

O-445-15

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 047 484 BY
BRIGHTFLASH USA LLC TO REGISTER THE TRADE MARK IWATCH IN CLASS
09

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 402 646 BY ICE
IP S.A.

Background and pleadings

1. Brightflash USA LLC (the applicant) applied to register the trade mark IWATCH in the UK on 18 March 2014. It was accepted and published in the Trade Marks Journal on 13 June 2014 in respect of the following goods in Class 09: *Computer software; security devices; monitors and monitoring devices; cameras; computers; computer hardware; computer peripherals; wireless communication devices; radios; audio and video devices; global positioning system devices; accessories, parts, components, and cases for all of the foregoing goods.*
2. ICE IP S.A. (the opponent) opposes the trade mark on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of the following earlier trade marks:

Community trade mark No 1 046 763



Class 09:

Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers; Magnetic cards; Computer software; Telephone apparatus; Telephone receivers; Telephone transmitters; Computer games apparatus; Photographic apparatus; Radio receivers; Radio transmitters; Computer hardware; Parts and accessories for handheld and mobile digital electronic devices; Parts and accessories for mobile telephones; Mobile telephone covers; Mobile phone covers; Batteries; Chargers; Headphones; Loudspeakers; Microphones; Apparatus for connecting and charging portable and handheld digital electronic devices; Parts and fittings for all the aforesaid.

International trade mark No 1 152 655:



Class 09:

Apparatus for recording, transmission or reproduction of sound or images; magnetic data media; magnetic cards; software; telephone apparatus; telephone receivers; telephone transmitters; photographic cameras; radio receivers; radio transmitters; computer hardware; parts

O-445-15

and accessories for mobile and portable digital electronic devices; parts and accessories for mobile telephones; cases for mobile telephones; covers for mobile telephones; cells and batteries; chargers; earphones; loudspeakers; microphones; apparatus for connecting and charging mobile and portable digital electronic devices; parts and component parts for all the aforesaid goods

International trade mark No 1 029 087:



Class 14:

Timepieces and chronometric instruments.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Neither side filed evidence.
6. A Hearing took place on 2 September 2015, with the opponent represented by Mr Michael Elliott of Palmer Biggs Legal, trade mark attorney for the opponent and the applicant by Mr Thomas St Quintin of Counsel, instructed by Harper MacLead LLP, trade mark attorney for the applicant.

DECISION

Section 5(2) (b)

Sections 5(2) (b) of the Act is as follows:

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

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

Comparison of goods and services

7. For reasons of procedural economy, this decision will initially consider the opposition in respect of earlier trade mark 1 046 763.
8. In its skeleton argument, the applicant formally accepted that the vast majority of the later goods are identical to those of the earlier mark. The only exceptions were “security devices” and “global positioning system devices”. At the hearing, the applicant conceded that these were similar. The upshot is that the contested goods are either identical or similar to those of the earlier specification.


Comparison of marks

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

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

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

O-445-15

	IWATCH
Earlier trade mark	Contested trade mark

12. In considering the respective marks distinctive and dominant components, it is noted that in the contested mark the letter I is conjoined with the remaining WATCH with no stand out dominant and distinctive element present. In the earlier mark it is the element ICE with the small circular device which catches the eye first and is the most distinctive element. It is likely to be the most memorable aspect of the mark. However WATCH is not de minimis within the sign and so the correct comparison to be made is as between the marks as wholes.
13. In this regard the marks coincide in respect of the letters i-w-a-t-c-h and differ in respect of the additional elements as shown. Bearing in mind all of the aforesaid, including aspects of relative size and positioning, the marks are considered to be visually similar only to a low degree.
14. Aurally the matter is somewhat different – icewatch and iwatch. They are aurally similar to a moderate degree.
15. Conceptually, the opponent argues that the presence of WATCH in each of the signs creates a conceptual link between them. It is considered that the matter is not as straightforward as the opponent suggests. Bearing in mind that the marks should rightfully be considered as wholes, it is the elements ICE and I which provide different contexts for WATCH in each of the signs. The earlier trade mark is considered to be likely to evoke images of frozen water and it is this message that is overriding and will be grasped by the relevant public. The later trade mark is considered to be likely to immediately convey a message in respect of technology, possibly that it is the latest or most advanced piece of technology. Further, an additional meaning is possible, that of being able to monitor what is going on somewhere: “I can watch”. Bearing in mind these distinctions, all of which are clear, it is considered that there is a conceptual gap between these marks. Thus, they are not similar in this regard.

Average consumer and the purchasing act

16. 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*.

17. 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.”

18. The goods in question are in Class 09, many of which can be expensive and are generally purchased infrequently. Almost all will be considered so as to ensure items with the desired functionality are correctly purchased and it is likely that a period of research/review will have preceded the purchasing act. The relevant public will consist of both the professional public such as businesses and the public at large. Though there may be a difference in the level of attention paid to, for example, a computer case as opposed to a computer, it is considered that the average level of attention will be fairly high.

Distinctive character of the earlier trade mark

19. 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

O-445-15

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)."

20. There is no evidence that the earlier trade mark has acquired an enhanced distinctive character. As such, the matter must be judged on a prima facie basis. The earlier trade mark has no clear meaning in respect of the relevant goods in this opposition. Indeed it is considered to be unusual and somewhat fanciful. It is therefore considered to be distinctive to a fairly high degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

21. 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.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has

O-445-15

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.

22. It has been found that the goods are either identical or similar. This degree of closeness at least in respect of the identical goods, can offset a lesser degree of similarity between the marks. Further there is a moderate degree of aural

O-445-15

similarity. However, there is only a low degree of visual similarity between the marks and importantly, there is a clear conceptual gap present. In this respect the following guidance is helpful: In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

23. The conceptual difference here will provide a differentiating hook in the mind of the average consumer. Further, the goods in question will attract a fairly high degree of attention during the purchasing process. All of the aforesaid factors militate against an imperfect recollection occurring and so, a likelihood of confusion. It is true that the earlier trade mark is fairly highly distinctive, but it is difficult to see how that would balance the scales in favour of the opponent bearing in mind the differences in the marks as already described. It is considered that there is no likelihood of confusion here, even in respect of the goods found to be identical. The opposition therefore fails in its entirety.

Final Remarks

24. It is noted that the opponent relies on two further earlier trade marks. However, these are for the same mark as has already been compared. Further, the class 09 specification in one is narrower and in the other is class 14 which is considered to be further away from the goods applied for. As such, these marks do not place the opponent in a materially better position. They therefore will not be considered.

COSTS

25. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: - £200
Preparing written submissions - £300
Preparation for and attending a Hearing - £500
TOTAL - £1000

26. I therefore order ICE IP S.A. to pay Brightflash USA LLC the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of September 2015

For the Registrar,

Louise White