

BL O/0086/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 3593438

**IN THE NAME OF HONG KONG CHENYI TECHNOLOGY LIMITED
FOR THE TRADE MARK:**

X2

AND

AN APPLICATION FOR THE INVALIDATION THEREOF UNDER NO. 504343

BY VIVO MOBILE COMMUNICATION CO., LTD

Background and pleadings

1. On 10 February 2021, Hong Kong Chenyi Technology Limited (the “Proprietor”) applied to register the trade mark **X2** for the following goods in class 9:

Class 9 *Notebook computers; Smartwatches (data processing apparatus); set-top boxes; Routers; Power bank (rechargeable battery); Connected bracelets [measuring instruments]; Web camera; Electronic surveillance apparatus; Processors [central processing units]; Computer operating software; Large-screen liquid crystal displays [LCDs]; Facial recognition apparatus; Attendance machine; Scales; Measures; Electronic notice boards; Cameras [photography]; Surveying apparatus and instruments; Optical lenses; USB cables; Chips [integrated circuits]; Sensors; Remote control apparatus; Digital door locks; 3D spectacles; Smartphones; Smartglasses (data processing apparatus); Wearable activity trackers; Covers for smartphones; Cases for smartphones; Protective films adapted for mobile telephone screens; Selfie sticks [hand-held monopods]; Cabinets for loudspeakers; Touch screens; Batteries, electric; Tablet computers; Headsets; Television apparatus; Camcorders; Portable media players; Encoded identification bracelets, magnetic; none of the aforesaid goods being dedicated medical devices or in the field of radiology and medical imaging.*

2. It was registered on 20 August 2021.

3. On 12 November 2021, VIVO MOBILE COMMUNICATION CO., LTD (the “Applicant”) applied to have the contested mark declared invalid in its entirety under Section 47 of the Trade Marks Act 1994 (“the Act”), with the Applicant claiming that registration of the contested mark was contrary to Section 5(1) and 5(2)(a) of the Act. For the purposes of the invalidation, the Applicant relied upon its earlier United Kingdom Trade Mark (UKTM):

UKTM 918226955

X2

Filing date: 18 April 2020

Receiving date: 19 December 2020

Registration date: 5 August 2020

4. Since the filing date of the earlier mark predates that of the contested mark, the Applicant's mark is an "earlier mark" in accordance with section 6 of the Act. However, as it had not been registered for five years or more before the filing date of the contested mark, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Applicant may rely upon any or all of the goods for which the earlier mark is registered without having to show that it has used the mark at all.

5. For the purposes of the invalidation, the Applicant relies upon all of the goods for which the earlier mark is registered, namely:

Class 9 *Smartphones; Mobile phones; Earphones for cellular telephones; Protective cases for mobile phones; Stands adapted for mobile phones; Mobile phone display screen protectors in the nature of films; Mobile phone battery chargers; Displays for mobile phones; Keyboards for mobile phones; Batteries for mobile phones; Wireless headsets for mobile phones; Wireless headsets for smartphones; Headsets for mobile telephones; USB cables for cellphones; Power banks; Cases for mobile phones; Mobile phone straps; Selfie sticks used as smartphone accessories; Smart glasses; Smart watches; Smartbands; Smart speakers; Tablet computers; Headphones; Earphones; Headsets; Earbuds.*

6. The Applicant contended that the contested mark is identical to its earlier mark, and that some of the goods for which it is registered are identical to those of its earlier mark. The Applicant's submissions in relation to the identity of the goods at issue included arguing that the broad scope of the goods of the earlier mark would encompass the contested goods, and vice versa. More detailed submissions were provided as to the identity (and similarity) of the goods at issue which shall not be summarised here, but rather will be called upon if they provide assistance during my

own comparison of the goods. The Applicant argued that the contested mark has therefore been registered contrary to Section 5(1) of the Act.

7. Additionally, the Applicant contended that the contested mark has been registered contrary to Section 5(2)(a) of the Act, as the contested goods are at least similar to those of the earlier mark. As a result, there would exist a likelihood of confusion on the part of the public, including a likelihood of association.

8. The Applicant submitted that the earlier mark has at least an average degree of inherent distinctive character which has subsequently acquired an enhanced degree of distinctive character through use. The Applicant indicated that evidence to support this submission would be provided later in the proceedings. It is noted that at the relevant opportunity, the Applicant elected not to file such evidence. The Applicant also argued that the relevant public should be considered to include members of the general public, with an average/medium degree of attention. The Applicant argued in addition that due to the principle of interdependence, the lesser degree of similarity between some of the goods at issue may be offset by the high degree of similarity between the marks.

9. On 16 March 2022, the Proprietor filed a counterstatement in which it denied that the contested mark contravenes either Section 5(1) or 5(2)(a). The Proprietor further denied that the contested goods were either identical or similar to those of the earlier mark, and subsequently requested the rejection of the invalidation.

10. Only the Proprietor elected to file further submissions, which were received on 30 August 2022. In its submissions, the Proprietor agreed that the marks at issue are identical, however, it denied that the contested goods are either identical or similar to those of the earlier mark. The Proprietor argued that it cannot be assumed that simply because each mark is registered for goods in Class 9 that they are automatically identical or similar. For example, the Applicant's goods cover *mobile phones* and *accessories*, whilst the Proprietor's goods "go[es] beyond this one area of the market". The Proprietor identified the following specific contested goods which it considered to be different to those of the earlier mark:

set-top boxes; Routers; Web camera; Electronic surveillance apparatus; Processors [central processing units]; Computer operating software; Large-

screen liquid crystal displays [LCDs]; Facial recognition apparatus; Attendance machine; Scales; Measures; Electronic notice boards; Cameras [photography]; Surveying apparatus and instruments; Optical lenses; Chips [integrated circuits]; Sensors; Remote control apparatus; Digital door locks; 3D spectacles; Cabinets for loudspeakers; Touch screens; Television apparatus; Camcorders; Portable media players; none of the aforesaid goods being dedicated medical devices or in the field of radiology and medical imaging.

11. No Hearing was requested, and neither party filed submissions in lieu of a Hearing.

12. Both parties are professionally represented. The Proprietor is represented by Forresters IP LLP, and the Applicant is represented Ashfords LLP.

Decision

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 47

14. Section 47 states:

“(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (2) obtain, or

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Section 5(1) and 5(2)(a)

15. Section 5(1) of the Act states:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

16. Section 5(2)(a) of the Act reads as follows:

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

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

(b) [...]

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

17. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

18. In its latest submissions, the Proprietor accepted that the marks at issue are identical. I agree. The marks are indeed visually, aurally and conceptually identical.

Comparison of the goods

19. Each party provided submissions in relation to the identity, similarity, or complete lack thereof, of the goods at issue. The parties did not present an agreed position in this regard. The degree of similarity or identity of the specifications, as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods at issue, referring to the submissions if and when I consider them to provide assistance and clarity.

Earlier mark	Registration
<p><i>Class 9: Smartphones; Mobile phones; Earphones for cellular telephones; Protective cases for mobile phones; Stands adapted for mobile phones; Mobile phone display screen protectors in the nature of films; Mobile phone battery chargers; Displays for mobile phones; Keyboards for mobile phones; Batteries for mobile phones; Wireless headsets for mobile phones; Wireless headsets for smartphones; Headsets for mobile telephones; USB cables for cellphones; Power banks; Cases for mobile phones; Mobile phone straps; Selfie sticks used as smartphone accessories; Smart glasses; Smart watches; Smartbands; Smart speakers; Tablet computers; Headphones; Earphones; Headsets; Earbuds.</i></p>	<p><i>Class 9: Notebook computers; Smartwatches (data processing apparatus); set-top boxes; Routers; Power bank (rechargeable battery); Connected bracelets [measuring instruments]; Web camera; Electronic surveillance apparatus; Processors [central processing units]; Computer operating software; Large-screen liquid crystal displays [LCDs]; Facial recognition apparatus; Attendance machine; Scales; Measures; Electronic notice boards; Cameras [photography]; Surveying apparatus and instruments; Optical lenses; USB cables; Chips [integrated circuits]; Sensors; Remote control apparatus; Digital door locks; 3D spectacles; Smartphones; Smartglasses (data processing apparatus); Wearable activity trackers; Covers for smartphones; Cases for smartphones; Protective films adapted for mobile telephone screens; Selfie sticks [hand-held monopods]; Cabinets for</i></p>

	<p><i>loudspeakers; Touch screens; Batteries, electric; Tablet computers; Headsets; Television apparatus; Camcorders; Portable media players; Encoded identification bracelets, magnetic; none of the aforesaid goods being dedicated medical devices or in the field of radiology and medical imaging.</i></p>
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20. 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”.

21. 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.

22. It has been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... 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 the responsibility for those goods lies with the same undertaking.”

Class 9

24. The contested *Smartwatches (data processing apparatus); Power bank (rechargeable battery); USB cables; Smartphones; Smartglasses (data processing apparatus); Covers for smartphones; Cases for smartphones; Protective films adapted for mobile phone telephone screens; Selfie sticks [hand-held monopods]; Batteries, electric; Tablet computers and Headsets* are self-evidently identical (at the very least through the *Meric* principle by way of being, or falling within, a more general category) to the *Smart watches; Power banks; USB cables for cellphones; Smartphones; Smart*

glasses; Protective cases for mobile phones; Mobile phone display screen protectors in the nature of films; Selfie sticks used as smartphone accessories; Batteries for mobile phones; Tablet computers and Headsets of the earlier mark.

25. The earlier mark is registered for *Tablet computers*. Such goods are complicated devices, which possess many technical features that enable them to carry out an array of tasks. Essentially, they are mobile versions of computers that use touch-screen technology, although many enable connection to a keyboard for easier typing. Several of the contested goods are either parts or components of a *Tablet computer*, i.e., *Web camera; Processors [central processing units]; Computer operating software; Large-screen liquid crystal displays [LCDs]; Facial recognition apparatus [sic]; Chips [integrated circuits]; and Touch screens*. I am aware of the finding in *Les Éditions Albert René v OHIM*, Case T-336/03, whereby the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

26. I am also aware that the identified goods are frequently sold independently of a *Tablet computer*, and could be used in addition to other items, such as a personal computer (PC). However, I do not dismiss the possibility that the identified goods can and are purchased as replacements, either by the average consumer or technical specialist charged with repairing the device. Therefore, I consider the *Web camera; Processors [central processing units]; Computer operating software; Large-screen liquid crystal displays [LCDs]; Facial recognition apparatus [sic]; Chips [integrated circuits]; and Touch screens* to be similar to at least a low degree as they have the same nature, intended purpose, user and trade channels. In addition, by way of finding such goods to be parts and components that are essential or important for enabling a *Tablet computer* to perform, I also consider them to be complementary.

27. The contested *Portable media players* are similar in many aspects to both the *Smartphones* and *Tablet computers* of the earlier mark, insofar as they all enable the downloading, storing, viewing (i.e., “playing”) of media. Whilst *Smartphones* and

Tablet computers have several additional functions which a *Portable media player* cannot perform, they nevertheless share the intended purpose of playing media. Also, they have the same users, and are frequently sold in the same stores and via the same trading channels. I therefore consider them to be similar to a medium degree.

28. The earlier mark is registered for goods in Class 9 that consist essentially of *Smartphones, Mobile phones, Tablet computers*, and their accessories. The remaining contested goods consist of a variety of items that in the Proprietor's words "go[es] beyond this one area of the market". I agree with the Proprietor's position in relation to the remaining goods that I have not found to be either identical, similar or complementary. In my opinion, the remaining contested goods do not share any characteristic with those goods of the earlier mark, and differ as to their nature and intended purpose, whilst also having a different end user and trade channel. For example, I fail to see any similarity between an *Attendance machine, a Digital door lock* or *Encoded identification bracelet* on the one hand, and a *Smartphone, Mobile phone, Tablet computer* or any of their accessories on the other. Therefore, the contested *Set-top boxes; Routers; Connected bracelets [measuring instruments]; Electronic surveillance apparatus; Attendance machine; Scales; Measures; Electronic notice boards; Cameras [photography]; Surveying apparatus and instruments; Optical lenses; Sensors; Remote control apparatus; Digital door locks; 3D spectacles; Wearable activity trackers; Cabinets for loudspeakers; Television apparatus; Camcorders; Encoded identification bracelets, magnetic; None of the aforesaid goods being dedicated medical devices or in the field of radiology and medical imaging* are found to be dissimilar.

Conclusion

29. It is a prerequisite of Section 5(1) that both the marks and the goods at issue are identical. The marks have been agreed by both parties to be identical. I have subsequently found the following contested goods to be identical:

Smartwatches (data processing apparatus); Power bank (rechargeable battery); USB cables; Smartphones; Smartglasses (data processing apparatus); Covers for smartphones; Cases for smartphones; Protective films

adapted for mobile phone telephone screens; Selfie sticks [hand-held monopods]; Batteries, electric; Tablet computers and Headsets

As a result, the invalidation is successful under Section 5(1) against the above contested goods.

30. The invalidation is also successful under Section 5(2)(a) against those goods found to be similar, i.e.:

Web camera; Processors [central processing units]; Computer operating software; Large-screen liquid crystal displays [LCDs]; Facial recognition apparatus [sic]; Chips [integrated circuits]; Touch screens; Portable media players.

31. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

32. For those goods found to be dissimilar, there can be no likelihood of confusion under either Section 5(1)(a) or 5(2)(a). Therefore, in relation to the following list of goods the invalidation fails:

Set-top boxes; Routers; Connected bracelets [measuring instruments]; Electronic surveillance apparatus; Attendance machine; Scales; Measures; Electronic notice boards; Cameras [photography]; Surveying apparatus and instruments; Optical lenses; Sensors; Remote control apparatus; Digital door locks; 3D spectacles; Wearable activity trackers; Cabinets for loudspeakers; Television apparatus; Camcorders; Encoded identification bracelets, magnetic;

None of the aforesaid goods being dedicated medical devices or in the field of radiology and medical imaging

COSTS

33. Neither party has been wholly successful, with both parties having achieved some measure of success. As a result of this, I decline to make an award of costs in favour of one particular party and I direct each party to bear their own costs.

Dated this 27th day of January 2023

Dafydd Collins

For the Registrar

The Comptroller-General