

O-444-19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3360494
BY IDEA EVOLUTION CO., LIMITED
TO REGISTER:**

TAURI

AS A TRADE MARK IN CLASS 9

AND

**OPPOSITION THERETO (UNDER NO. 600001060) BY
DBI INNOVATIONS GROUP LIMITED**

Background and pleadings

1. The subject proceedings relate to an opposition against the registration of the above trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on one earlier mark, UK registration no. 31655554. Consequently, the question to be determined is whether there is a likelihood of confusion between the following marks:

The application	The earlier mark
<p style="text-align: center; font-size: 2em; font-weight: bold;">TAURI</p>	
<p>Class 9: Mobile telephone and Tablet PC accessories, namely, leather cases, non-leather cases, vinyl cases, plastic snap-on cases, batteries and battery chargers, cables and replacement housings; mobile computer accessories, namely, leather cases, non-leather cases, vinyl cases, plastic snap-on cases, and protective display screen covers, batteries and battery chargers, cables; Carrying cases and bags specially adapted for consumer electronics, namely, notebook computers, laptop computers, MP3 players, digital cameras, smartphones, PC tablets, portable telephones and computers; Battery cases; Battery packs; Mobile power pack, namely, battery packs for mobile telephones; Screen protectors for cell phones and</p>	<p>Class 9: Phone covers [specifically adapted]; Phone extension jacks; Phone extension leads; Phone plugs; Mobile phone straps; Mobile telephone batteries; Mobile telephones; Mobile data receivers; Mobile communication terminals; Mobile data apparatus; Mobile data communications apparatus; Mobile radio receiving apparatus; Mobile radio transmitting apparatus; Mobile telecommunications apparatus; Mobile phones; Mobile or portable fax machines; Mobile telephone apparatus with built-in facsimile systems; Mobile phone docking stations; Mobile High-Definition Link (MHL) cables; Mobile telephone covers made of cloth or textile materials; Mobile telephone cases made of leather or imitations of leather.</p>

tablet computers; Protective screen film for cell phones and portable electronic devices.	
Filed on 13 December 2018	Filed on 19 May 2016 Registered on 2 September 2016
Applicant: Idea Evolution Co., Limited	Opponent: DBI Innovations Group Limited

2. The opponent used the fast track opposition procedure.

3. 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.

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

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. Neither side requested a hearing. The opponent filed written submissions. I note that in its submissions the opponent referred to matters which would have constituted evidence of fact, e.g. references to its brand history, where it sells its goods and Google search results. This is not material that can be taken into account in submission. Absent leave being sought in these fast track proceedings to file evidence, such material forms no part in the decision I come to make. The only other submission made was that the marks have the same component (TAURI) and that the goods are similar.

6. The opponent has represented itself. The applicant has been represented by Katarzyna Eliza Binder-Sony.

Decision

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

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

...

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

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

8. An “earlier trade mark” is defined in section 6 of the Act:

6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

9. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the earlier mark was registered within the five years before the date on which the applicant’s mark was filed (it having no priority date), it is not subject to proof of use (section 6A refers). The opponent is therefore entitled to rely upon its mark for all the goods for which it is registered.

Section 5(2)(b) case law

10. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*(Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v OHIM* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05P) and *Bimbo SA v OHIM* (Case C-591/12P):

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer 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

11. All relevant factors relating to the goods/services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”), Case C-39/97, 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.”

12. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“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..”

14. The earlier mark covers the following goods:

Class 9: Phone covers [specifically adapted]; Phone extension jacks; Phone extension leads; Phone plugs; Mobile phone straps; Mobile telephone batteries; Mobile telephones; Mobile data receivers; Mobile communication terminals; Mobile data apparatus; Mobile data communications apparatus; Mobile radio receiving apparatus; Mobile radio transmitting apparatus; Mobile telecommunications apparatus; Mobile phones; Mobile or portable fax machines; Mobile telephone apparatus with built-in facsimile systems; Mobile phone docking stations; Mobile High-Definition Link (MHL) cables; Mobile telephone covers made of cloth or textile materials; Mobile telephone cases made of leather or imitations of leather.

15. I break the applied for goods down as follows:

Mobile telephone and Tablet PC accessories, namely, leather cases, non-leather cases, vinyl cases, plastic snap-on cases, batteries and battery chargers, cables and replacement housings

16. The earlier mark covers covers and batteries, albeit for phones. I consider a case and cover to be interchangeable terms. Therefore, the cases and batteries for mobile phones are identical to goods covered by the earlier mark. In terms of cases and batteries for tablet PCs, they are very similar in nature, purpose and channels of trade. They are highly similar, even if those for a tablet PC would not fit a mobile phone. In terms of battery chargers, these are similar to the opponent's goods (particularly batteries) as they will be sold through the same trade channels and have a complementary relationship. In terms of cables, the opponent's goods cover forms of cable which could be used for mobile devices – the goods are considered identical. Finally, there are replacement housings for mobiles phones and tablet PCs, which I consider to have at least a medium degree of similarity to mobile phones themselves (as covered by the earlier mark) and tablet PCs (which would be covered by the earlier mark's mobile data communication apparatus) – they are similar because they are in integral part and could be sold as a replacement part if they are damaged – it is inevitable that the consumer would believe the undertaking of one being responsible for the other.

Mobile computer accessories, namely, leather cases, non-leather cases, vinyl cases, plastic snap-on cases, and protective display screen covers, batteries and battery chargers, cables

17. A mobile computer could be a tablet PC or, indeed, something akin to a phone, so the cases and batteries are at least highly similar to the covers and batteries of the earlier mark. I have already commented upon the chargers and their similarity to the opponent's batteries – the same applies here. The same finding as above in relation to cables also applies here. That leaves the protective screen covers. Whilst the opponent's goods do not explicitly mention such items, the specification does contain covers – this means that there is some similarity in purpose (to protect the electronic devices), are likely to be sold through the same channels, and have a degree of complementarity. There is a medium degree of similarity.

Carrying cases and bags specially adapted for consumer electronics, namely, notebook computers, laptop computers, MP3 players, digital cameras, smartphones, PC tablets, portable telephones and computers

18. Cases and bags specifically for such items are designed for the items in question. There is clearly a high degree of similarity with covers for smartphones and portable telephones on account of the similar purpose and channels of trade. There is at least a medium degree of similarity with cases/bags for PC tablets and portable/laptop computers. There is less similarity with bags/cases for MP3 players and digital cameras but still some (albeit of a low degree).

Battery cases

19. There is a degree (medium) of similarity with the opponent's batteries. The goods will likely be sold through the same trade channels and the consumers will see a complementary relationship

Battery packs; mobile power pack, name battery packs for mobile telephones

20. The opponent's goods cover batteries, which could be in pack form. The goods are identical, or if not highly similar.

Screen protectors for cell phones and tablet computers; protective screen film for cell phones and portable electronic devices

21. I have already commented on the above (see paragraph 17). There is a medium degree of similarity.

Average consumer and the nature of the purchasing act

22. In accordance with the case law cited in paragraph 10, I must determine who is the average consumer and the nature of the purchasing act. 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 in question¹.

23. The goods are likely to be purchased by the general public, seeking parts and accessories for mobile phones, tablets, and other consumer electronics. Some care will be taken to ensure compatibility of the part/accessory with the device to which it is to be fitted, and to the style of product etc. None of the goods strike me as everyday purchases, although their cost is unlikely to be greatly expensive. This strikes me as a purchase that has an average level of care and consideration, no higher or lower than the norm. The goods are likely to be selected in the electrical departments of supermarkets or specialist consumer electronic stores. Either way, the selection is likely to focus upon the visual impact of the mark with most items being self-selected. I do not, though, rule out that some of the goods may be discussed with sales people (batteries for example).

¹ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *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.²

25. It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26. The respective marks are shown below:

88 TAURI

v

TAURI

² C-591/12P, para. 34

27. The applied for mark TAURI is comprised of just that word, so that is the only thing that contributes to its overall impression. The earlier mark comprises the word TAURI, preceded by what is likely to be seen as the number 88. I believe that TAURI will take on slightly more significance in the overall impression given its longer length and consequent impact, but 88 still plays a reasonable role in the overall impression of the mark. The stylisation of the earlier mark also plays a role, but a quite a limited one given that it is fairly unremarkable in nature.

28. The marks share the word TAURI which comprises the totality of the applied for mark and one component of the earlier mark. Notwithstanding the visual differences that exist on account of the additional aspects of the applied for mark, there is still a reasonably high degree of visual similarity.

29. The marks will be articulated as AY-T-ATE-TOR-REE v TOR-REE. The former articulation is clearly longer than the latter, but it still ends with the same two syllables. I consider there to be a medium degree of similarity.

30. Conceptually, whilst the word TAURI appears to have a meaning - as the ancient people of southern Crimea (see Merriam-Webster Online) or the Latin genitive of Taurus (see Collins Online), it is not clear to me that the average consumer will be aware of such meanings. Therefore, the inclusion of TAURI in both marks gives rise to no conceptual similarity. One mark has the number 88, the other does not, which provides a degree of conceptual difference.

Distinctive character of the earlier trade mark

31. It is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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).

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).³

32. I have only the inherent characteristics of the mark to consider, based upon the distinctiveness of the stylised mark 88 TAURI, although, it is the distinctiveness of the common TAURI element which matters most in the assessment. Whether it is the mark as a whole, or just the TAURI element, I consider the mark to have a reasonably high degree of inherent distinctive character, TAURI being seen essentially as a made-up word. It will strike the average consumer as an unusual word/mark.

Conclusions on likelihood of confusion

33. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

³ C-342/97, paras. 22-23

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.⁴

34. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

35. Some of the goods are identical or highly similar. In this context, there is in my view an inevitable likelihood of confusion. Whilst not ruling out the possibility that the average consumer may overlook the 88 element in the earlier mark through the effects of imperfect recollection, the average consumer would, even if this difference were spotted, assume that the commonality of the unusual word TAURI (which plays an independent distinctive role in the earlier mark) is indicative of the goods originating from the same or related undertaking. The difference will be put down to a variant brand of the other. I apply this finding to all of the goods, even those where there was only a low degree of similarity. The average consumer will assume that the same undertaking is responsible for all of the goods which are all, essentially, accessories for various items of small consumer electronic products.

⁴ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

36. The opposition under section 5(2)(b) succeeds. Subject to appeal, the application is refused registration.

Costs

37. The opponent has been successful and is entitled to a contribution towards its costs. The opponent, being unrepresented, was sent a pro-forma to complete if it wished to claim costs. It was advised that failure to return this form would result in no costs being awarded other than the official fee for lodging the opposition. The form was not returned. As such, the only award I make is in respect of the opposition fee, £100.

38. I therefore order Idea Evolution Co., Limited to pay DBI Innovations Group Limited the sum of £100. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated 31 August 2019

Oliver Morris

For the Registrar,

The Comptroller-General