar to its 'electric control apparatus, systems, devices and installations; programmable control apparatus'. The opponent's term is wide and covers security/intruder alert systems. The goods are identical.

29. In relation to the holder's *cameras; video cameras; cameras (photography); slide projectors; photographic projectors for slides; photographic slides; slide framing apparatus; slide projection lenses; slide film mounts*, it is not apparent to me why they are similar to any of the opponent's goods and services. The opponent submits that the goods are similar to its adapters, chargers and batteries because they are indispensable for their functioning. This is the same argument as above, in relation to the class 7 goods. All electrical goods require a power source of some description, but that does not make them similar goods.

30. The remaining class 9 goods in the international registration are *scales; electric wires; silicon wafers; semi-conductors; other contacts (electric connections); optical instruments, other than for medical use; optical glasses; glasses adapted to protect the eyes; sunglasses; animated cartoons*. These do not appear to be similar to the opponent's goods and services on any level.

#### Class 11 goods

31. The following goods in the international registration are identical to goods covered by the opponent's class 11 specification: *electric lamps; lighting lamps; lighting apparatus and installations; lighting devices for showcases; lampshades; flashlights; safety lamps; lighting installations for air vehicles; vehicle lighting*



*apparatus; motor vehicle lamps; lamps; pocket torches, electric; electric heaters; electric heating apparatus; portable electric heaters.*

32. The average consumer would consider the term 'heating' to mean the heating of the ambient temperature, for example, central heating, domestic fires or portable heating. However, "apparatus and installations for heating" goes wider, in my view, and encompasses the holder's *water heaters*; the simple purpose of which is to heat water. Domestic immersion heaters are closely connected to domestic central heating systems. If I am wrong about that, and the goods are not identical, they are similar to a high degree.

33. Although electric kettles also heat water, they are not heating apparatus, in the normal usage of that term, and heaters for irons would not be regarded as heating apparatus, but as part of an iron. The various types of dryers in the holder's specification also heat up in order to provide their drying function, but they are not heaters *per se*. Consequently, there is no meaningful similarity between the opponent's goods and services and the holder's *electric kettles; air dryers; clothes dryers; dryers for the hands using a warm air drying stream; drying apparatus; heaters for heating irons; electric hair dryers; drying apparatus and installations.*

34. There is also no meaningful similarity between the earlier goods and services and the following of the holder's goods: *electric cookers; cooking apparatus and installations; electric pressure cookers; toasters; lighters.* Although these goods work by producing heat, they are cooking apparatus, not heating apparatus. They do not share nature, purpose or methods of use; are not complementary and are not in competition.

35. The remaining goods are for treating air, steaming fabric, water installations and apparatus for cooling: *freezers; refrigerators; refrigeration installations; refrigeration units; refrigerator deodorizing units; air purification apparatus; air conditioning apparatus; air filtration installations; air cooling apparatus; air-conditioning fans; water filter apparatus; gas purification apparatus; ionizers for the treatment of air or water; machines for the processing (purification) of sewage; apparatus for water*

*purification; fabric steamers; ventilating fans; axial fans; air humidifier; automatic faucets; water distributing apparatus (automatic); water installations (automatic); automatic flushing installations for urinals; toilet stool units with a washing water squirter; toilets with washing functions; automatic watering installations; bathroom fixtures; bathroom installations; bath fittings.* These are not similar to the opponent's goods and services.

#### Class 35

36. These are all business services and are not similar to any of the earlier goods and services.

#### Class 42

37. The opponent's 'installation of communications networks instruments' is similar to a moderate degree to the holder's *rental and maintenance of computer software; rental of computer hardware; rental of computers.* This is because communications network instruments are likely to be, or incorporate, computer hardware. There is a degree of complementarity, as to install the network instruments it is necessary to supply the hardware itself. There is also a shared trade channel aspect to the comparison.

38. The opponent's 'computer software for use in meter reading, monitoring and reporting; interactive computer software accessible on computers and via mobile telephones; mobile phone applications' are moderately similar to the holder's *computer programming; computer software consultancy; updating of computer software; providing information, including online, about design and development of computer hardware and software; recovery of computer data; development of computer systems; advisory services relating to computer system analysis; computer systems integration services; computer systems design; copying of computer software; installation of computer software; computer virus protection services; monitoring of computer systems by remote access; provision of Internet search engines.* The opponent's 'interactive computer software accessible on computers

and via mobile telephones; mobile phone applications' are unlimited as to subject matter. There is a degree of complementarity between the development, installation and maintenance of software and the software itself. There are shared channels of trade; for example, consumers will expect an app providing virus protection to be kept up to date by the app provider.

39. The holder's *calibration (measuring); measurement* services are complementary to the opponent's 'devices for measuring energy', and share the same purpose. They are similar to a moderate degree.

40. There is no meaningful similarity with the remainder of the holder's class 42 services, within the parameters of the caselaw: *technical research; biotechnology research; research and development of new products for others; scientific research and development; scientific laboratory services; quality control; building and structural inspection services (engineering, quality assessment, and surveying services); meteorological information; material testing; mechanical research; industrial design; packaging design; interior design; fashion design; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; rental of web servers; rental of a database server (to third parties); digitization of documents (scanning); product quality evaluation; quality control of goods; graphic art design.*

#### Average consumer

41. 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.*

42. The average consumer for the parties' goods and services will be the general public and commercial users. Many of the goods will be technical, expensive and goods which are expected to last for a considerable time after installation. There will



be a range of degrees of attention paid to the purchasing process, accordingly, from average to a close degree. The purchase will be primarily visual, after research has been conducted on websites, from brochures and from packaging. There may also be an aural aspect to the purchase if advice is sought from sales operatives.

Comparison of marks

43. 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 Court of Justice of the European Union 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.”

44. 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. The respective marks are:

Opponent	Holder
	

45. The overall impressions of both marks are dominated by the letters MIHOME (this is the only component of the holder's mark). The main visual differences between the marks are that the earlier mark has a thin green vertical line between the 'i' and the 'H', and that the letters Mi in the earlier mark are emboldened compared to the word HOME. These differences are relatively minor and do little to put a visual distance between the marks, which both consist of the same letters in the same sequence. They are visually highly similar.

46. Home is a common English word. Mi is not an English word and, in the UK, could be pronounced as the English words 'me' or 'my'. The parties' marks could, therefore, be either identical or highly similar aurally.

47. The slight separation between the Mi and Home elements in the earlier mark, created by the thin vertical line and the emboldened Mi, highlights the word 'home'. The average UK consumer reads word marks from left to right. Since 'home' is a known word, the natural propensity is to make sense of the element that comes before it, Mi. Although Mi is not a dictionary word, as an element separate to 'home' it is likely to be approximated to the word My by the average UK consumer. This creates the concept of 'my home'. Depending on the pronunciation of the later mark, the concept will either be identical (my home) or will be reasonably similar, as the mark will be pronounced as 'me home'. Home is a recognisable concept in both marks.

48. Putting the variables together, the marks are either conceptually identical, or they are similar to a good degree. Overall, the marks are highly similar.

#### Distinctive character of the earlier mark

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>2</sup> the CJEU stated that:

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<sup>2</sup> Case C-342/97.

“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).”

50. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its trade mark to consider. Although ‘my home’ is not very distinctive for goods and services for use in, or which relate to, the home, the mark is not actually the words ‘my home’, although the components are evocative of this meaning. The inherent distinctive character of the mark is average for the registered goods and services.

#### Likelihood of confusion

51. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping

in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). Where there is no similarity, there can be no likelihood of confusion. This means that the opposition fails in respect of the goods and services for which I found no similarity.

52. Taking all the relevant factors into account, I find that there is a likelihood of confusion in relation to all the goods and services which I have found to be identical and similar, to whatever degree. The marks are highly similar and, depending on interpretation, almost identical. This means that, taking into account the interdependency principal, there is a greater chance of imperfect recollection than if the marks had been more different to one another.

## **Outcome**

53. Protection is refused for the following goods and services:

*Class 9: computer programmes (programs), recorded; computer operating programs, recorded; computer software; computer software (recorded); computer programs (downloadable software); computer game software; counters; measuring apparatus and instruments; gauges; dynamometers; meters; Time recording apparatus; electronic timers; time clocks (time recording devices); detectors; electric sensors; sensor apparatus, other than for medical use; temperature indicators; pressure gauges; instruments for measuring pressure; on-off sensors; measuring devices for telephone lines; automatic test instruments for monitoring telephone lines; electric control apparatus; remote control apparatus; simulators for driving or control of vehicles; batteries; battery chargers; vehicle batteries; regulated power supply apparatus; light regulators (dimmers), electric; plugs, sockets; computer storage apparatus; computer apparatus; keyboards; computer peripheral equipment;*

*monitors (computer hardware); computer monitoring apparatus; computer monitoring instruments; computer mouse; data processing equipment; optical data media; optical disks; central processing units; scanners (data processing equipment); electronic cards; notebook computers; USB flash drives; portable computers; electronic publications (downloadable); downloadable ring tones for mobile phones; downloadable music files; downloadable image files; mobile or portable fax machine; fax devices; electronic bulletin board apparatus; photocopiers (photographic, electrostatic, thermic); telephone handsets; apparatus for navigation; navigational instruments; radiotelegraphy sets; telegraphic apparatus; radio apparatus; radio receivers; radios; telephones; video phones; satellite navigational apparatus; radio control units; wireless headsets for smartphones hands free kits for phones; global positioning system (GPS) apparatus; mobile phones for use in vehicles; cell phones; telephone sets; headsets for telephones; headsets for use with computers; anti-dust headsets; video receivers, tape recorders; audio amplifiers; loud speakers; apparatus for sound transmission; sound recording devices; recording devices for sound and image carriers; speakers (audio equipment); portable media players; video recording apparatus; stereoscopes; video monitors; electrical anti-theft devices, other than for vehicles; anti-theft warning devices; burglar alarms.*

*Class 11: electric lamps; lighting lamps; lighting apparatus and installations; lighting devices for showcases; lampshades; flashlights; safety lamps; lighting installations for air vehicles; vehicle lighting apparatus; motor vehicle lamps; lamps; pocket torches, electric; electric heaters; electric heating apparatus; portable electric heaters; water heaters.*

*Class 42: rental and maintenance of computer software; rental of computer hardware; rental of computers; computer programming; computer software consultancy; updating of computer software; providing information, including online, about design and development of computer hardware and software; recovery of computer data; development of computer systems; advisory services relating to computer system analysis; computer systems integration services; computer systems design; copying of computer software; installation of computer software; computer virus protection services; monitoring of computer systems by remote*



*access; provision of Internet search engines; calibration (measuring); measurement services.*

54. The international registration may be protected for:

*Class 7: Agitators; mixers (machines); dishwashers; grinding machines; electric blenders; electric kitchen machines; electric fruit presses for household use; soybean reaping cutters (machines); industrial washing machines; washing machines for household purposes; washing machines incorporating drying facilities; ironing machines; industrial robots; knives (parts of machines); knife blades for electric knives; knife sharpeners (electric); mills (machines); industrial cleaning machines; electric cleaning machines; carpet cleaning machines; apparatus for the removal of dust from buildings; electric dust removing (cleaning) apparatus; dust removing installations for cleaning purposes; dust separators; dust filters and bags for vacuum cleaners; air filters being parts of engines; machines for manufacturing air filter elements; filters (parts of machines or engines); apparatus (machines) for filtering; filter presses; filters for industrial purposes; central vacuum cleaning apparatus.*

*Class 9: Cameras; video cameras; cameras (photography); slide projectors; photographic projectors for slides; photographic slides; slide framing apparatus; slide projection lenses; slide film mounts, scales; electric wires; silicon wafers; semi-conductors; other contacts (electric connections); optical instruments, other than for medical use; optical glasses; glasses adapted to protect the eyes; sunglasses; animated cartoons.*

*Class 11: Electric kettles; air dryers; clothes dryers; dryers for the hands using a warm air drying stream; drying apparatus; heaters for heating irons; electric hair dryers; drying apparatus and installations electric cookers; cooking apparatus and installations; electric pressure cookers; toasters; lighters; freezers; refrigerators; refrigeration installations; refrigeration units; refrigerator deodorizing units; air purification apparatus; air conditioning apparatus; air filtration installations; air cooling apparatus; air-conditioning fans; water filter apparatus; gas purification apparatus; ionizers for the treatment of air or water; machines for the processing*

*(purification) of sewage; apparatus for water purification; fabric steamers; ventilating fans; axial fans; air humidifier; automatic faucets; water distributing apparatus (automatic); water installations (automatic); automatic flushing installations for urinals; toilet stool units with a washing water squirter; toilets with washing functions; automatic watering installations; bathroom fixtures; bathroom installations; bath fittings.*

*Class 35: Advertising; advertising agency services; online advertising on a computer network; presentation of goods on communication media, for retail purposes; placing of advertisements; preparation of advertisements; cost analysis; business information agency services; business management and organization consultancy; market analysis; business evaluation services; business research; provision of business information; arranging exhibitions for commercial purposes; arranging exhibitions for advertising purposes; commercial information and advice for consumers (consumer advice shop); provision of assistance (business) in the establishment of franchises; administration of the business affairs of franchises; import and export agencies; on-line trading services in which seller posts products to be auctioned and bidding is done via the Internet marketing; arranging and concluding commercial transactions for others; computer file management; data processing; compilation of information into computer databases; database management; data retrieval; accounting; account auditing; sponsorship search.*

*Class 42: Technical research; biotechnology research; research and development of new products for others; scientific research and development; scientific laboratory services; quality control; building and structural inspection services (engineering, quality assessment, and surveying services); meteorological information; material testing; mechanical research; industrial design; packaging design; interior design; fashion design; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; rental of web servers; rental of a database server (to third parties); digitization of documents (scanning); product quality evaluation; quality control of goods; graphic art design.*

## **Costs**

55. As both parties have achieved a roughly equal measure of success, I order each party to bear its own costs.

**Dated this 22<sup>nd</sup> day of February 2018**

**Judi Pike**

**For the Registrar,  
the Comptroller-General**