

O/598/18

TRADE MARKS ACT 1994

IN THE CONSOLIDATED MATTERS OF

TRADE MARK APPLICATION NO. 3234897 BY OFO UK LIMITED TO REGISTER



AS A TRADE MARK FOR GOODS AND SERVICES IN CLASSES 6, 9, 12, 39 AND 42

AND

OPPOSITION NO. 410196 THERETO BY NOKIA TECHNOLOGIES OY

AND

OF TRADE MARK REGISTRATION NO. 3203977 IN THE NAME OF OFO UK LIMITED

AND

THE APPLICATION BY NOKIA TECHNOLOGIES OY UNDER NO. 501840 TO

CANCEL PART THEREOF

BACKGROUND AND PLEADINGS

1. This decision deals with consolidated opposition and cancellation proceedings brought by Nokia Technologies Oy (“**Nokia**”) against OFO UK Limited (“**OFO**”).
2. On 18 May 2017 OFO applied to register as a UK trade mark (under application No. 3234897 “**the Application**”) the figurative mark shown on the front page of this decision, for goods in Classes 6, 9 and 12 and for services in Classes 39 and 42, as set out in the table in the **annex** at the end of this decision. The Application was published for opposition purposes on 9 June 2017.
3. Nokia **opposes part of the Application**, namely in relation to the following of OFO’s goods in **Class 9**: *Application software for mobile phones and tablet devices; Computer Software*, and in relation to all the services applied for in **Class 42**: *IT services namely Software development, programming and implementation; computer hardware development; hosting services and software as a service and rental of software; rental of computer hardware and facilities; IT consultancy, advisory an information services; IT security, protection and restoration; data duplication and conversion services; data coding services; computer analysis and diagnostics; research, development and implementation of computers and systems; computer project management services; data mining; digital watermarking; computer services; technological services relating to computers; computer network services; updating of memory banks of computer services; data migration services; updating websites for others; monitoring of computer services by remote access.*
4. OFO is also the registered proprietor of trade mark registration No. 3203977 (“**the Registration**”) – filed on 23 December 2016, published for opposition on 13 January 2017 and registered on 24 March 2017 - which is in respect of the same figurative mark and is registered for the same goods and services in Classes 6, 9 and 39 as under the Application. Nokia has applied to **cancel part of the Registration** in relation to the same selection of OFO’s goods in **Class 9**, namely *Application software for mobile phones and tablet devices; Computer Software*.
5. The grounds, both of the opposition and the application for cancellation, were based originally on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), but Nokia subsequently withdrew its sections 5(3) and 5(4)(a) grounds. Consequently, the

proceedings in each case are based only on the grounds set out **section 5(2)(b) of the Act**, Nokia relying on its ownership of the European Union Trade Mark (EUTM) registration **14414106** for the word mark “OZO”, filed on 27 July 2015 and registered on 13 July 2016. In both proceedings, Nokia relies on all goods and services registered under its mark, which are as follows:

Nokia’s goods and services under EUTM 14414106

Class 9: *Photographic, cinematographic and optical apparatus and instruments; apparatus for recording, capturing, storing, processing, editing, displaying, transmission, reproduction and play back of sound or images; digital and optical recording media; audio, video, imaging, virtual-reality and presence-capture software; cameras; audio, video, imaging, virtual-reality and presence-capture sensors; head-mounted displays; spectacles (optics); downloadable sound and image files; audio, video and images encoder/decoder (codec); algorithms for the compression, decompression, encoding, decoding and processing of audio, video and imaging data; electronic publications; chips [integrated circuits]; microprocessors; parts, fittings and accessories of all the aforementioned goods.*

Class 41: *Audio, video and images editing and production services.*

Class 42: *Audio, video, imaging, digital media, multimedia and virtual reality technology services and research and design relating thereto; design, engineering and development of audio, imaging, video, digital media, multimedia and virtual reality hardware and software; technological analysis, research, development, support, technical troubleshooting and consultancy services in the field of audio, imaging, video, digital media, multimedia, virtual reality and presence capture technologies; data encoding and decoding services exclusively for use in relation to audio, imaging, video, digital media, multimedia, virtual reality and presence capture software and hardware; software as a service [SaaS] exclusively for use in relation to audio, imaging, video, digital media, multimedia, virtual reality and presence capture software and hardware; platform-as-a-service (PaaS)exclusively for use in relation to audio, imaging, video, digital media, multimedia, virtual reality and presence capture software and hardware; rental of audio, imaging, video, digital media, multimedia, virtual reality and presence capture software and hardware.*

6. Nokia claims that the parties' marks are highly similar since they share the same beginning and end and differ by one letter in the middle, and that the colour and minimal stylisation are insufficient to distinguish the marks. Nokia claims that the goods and services are identical and/or similar and that there exists the likelihood of confusion, whereby the relevant public will think that OFO's goods and services emanate from Nokia or from an undertaking economically linked with Nokia.
7. OFO filed counterstatements in defence of the Registration and the Application, denying that registration of its mark conflicts (or would conflict) with section 5(2)(b). It makes the following points:
 - It **denies** in particular that the relevant public will think its goods and services emanate from Nokia or from an undertaking economically linked with Nokia.
 - It **admits** that its contested **Class 9 goods** are identical or similar to the goods and services on which Nokia relies.
 - It **admits** "some similarity" between its **applied-for services in Class 42** and the goods and services on which Nokia relies, **except** in relation to: "*data mining; digital watermarking; IT security, protection and restoration; computer network services; updating of memory banks of computer services; data migration services; updating websites for others; monitoring of computer services by remote access*", which it **denies are identical or similar**.
 - It **denies** that the marks are highly similar as the letter "Z" in Nokia's mark, instead of a letter "F", creates a very different overall impression between the two marks, with there being distinct visual, aural and conceptual differences enabling the consumer to distinguish between the marks. Any similarity between the marks (if any) is low and the level of similarity is insufficient to create a likelihood of confusion – even where the goods / services are held to be identical or similar.
 - It claims that the nature and expense of the goods / services at issue will lead the average consumer to pay an above average degree of attention and that their visual means of selection will be most important.

Papers filed and representation

8. Both Nokia and OFO filed submissions during the evidence rounds; OFO filed submissions in lieu of an oral hearing along with a "fall-back position" in the form of limited specifications

to be considered only in the event that the decision in these proceedings should find to any extent in favour of Nokia. Neither side filed evidence. Osborne Clarke LLP acts for Nokia in these proceedings; OFO is represented by Ashfords LLP. Neither party requested an oral hearing and I take this decision based on a careful reading of the papers filed.

My approach in this decision

9. Both proceedings are based on the same single ground, where OFO's contested mark is the same in both instances. Both proceedings are also directed at the same goods in Class 9, which OFO has admitted are identical or similar to the goods and services on which Nokia relies. In these circumstances I find it procedurally efficient to make my decision initially only on the basis of assessing the likelihood of confusion in relation to those **Class 9 goods**, since if I find them to be identical but find no likelihood of confusion, there can be little benefit in assessing the other goods and services.

DECISION

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

"... A trade mark shall not be registered if because-

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

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

11. The mark on which Nokia relies is an earlier trade mark¹ for these purposes and is not subject to proof of use², so Nokia is able to rely for these proceedings on all its claimed goods and services without having to show that it has used it mark.

¹ See section 6(1) of the Act.

² See section 6A of the Act.

12. I bear in mind the relevant principles from decisions³ of the EU courts and will refer to those principles as appropriate.

Comparison of the goods and services

13. OFO has applied for, and has a registration for, the following goods in Class 9 that are contested by Nokia: *Application software for mobile phones and tablet devices; Computer Software*. OFO admits that those goods are identical or similar to the goods and services on which Nokia relies.
14. I note that the goods in Class 9 relied on by Nokia include, for example, “*audio, video, imaging, virtual-reality and presence-capture software*” and “*downloadable sound and image files*” and “*algorithms for the compression, decompression, encoding, decoding and processing of audio, video and imaging data*”.
15. It is clear from case law such as *Merici*⁴ that goods can be considered as identical when the goods or services designated by the earlier mark are included in a more general category designated by the trade mark application or vice versa. On the basis of the principle expressed in *Merici* **I find that OFO’s contested software goods in Class 9 are identical to goods in Class 9 relied on by Nokia**. I have no doubt in finding that identity, but note that those goods have in common a shared nature, purpose, method of use and are complementary in the sense described in *Boston Scientific*⁵ (cited by OFO in its submissions). Such factors⁶ in themselves would lead to the goods being considered at least highly similar.

³ *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; *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P.

⁴ See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

⁵ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

⁶ See ruling of the Court of Justice of the European Union (“the CJEU”) in *Canon* Case C-39/97, at paragraph 23; see too the relevant factors identified by Jacob J. (as he then was) in *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

The average consumer and the purchasing process

16. It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. 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 question⁷. In *Hearst Holdings Inc*,⁸ 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 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 word "average" denotes that the person is typical... ."

17. I have found identity between the respective goods of the parties in Class 9⁹. The contested goods in Class 9 are essentially software, although Nokia has a wider array of goods in that class, including photographic equipment, spectacles and microprocessors. I find that the average consumer for such goods will be the public at large, although some of the goods will also be of interest to business customers. OFO claims in its counterstatement that the nature and expense of 'the goods / services at issue' (as a whole) will lead the average consumer to pay an above average degree of attention - the implication of a greater degree of care paid by the average consumer in the purchasing processing is that it tends to reduce the likelihood of confusion. Although the parties' goods in Class 9 could include goods that are expensive and uncommon purchases - and although the average consumer may include businesses, whose purchasing process tends to be more considered and systematic than for members of the public at large - I find that the goods could equally include inexpensive and relatively common purchases made by ordinary members of the public (for example, apps for mobile phones). I therefore find that the **level of attention may be above normal in some cases, but in other cases will be no more than normal or ordinary.**

⁷ *Lloyd Schuhfabrik Meyer*, Case C-342/97


⁸ *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)

⁹ I make a comment in relation to the services where I deal with likelihood of confusion below.

18. The average consumer will see the marks used on the goods as labelling or branding or in advertising, where a consumer will browse shelves in shops, search the internet or peruse a catalogue to select the goods. Therefore, I consider the purchase to be a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations, so I also take into account the aural impact of the marks in the assessment.

Comparison of the marks

19. It is clear from *Sabel*¹⁰ 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. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Nokia’s earlier trade mark:	OZO
OFO’s contested trade mark:	

20. The overall impression of Nokia’s mark is that it is simply the word “ozo”, which appears to be an invented word, without a meaning in the English language.

21. The overall impression of OFO’s mark is that it is the word “ofo”, which again appears to be an invented word, without a meaning in the English language. One is also struck by a degree of stylisation. The word is dominant in the overall impression, but the figurative

¹⁰ *Sabel BV v Puma AG*, Case C-251/95

embellishments are not negligible. The mark's yellow colour also contributes to its overall impression, but its significance is removed as I explain below.

Visual similarity

22. Both marks involve only three letters and start and end with the letter "O". They differ in their middle letters. Nokia's earlier trade mark happens to be shown in upper case, whereas the stylised words of OFO's mark appears to be in lower case; however, that visual difference created by Nokia's mark being presented in upper case may be disregarded for the purposes of assessing visual similarity, since it is well established that fair and notional use of a word mark (unstylised) would allow the mark to be presented in lower case¹¹.
23. Nokia submits that "the 'double Os' in a short 3-letter word are striking and this gives the signs a significant degree of visual similarity." It also submits that the difference of one letter is "not material", whereas OFO submits that "being such short words, the average consumer would easily be able to perceive the visual differences between the marks. The letter 'f' is quite clearly visually different from the letter 'Z'."
24. I find that there is a clear visual overlap in that two of the three letters of the marks are the same and in the same positions. However, I find the difference in the middle letter in the marks is plain to see. They are different letters and the letter "f" extends above the letters "o" either side of it. No ordinary and fair notional use of the letter "Z" in Nokia's mark would stand it proud of its neighbouring Os, since that would impact on the distinctive character of the mark¹².
25. I also note other differences between OFO's stylised mark and the earlier word mark. Although OFO's mark is presented in a named tone of yellow, its use is not limited to that colour; equally Nokia's word mark may notionally be used in any colour. Colour is therefore not influential in assessing visual similarity of the marks. I note too the stylisation of the text in OFO's mark; the stylisation is subtle, but I find that it contributes to the distinctive character and overall impression of the mark, giving rise to a further visual difference.

¹¹ See the ruling of Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14 (at paragraph 21).

¹² See the ruling of the CJEU in *Sadas SA, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-346/04 4 November 2005 at paragraph 47.

26. Overall, I find the marks to be **visually similar to a degree that is, at most, between low and medium.**

Aural similarity

27. OFO submits that that its mark would be pronounced as “oh-eff-oh” whereas Nokia’s mark would be pronounced “oh-zed-oh” or “OH-ZOH”. Nokia submits that “each sign will be pronounced as two syllables” – presumably OH-FOH (or OV-O) and OH-ZOH (or OZ-OH) – and submits that aurally they “are highly similar” because their pronunciation “coincides in the sound of the two Os, one at the beginning and one at the end” and “while the middle letters are not the same, they are similar because they are both softly pronounced within each sign and would be overwhelmed by the beginnings and ends of the signs and play no significant part in the pronunciation of the signs.”
28. I find it more likely that the average consumer would pronounce the marks as two-syllables - OH-FOH or OV-O and OH-ZOH or OZ-OH, but if the average consumer were to voice OFO’s mark as its three component letters as OFO submits, then I find that the same consumer would equally pronounce Nokia’s mark as three syllables. I disagree with Nokia’s submission that the middle letters play no significance in the pronunciation of the signs – the marks will be pronounced differently and the average consumer will be able to distinguish OH-FOH or OV-O from OH-ZOH or OZ-OH, and if the words were pronounced as three separate letters, the aural differences are at least as clear. The marks are aurally similar to **a degree that is, at most, between low and medium.**

Conceptual similarity

29. Nokia submits that each sign is an invented word in English “and therefore a conceptual comparison cannot be made.” In its submissions, OFO agrees that the marks/signs in question are comprised of invented words, adding further that the words are meaningless in English, and “thus there is no conceptual similarity between the marks/signs”. In the circumstances, I find that there is **no conceptual similarity between the marks, but that that finding is neutral** in its effect.

Distinctive character of earlier trade mark

30. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*¹³ the Court of Justice of the European Union 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

*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).”*

31. Nokia’s trade mark is an invented word, with no descriptive or allusive message. It is **inherently distinctive to a good degree**. The level of inherent distinctiveness of a trade mark may be enhanced through use in the UK, but since no evidence was filed in these proceedings, I only have inherent distinctive character to consider.

Conclusion as to likelihood of confusion

32. I now turn to consider the likelihood of confusion between the parties’ marks if they were used in relation to the respective goods. I make a global assessment of the likelihood of confusion, taking account of all relevant factors.

¹³ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

33. I take due account of some interdependence¹⁴ between the relevant factors, including that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the goods. I have found that at least the contested goods in Class 9 are identical to goods on which Nokia relies. I have also found that Nokia's earlier mark is inherently distinctive to a good degree. Such considerations favour Nokia. However, I have found that the purchasing process will involve primarily visual considerations of the marks, which I have assessed to be visually similar to a degree that is, at most, between low and medium. I have also found the marks to be aurally similar again only to a degree that is, at most, between low and medium. In comparing the marks from a conceptual perspective, my findings are neutral.
34. Despite the level of similarity that arises from the shared letters, the difference in middle letter is striking in the overall impression of OFO's mark, especially as the letter "f" in the figurative mark protrudes clearly above the letters o. The parties' marks look and sound different from one another. Whilst the average consumer may hold in mind an imperfect picture of the marks, s/he is deemed reasonably well informed and reasonably circumspect and observant, and in this case even paying a level of attention that is no more than normal or ordinary, I find that the average consumer will readily distinguish between the marks and will not directly mistake one mark for the other. No likelihood of confusion arises and there will be no association between the marks and no risk that the public might believe that the respective goods come from the same or economically-linked undertakings.
35. **The opposition to the Application and the application to cancel the Registration therefore fail on the basis of my analysis of the marks.** My assessment of likelihood of confusion was founded on identical goods in Class 9 and on a level of attention assessed at its lowest as no more than normal or ordinary. Nokia could therefore have no greater prospect of success were I to compare the contested services in Class 42 (especially since such services are likely to involve a higher degree of attention by the average consumer).

Costs

36. OFO has successfully defended the Application and the Registration and is entitled to a contribution towards its costs. My assessment of a contribution towards the cost of the

¹⁴ See paragraph 17 of the judgment in Canon Case C-39/97.

proceedings is based on the guidance in Tribunal Practice Notice 2/2016 and I award the sum of £650, calculated as follows:

Considering the statements of grounds and preparing counterstatements:	£300
Considering the other side's submissions and preparing own submissions:	£350
Total:	£650

37. I therefore order Nokia Technologies Oy to pay OFO UK Limited the sum of £650 (six hundred and fifty pounds) to 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 25th day of September 2018

Matthew Williams

For the Registrar

Annex

OFO UK's goods and services	
<i>(Classes 6, 9 and 39 being the same both in OFO UK's application and registration)</i>	
Class	
6	Locks; Bicycle locks; metal locks; Spring locks.
9	<i>Application software for mobile phones and tablet devices; Computer Software; Electronic Locks; Electric locks; Digital locks.</i>
12	Vehicles; apparatus for locomotion by land; parts and fittings for vehicles; wheels and tyres and continuous tracks for vehicles; anti-theft, security and safety devices and equipment for vehicles.
39	Passenger vehicle hire; Vehicle hire services; Arranging vehicle hire; Rental and hire of vehicles; Provision of hired vehicles for the transport of passengers.
42	<i>IT services namely Software development, programming and implementation; computer hardware development; hosting services and software as a service and rental of software; rental of computer hardware and facilities; IT consultancy, advisory and information services; IT security, protection and restoration; data duplication and conversion services; data coding services; computer analysis and diagnostics; research, development and implementation of computers and systems; computer project management services; data mining; digital watermarking; computer services; technological services relating to computers; computer network services; updating of memory banks of computer services; data migration services; updating websites for others; monitoring of computer services by remote access.</i>
