

O-573-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3291960
BY THE VGD GROUP LTD
TO REGISTER**

ROCCO
LONDON

**AS A TRADE MARK
IN CLASS 9
AND OPPOSITION THERETO (UNDER NO. 412797)
BY
ROCCAT GMBH**

Background & Pleadings

1. The VGD Group Ltd ('the applicant') applied to register the trade mark set out on the title page on 22 February 2018. The mark was published in the Trade Mark Journal on 16 March 2018 in class 9. The goods will be set out later in this decision.

2. Roccat GmbH ('the opponent') opposes the application under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of four EU trade marks outlined below. The opponent states it is relying on all the goods set out in its specifications which are listed at paragraph 18.

EU TM No. 5568878 Roccat	Filing date: 20 December 2006 Registration date: 6 November 2007
EU TM No. 11352101 Roccat	Filing Date: 16 November 2012 Registration date: 18 April 2013
EU TM No. 11410371 ROCCAT	Filing date: 10 December 2012 Registration date: 28 May 2013
EU TM No. 16267437 Roccat	Filing date: 20 January 2017 Registration date: 4 May 2017

3. The opponent claims under section 5(2)(b) that the applicant's mark is similar to its earlier marks and is in respect of identical or similar goods to the earlier marks and that there exists a likelihood of confusion.

4. The opponent's trade marks ending '101', '371' and '437' are earlier marks, in accordance with section 6 of the Act but, because they have not been registered for five years or more at the publication date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act. The opponent's mark

ending '878 has been registered for more than five years at the publication date of the applicant's mark so would ordinarily be subject to proof of use requirements. However, in the applicant's form TM8 in answer to question 7 which states "Do you want the opponent to provide 'proof of use'?", the applicant ticked the "No" box. Consequently, the opponent is entitled to rely on the full breadth of the goods in its specifications for which it made a statement of use.

5. The applicant filed a counterstatement denying the ground of opposition.

6. The applicant is not represented in these proceedings and the opponent is represented by Sanderson & Co.

7. The applicant has not provided anything beyond the counterstatement. The opponent has provided evidence and written submissions in lieu of a hearing. I make this decision from the material before me.

Preliminary issues

8. In the counterstatement, the applicant claims there is an absence of confusion in the market place as no evidence has been provided to the contrary. However, the absence of confusion defence was addressed in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

"80. ...the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has

been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

9. The applicant also claims there are several trade marks appearing on the UK and EU registers which contain the letters ROC in class 9. However, this is not relevant to my decision. I refer to *Zero Industry Srl v OHIM*, Case T-400/06, in which the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

Opponent’s evidence

10. The opponent provided a witness statement in the name of James Sanderson, its legal representative, and appended three exhibits. The exhibits demonstrate the opponent’s goods and the applicant’s goods being sold from two retail websites linked to the applicant.

Section 5(2)(b)

11. Section 5(2)(b) of the Act states as follows:

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

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

12. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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

13. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

15. The following case law is also applicable in this case. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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”.

16. In its counterstatement the applicant contends that,

“Roccat GmbH sells computer gaming accessories (including keyboards, mice and headsets) using the mark **Roccat**. Whereas the VGD Group sells mobile phone and tablets accessories using the **Rocco London** mark. Since the two companies sell a completely different range of goods it would seem unlikely that any reasonable consumer would be confused as to the source of the goods and services they were buying.”

17. Even if I accept that the applicant and the opponent operate in different markets, this would not in any case be relevant to the issue of confusion which I must decide in these proceedings. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of goods covered by the parties’ respective specifications. It is the inherent nature of the goods which has to be considered. My task, therefore, is to conduct the comparison of the goods as they are set out in the respective specifications. The concept of ‘notional and fair use’ is also outlined in the *Roger Maier* decision, particularly paragraph 78,

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

18. The goods to be compared are:

Applicant's goods	Opponent's goods
<p>Class 9: Audio equipment; Audio speakers; Mobile phone cases; Mobile telephone cases; Cellular telephone cases; Tablet computer cases; Laptop carrying cases; Cell phone cases; Cases for smartphones; Protective cases for laptops; Cases for MP3 players; Leather cases for smartphones; Cases for tablet computers; Protective cases for smartphones; Cases adapted for cameras; Cases for mobile phones; Leather cases for mobile phones; Cases for portable media players; Cases for satellite navigation devices; Protective cases for mobile phones; Protective cases for cell phones; Protective cases for MP3 players; Leather cases for tablet computers; Cases adapted for mobile phones; Protective cases for tablet computers; Protective cases for portable media players; Protective cases for personal digital assistants; Mobile telephone cases made of leather or imitations of leather; Cell phone battery chargers; Battery chargers for mobile phones; Battery charge devices; Battery chargers for use with telephones; Cell phone battery chargers for use in vehicles; Camera covers; Tablet covers; Mobile phone covers; Covers for PDAs; Covers for smartphones; Cell phone</p>	<p>EU TM No. 5568878</p> <p>Class 9: Apparatus for recording, transmission or reproduction of sound or images; data processing equipment and computers, including notebooks and PDAs (organisers and handheld computers); ancillary equipment for computers, television sets, electronic apparatus, including multimedia apparatus and computer games (included in class 9), namely joysticks, gamepads, games consoles, input and output apparatus; control mice and mousepads, computer mice, graphics tablets, keyboards, keypads, electronic tracer pens and input pens, control pads and operating stations with keyboards, hand-operated control and operating stations; accelerator pedals and brake pedals, and steering wheels and steering wheel columns for electronic games and for operating electronic apparatus; guns for computer games; amusement apparatus adapted for use with television receivers; electronic games adapted for use exclusively with a television receiver; programmable data stations and terminals; magnifying glass devices and holders for holding and operating electronic apparatus with displays; display lighting devices and holders for connecting to electronic</p>

covers; Flip covers for smartphones; Covers for MP3 players; Phone covers [specifically adapted]; Protective covers for cell phones; Protective covers for tablet computers; Protective covers for smartphones; Covers for portable media players; Covers for personal digital assistants [PDAs]; Flip covers for mobile phones; Computer cables; Computer mouse; Computer mouse pads; Earphones; Headphones; External computer hard drives; Protective films adapted for smartphones; Liquid crystal protective films for smartphones; Wireless audio speakers; Computer application software for mobile phones; Software for mobile phones; Mobile phone display screen protectors in the nature of films; Keyboards; Keyboards for tablets; Keyboards for mobile phones; Microphones; Protective glasses; Radio transmitters; Straps for mobile phones; Tripods [for cameras]; USB cables; USB cables for cellphones; Wireless speakers; Data transmission cables; Stands adapted for mobile phones; Camera stands; Stands adapted for tablet computers; Holders adapted for mobile phones; Hands-free holders for cell phones; Tablet holders adapted for use in cars; Dashboard mounts for mobile phones; Selfie sticks; Covers for

apparatus, in particular for lighting displays for electronic games; interfaces for small computers and memories, interface adaptation components, for ATA, ATAPI, USB, PCI, Cardbus and Bluetooth; plug-in cards for ATA, ATAPI, USB, PCI, Cardbus and Bluetooth; memories, reading apparatus for memory cards, memory card modules, input sockets and ports for card modules; hard disc drives, table-top drives, in particular external hard disc and table-top drives; network cards for wireless and cable networks, adapters for networks, in particular ATA, ATAPI, PCI, Cardbus and Bluetooth adapters, including all the aforesaid adapters for wireless services, adapter cables; network switches, switch ports; peripheral devices, including network printers, network servers, network scanners; network telephony interfaces, network telephony devices and combined headphone-microphone devices; network routers, wireless network routers, broadband network routers and network routers for wireless local area networks (WLAN networks); switches for keyboard video mice, KVM switches for controlling multiple computers with a keyboard/computer mouse only, remote controls, control apparatus and connector units;

<p>tablet computers; Dashboard mounts for navigation devices; Stands adapted for tablet computers.</p>	<p>headphones, microphones, microphone-headphones, communication and operating terminals for Internet connections, Internet telephones; active loudspeakers; connector cables, adapter cables, audio and video cables, ATP, ATPI, USB, PCI, Bluetooth, Cardbus and fireware cables, network cables; modems, batteries, accumulators, mains power supply units, power supply apparatus, including software for controlling power supply, chargers, AC/DC adaptors, electric adaptor switches, decoders, electronic adaptors for displaying screen content; built-in connection and fastening parts for constructions, for the aforesaid goods (included in class 9); goods of leather and plastic (semi-finished goods), namely protective bags, carrying bags and belt bags, protective sleeves and cases, all adapted for holding and storing data carriers, personal computers, electronic apparatus, electronic organisers, very small databases, electronic games and multimedia apparatus; mountings, in particular straps and tray mountings for electronic apparatus, in particular electronic games; impact protection boxes and holders adapted for holding and storing electronic apparatus; in particular electronic games; archiving</p>
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	<p>and storage containers adapted for holding electronic apparatus, electronic data carriers and data memories, electronic apparatus, equipment modules and floppy discs; housings for electronic memories and memory cards with and without electronic display devices.</p> <p>Class 20: Furniture, namely archiving and storage stands, consoles, tablets and frames for holding electronic apparatus, electronic data carriers and data memories, electronic apparatus, equipment modules and floppy discs.</p>
	<p>EU TM No. 1135101</p> <p>Class 9: Software for the remote control of computers; Software for the remote control of computers via mobile radio apparatus; Cellular mobile telephones, PDAs and tablets; Computer mice, Computer keyboards, Trackpads, Computer mice for tablet computers, computer mice for mobile radio apparatus, computer mice for PDAs; Computer keyboards for computers, computer keyboards for tablet computers, computer keyboards for PDAs; USB ports.</p>
	<p>EU TM No.11410371</p> <p>Apparatus for recording, transmission or reproduction of sound or images; Data processing equipment and computers,</p>

	<p>including notebooks and PDAs (organisers and handheld computers); Ancillary equipment for computers, television sets, electronic apparatus, including multimedia apparatus and computer games (included in class 9), namely joysticks, gamepads, games consoles, input and output apparatus; Control mice and mousepads, computer mice, graphics tablets, keyboards, keypads, electronic tracer pens and input pens, control pads and operating stations with keyboards, hand-operated control and operating stations; Amusement apparatus adapted for use with television receivers; Electronic games adapted for use exclusively with a television receiver; Programmable data stations and terminals; Magnifying glass devices and holders for holding and operating electronic apparatus with displays; Display lighting devices and holders for connecting to electronic apparatus, in particular for lighting displays for electronic games; Interfaces for small computers and memories, interface adaptation components, for ATA, ATAPI, USB, PCI, Cardbus and Bluetooth; Plug-in cards for ATA, ATAPI, USB, PCI, Cardbus and Bluetooth; Memories, reading apparatus for memory cards, memory card modules, input sockets and ports for</p>
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	<p>card modules; Hard disc drives, table-top drives, in particular external hard disc and table-top drives; Network cards for wireless and cable networks, adapters for networks, in particular ATA, ATAPI, PCI, Cardbus and Bluetooth adapters, including all the aforesaid adapters for wireless services, adapter cables; Network switches, switch ports; Peripheral devices, including network printers, network servers, network scanners; Network telephony interfaces, network telephony devices and combined headphone-microphone devices; Network routers, wireless network routers, broadband network routers and network routers for wireless local area networks (WLAN networks); Switches for keyboard video mice, KVM switches for controlling multiple computers with a keyboard/computer mouse only, remote controls, control apparatus and connector units; Headphones, microphones, microphone-headphones, communication and operating terminals for Internet connections, Internet telephones; Active loudspeakers; Connector cables, adapter cables, audio and video cables, ATP, ATPI, USB, PCI, Bluetooth, Cardbus and fireware cables, network cables; Modems, batteries, accumulators,</p>
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	<p>mains power supply units, power supply apparatus, including software for controlling power supply, chargers, AC/DC adaptors, electric adaptor switches, decoders, electronic adaptors for displaying screen content; Built-in connection and fastening parts for constructions, for the aforesaid goods (included in class 9); Goods of leather and plastics in extruded form for use in manufacture, namely protective bags, carrying bags and belt bags, protective sleeves and cases, all adapted for holding and storing data carriers, personal computers, electronic apparatus, electronic organisers, very small databases and multimedia apparatus; Mountings, in particular straps and tray mountings for electronic apparatus, in particular electronic games; Impact protection boxes and holders adapted for holding and storing electronic apparatus; Archiving and storage containers adapted for holding electronic apparatus, electronic data carriers and data memories, electronic apparatus, equipment modules and floppy discs; Housings for electronic memories and memory cards with and without electronic display devices.</p> <p>Class 20: Furniture, namely archiving and storage stands, consoles, tablets</p>
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	<p>and frames for holding electronic apparatus, electronic data carriers and data memories, electronic apparatus, equipment modules and floppy discs.</p> <p>Class 28: Accelerator pedals and brake pedals, and steering wheels and steering wheel columns for electronic games and for operating electronic apparatus; Guns for computer games; Goods of leather and plastics in extruded form for use in manufacture, namely protective bags, carrying bags and belt bags, protective sleeves and cases, all adapted for holding and storing electronic games; Impact protection boxes and holders adapted for holding and storing electronic games.</p>
	<p>EU TM No.16267437</p> <p>Class 9: Recorded content; Information technology and audio-visual, multimedia and photographic devices; Media content; Electronic databases recorded on computer media; Electronic publications recorded on computer media; Books recorded on disc; Instruction manuals in electronic format; Digital books downloadable from the Internet; Prerecorded CD-ROMs; Pre-recorded DVDs; Pre-recorded video compact discs; Prerecorded videodiscs; Downloadable image files; Computer documentation in electronic form; E-</p>

	<p>books; Downloadable comic strips; Downloadable computer graphics; Downloadable digital photos; Downloadable digital music; Digital music downloadable provided from MP3 internet web sites; Downloadable electronic brochures; Downloadable electronic books; Downloadable electronic newsletters; Electronic publications, downloadable; Downloadable electronic publications in the nature of magazines; Electronic publications, downloadable, relating to games and gaming; Downloadable information relating to games and gaming; Downloadable movies; Downloadable podcasts; Downloadable publications; Downloadable video recordings; Downloadable video recordings featuring music; Talking books; Interactive DVDs; Prerecorded video tapes featuring music; Optical discs featuring music; Prerecorded audio tapes featuring music; Pre-recorded DVDs featuring games; Pre-recorded audio tapes featuring games; Pre-recorded video tapes featuring games; Prerecorded motion picture videos; Prerecorded video cassettes featuring cartoons; Multi-media recordings; Multimedia software recorded on CD-ROM; Musical sound recordings; Musical recordings in the</p>
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	<p>form of discs; Downloadable music files; Musical video recordings; Training manuals in the form of a computer program; Audio visual recordings; USB web keys; USB web keys for automatically launching pre-programmed website URLs; Video recordings; Video tapes with recorded animated cartoons; Video films; Video disks with recorded animated cartoons; Prerecorded non-musical audio tapes; Digital music downloadable provided from a computer database or the internet; Prerecorded digital audio tapes; Databases (electronic); Application software; Application software for televisions; Application software for mobile phones; Application software for wireless devices; Computer software downloaded from the internet; Computer game software downloadable from a global computer network; Computer application software featuring games and gaming; Computer programs for video and computer games; Computer programs for connecting remotely to computers or computer networks; Computer programs for accessing and using the internet; Computer programs for pre-recorded games; Computer programmes for interactive television and for interactive games and/or</p>
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	<p>quizzes; Computer programs for editing images, sound and video; Computer software to enable the provision of electronic media via the Internet; Computer software to enable the provision of electronic media via communications networks; Computer software for use on handheld mobile digital electronic devices and other consumer electronics; Computer software that permits games to be played; Computer software to enhance the audio-visual capabilities of multimedia applications; Programs recorded on electronic circuits for amusement apparatus with liquid crystal screens; Interactive computer software; Interactive computer software enabling exchange of information; Interactive computer game programs; Interactive multimedia computer programs; Interactive multimedia software for playing games; Interactive entertainment software; Interactive entertainment software for use with personal computers; Interactive video software; Children's educational software; Educational software; Multimedia software; Augmented reality software; Augmented reality software for use in mobile devices; Augmented reality software for use in mobile devices for integrating electronic data</p>
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	<p>with real world environments; 3D spectacles; 3D spectacles for television receivers.</p> <p>Class 28: Protective carrying cases specially adapted for handheld video games; Battery-powered computer game with LCD screen; Computer game apparatus; Hand-held electronic video games; Hand-held electronic games; Electronic hand-held game units; Electronic amusement apparatus incorporating a liquid crystal display; Gaming mice; Handheld computer games; Hand held units for playing video games; Hand-held units for playing electronic games; Home video game machines; Joysticks for video games; LCD game machines; Coin-operated video amusement apparatus; Token-operated video game machines; Protective cases for video game device remote controls; Protective films adapted for screens for portable games; Protective films for video game device remote controls; Bags specially adapted for handheld video games; Video output game machines for use with televisions; Games adapted for use with television receivers; Apparatus for games adapted for use with television receivers; Game consoles; Controllers for game consoles; Hand-held games with liquid</p>
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	<p>crystal displays; Gaming keypads; Portable games with liquid crystal displays; Amusement apparatus adapted for use with television receivers only; Arcade video game machines.</p>
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19. I have grouped terms from the applicant's specification together to facilitate easier comparison.

20. *Audio equipment; Audio speakers; Wireless audio speakers; Wireless speakers; Radio transmitters*

I find these goods to be covered by the broader term *Apparatus for recording, transmission or reproduction of sound or images* in the opponent's EU TM no. 5568878 class 9 specification making them identical goods under the *Meric* principle.

21. *Cell phone battery chargers; Battery chargers for mobile phones; Battery charge devices; Battery chargers for use with telephones; Cell phone battery chargers for use in vehicles;*

I find these goods to be covered by the broader term *Chargers* in the opponent's EU TM no. 5568878 class 9 specification making them identical goods under the *Meric* principle.

22. *Computer mouse; Computer mouse pads; Earphones; Headphones; Microphones; External computer hard drives; Keyboards; Keyboards for tablets; Keyboards for mobile phones*

I find these goods to be identical to *control mice; computer mouses; mousepads; headphones; microphone-headphones; microphones; hard disc drives in particular external hard disc drives; keyboards* in the opponent's specifications.

23. *Computer application software for mobile phones; Software for mobile phones;*

I find these goods to be identical to *application software for mobile phones* in the opponent's class 9 specification in EU TM no.16267437.

24. *Computer cables; USB cables; USB cables for cellphones; Data transmission cables*

I find these goods to be highly similar if not identical to *connector cables, adaptor cables, audio and video cables* in the opponent; class 9 specification for EU TM no. 5568878.

25. *Protective films adapted for smartphones; Liquid crystal protective films for smartphones; Mobile phone display screen protectors in the nature of films; Protective glasses*

I find these goods to be similar to a medium degree to *protective films adapted for screens for portable games; protective films for video game device remote controls*. The goods are all protective films by their nature and whilst their uses may be on different products they are likely to be sold through the same channels.

26. *Straps for mobile phones; Stands adapted for mobile phones; Camera stands; Stands adapted for tablet computers; Holders adapted for mobile phones; Hands-free holders for cell phones; Tablet holders adapted for use in cars; Dashboard mounts for mobile phones; Selfie sticks; Covers for tablet computers; Dashboard mounts for navigation devices; Stands adapted for tablet computers; Tripods [for cameras].*

I find these goods to be covered by the broader terms *holders adapted for holding and storing electronic apparatus; holders for holding and operating electronic apparatus with displays* in class 9 and similar to *storage stands, consoles, tablets and frames for holding electronic apparatus* in class 20 of the opponent's EU TM nos. 11410371 and 5568878.

27. *Mobile phone cases; Mobile telephone cases; Cellular telephone cases; Tablet computer cases; Laptop carrying cases; Cell phone cases; Cases for smartphones;*

Protective cases for laptops; Cases for MP3 players; Leather cases for smartphones; Cases for tablet computers; Protective cases for smartphones; Cases adapted for cameras; Cases for mobile phones; Leather cases for mobile phones; Cases for portable media players; Cases for satellite navigation devices; Protective cases for mobile phones; Protective cases for cell phones; Protective cases for MP3 players; Leather cases for tablet computers; Cases adapted for mobile phones; Protective cases for tablet computers; Protective cases for portable media players; Protective cases for personal digital assistants; Mobile telephone cases made of leather or imitations of leather; Camera covers; Tablet covers; Mobile phone covers; Covers for PDAs; Covers for smartphones; Cell phone covers; Flip covers for smartphones; Covers for MP3 players; Phone covers [specifically adapted]; Protective covers for cell phones; Protective covers for tablet computers; Protective covers for smartphones; Covers for portable media players; Covers for personal digital assistants [PDAs]; Flip covers for mobile phones

I find these goods to be covered by the broader terms *goods of leather and plastic (semi-finished goods), namely protective bags, carrying bags and belt bags, protective sleeves and cases, all adapted for holding and storing data carriers, personal computers, electronic apparatus, electronic organisers, very small databases, electronic games and multimedia apparatus* in the opponent's EU TM no. 5568878 class 9 specification making them identical goods under the *Meric* principle.

Average consumer and the purchasing process

28. I have to consider who the average consumer is for the contested goods and how they are purchased. 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*.

29. 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.”

30. In this case the average consumers are the general public. The cost of the goods is likely to vary. Some could be very expensive purchases like audio equipment whilst other goods are less expensive such as mobile phone covers. Ordinarily I would expect a normal of attention being paid by the consumer when selecting such goods. The purchasing act will be primarily visual as goods will be selected by viewing products in traditional bricks and mortar retail premises, or from perusal of images on Internet websites or in catalogues. However, I do not discount any aural considerations such as word of mouth recommendations.


Comparison of the marks

31. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

33. The marks to be compared are:

Applicant's mark	Opponent's marks
	

34. The applicant's mark comprises the word **Rocco** in a stylised font, with the initial character resembling a letter R missing a section of its upright stroke. **Rocco** is placed above the much smaller word **London**. The subordinate size and positioning means that the **London** element has less impact and carries less weight than **Rocco** in the overall impression of the mark. Moreover **London** will be perceived as the geographical location which also lessens its significance. The mark will likely to be referred to as **Rocco** and so it is this element which carries the greatest weight and is the dominant and distinctive element in the overall impression of the mark.

35. Three of the opponent's earlier marks are word marks, namely **Roccat**, and their overall impressions are based solely on this word. The opponent's remaining mark is a stylised presentation of the same word with each letter appearing to be dissected into two component parts. The overall impression of the figurative mark is based upon both the word and its presentation.

36. The initial character of the applicant's mark is meant to resemble a letter R and in my view consumers would see it as such. Therefore in a visual comparison, I believe that the marks are similar to the extent that they share the letters **R-O-C-C** which comprise four out of the five letters of the applicant's predominant word element and four out of the six letters of the earlier marks. The opponent's word

marks have no other visual elements to them and although the opponent's remaining mark is highly stylised, it is clearly readable as **Roccat**. In terms of differences the applicant's mark and the opponent's figurative mark are both highly stylised which will make a visual impact. In addition, the applicant's mark has the additional word **London**, albeit that it is smaller in size and in a subordinate position.

37. However, in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends. Taking this guidance in to account as the marks share their first four letters, I find there to be a medium degree of visual similarity.

38. Clearly the stylisation of the marks will have no bearing on the aural comparison I must make. Turning firstly to pronunciation, it appears from the applicant's Form TM8 and the opponent's written submissions (page 2) that both parties agree that the applicant's mark is likely to be pronounced as ROCK-O and the opponent's marks as ROCK-AT. As such then, the first syllable of the mark is pronounced identically but the second syllable sounds different. A further point of difference is the additional London word element in the applicant's mark which may be verbalised. As with the visual comparison, I am guided by the *El Corte Ingles* decision that more attention is paid to the beginning of words than the ends. Overall on this basis I find there is a medium degree of aural similarity.

39. Finally with regard to the conceptual similarity, I note the applicant's contention in its counterstatement that "Rocco is a common Italian male forename which is also used in the UK". The opponent responded to that point in their written submission stating that,

"...it must be appreciated that if the word ROCCO is used in the UK as a name, it is certainly not common and a significant part of the relevant public would not be familiar with the word, even in a name context. It is highly unlikely that the relevant public in the UK would associate the word ROCCO as a name and would therefore consider it to be a coined word. Similarly the word element of the prior marks ROCCAT would too be considered as an invented word. Neither marks have any meaning in relation to the relevant

goods. Overall since neither mark brings to mind a concept, a conceptual comparison cannot be made.”

40. I agree with the opponent on this point. It may be that some average consumers do recognise Rocco as an Italian forename, but I think a significant proportion will not and will see the word as invented. As such I see the words **Rocco** and **Roccat** as being conceptually neutral. I have not overlooked the **London** element of the applicant’s mark in this conceptual consideration. However it is most likely that the average consumer will see it simply as a geographical location and will attach no further conceptual significance to it. It is not uncommon for geographical place names to feature in trade marks and consumers are used to seeing it.

Distinctiveness of the earlier marks

41. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. The opponent did not file any evidence showing use of the earlier marks to demonstrate enhanced distinctiveness. In any event it would not have materially assisted the opponent’s case as the earlier marks are invented words which have no meaning in respect to the goods and as such are considered inherently distinctive to a high degree.

Likelihood of confusion

43. Drawing together my earlier findings on the global assessment of the likelihood of confusion, I keep in mind the following factors and those set out in paragraph 12:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

44. Confusion can be direct, when the average consumer mistakes one mark for the other or indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related.

45. So far in this decision, I have found the parties’ goods to be identical and similar to a medium degree. They will be purchased visually by the general public who will be paying a normal level of attention during the purchasing process. In addition, I have found that the earlier marks have the highest level of inherent distinctiveness

and that they are visually and aurally similar to a medium degree but conceptually neutral when compared to the contested mark.

46. Based on the marks and the goods before me and considering the assessments made so far and the factors outlined above, I find the most pertinent point relates to imperfect recollection. There is a difference of one and two letters between the earlier marks and the dominant word element of the applicant's mark and this difference is at the end of the respective words. As such this could be easily overlooked and lead to one mark being mistaken for the other. I have not overlooked the **London** element, but as previously stated consumers will see it simply as a geographical location and will attach no greater significance to it than that. Additionally, both parties' marks are likely to be perceived as invented words so there is no conceptual hook provided by the marks to fix in the mind of a consumer. As set out above a consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection. I consider that to be the case here and as such I find that there is a likelihood of direct confusion.

Conclusion

47. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against my decision, the application is refused in its entirety.

Costs

48. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in TPN2/2016 I make the following award:

£100 Official fee for filing the Notice of Opposition

£300 Preparing the Notice of Opposition

£450 Preparing written submissions

£850 Total

49. I decline to award costs for the filing of evidence in these proceedings as it was not material to the outcome of the case.

50. I order The VGD Group Ltd to pay Roccat GmbH the sum of £850. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of September 2019

**June Ralph
For the Registrar,
The Comptroller General**