

BL O/0286/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3619501

BY

CHAL-TEC GMBH

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION NO. 430062 THERETO

BY

BLACKBERRY LIMITED

Background and pleadings

1. Although Chal-Tec GmbH (the “Applicant”) filed the contested application as seen on the cover of this decision in the UK on 31 March 2021, it was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, with the EU filing date being 12 March 2020. The EU filing benefited from an International Convention priority date, based on a filing in Germany on 12 September 2019. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 8 October 2021. Registration of the mark is sought in respect of goods and services in Classes 7, 9, 11, 20, 21, 22, 25, 28, 35 and 39.

2. On 31 January 2022, BlackBerry Limited (the “Opponent”) partially opposed the application in relation to Class 9 only, opposing the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purposes of the opposition, the Opponent relied upon two earlier comparable United Kingdom Trade Marks (UKTMs)¹:

UKTM 917984596 (the “BB” mark)	UKTM 909055377 (the “BBM” mark)
BB	BBM
Filing date: 21 November 2018	Filing date: 12 April 2010
Registration date: 22 June 2019	Registration date: 15 November 2010
Classes 9, 38, and 42	Classes 9, 38 and 42.

¹ The trade marks relied upon by the opponent are ‘comparable’ UK trade marks. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing IR and/or EUTM.

3. Since the filing dates of each of the Opponent's marks predate that of the contested mark, the Opponent's marks are "earlier marks" in accordance with Section 6 of the Act. As the BB mark has 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, and as a consequence may rely upon any or all of the goods and services for which it is registered without having to show that it has used the mark at all.

4. For the purposes of the opposition, the Opponent chose to rely upon the entire list of goods and services for which the earlier mark BB is registered, whereas it chose to only rely upon the goods and services for which the earlier mark BBM is registered in Classes 9 and 38.

5. The Opponent argued that despite the contested mark's slight stylisation, the earlier mark BB is "clearly recognisable" as being fully incorporated at the beginning of the contested mark. The Opponent submitted that it is the beginning of marks where consumers tend to pay a greater deal of attention. The Opponent argued that the earlier mark BBM overlaps with the contested mark in relation to each mark's respective first two letters. The Opponent contended that the earlier mark BBM is the same length as the contested mark, and that this increases the levels of visual and aural similarity.

6. The Opponent provided submissions as to the identity and/or similarity of the goods and services at issue which shall not be summarised here, rather they shall be called upon if they provide assistance during my own comparison of the goods and services.

7. On 1 April 2022, the Applicant filed a counterstatement in which it denied the contested mark is similar to either of the two earlier marks. The Applicant also denied that the contested goods are either identical or similar to the goods and services covered by the earlier marks, and put to the Opponent to proof of use.

8. No hearing was requested.

9. Both parties are professionally represented. The Applicant is represented by Bird & Bird LLP, and the Opponent is represented by Kilburn & Strode LLP.

Submissions

10. On 22 August 2022, the Opponent filed evidence and submissions to support its claim that the earlier mark BBM has been put to genuine use. The Opponent also filed submissions claiming that the earlier BB mark enjoys enhanced distinctiveness, and referred to the exhibits NXF3 and NXF4 to support this claim. The Opponent also contended the following: a global assessment implies interdependence; the more highly distinctive the earlier mark the greater the likelihood of confusion; and the average consumer rarely has the chance to make a direct comparison between marks and therefore must rely upon imperfect recollection.

11. On 28 December 2022, both parties provided submissions in lieu of a Hearing.

12. The Applicant argued that consumers pay particular attention to the differences in marks consisting of three or fewer letters, and therefore the difference between the final letter of the contested mark and earlier mark BBG is “going to be more pronounced and recognisable to consumers”. The Applicant submitted that the letter ‘G’ at the end of the contested mark is “highly significant” especially when considering the letters ‘BB’ in each of the marks are “repetitive” and “blend together”, thereby being less distinctive or noticeable to the consumer. The letter ‘G’ also creates a clear phonetic difference between the contested and earlier mark. The Applicant further argued that in marks consisting of only two or three letters none of the individual elements (i.e., letters) are to be attributed any more weight than the others.² The Applicant referred to the contested mark’s “distinctive white lettering in unusual font that are situated in the middle of a black rectangle” as a stylistic difference between the contested mark and both of the earlier marks. The Applicant stated that neither the contested mark nor either of the earlier marks have any conceptual meaning, and therefore they cannot be compared conceptually. That having been said, the Applicant went on to explain that the contested mark is an abbreviation of Berlin Brands Group, whereas the earlier marks are abbreviations for BlackBerry (BB) and BlackBerry Messenger (BBM).

² The Applicant referred to the decision of the EUIPO Board of Appeal, R 1601/2017-2 to support this statement. It should be noted that the language used by the board was less definitive, and said it was an “assumption” that in short marks the beginning is no more important than the middle or ending (see paragraph 49).

13. The Applicant argued that the Opponent's evidence does not prove the earlier mark BBM has been put to genuine use for either *computer software* in Class 9 or *telecommunications services* in Class 38. The Applicant provided more detailed submissions in relation to the comparison of the goods and services at issue which shall be referred to later in the decision to the extent I consider necessary. As for the relevant consumer, the Applicant argued that because the goods and services at issue are highly technical, are infrequently purchased, and are expensive, the consumer would be a professional with a high degree of attention who would be able to distinguish between the marks.

14. The Opponent's submissions in lieu reflected the events and filings of the proceedings so far and reiterated many of the arguments and contentions made in its previous submissions relating to the assessment of proof of use evidence. No new submissions of substance were made.

Evidence

15. The Opponent's evidence for the purposes of establishing proof of genuine use of the earlier mark BBM consisted of the witness statement of Nora Fowler, Trade Mark Attorney of the Opponent's appointed representative Kilburn & Strode LLP. It was dated 22 August 2022 and was accompanied by Exhibits NXF1 – NXF9.

16. The evidence shall not summarised here other than to mention that the witness statement claims the earlier mark BBM has been documented as referring to 'Blackberry Messenger', and that it has a history in software, and that it enjoys a "popularity" which has led to enhanced distinctiveness. The evidence shall be referred to more precisely at appropriate points in the decision to the extent that I consider necessary.

Section 5(2)(b)

17. Section 5(2)(b) of the Act is as follows:

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

(a) ...

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

Section 5A

18. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

19. The following principles are gleaned from the decisions of the EU courts 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, 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

20. 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.

Procedural economy

21. For the purposes of procedural economy in oppositions which rely upon more than one earlier mark, it is often beneficial and logical to identify if a particular earlier mark may provide the Opponent with its greatest chance of success. There are certain factors to keep in mind when trying to identify the Opponent's strongest case, one being whether an earlier mark is subject to proof of use. The earlier mark BBM is subject to a valid proof of use request, whereby the relevant period for proving genuine use would be 13 September 2014 to 12 September 2019. By contrast, the earlier mark BB is not subject to proof of use. Another factor to consider is which of the earlier marks has the greatest scope of protection. The Opponent has chosen to rely upon only a limited number of goods and services for which the earlier mark BBM is registered, whilst it has chosen to rely upon the entire list of goods and services for which the earlier mark BB is registered. In addition, the earlier mark BB is registered for a broader scope of goods in Class 9 than the earlier mark BBM.

22. In view of the above, it seems sensible to me to compare the contested mark with the earlier mark BB in the first instance under Section 5(2)(b).

Comparison of goods

23. Both parties have provided submissions in relation to the respective goods and services at issue, and whether they are identical or similar, or not. Whilst the parties' comments are noted, 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 and services at issue. I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity.

24. The parties' respective specifications are:

Earlier mark BB	Contested mark (class 9 only)
Class 9: Computer software in the fields of Mobile Device Management (MDM), Mobile Applications Management	Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling,

<p>(MAM), Mobile Security Management (MSM), Mobile Information Management (MIM), and mobile Identity and Access Management (IAM); computer software in the field of Enterprise Mobility Management (EMM) for the operation, management, security and maintenance of networks; computer network connectivity software, namely, software and middleware used to allow software applications to interface with mobile and remote devices and to allow connectivity, memory storage, and device management, all via a computer network; computer software to allow network administrators to monitor, manage, and quarantine devices that are granted access to a network; Internet of things (IOT) management software platform consisting of downloadable cloud-based software, mobile and desktop applications, and premise-based gateway agent software; software for uploading, monitoring, analyzing and reporting on data acquired from network and Internet-connected devices; device driver software; cloud computing software; internet connectivity software; software for use in managing device-to-device, device-to-cloud and cloud-to-device communications; computer software for machine-to-machine (M2M) communication, remote data collection</p>	<p>checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, storing, transforming, converting, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Mechanisms for coin-operated apparatus; Cash registers; Calculating devices; Data-processing equipment and computers; Fire-extinguishing apparatus; Directional compasses; Ergometers; Rowing machine ergometers; Multimeters; Oscilloscopes; Closed circuit television cameras; Racks (Photographic -); Acoustic couplers; Sound alarms; Anode batteries; Answering machines; Junction boxes [electricity]; Connections for electric lines; Antennas; Electricity indicators; Astronomy (Apparatus and instruments for -); Distance recording apparatus; Azimuth instruments; Apparatus for the acoustic monitoring of small children; Batteries, electric; Limiters [electricity]; Light meters; Screens (computers); Video telephones; Diaphragms [photography]; Anti-glare glasses; Anti-dazzle shades; Flashlamps for cameras; Flash bulbs; Compact disc players; Integrated circuit chips; Compact discs</p>
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<p>and process control; software for performing calculations and transformations on data; computer software for asset tracking; software to track and manage IP-enabled machines and other connected devices; Software Development Kits (SDKs), Application Programming Interface (API), Enterprise Application Integration (EAI) software for creating software and applications related to machine to machine (M2M) devices, network and Internet connected devices, and IOT devices; downloadable middleware for software application integration; downloadable middleware for providing an interface between network or Internet-connected devices and enterprise software applications; software to collect, filter and process data; computer software for data transmission, storage, retrieval, filtering, processing, reproduction and integration; software for sending, receiving and analyzing data from network and Internet-connected devices; software for processing rules and sending dispatches; Mobile phones, smart phones, tablet computers and wireless communication devices; accessories for mobile phones, smart phones, tablet computers and wireless communication devices, namely, headsets and earphones, phone</p>	<p>[read-only memory]; Discs (Compact -) [audio-video]; Computers; Peripherals adapted for use with computers; Computer keyboards; Detectors; Transparencies [photography]; Transparency projection apparatus; Theft prevention installations, electric; Burglar alarms; Regulators [dimmers] (Light -), electric; Printers for computers; Lamps (Darkroom -) [photography]; Darkrooms [photography]; DVD players; Digital video disc players; Electric cables; Electronic notice boards; Electronic pens; Electronic pocket translators; Electronic agendas; Audio- and video-receivers; Distance measuring apparatus; Television apparatus; Telephones; Cinematographic apparatus; Film cutting apparatus; Camera filters; Cameras; Photocopiers; Hands free kits for phones; Radiotelephony sets; Juke boxes; Cassette players; Headphones; Loudspeakers; Speaker enclosures; Luminous signs; Megaphones; Measuring apparatus; Measuring instruments; Metronomes; Microphones; Cell phones; Modems; Monitors [computer hardware]; Monitors [computer programs]; Notebook computers; Objectives [lenses] [optics]; Lenses for astrophotography; Precision measuring apparatus; Projection</p>
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<p>chargers, battery chargers, mounts, cradles and holders for hands-free phone use, charging and docking stations, cell phone and tablet computer protective cases, protective covers and cases, cell phone holsters, and speakers; Computer operating systems; computer software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and text to others via the global computer network; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one and more electronic device; computer software for scheduling, hosting and participating in video conferences; intrusion detection software; software for monitoring, analyzing, reporting, preventing, and resolving security and privacy risks; software for identifying, terminating, and removing malicious software programs; software for monitoring mobile devices; antivirus and security software for mobile devices; mobile device software for tracking, locating, locking and wiping mobile electronic devices; encryption and decryption software; sd-cards; computer software for performing data security functions in the field of</p>	<p>apparatus; Projection screens; Radios; Vehicle radios; Frames for photographic transparencies; Centering apparatus for photographic transparencies; Smoke detectors; Stage lighting regulators; Satellite navigational apparatus; Scanners [data processing equipment]; Commutators; Switches, electric; Switchgear [electric]; Distribution consoles [electricity]; Electricity control panels; Mechanical signs; Screens [photography]; Transmitters of electronic signals; Solar energy collectors for electricity generation; Solar batteries; Memories for data processing equipment; Games software; Sports glasses; Speaking tubes; Sprinkler systems for fire protection; Coils, electric; Stands for photographic apparatus; Camera tripods; Sockets, plugs and other contacts [electric connections]; Electricity conduits; Converters, electric; Buzzers; Buzzers, electric; Metronomes; Batteries for pocketlamps; Pocket calculators; Telephones; Telephone receivers; Facsimile and telecopier machines; Distance measuring apparatus; Teleprompters; Telescopes; Sound recording apparatus; Tape recorders; Sound recording carriers; Amplifiers; Sound reproduction apparatus; Sound transmitting apparatus; Personal stereos; Walkie-</p>
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<p>cryptographic network security; computer software for automating a process for authentication of identity using existing databases in connection with the issuance and management of digital certificates used for authentication or encryption of digital communications over the Internet and other computer networks; computer software, namely encryption software to enable secure transmission of digital information; computer software to integrate managed security, namely, virtual private network (VPN), public key infrastructure (PKI), digital certificate issuance, verification and management; Software for providing initiation, distribution, delivery and response tracking of emergency notifications to users via personal communication devices and public mass communication devices; software for supporting exchange of information and collaboration processes amongst organizations and people during emergency and crisis situations; software for the purposes of data collection, monitoring, and mass notification services for managing emergency, and crisis and business critical situations and improving crisis communications capability; software for the transmission of mass notification emergency information via audio, video</p>	<p>talkies; Transistors [electronic]; Enlarging apparatus [photography]; Sound amplifiers; Amplifying tubes; Videotapes; Camcorders; Video cassettes; Video game cartridges; Scales; Weighing apparatus and instruments, weighing machines; Voting machines; Heat regulating apparatus; Intercommunication apparatus; Animated cartoons; Data processing equipment; Computer software; Coaxial cables; Electricity conduits; Identification threads for electric wires; Identification sheaths for electric wires; Wire connectors [electricity]; Sheaths for electric cables; Wall brackets for cables, television apparatus, beamers and other apparatus for recording, transmission or reproduction of sound and images; Light emitting diode displays (light diodes); LED panels for displaying video or images; electronic regulating and control devices for the operation of light emitting diodes (LEDs); Apparatus and instruments for lighting control, including apparatus and instruments for controlling stage lighting, computerised control systems for lighting apparatus and instruments; Control consoles for lighting apparatus and instruments; Programmable controls for lighting apparatus and instruments; remote control apparatus for lighting apparatus</p>
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and electronic communications networks and devices, including social networks; software for managing and analyzing data feeds and data inputs in the field of crisis reporting, communication and management, and for sending notifications through multiple IP network channels and delivery services; software for loading data from personnel directories, and managing users for purpose of crisis communication; software for managing organization directories and connections across organizations for the purpose of connecting them and facilitating collaboration before, during and after crisis situations; software for locating personnel for security and safety purposes using a global positioning system, user self-reporting, and other locating means; software for electronically monitoring, detecting and reporting on alarms, alerts, emergencies, hazards, security threats, and dangerous weather; software for notifying individuals and organizations of a changed status or condition of a sensing device or input feed via network based message alerts; downloadable software in the nature of a mobile application for sending, receiving, confirming and responding to alerts, messages, and notifications via wireless

and instruments; Audio-sensitive controls for lighting apparatus and instruments; Lighting control software, including control software for use in commercial and industrial establishments, in theatres, in nightclubs and during concerts; Lighting control software for use in stage lighting apparatus and instruments and for controlling stage lighting apparatus and instruments; Cables, Connection elements (electric installation materials) and switches for stage lighting apparatus and instruments; Image projectors for projecting patterns, pictures, logos, text or shapes; Overhead slide projectors; Electronic control and regulating apparatus and instruments for effect lighting; Baby monitors; Digital indicators with moving screens; Light-emitting electronic pointers; Containers for microscope slides; Totalizers; Stands adapted for mobile phones; Carriers adapted for mobile phones; Electric cables for the transmission of sounds and images; Stands for computer equipment; Racks for loudspeakers; Stands adapted for tablet computers; Telecommunications cables; Headphone consoles; Music files; Record players; Audio- and video-receivers; Digital thermometers, other than for medical purposes; Electronic

<p>communications networks or the Internet; desktop software applications for providing desktop notifications that capture the user's attention with audio-visual signals and allow users to confirm, respond to notifications or receive additional information related to notifications; computer hardware and software communication system enabling users to manage information and data provided to the system and to control the delivery of messages through the system.</p>	<p>thermometers, other than for medical use; Thermometers, not for medical purposes; Phototelegraphy apparatus; Portable media players; Skateboard helmets; Film recording apparatus; Film recorders; Recorded content; Information technology and audiovisual equipment; Magnets, magnetizers and demagnetizers; Apparatus, instruments and cables for electricity; Optical devices, enhancers and correctors; Navigation, guidance, tracking, targeting and map making devices; Measuring, detecting and monitoring instruments, indicators and controllers; Coin-operated mechanisms for television sets; Coin-operated mechanisms; Coin-operated mechanisms for television sets; Counter-operated apparatus (Mechanisms for -); Switchboxes [electricity]; Tap boxes; Cable ducts (electricity); Distribution boards [electricity]; Power adapters; Electrical adapters; Electrical inductors; Armatures [electricity]; Distribution boxes [electricity]; Distribution boards [electricity]; Reducers [electricity]; Connectors [electricity]; Terminals [electricity]; Switchboxes [electricity]; Anti-interference devices [electricity]; Strain relief cable glands; Branch boxes [electricity]; Junction boxes [electricity]; Electrical branch boxes; Panels for the connection of electricity; Distribution</p>
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	<p>boxes [electricity]; Branch terminals; Electrical power extension cords; Ducts [electricity]; Winding wires (electricity); Switch panels [electric]; Portable solar panels for generating electricity; Audio- and video-receivers; Audio- and video-receivers; Phonograph records; Record decks; Record players; Records [sound recordings]; Records [sound recordings]; Cleaning apparatus for sound recording discs; Readers [data processing equipment]; Scanners [data processing equipment]; Electronic data processing equipment; Data processing equipment and accessories (electrical and mechanical); Interface cards for data processing equipment in the form of printed circuits; Electric cords; Loudspeaker systems; Speaker enclosures; Loudspeaker systems; Loudspeaker systems; Speaker switches; Speakers [audio equipment]; Stands adapted for loudspeakers; Speakers for computers; Speakers for record players; Signal processors for audio speakers; Horns for loudspeakers; Speaker enclosures; Loudspeakers with built in amplifiers; Electronic audio signal processors for compensating sound distortion in speakers; Electronic units for transmitting audio signals; DMB (Digital Multimedia Broadcasting) televisions; Satellite transmission apparatus;</p>
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	<p>Apparatus for the transmission of data; Digital optical transmission apparatus; Cables for transmitting and receiving cable television signals; Transmitters for the transmission of electronic signals; Transmitters for the transmission of electric signals; Telephone transmitters; Transmitting tubes; Apparatus for the reproduction of images; Audio mixing consoles; Audio switching apparatus; Preamplifiers; Tape cassettes; Audio recordings; Sound recorders; Sound amplifiers; Sound reproduction apparatus; Audio tape players; Apparatus for amplifying sound; Sound amplifying apparatus; Sound recording strips; Audio processing apparatus; Audio tapes; Sound registering discs; Sound amplifying receivers; Audio cassettes; Audio tapes; Portable sound reproducing apparatus; Blank audio cassettes; Audio- and video-receivers; Recorded tape cassettes; Digital sound processors; Audio tape recorders; Electroacoustic emphasisers; Integrated audio amplifiers; Analogue sound modifiers; Digital audio tapes; Sound reverberation units; Audio recordings; Audio tapes; Recorded tapes; Audio apparatus; Audio cassettes; Audio cassettes; Audio head cleaners; Sound locating instruments; Audio mixing apparatus; Sound mixers with integrated</p>
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	<p>amplifiers; Sound mixing apparatus; Audio mixing consoles; Tonometers for measuring [not for medical purposes]; Sound processors; Musical instrument amplifiers; Portable sound recording apparatus; Blank audio cassettes; Pre-recorded audio tapes; Instruments for the reduction of noise in systems for recording audio signals; Security apparatus for processing audio signals; Audio dubbing apparatus; Optic discs carrying audio recordings; Pick-ups for electrical musical instruments; Electrical amplifiers for sound signals; Boom poles for sound transmission apparatus; Audio mixing consoles; Picks-ups for guitars; Cassette head cleaners for audio tapes; Head cleaning tapes [recording]; Tone arms for record players; Video recordings; Pick-up arms; Magnetic data carriers, recording discs; Magnetic recording tapes; Annunciators; Pressure regulators; Apparatus for scientific research and laboratories; Instrumentation simulators; Photographic surveying instruments; Photographic apparatus and instruments; Nautical apparatus and instruments; Digital recording media; Data communications hardware; Hygrometers; Video baby monitors; Motion sensor; Mirrors [optics]; Temperature indicating apparatus;</p>
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	<p>Batteries; Television apparatus; DVD recorders; Antennas and aerials as communications apparatus; Antennas and aerials as components; Weighing apparatus and instruments for standard unit; Protective work clothing [for protection against accident or injury]; 3D spectacles; Aerometers; Alarms; Alarm bells, electric; Whistle alarms; Alcoholmeters; Ammeters; Starter cables for motors; Connection units (Electric -); Oxygen transvasing apparatus; Asbestos clothing for protection against fire; Breathing apparatus for underwater swimming; Breathing apparatus, except for artificial respiration; Respiratory masks, other than for artificial respiration; Respirators for filtering air; Balancing apparatus; Beacons, luminous; Barometers; Petrol gauges; Observation instruments; Accelerometers; Flashing lights [luminous signals]; Surge arresters; Letter scales; Chemistry apparatus and instruments; Chronographs [time recording apparatus]; Crash test dummies; Digital photo frames; Dictating machines; Dosimeters; Revolution counters; Pressure measuring apparatus; Tires (Automatic indicators of low pressure in vehicle -); Dynamometers; Electronic book readers; Egg-candlers; Electrical</p>
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	<p>adapters; Ignition (Electric apparatus for remote -); Electronic locks; Electricity transformers; Electric wires; Electronic notice boards; Electronic pens; Electronic notebooks; Electrified fences; Distance measuring apparatus; Range finders; Discharge tubes, electric, other than for lighting; Milage recorders for vehicles; Counterfeit [false] coin detectors; Facsimile machines; Binoculars; Binoculars; Telescopes; Teletypewriters; Fire blankets; Fire extinguishers; Fire pumps; Fire alarms; Fire beaters; Clothing for protection against fire; Photovoltaic cells; Spark-guards; Gas testing instruments; Gasometers [measuring instruments]; Juke boxes, musical; Money counting and sorting machines; Speed checking apparatus for vehicles; Speed measuring apparatus [photography]; Weights; Global Positioning System [GPS] apparatus; Altimeters; Holograms; Dog whistles; Hydrometers; Hygrometers; Ionization apparatus not for the treatment of air or water; Calipers; Boiler control instruments; Push buttons for bells; Bells [warning devices]; Knee-pads for workers; Collectors, electric; Fuel gauges; Bullet-proof clothing; Jackets [bullet proof]; Copper wire, insulated; Chargers for electric batteries; Surveying instruments; Sleeves for</p>
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	laptops; Laptop computers; Bags adapted for laptops; Lasers, not for medical purposes; Gauges; Beacons, luminous; Light-emitting diodes [LED]; Heliographic apparatus; Light meters; Light-emitting electronic pointers; Sounding apparatus and machines; Air analysis apparatus; Magnifying glasses; Magnetic tape units for computers; Magnets; Manometers; Marker buoys; Solderers' helmets; Quantity indicators; Metal detectors for industrial or military purposes; Meteorological balloons; Meteorological instruments; Rules [measuring instruments]; Micrometer gauges; Microscopes; Teeth protectors; Juke boxes, musical; Food analysis apparatus; Nose clips for divers and swimmers; Vehicles (Navigation apparatus for -) [on-board computers]; Navigational instruments; Gradient indicators; Neon signs; Surveyors' levels; Eyepieces; Opticians' goods; Optical apparatus and instruments; Optical data media; Optical lanterns; Optical lenses; Oscillographs; Ozonisers [ozonators]; Parking meters; Radio pagers; Physics (Apparatus and instruments for -); Plotters; Precision balances; Radar apparatus; Life buoys; Life-saving rafts; Fire escapes; Safety nets; Lifebelts; Levels [instruments for determining the horizontal]; Cathodic
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	<p>anti-corrosion apparatus; Sound locating instruments; Switchboards; Switchgear [electric]; Scales (Lever -) [steelyards]; Protective suits for aviators; Head protection; Protective masks; Transmitters [telecommunication]; Signalling apparatus; Signals, luminous or mechanical; Signalling panels, luminous or mechanical; Sirens; Smartphones; Computer software applications, downloadable; Solar panels for the production of electricity; Sonars; Lens hoods; Voltmeters; Computer memory devices; Covers for electric outlets; Stereoscopes; Actinometers; Stroboscopes; Lighting ballasts; Circuit closers; Circuit breakers; Tablet computers; Tachometers; Diving suits; Gloves for divers; Temperature controlling apparatus; Walkie-talkies; Personal stereos; Step-up transformers; Transistors [electronic]; Peepholes [magnifying lenses] for doors; Electric door bells; Voltage surge protectors; Mains monitoring apparatus (Electric -); Mannequins (Resuscitation -) [teaching apparatus]; Clothing for protection against accidents; Clothing for protection against accidents, irradiation and fire; USB flash drives; Surveying apparatus and instruments; Panels for the distribution of electricity; Video screens; Video recorders; Digital video recorders;</p>
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	<p>Voltmeters; Vehicle breakdown warning triangles; Marine depth finders; Bubble levels; Wavemeters; Anemometers; Numerical counters; Distribution boards [electricity]; Time recording apparatus; Time switches, automatic; headguards.</p>
<p>Class 38: Telecommunication services, namely, data transmission and reception services via telecommunications networks; electronic exchange of voice, data, audio, video, text and graphics accessible via computer and telecommunications networks; instant messaging services; Providing electronic message alerts via the Internet, global computer and telecommunications networks, and mobile communications devices to deliver emergency notifications and facilitate collaboration amongst individuals and organizations before, during and after critical situations; providing mass notification services through all communication devices, telephones, tablets, smartphones, email, text messaging, and instant messaging; providing electronic transmission of data and digital messaging via mobile handheld devices and via wired and wireless communication devices before, during and after critical situations; telecommunications services that enable users and organizations to electronically</p>	

transmit messages, text, multimedia content, videos, audio, animation and images via a global computer network before, during and after critical situations; providing multiple user access to interactive databases through web sites on a global computer network to manage, administrate and use crisis communication capabilities; providing electronic transmission of converged data, address location information, text, pictures, and streaming media, all for use in crisis communications; providing telecommunication connectivity services for transfer of messages, audio, visual, and data information for crisis communications; electronic messaging services, namely, providing services to access, process, and transmit critical, time-sensitive notifications to individuals and organizations.

Class 42: Mobile Device Management (MDM) services in the field of Enterprise Mobility Management (EMM), namely, remote management of mobile devices' software applications, access, and security; software as a service (SAAS) services in the field of Enterprise Mobility Management (EMM), featuring software for Mobile Device Management (MDM), Mobile Applications Management (MAM), Mobile Security Management (MSM), Mobile Information Management

(MIM), and mobile Identity and Access Management (IAM); software as a service (SAAS) services in the field of Enterprise Mobility Management, featuring software for the operation, management, security and maintenance of enterprise networks, data center management, resource management and performance optimization; software as a service (SAAS) services featuring computer software in the field of electronic file security to allow users to encrypt, electronically watermark, provide restricted access to, and provide secure transmission and tracking of electronic documents and other electronic and digital files; Platform as a service (PAAS) services featuring computer software for security, management, collaboration and application services for mobile devices; computer services, namely, providing a virtual computing environment accessible via the Internet for the purpose of providing mobile communications data archiving, access to computing and data storage facilities, namely storage servers for archiving email, phone call logs, SMS/MMS messages, and other electronic data; Platform as a service (PAAS) services featuring computing platform and solution stack that allows users or

enterprise software applications to interface with, connect to and manage remote devices and to provide messaging, management and memory storage services; Infrastructure as a service (IAAS) services featuring computer software platforms for creating, managing, and deploying cloud computing infrastructure services; Design and development of computer software and middleware for others; computer network design for others; technical consulting with regard to computer systems, computer network connectivity hardware and computer network connectivity software and middleware; computer software services, namely, development, maintenance, repair, installation, troubleshooting of problems, support in the nature of diagnosing problems, upgrade and updating, authoring, provision of information, consultation, design and customization of computer software and middleware; technical support services with regard to computer systems, computer network connectivity hardware and computer network connectivity software and middleware, namely, troubleshooting and diagnosing of problems; computer services, namely, providing remote management of remote devices via computer networks;

Providing non-downloadable software for managing machine-to-machine (M2M) and Internet of Things (IoT) communication; providing machine-to-machine (M2M) and Internet of Things (IoT) communication integration services, namely, the integration of disparate computer systems, networks and software through the application of wireless communication technology to facilitate M2M and IoT communication via web based browsers, personal digital assistants, mobile phones, embedded microprocessors, sensors and other electronic devices; providing a secure website in the nature of a web hosting platform for allowing users and enterprise software applications to interface with remote devices and to allow connectivity, memory storage, device management, device monitoring, device tracking, and device auditing, all via a computer network; providing temporary use of on-line non-downloadable software allowing users and enterprise software applications to interface with remote devices and to allow connectivity, memory storage, device management, device monitoring, device tracking, and device auditing, all via a computer network; Software as a service (SAAS) services featuring application software that allows users or

enterprise software applications to interface with, connect to and manage remote devices and to provide messaging, management and memory storage services; Technical support services, namely, installation, administration, and troubleshooting of web and database applications; technical consulting and assistance with computer-based information systems and components, namely, technical consulting services in the fields of Mobile Device Management (MDM), Mobile Applications Management (MAM), Mobile Security Management (MSM), Mobile Information Management (MIM), mobile Identity and Access Management (IAM), datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; Design and development of crisis communication systems comprised of computer hardware and software; engineering and computer systems analysis in the field of crisis communication systems; computer services, namely, providing online system management services that allow users to remotely view, monitor, program, operate and control crisis communication systems; technical research in the field of crisis

communication technology; testing of crisis communication systems; cloud computing featuring software for providing crisis communication through multiple IP network channels and delivery services; computer services, namely, integration of private and public cloud computing environments for crisis communication; computer services, namely, cloud hosting provider services for crisis communication; computer services, namely, installation of software for private cloud computing for crisis communication; consulting services in the field of cloud computing for crisis communication; computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, invite other organizations to the community and engage collaboration in the field of security and crisis communication and management; software as a service (SAAS) services featuring software for use in sending, receiving, confirming and responding to alerts, messages, and notifications in the field of crisis communication and management; software as a service (SAAS) services, namely, hosting software for use by others for use in sending, receiving, confirming and responding to alerts,

messages, and notifications in the field of crisis communication and management; providing online non-downloadable computer software for the purposes of data collection, monitoring, and mass notification services for managing emergency and crisis situations and improving crisis communications capability.	
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25. In the judgment of the Court of Justice of the European Union (CJEU) 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”.

26. 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.

27. 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 fur 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”.

28. 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.”

38. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

29. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, Jacob J. (as he then was) stated:

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

Class 9

30. The earlier mark BB is registered for goods in Class 9 that consist predominantly of varying types of software, including software that relates to management, security, mobile devices, monitoring, analysing, connectivity and transmission. The contested goods in Class 9 also include types of software. The contested *Computer software* and *Computer software applications, downloadable* are considered to be general categories that would likely include the more specific types of software of the earlier mark and are therefore found to be identical in accordance with the *Meric* principle. The other types of contested software are software for games and software for controlling lighting in locations such as theatres and nightclubs. The software of the earlier mark does not relate to either gaming or lighting, nor does it facilitate the playing or controlling of such goods. The contested *Games software; Lighting control software, including control software for use in commercial and industrial establishments, in theatres, in nightclubs and during concerts; and Lighting control software for use in*

stage lighting apparatus and instruments and for controlling stage lighting apparatus and instruments are therefore all dissimilar. The contested mark does not contain any other types of software.

31. In its submissions in lieu of a Hearing, the Applicant contended that the entirety of the goods in Class 9 of the earlier mark(s) are computer software. This is not accurate. Whilst the vast majority of the goods in Class 9 of the earlier mark BB are varying types of software, the mark is also registered for *Mobile phones, smart phones, tablet computers and wireless communication devices; accessories for mobile phones; and sd-cards*. Such goods shall also, therefore, be considered for comparison purposes against the contested goods in Class 9.

32. The contested *smartphones* are identically registered in the earlier mark. The contested *telephones* and *video telephones* are general categories that would include both the *mobile phones* and *smart phones* of the earlier mark and are therefore identical in accordance with the *Meric* principle. The contested *cell phones* are a synonym of the earlier mark's *mobile phones* and are therefore identical. The contested *telephone receivers* and *telephone transmitters* are two elements that enable a telephone to operate. They are undoubtedly either parts or components of both mobile and smart phones. 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.”

33. I am also aware that *telephone receivers* and *telephone transmitters* are frequently sold independently of a mobile or smart phone (most likely to replace a part in a landline telephone). However, this does not mean that there are not mobile or smart phones receivers and transmitters that can and are purchased as replacements, either by the average consumer or a technical specialist charged with repairing the device. Therefore, I consider the contested *telephone receivers* and *telephone transmitters* to be similar to at least a medium degree to the *mobile phones* and *smart phones* of the

earlier mark 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 effectively indispensable or important for enabling a mobile or smart phone to operate/perform, I also consider *telephone receivers* and *telephone transmitters* to be complementary.

34. The contested *stands adapted for mobile phones; carriers adapted for mobile phones; and hands free kits for phones* are all included in the general category of the earlier mark's *accessories for mobile phones*, and are therefore identical.

35. The contested *tablet computers* are identical to the *tablet computers* of the earlier mark. The contested *Data-processing equipment and computers* are also identical to the *tablet computers* of the earlier mark, by virtue of being more general categories that would include the earlier mark's *tablet computers* within them. The contested *laptop* and *notebook computers* are highly similar to the *tablet computers* of the earlier mark, insofar as they have the same distribution and trade channel, are sold in the same stores, are likely produced by the same manufacturers, have the same use and intended purposes, and attract the same end user. I consider the same to apply to the contested *peripherals adapted for use with computers; Computer keyboards; Printers for computers; Speakers for computers; Screens (computers); Magnetic tape units for computers*.

36. The earlier mark is registered for *accessories for wireless communication devices, namely...tablet computer protective cases, protective covers and cases*. Considering that laptops are not only similar to tablet computers, but are also classified as being wireless communication devices, I consider the following contested laptop accessories to be highly similar to the accessories and covers/cases of the earlier mark: *sleeves for laptops; bags adapted for laptops*. In addition, I consider the contested *stands adapted for tablet computers* to be an *accessory for wireless communication devices*. The contested *headphones; headphone consoles and speakers for computers* would fall within the general category of the earlier mark's *accessories for wireless communication devices, namely...headsets, mounts, and speakers*, and are therefore identical.

37. The earlier mark is registered for *sd-cards*. An *sd-card* is a 'secure digital card', used ordinarily as a memory card in a range of portable devices. The following contested goods are highly similar to *sd-cards*, as they have the same intended purpose, are of the same nature, have the same end user and trade channels, and are likely sold in the same store: *Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs [read-only memory]; Discs (Compact -) [audio-video]; Monitors [computer hardware]; Recorded content; Records [sound recordings]; Records [sound recordings]; Audio recordings; Audio tapes; Audio cassettes; Audio tapes; Blank audio cassettes; Recorded tape cassettes; Audio recordings; Audio tapes; Recorded tapes; Audio cassettes; Audio cassettes; Blank audio cassettes; Pre-recorded audio tapes; Magnetic data carriers, recording discs; Magnetic recording tapes.*

38. I note that the Opponent implied in its submissions in lieu of a Hearing that all of the contested Class 9 goods are either identical or similar to the goods and services of the earlier mark, most specifically the software and telecommunications goods and services. I do not agree that all of the contested goods are either identical to or similar with the goods and/or services of the earlier mark. In fact, some of the contested goods are clearly entirely different from software and telecommunications, e.g., *skateboard helmets; breathing apparatus for underwater swimming; fire blankets; and teeth protectors.*

39. The Opponent also argued that many of the goods are compatible with the earlier mark's *Internet of things (IOT) management software*, and cited by way of example contested goods such as *microphones, loudspeakers, door bells and alarms* as items that are connected with and use IOT. The Opponent has not provided specific submissions as to what IOT management software actually is. Without being an expert in the field, it is left to me to endeavour to understand the meaning of *IOT management software* based on the most immediately obvious and available definitions found on the internet. It appears to me that IOT refers to physical objects with sensors that connect and exchange data with other devices and systems. In order to do so, the physical objects would use software and would require the internet or another communication system. It is possible that the example of goods listed by the Opponent are the type of physical objects that have sensors, and probably do connect to the

internet to exchange data using software, for example. However, I do not consider it likely that the purchaser of a *microphone* or *door bell*, for example, would separately purchase IOT management software in order to ensure the goods function. In my opinion, a consumer would more likely expect such empowering software to already be installed and included within the physical object as a hidden component. As identified in *Les Éditions*, a component element and end product are not necessarily similar. I consider this finding to apply in relation to the physical objects and IOT software. In addition, I disagree with the Opponent's argument that the IOT software would be sold together with the physical goods. In my opinion, the software and physical goods are of a different nature, and are likely sold via different trade channels, in different stores, and are unlikely to be in competition.

40. I consider the contested *telecommunications cables* and *transmitters [telecommunications]* to be complementary to the Class 38 *Telecommunication services, namely, data transmission and reception services via telecommunications networks* of the earlier mark, insofar as the contested telecommunications goods are indispensable or important to the provision of the telecommunications services.

41. The remaining contested goods and services not specifically referred to in the above comparison are found to be dissimilar to the goods and services in Classes 9 and 38 of the earlier mark. The earlier mark is also registered for services which focus on mobile management and communications systems in various forms in Class 42. I do not believe that such services would be any more similar to the remaining contested goods than the goods and services in Class 9 and 38 of the earlier mark have been found to be.

42. In summary, further to a goods and services comparison I have found the following contested goods to be either identical, similar or complementary to the goods and services of the earlier mark:

Class 9 *Computer software; Computer software applications, downloadable; smartphones; telephones; video telephones; cell phones; telephone receivers; telephone transmitters; stands adapted for mobile phones; carriers adapted for mobile phones; hands free kits for phones; tablet computers; Data-processing equipment and computers; Laptop*

computers; Tablet computers; peripherals adapted for use with computers; Computer keyboards; Printers for computers; Speakers for computers; Screens (computers); Magnetic tape units for computers; sleeves for laptops; bags adapted for laptops; stands adapted for tablet computers; headphones; headphone consoles; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs [read-only memory]; Discs (Compact -) [audio-video]; Monitors [computer hardware]; Recorded content; Records [sound recordings]; Audio recordings; video recordings; Audio tapes; Audio cassettes; Audio tapes; Blank audio cassettes; Recorded tape cassettes; Audio recordings; Audio tapes; Recorded tapes; Audio cassettes; Audio cassettes; Blank audio cassettes; Pre-recorded audio tapes; Magnetic data carriers, recording discs; Magnetic recording tapes; telecommunication cables; transmitters [telecommunications].

Comparison of marks

43. 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.

44. In relation to the those contested goods not specifically identified as being identical, similar or complementary in paragraph 42, there can be no likelihood of confusion with the earlier mark BB. It is therefore not necessary to conduct a comparison of the marks in relation to those goods.



45. 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.”

46. It would be wrong, therefore, to dissect the trade marks artificially, 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.

47. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	

48. The earlier mark consists of the combination of two letters ‘BB’ in a plain, non-stylised font. The letters are of equal size, and so neither is considered to be more

dominant or distinctive. The overall impression rests in the combination of letters, which is also where any distinctiveness lies.

49. The contested mark consists of the combination of white letters BBG, on a black rectangular background. The letters are slightly stylised but are not of a particularly distinctive font. The black rectangular background is noticeable, however, it is essentially banal and performs the functional task of enabling the white coloured letters to be seen. The overall impression is dominated by the letters BBG, which is also where any distinctiveness lies.

Visual similarity

50. The marks are visually similar insofar as the first two letters of each respective mark are 'BB'. This is the extent of the visual similarity. The visual differences between the marks consist of the inclusion of a third letter in the contested mark, being the letter 'G', the use of a slightly stylised font in the lettering, and the use of a black rectangle background. The marks are found to be visually similar to a medium degree.

Aural similarity

51. Neither the earlier mark nor the contested mark consists of a collection of letters that form a pronounceable word, and as a result each letter will be enunciated separately. With this in mind, the marks are aurally similar to the degree that they share the identical sound presented by the letters 'BB'. The contested mark contains the additional letter 'G', which has no counterpart in the earlier mark, and represents an aural difference. The black background of the contested mark will not be pronounced and does not affect the aural comparison. The marks are found to be aurally similar to a medium degree.

Conceptual similarity

52. Although the Applicant submitted that each mark is an abbreviation, it also submitted that neither mark has any conceptual meaning. I agree that neither BB nor BBG have any immediate or obvious meaning, and as a result there can be no conceptual comparison.

Average consumer and the purchasing act

53. 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.

54. 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."

55. The goods at issue are everyday goods, insofar as they are bought and used on a daily basis. The price range will vary considerably, with *blank audio cassettes* and *sleeves for laptops* being relatively inexpensive items, whilst *smartphones* and *tablet computers* would be significantly more expensive. That having been said, in *Bang & Olufsen A/S v OHIM*, Case T-460/05, the GC stated that:

"According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T 110/02 *Axions and Belce v OHIM* (Brown cigar shape and gold ingot shape) [2003] ECR II 1897, paragraph 36)."

56. Generally speaking, the goods and services at issue are bought by the average consumer who is a member of the general public. The level of attention of the consumer would likely be higher in relation to goods such as *smartphones* and *tablet computers*, as the consumer may be making a choice as to which item to purchase

based on the availability (or lack thereof) of particular technical functions. Such products may even attract a more specialist consumer as part of its relevant public. The same analysis could also apply to certain types of software. That having been said, not all smartphones, tablet computers or software, etc., are exclusively specialist items, with some being more rudimentary than others, and subsequently more likely to attract the attention of a non-specialist and average consumer. Overall, the degree of attention will be medium.

57. Based on the nature of the goods and services at issue they are invariably made available for purchase in a retail store, app store, brochure, magazine or online. As such, the purchase process would predominantly depend on the visual aspect. I do not discount the possibility that the goods and services may also be bought over the telephone from a telemarketer or following consultation with a shop assistant or technical expert, for example, in which case both interactions would rely heavily on an oral exchange. As such there would logically be an aural element to the purchasing process. However, I consider this to be a secondary purchasing process to the visually dominant process.

Distinctive character of the earlier trade mark BB

58. 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).”

59. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

60. In its submissions the Opponent submitted that BlackBerry is regularly referred to as BB, and cited the appearance of BB in exhibits NXF3 (as BB 10) and NXF4 as support for the claim that BB enjoys enhanced distinctiveness.³ Exhibit NXF3 consists of a collection of press and media articles. The term BB 10 appears only once within the entirety of the press and media articles, where it is mentioned in a *BBC Technology* piece dated 2013. The article discusses how BlackBerry “...continues to face the twin demons of consumer-driven buying power and a chronic inability to appeal to mature market consumers ...there is nothing in what we’ve seen so far of BB 10 that suggests it will conquer the second of these demons, and the first is utterly out of BlackBerry’s control”. The combination BB 7 also appears in the same *BBC Technology* article, quoted as “BB7 - the previous system upgrade which was just incremental – was, let’s say, a failure.” Rather than supporting a claim for enhanced distinctiveness, the limited references to BB (twice in total) in articles which are questioning the attraction of the mark’s products would suggest an alternative opinion. The Exhibit NXF4 indicates that BlackBerry uses BB on the New York Stock Exchange, Yahoo Finance and Bloomberg. However, I do not consider that the use as a reference in finance-specific worlds would be known to the majority of average consumers (which I have identified

³ “It is submitted that the Opponent’s earlier marks enjoy an enhanced distinctiveness” paragraph 33 of the submissions dated 22 August 2022; “It is submitted that the Opponent’s earlier marks enjoy enhanced distinctiveness through its extensive use and recognition on the UK (and EU and worldwide) market over many years” paragraph 24 of the submissions in lieu dated 28 December 2022.

the relevant public to be). In my opinion, neither of the exhibits support the Opponent's claim of enhanced distinctiveness. Going forward, my assessment of the degree of distinctive character of the earlier mark will be made on the basis of its inherent features only, i.e., the combination BB.

Likelihood of Confusion

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

62. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

63. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed.

If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

64. In *Quelle AG v OHIM*, Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

65. The marks at issue have been found to be both visually and aurally similar to a medium degree, whilst the level of attention of the average consumer, who will predominantly make a purchase based on the visual aspect of the mark, has also been found to be medium. Despite this, I am of the opinion that the marks will not be directly confused. The marks at issue are undeniably short. The comparison of short marks does not include any special test, but it does require a common sense approach, whereby the change of one letter may have a greater impact than it would in a longer mark.⁴ I refer to the finding of Iain Purvis QC as he then was, acting as the Appointed Person in BL O/277/12, who stated:

“In considering visual similarity, it was clearly right to take into account the shortness of the marks, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark”.

66. The contested mark includes an additional letter ‘G’, which has no counterpart in the earlier mark. The addition of this letter creates a clear visual and aural difference, which will perhaps be more keenly felt when considering that each mark will be enunciated as a series of letters.

67. Although the degree of attention being paid during the selection and purchase process is “only” medium, and the consumer is “only” the average consumer, I believe it would be a disservice to suggest that they would mistake the later mark BBG for the earlier mark BB, despite the notion of imperfect recollection. The change of one letter carries more weight in a short mark than it does in a longer mark, and as such the consumer would notice it as a point of difference. Therefore, I do not consider there to be a likelihood of direct confusion.

68. Having found that there is no likelihood of direct confusion between the marks, I must now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.⁵ Further, there must be a proper basis

⁴ *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraph 38.

⁵ *In Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017*, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria (O/219/16)* paragraph 16

for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.⁶

69. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. as he then was, as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

⁶ *Ibid*, Arnold LJ's words at paragraph 13.

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

70. The marks at issue coincide in the combination BB at the beginning of each mark, which is where the consumer tends to attach more importance.⁷ However, whilst the additional letter ‘G’ is at the end of the contested mark, it is not being added to a common element (BB) that is so strikingly distinctive that the consumer would assume no-one else but the brand owner would be using it in a trade mark. Despite submissions to the contrary, the combination of letters BB has not been proven to enjoy an enhanced degree of distinctive character. The distinctive character of the earlier right is therefore limited to the overall impression of the combination of letters BB, which has no immediately obvious or discernible concept. In my opinion, a finding of indirect confusion on the basis that the marks share a combination of two letters, which does not enjoy any greater degree of distinctiveness than the overall impression, would be unfairly extending the protection of the earlier mark.

71. Although the letter ‘G’ is at the end of the contested mark, it is being added to an extremely short mark. It is therefore more likely to be noticed as a point of both visual and aural difference than it would be had it been added to a longer mark. The letter ‘G’ is also likely to be noticed because it is not simply the addition of a basic non-distinctive element in the same way that the addition of LITE or MINI would be. As is the case with the combination BB, the letter ‘G’ does not have an immediately obvious concept, and therefore it cannot be considered to be non-distinctive. The addition of the letter ‘G’ does not follow any apparent logic, and subsequently it does not fulfil the role that a consumer would expect in a sub-brand. Similarly, the addition of the letter ‘G’ is not consistent with a brand extension.

72. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as he then was, as the Appointed Person stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This would be mere association rather than indirect confusion. The fact

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

that the marks at issue share the letters BB' is not reason enough, in and of itself, to find indirect confusion.

73. I consider the additional letter 'G' to noticeably differentiate the later mark from the earlier mark to the extent that it is not offset by the finding of identity, similarity or complementarity between certain goods and services.⁸ I therefore find there to be no likelihood of indirect confusion.

74. The Section 5(2)(b) opposition based on the earlier mark BB fails in its entirety.

Earlier mark BBM

75. For reasons of procedural economy, I do not consider it necessary to assess the evidence that has been submitted for the purposes of proving genuine use of the earlier mark BBM. This is because even if the evidence were found to be sufficient, the mark would nevertheless be neither directly nor indirectly confusable with the contested mark.

76. The earlier mark BBM is itself a short mark, and therefore the relevant considerations as identified and applied in relation to the earlier mark BB remain pertinent. Essentially, the changing of a letter 'M' (earlier mark) to a letter 'G' (contested mark) would indeed be noticed by even the average consumer who is not necessarily displaying a heightened degree of attention, as changes of one letter in short marks are impactful and significant. The replacing of the letter 'M' with a letter 'G' would create visual and aural differences between the marks at issue, which would prevent the marks from being directly mistaken for one another. Further, the changing of the letter 'M' for the letter 'G' would not appear either logical or consistent with a sub-brand or brand extension. In my opinion, the changing of the final respective letters would not be missed by the average consumer, despite the notion of imperfect recollection. Even if the letter combination BB in the later mark were to call to mind the letter combination in the earlier mark, this would be mere association and insufficient for a finding of indirect confusion.

⁸ The interdependency principle, *Canon*, C-39/97, para 17

77. Whilst the earlier mark BBM is different from the earlier mark BB, the principles to be applied in the comparison with the contested mark are the same. And in my opinion the outcome is the same.

78. I am aware that there is a greater likelihood of confusion where the earlier mark has high distinctive character, either per se or because of the use that has been made of it.⁹ The inherent distinctive character of the earlier mark BBM is on an equal footing with that of the earlier mark BB, insofar as it consists of a combination of letters that have no immediately obvious or discernible concept. As for the claim of enhanced distinctiveness, I do not consider it to be discernibly stronger for BBM than it was for the earlier mark BB. The Opponent referred to exhibits NXF1 - NXF3 to support the claim that its earlier mark BBM enjoys enhanced distinctiveness.

- The Opponent submitted that NXF1 evidences BBM as an entry in a dictionary. The dictionary in question is dictionary.com, and in my opinion does not suffice in isolation to unequivocally prove it as a dictionary term. The combination is notable by its absence from Oxford, Collins and Merriam-Webster dictionaries.
- NXF2 is an extract from Wikipedia, detailing the history of BBM:

“BBM was a proprietary mobile instant messenger and videotelephony application included on Blackberry devices... BBM Consumer for Android and iOS was shut down on 31 May 2019, however the paid enterprise version of the software, BBMe, is still supported on these platforms.”

The entry appears to me to follow the sentiment of the articles discussing the earlier mark BB, insofar as the implication is that the mark’s use and presence is not what it was.

- NXF3 consists of a collection of media articles including those taken from the BBC, Financial Times and The Guardian. In my opinion these articles refer to BBM as a previously-known entity. The articles include those dated 2011 and

⁹ *Sabel BV v Puma AG*, Case C-251/95.

2013, which would be from outside of the relevant period for proving use¹⁰. One BBC article dated 4 January (year missing) includes the text “If you had a phone in the 2000s and 2010s, there’s a decent chance you were owner to some form of Blackberry handset. **Today marks the end of an era; the company’s software will stop working entirely.** It stopped marking its own phones in 2016.” (pages 24-25)

79. The articles included within the relevant period are limited in number and probative value. In isolation, and without accompanying information such as financial figures, market share, advertising expenditure etc., the articles are insufficient to support the claim of enhanced distinctiveness. To the contrary, they appear in my mind to indicate that BBM is on the wane rather than enjoying an enhanced reputation.

80. I do not consider the evidence submitted to have proven an enhanced degree of distinctive character of BBM. Therefore, the earlier mark BBM does not allow for a greater likelihood of confusion by virtue of it being an earlier mark that has high distinctive character.

81. The Opponent chose to rely upon a restricted list of goods and services for which the mark BBM is registered. Considering that the earlier mark BB is registered for a broader specification, and was still found to be neither directly nor indirectly similar, it seems to me that an earlier mark with a narrower scope is unlikely to be any more successful in an opposition.

82. The Section 5(2)(b) opposition based on the earlier mark BBM fails in its entirety.

Conclusion

83. The opposition has failed under section 5(2)(b) of the Act. The application may, subject to appeal, be registered for all of the goods and services applied for.

COSTS

¹⁰ Section 6A(1A) of the Trade Marks Act would create a relevant period as being 5 years ending with the date of application for registration or the date of the priority claimed for that application. The contested mark was filed pursuant to Article 59 of the Withdrawal Agreement, and is a comparable mark based on a EU filing date of 12 March 2020, which itself claims priority from a German filing of 12 September 2019. The relevant period is therefore 13 September 2014 – 12 September 2019.

84. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the statement of grounds and preparing a counterstatement	£300
Preparing submissions in lieu of a Hearing	£400
Total	£700

85. I therefore order BlackBerry Limited to pay Chal-Tec GmbH the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 17th day of March 2023

Dafydd Collins

For the Registrar