

O-337-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3054403
BY GSE TECHNOLOGY LTD
TO REGISTER THE TRADE MARK**

DROIDVISION

IN CLASS 9

AND

**THE OPPOSITION THERETO UNDER NO. 402793
BY GOOGLE INC.**

Background and pleadings

1. GSE Technology Ltd (“the applicant”) applied for the trade mark DROIDVISION on 6 May 2014 for the following goods in Class 9:

Apparatus for recording, transmission or reproduction of sound or images; computers; mini computers; satellite television receiving apparatus; audio and video receivers, transmitter; USB sticks; USB cables; computer operating programs; computer software; computer hardware; mobile phones; tablet computers; set-top boxes, IPTV box, netbook computers; laptop computers; radios; remote controls; televisions; stereos; DVD players; video recorders; MP3 player; computer servers, IPTV servers, IPTV clients; keyboards, computer mice, air-mice, external computer hard drives, audio components, headphones, audio speakers, set-top boxes, home theater systems, videoprojectors, movie projectors, audio and video equipment for vehicles, adapters (electricity), headsets, power cables, leads connectors. Electronic albums; digital picture frames; notebook computers; terminals for electronic toll collection; terminals for electronic transactions installed in vehicles; cameras for closed circuit television [CCTV] ; cameras for monitoring network systems; digital signage; monitors for video. hardware for allowing users to access and view movies.

2. The application was published on 6 June 2014. It was subsequently opposed by Google Inc. (“the opponent”) on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon four earlier marks for its grounds under sections 5(2)(b) and 5(3) of the Act, as follows:

(i) UK 2530935

ANDROID

Class 9: Hardware and software; telecommunications apparatus and instruments; mobile devices and peripherals; mobile phones, cell phones, smart phones, personal digital assistants (PDAs), mobile computers, wireless handhelds, and portable phones; peripherals for mobile phones, cell phones, smart phones, personal digital assistants (PDAs), mobile computers, wireless handhelds, and portable phones; parts and fittings for all the aforesaid.

Filing date: 9 November 2009; date registration procedure completed: 23 April 2010.

(ii) Community Trade Mark (“CTM”) 8458309

ANDROID

Class 9: mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants (PDAs), and peripherals for same; computer software for use in connection with mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants (PDAs).

Filing date: 29 July 2009; date registration procedure completed: 8 March 2010.

(iii) CTM 6410856

ANDROID

Class 9: Computer hardware and computer software for use in connection with mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants.

Filing date: 6 November 2007; date registration procedure completed: 21 October 2010.

(iv) CTM 10402808

ANDROID

Class 9: Computer software, computer hardware, mobile phones, mobile peripherals, computers, tablet computers, netbook computers, laptop computers, integrated circuit chips, microchips, camera cases, camcorder cases, thermostats, radios, telephones, remote controls for radios, televisions and stereos, video game consoles, DVD players, video cassette recorders, digital video recorders, MP3 players, audio amplifiers, computer servers, printers, scanners, photocopying machines, computer monitors, fax machines, network routers, keyboards, computer mice, external computer hard drives, camcorders, cameras, calculators, gps navigation devices, audio components, headphones, audio speakers, audio receivers and video receivers, personal digital assistants (PDA), set-top boxes, home theater systems, video projectors, movie projectors, security alarms, fire alarms, fire and smoke detectors, radar detectors, audio and video equipment for vehicles, battery chargers, adapters (electricity), answering machines, headsets, electric light switches.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; light bulbs, microwave ovens, refrigerators, freezers, electric appliances namely refrigerators, freezers, toasters, toaster ovens, cooking ranges, microwave ovens, cooking ovens, convection ovens, cooking stoves, coffee machines, kettles, hot plates, popcorn makers, rice cookers, food steamers, rotisseries, bread makers, deep fryers, griddles, grills, waffle irons, food steamers, ice cream makers, roasters, ice makers, food warmers, dehydrators, clothes dryers, air conditioning apparatus, heaters, fans, water ionizers, air purifiers, air filters, furnaces, hair dryers, humidifiers, vaporizers, space heaters and beverage coolers, cooking ranges, cooking ovens, electric stoves, electric lamps, ceiling lights, wall lights, clothes dryers, air conditioning apparatus, electric heaters, electric fans, ceiling fans, furnaces.

Class 16: *Books, magazines, newsletters, manuals; notebooks, notepads, pens, greeting cards, stickers, decals, sticky notes, stationery, organizers; pencils, mechanical pencils, pencil-sharpeners, correction fluid; postcards; adhesives; pencil cases; paper clips; staplers; paper staples, clipboards, desk sets, posters, memo pads, paperweights, calendars, book covers.*

Class 28: *Collectable toy figures, doll toys; hand-held units for playing electronic games; playing cards.*

Class 35: *Advertising services; online retail services with regard to software, music, books, movies, games and digital media.*

Class 38: *Telecommunications services; transmission of data by global computer network; streaming of audio, visual and audiovisual material via a global computer network; providing online resources for software developers, namely providing discussion groups.*

Class 41: *Providing online resources for software developers, namely, providing documentation, articles, videos, blogs, tutorials and lessons relating to software development and software troubleshooting; providing guides for software developers; providing online journals, namely, blogs in the field of software development; online game services; mobile game services.*

Class 42: *Application services provider (ASP), namely, hosting computer software applications of others; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking in the field of software development; providing temporary use of non-downloadable software; providing online resources for software developers, namely providing software and sample codes.*

Filing date 9 November 2011; priority date 9 May 2011 (Argentina); date registration procedure completed: 31 July 2012.

3. The opponent relies upon all of the registered goods and services to oppose all of the applied-for goods. It claims that there is a likelihood of confusion under section 5(2)(b), owing to the similarities between the marks and the goods and services. Under section 5(3), the opponent claims that the reputation enjoyed by its marks means that use of the application would cause detriment to the earlier marks' distinctive character and reputation, would take unfair advantage of the earlier marks' reputation, and would lead to an assumption by the average consumer that there is an economic connection between the parties.

4. Under section 5(4)(a), the opponent relies upon use of its sign ANDROID, since 5 November 2007, throughout the UK, upon all the goods for which mark (i) is registered. The opponent claims that use of the application would be a misrepresentation, which would lead to damage to the opponent's business

connected with its sign. It claims, therefore, that it is entitled to prevent the use of the application under the law of passing off.

5. The applicant denies the grounds. Its counterstatement comprises essentially the only submissions made by the applicant during the course of the proceedings, which I have taken into account fully in making this decision.

6. The opponent is professionally represented, whilst the applicant represents itself. The opponent filed evidence. The applicant filed nothing of substance after filing the counterstatement. The parties were asked if they wished to be heard or for a decision to be made from the papers. The opponent asked to be heard and was represented at a hearing before me by Mr Leigh Cassidy, of Field Fisher Waterhouse LLP, on 10 July by video conference. The applicant did not attend and did not file written submissions in lieu of a hearing.

Opponent's evidence

7. This comes from Gavin Charlston, who has been the opponent's Trademark Counsel since 2012. He has full access to the opponent's records.

8. Mr Cassidy accepted at the hearing that the evidence shows that the opponent's reputation in its marks extends only to that of an operating system for mobile devices, such as smartphones, tablets and wearable devices. The applicant also accepted the opponent's use of its marks in an email to the Registry, dated 16 April 2015 (from its director, Naing Han Thar¹). Mr Charlston describes the nature of the opponent's products:

“8. The ANDROID and ANDROID stylised trade marks are used extensively and with great success by the Opponent for an operating system for mobile devices such as smart phones and tablet computers.

9. I will come back to specific details of that reputation, and to the opponents' evidence relating to the applicant, at the appropriate points in this decision. The opponent is entitled to rely upon notional and fair use of its marks but without that use having enhanced the mark's distinctive character or reputation in relation to the goods and services registered under its earlier marks which do not comprise operating systems for mobile devices.

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

“(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,

¹ Reproduced verbatim: “As per their evidents , Google have no devices or products name “android” apart from open source operating system “android”.”

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 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 the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. The applicant has not denied, or commented upon, the opponent's claim that the parties' goods and services are similar or identical. The counterstatement denies only that the marks are similar. However, the applicant is unrepresented and the contents of the counterstatement indicate that it is unfamiliar with the part which an assessment of the similarity of the goods and services plays in the assessment as to whether there is a likelihood of confusion. I will, therefore, undertake a comparison of the parties' goods and services. Mr Cassidy's primary submission was that 'hardware and software' in the opponent's earlier mark UK 2530935 is broad enough to cover the applicant's goods. In case I disagreed with that submission, Mr Cassidy's skeleton argument contained a helpful table comparing the parties' goods and services.

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

14. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

"82 It is true that goods are complementary if 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 that the responsibility for those goods lies with the same undertaking...".

15. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

16. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

18. I will go through the applicant's goods and compare them to the goods and services in the opponent's specifications. For economy of procedure, if there are several terms in the opponent's specifications which are identical or similar, I will not list them all.

- *Apparatus for recording, transmission or reproduction of sound or images.* These are identical to the opponent's 'telecommunications apparatus and instruments' in the specification for 2530935.
- *Computers; mini computers; netbook computers; notebook computers; laptop computers; tablet computers.* These are identical to the opponent's 'mobile computers' in the specification for in 2530935.
- *Satellite television receiving apparatus; audio and video receivers, transmitter.* These are identical to the opponent's 'telecommunications apparatus and instruments' in the specification for 2530935.
- *Computer operating programs; computer software.* These are identical to the opponent's 'software' in the specification for 2530935.
- *Computer hardware; hardware for allowing users to access and view movies.* These are identical to the opponent's 'hardware' in the specification for 2530935.

- *Mobile phones* are identical to 'mobile phones' in the specification for 2530935.
- *Set-top boxes, IPTV box²*. These are identical to 'telecommunications apparatus and instruments' in the specification for 2530935 and to 'set top boxes' in the specification for the stylised CTM 10402808.
- *Digital picture frames* are identical to 'hardware' in the specification for 2530935.
- *Televisions, radios, stereos, remote controls, DVD players; video recorders; MP3 player* are identical to 'televisions, radios, stereos, DVD players, video cassette recorders, MP3 players, remote controls for radios, televisions and stereos' in the specification for the stylised CTM 10402808. I would not describe these as hardware, although converging technology allows streaming of audio visual content through smart TVs and internet radio. There may therefore be some sharing of purpose and method of use in relation to hardware, televisions and radios.
- *Computer servers, IPTV servers*, are identical to 'hardware' in the specification for 2530935 and to 'computer servers' in the specification for the stylised CTM 10402808. *IPTV clients* are identical to 'software' in the specification for 2530935.
- *Keyboards, computer mouses, air-mouses, external computer hard drives, audio components, headphones, audio speakers, set-top boxes, home theater systems, videoprojectors, movie projectors, audio and video equipment for vehicles, adapters (electricity), headsets, power cables, leads connectors; USB sticks; USB cables*. These are identical to hardware, parts and fittings for hardware in the specification for 2530935.
- *Electronic albums*. The opponent submits that these are similar to its MP3 players and its software. An electronic album does not seem to me to be similar to an MP3 player, any more than an LP is similar to a record player, or a CD to a CD player. Whilst each is necessary for the other (so are complementary), they are not of a similar nature, purpose, or method of use. There is no evidence that audio equipment is commonly sold via the same trade channels as the music itself. There is no similarity between them. In relation to the opponent's claim that electronic albums are similar to software, the software is an operating system that allows the downloading of an electronic album. It is not similar in nature, purpose, method of use, and is not in competition, nor is there evidence of shared trade channels. I find no similarity between electronic albums and software.

² From Wikipedia: "Internet Protocol television (**IPTV**) is a system through which television services are delivered using the Internet protocol suite over a packet-switched network such as a LAN or the Internet, instead of being delivered through traditional terrestrial, satellite signal, and cable television formats."

- *Terminals for electronic toll collection; terminals for electronic transactions installed in vehicles; digital signage; monitors for video.* These are identical to the opponent's 'hardware' in the specification for 2530935.
- *Cameras for closed circuit television [CCTV]; cameras for monitoring network systems.* These are identical to 'cameras' in the specification for the stylised CTM 10402808 and to hardware in the specification for 2530935.

Average consumer

19. 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*.

20. 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.”

21. The goods of both parties are technical, for the most part potentially expensive, potentially with long-term important applications and will be purchased only after exercising an above average degree of care and attention to detail to ensure e.g. compatibility, price, functionality etc. In some cases, considerable care will be taken, such as cameras for closed circuit television [CCTV], cameras for monitoring network systems, terminals for electronic toll collection; terminals for electronic transactions installed in vehicles. The perception of the marks during the selection process will be primarily visual, on the basis of e.g. advertisements, company literature and websites, but I do not ignore the possibility of oral use of the marks during the purchasing process.

Comparison of marks

22. 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.”

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.

23. The respective marks are:

Opponent	Applicant
<p style="text-align: center;">ANDROID</p> 	<p style="text-align: center;">DROIDVISION</p>

24. The opponent’s word mark consists of a single word, ANDROID, so it is this single element which provides the dominant, distinctive element and the overall impression of the earlier mark. The opponent’s stylised mark also consists of the single word ANDROID, although the impression of this mark is of a futuristic representation of the word ANDROID, which is fairly heavily stylised. The applicant’s mark is presented as one word, but each word is plainly distinguishable. Its overall impression is of the conjunction of the words DROID and VISION.

25. There is a moderate degree of visual and aural similarity between ANDROID and DROIDVISION; the marks clearly share the DROID element, but there are also differences both at the beginnings and ends of the marks. There is a moderate degree of aural similarity between the opponent’s stylised mark and the applicant’s mark for the same reasons, but the level of visual similarity is only low, owing to the degree of disguise provided by the stylisation.

26. The marks are closer conceptually as ‘android’ and ‘droid’ both mean robots, albeit android is a robot in human-like form. The addition of the word vision does not detract from this conceptual similarity, since it adds the idea that the droid has the ability to see or that there is a televisual dimension involved. The marks are conceptually similar to a medium to high degree.

Distinctive character of the earlier marks

27. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*³ the CJEU stated that:

³ Case C-342/97.

“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).”

28. ANDROID (plain word) is inherently distinctive to a good degree for goods and services other than those which are for use with or in relation to robots. The stylised form is more inherently distinctive again. The opponent’s evidence does not entitle it to claim an enhanced level of distinctive character for the stylised mark since the evidence is almost completely focussed upon the plain word ANDROID. As already mentioned in this decision, I am satisfied that the opponent’s evidence supports a claim to an enhanced level of distinctive character in relation to the operating system (i.e. software) which supports various types of mobile devices, such as smartphones, wearable devices and tablets. There is no evidence of use on any of the other goods or services for which the earlier marks are registered. The evidence shows that, as of January 2013, ANDROID had 56.2% of the UK market share for smartphone operating systems. This is a huge margin over the next largest competitor iOS (Apple): iOS had 30.6%, Windows had 6.2%, Blackberry had 5.8% and there were 1.2% others in the market⁴. For operating systems for mobile devices, ANDROID is a highly distinctive mark.

Likelihood of confusion

29. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade

⁴ Page 113, exhibit GC15.

marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties' goods and services are either identical or are not similar. Where there is no similarity, there can be no likelihood of confusion, no matter how distinctive the earlier mark⁵. The opposition therefore fails in relation to *electronic albums*.

30. In relation to all the other goods, there is a likelihood of confusion with the opponent's word-only marks. The parties' goods are identical and there is a medium to high level of conceptual similarity between them. This will create a conceptual 'hook' in the minds of the average consumer, who will view the additional VISION as a descriptive/semi-descriptive element. The opponent referred to the lack of distinctiveness of VISION in its statement of case and the applicant admitted (perhaps unwittingly), in its counterstatement, that VISION is apt to describe the goods it plans to sell (reproduced below):

4 . Trademark distinctiveness

According to google statement Annexure A , NO.6 , **VISION suffix not distinctive of goods claimed.**

- The device we planned to manufacture and description of the trademark we registering class 09 , especially audio video devices are perfect match for class 9 goods.

And class 9 goods on our descriptions and any audio/video apparatus are perfect match with **VISION**

- **For example people sitting every day in front of device called television referred to (TELE/REMOTE VISION)**

"Apparatus for recording, transmission or reproduction of sound or images; computers; mini computers; satellite television receiving apparatus; audio and video receivers, transmitter; USB sticks; USB cables; computer operating programs; computer software; computer hardware; mobile phones; tablet computers; set-top boxes, IPTV box, netbook computers; laptop computers; radios; remote controls; televisions; stereos; DVD players; video recorders; MP3 player; computer servers, IPTV servers, IPTV clients; keyboards, computer mouses, air-mouses, external computer hard drives, audio components, headphones, audio speakers, set-top boxes, home theater systems, videoprojectors, movie projectors, audio and video equipment for vehicles, adapters (electricity), headsets, power cables, leads connectors. Electronic albums; digital picture frames; notebook computers; terminals for electronic toll collection; terminals for electronic transactions

⁵ CJEU *Waterford Wedgwood plc v OHIM* Case C-398/07.

installed in vehicles; cameras for closed circuit television [CCTV] ; cameras for monitoring network systems; digital signage; monitors for video. hardware for allowing users to access and view movies."

Vision is perfect match for audio video equipment , especially for class 9

So we strong disagree for this point.

31. Despite an above average degree of care and attention paid during the purchasing process, the high level of inherent distinctive character, the visual and aural similarities and particularly the conceptual similarities between the marks ANDROID and DROIDVISION will cause the average consumer to assume that there is either an economic connection between the parties or that the marks belong to the same undertaking. There is a likelihood of confusion in relation to all of the goods, bearing in mind the interdependency principle. There is a particular likelihood of confusion in relation to operating software, for which the earlier mark enjoys a huge amount of public recognition, and audio-visual goods. The opponent's evidence shows that it is expanding into the area of television which uses ANDROID operating systems (instead of terrestrial, cable or satellite). Fast developing converging technology means that there is a likelihood that the average consumer will perceive the later mark to be a televisual product linked to the opponent's mark. Save for electronic albums, the opposition succeeds under section 5(2)(b) of the Act.

32. Section 5(3) states:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

33. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls

the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

34. The conditions of section 5(3) are cumulative. Firstly, the opponent must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must establish that the level of reputation and the similarities between the parties' marks will cause the public to make a link

between the marks, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. It is also unnecessary for there to be a likelihood of confusion for success under section 5(3)⁶, but there must be a link leading to damage.

35. The opponent has the requisite reputation in ANDROID for operating system software, and only for this, which is covered by its earlier UK mark 2530935. This reputation is substantial. In my view, even in relation to electronic albums, the extent of the penetration into everyday life of ANDROID via smartphones and tablets will cause the earlier mark to be brought to mind for all of the applicant's goods, including electronic albums which, although not similar within the parameters of likelihood of confusion caselaw, are still in the relative ballpark of consumer electronics. A link will be made between the marks.

36. One of the types of damage claimed by the opponent is that the applicant's mark will take unfair advantage of the reputation of ANDROID. The CJEU explained the nature of the advantage in Case C-487/07, *L'Oréal v Bellure*:

"The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party **seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."**

In other words, the later mark will call to mind the earlier mark and will therefore appear instantly familiar to the public concerned, thereby making it easier for the applicant to establish its mark and to sell its goods without the usual marketing expenditure.

37. The opponent's evidence includes prints from the applicant's website⁷ which show a little green robot device (not relied upon in these proceedings) which is the opponent's device associated with its ANDROID operating system. The screen prints also refer to the applicant's goods as operating on Android. It seems to me to be a reasonable inference that the intention of the applicant is to use the earlier mark's reputation for accessible mobile technology to promote its own goods as being accessible and compatible with the latest mobile technology, using the extensive development and marketing which has gone into ANDROID to its own advantage. I find that the section 5(3) ground of opposition succeeds because the use of the application would take unfair advantage of the earlier mark.

⁶ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P.

⁷ Exhibit GC24, pages 252 and 253.

38. Given my findings under sections 5(2)(b) and 5(3), it is unnecessary for me to deal with the ground of opposition under section 5(4)(a) of the Act.

Costs

39. The opponent has been successful and is entitled to a contribution (not compensation) towards its costs, in line with the scale of costs published in Tribunal Practice Notice 4/2007. The breakdown of costs is as follows:

Opposition fee	£200
Preparing a statement and considering the counterstatement	£300
Filing evidence	£600
Attendance at hearing	£300
Total	£1400

40. I order GSE Technology Ltd to pay Google Inc. the sum of £1400 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 23rd day of July 2015

**Judi Pike
For the Registrar,
the Comptroller-General**