

BLO/670/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3460054

BY

VIVO MOBILE COMMUNICATION CO., LTD.

TO REGISTER THE TRADE MARK

The logo for Vivo, featuring the word "vivo" in a bold, lowercase, sans-serif font. The letter 'i' has a small diamond shape above it. The 'v' and 'o' are connected to the 'i' and 'v' respectively, creating a continuous, stylized look.

IN CLASS 9

AND

THE OPPOSITION THERETO UNDER NO 420454

BY

GARMIN SWITZERLAND GMBH

BACKGROUND AND PLEADINGS

1. On 21 January 2020, Vivo Mobile Communication Co., Ltd. ("the applicant") applied to register the above trade mark in class 9 for: ¹

"Telecommunication apparatus in the form of jewellery; Smart watches; Wearable computers; Navigational instruments; Global positioning system (GPS) apparatus; Wearable activity trackers; Wearable smart phones; Smartbands."

2. The application was published on 28 February 2020, following which Garmin Switzerland GmbH ("the opponent") filed a notice of opposition against all the goods listed in paragraph 1.²

3. The opponent bases its case on sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").³

4. The marks relied on by the opponent are as follows (the specifications for each of these marks can be found at Annex 1 to this decision):

Mark details:	Goods relied on:
EUTM: 014240048 VIVO Filed: 10 June 2015 Registered: 16 October 2020	Classes 10 and 14
EUTM: 013263009	

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

² On 29 September 2020, the applicant divided its application so that other goods in the original application, which were unopposed, proceeded to registration.

³ The original statement of grounds also relied on section 5(4)(a). This was removed in the opponent's written submissions dated 20 October 2020.

<p>VIVOACTIVE</p> <p>Filed: 17 September 2014 Registered: 10 March 2105</p>	<p>Classes 9, 10 and 14</p>
<p>EUTM: 015918543</p> <p>VIVOMOVE</p> <p>Filed: 12 October 2016 Priority date: 12 April 2016 From USTM 86973158 Registered: 6 March 2017</p>	<p>Classes 9, 10 and 14</p>
<p>EUTM: 017133547</p> <p>VIVOSPORT</p> <p>Filed: 21 August 2017 Priority date: 27 February 2017 From USTM 87351363 Registered: 20 December 2017</p>	<p>Classes 9, 10 and 14</p>
<p>EUTM: 014240055</p> <p>VIVOFIT</p> <p>Filed: 10 June 2015 Registered: 20 October 2020</p>	<p>Classes 9, 10 and 14</p>
<p>EUTM: 014240063</p> <p>VIVOSMART</p>	<p>Classes 9, 10 and 14 The same as the VIVOFIT mark above.</p>

Filed: 10 June 2015	
Registered: 21 October 2020	

Sections 5(1) and 5(2)(a)

5. The opponent pleads that its earlier VIVO mark and the mark applied for are identical, the 'negligible stylisation' of the applicant's mark not detracting from the identity. The goods are identical or identically contained within the category of goods in the opponent's specification. Accordingly, the application should be rejected under this ground.

6. In the event that the tribunal does not find the parties' respective goods to be identical, the opponent relies on the same VIVO mark for the purposes of the 5(2)(a) ground.

Section 5(2)(b)

7. Under this ground the opponent relies on all of its earlier rights. It claims that the application and the earlier trade marks are highly similar on all three levels - visually, phonetically and conceptually, on account of their shared element VIVO, which is the first and most dominant element of the opponent's earlier trade marks (other than the VIVO earlier right which has no other element). Further, the applicant's goods are identical or identically contained within the category of the opponent's goods and consequently it is claimed that there is a likelihood of direct confusion, alternatively indirect confusion, between the VIVO earlier rights and the mark applied for.

Section 5(3)

8. The opponent relies on all of its earlier marks under this ground and claims a substantial reputation in the United Kingdom (and throughout the European Union) in relation to all of the goods for which the earlier trade marks are registered. The relevant

public will inevitably make a connection – the required link - between the marks under comparison because they are identical (in the case of the VIVO earlier right) or highly similar (in the case of the VIVO formative earlier rights), and the goods are identical, virtually identical or highly similar. A likelihood of confusion is bound to occur, and as such a 'link' is inevitable.

9. The use of the mark applied for will free-ride off the coattails of the Vivo earlier trade marks, will cause detriment (through tarnishing) to the repute of the Vivo earlier trade marks and will cause detriment to the distinctive character (through blurring) of the VIVO earlier trade marks.

Section 5(4)(a)

10. The opponent relies on all of its earlier rights under this ground and claims that the applicant is seeking to exploit, without authorisation, 'the strong goodwill of the opponent'. Furthermore, by misrepresenting that the applicant's goods are owned by or associated with the opponent there will be damage or a real prospect of damage to the goodwill of the opponent.

11. In addition, on page 63 of its statement of grounds, the opponent claims:

"...the Opponent is the owner of numerous earlier marks which all contain the word "VIVO" so as to form a 'family of marks'."

12. The applicant filed a counterstatement in which it denied all the grounds of opposition. It declined to put the opponent to proof of use of its earlier trade mark EUTM 013263009, for the mark VIVOACTIVE, which is the only earlier mark relied on which would require use to be proved.⁴

13. The opponent filed evidence and written submissions. The applicant filed evidence. Neither side requested a hearing. The applicant is represented by

⁴ See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

Trademarkit LLP. The opponent is represented by Edwin Coe LLP. I make this decision following a careful review of all the papers before me.

14. 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.

The opponent's evidence

Witness statements of Andrew R Etkind and exhibits AE1-AE9

15. Mr Etkind is the Vice President and General Counsel of Garmin. His statement is dated 2 November 2020. Attached to his statement is Annex 1 which is a repeat of his witness statement dated 2 November 2020, with nine exhibits attached. The first, AE1, is a witness statement by Mr Etkind, dated 2016 and the second, AE2, is a witness statement by Mr Etkind, dated 2018. AE1 and AE2 were used in earlier proceedings at the EUIPO and on appeal. I note here that the numbering within exhibits AE8 and AE9, in particular, is somewhat confusing as it appears to retain the numbering from the previous cases, which is not consistent with this one. For the sake of clarity, I will refer to the relevant page numbers where possible.

16. Mr Etkind provides evidence of the opponent's use, reputation and goodwill in its earlier marks.

The applicant's evidence

Witness statement of Weihua Lian and exhibits WL1-WL5

17. Ms Weihua Lian is the applicant's IP Manager, a position she has held since 2019. Her statement is dated 11 March 2021. She gives evidence concerning the size and nature of the applicant's business.

DECISION

18. I will begin with section 5(2)(a) which reads as follows:

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

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

...

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

19. The opponent relies on its VIVO mark under this ground which is not subject to proof of use. This is because, at the date of application of the contested mark, it had not been registered for five years.⁵

20. Accordingly, in these proceedings, the opponent is entitled to rely on its earlier mark for the full specification in its application.

Comparison of marks

21. The opponent submits:

12.1 “the mark applied for and the Opponent’s earlier right for the mark VIVO are identical, the negligible stylisation by way of a very slightly different font does not detract from such identity...”

22. The opponent relies on *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*,⁶ in which the CJEU said in relation to what constitutes an identical trade mark:

⁵ See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

⁶ [2003] FSR 34.

“54...Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

23. In its counterstatement, the applicant submits that *Sadas*, “...does not apply in the present case where the contested mark is a figurative mark in a highly distinctive typeface.”

24. The earlier mark is ‘VIVO’ presented in plain black upper-case letters with no additional stylisation.

25. The mark applied for is ‘VIVO’ presented in a typeface which has a fairly low degree of stylisation. The addition of a tittle over the letter ‘i’ shows that it is presented in lower case. The remaining letters ‘v’ and ‘o’ look the same whether in upper or lower case. The ‘v’ letters in the application finish in a soft curve at the lowest point and the letter ‘o’ has a slightly squashed appearance making it wider than it is tall.

26. Nothing in the presentation of the mark applied for would prevent any of the letters from being seen as the letters ‘vivo’. Consumers in the UK are used to seeing trademarks presented in a variety of typefaces and in upper and/or lower case. In my view, the differences here are so insignificant that they may go unnoticed by the average consumer. In any case, the opponent’s earlier mark is a word only mark which can be used in any number of typefaces, including one with, for example, curves at the bottom of the letters ‘v’. These are identical trade marks.

Comparison of goods

27. The goods to be compared are as follows:

The opponent’s goods	The applicant’s goods
Class 10	Class 9

<p>Devices (for medical purposes) for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments (for medical purposes) for calculating, monitoring, tracking, recording or display purposes; devices (for medical purposes) incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for medical use for calculating, monitoring, tracking, recording or display purposes; and parts and fittings for all the aforesaid goods.</p> <p>Class 14</p> <p>Watches incorporating a Global Positioning System (GPS) or incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Horologic instruments being in the nature of or incorporating a Global Positioning System</p>	<p>Telecommunication apparatus in the form of jewellery; Smart watches; Wearable computers; Navigational instruments; Global positioning system (GPS) apparatus; Wearable activity trackers; Wearable smart phones; Smartbands.</p>
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(GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.	
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28. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

29. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*⁷ (hereafter *Treat*) for assessing similarity between goods and services:

- (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 found or are 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, taking into account how goods/services are classified in trade.

⁷[1996] R.P.C. 281

30. Where appropriate I will, for the purposes of comparison, group related goods together in accordance with the decision in *Separode Trade Mark*⁸:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

31. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

32. I will also bear in mind Floyd, J's statement in *YouView TV Ltd v Total Ltd*:⁹

“...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

⁸ BL O-399-10

⁹ [2012] EWHC 3158 (Ch) at [12]

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

33. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the General Court (GC) explained when goods were complementary:

"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."

34. Daniel Alexander, sitting as the Appointed Person, in *LOVE*¹⁰, at paragraph 20 warned against applying too rigid a test:

"20. In my judgment, the reference to 'legal definition' suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston."

35. The applicant's 'Global positioning system (GPS) apparatus' can include watches of the type listed in the opponent's class 14 specification, which has 'Horologic

¹⁰ BL O/255/13

instruments being in the nature of or incorporating a Global Positioning System (GPS)' and 'Watches incorporating a GPS'. I find these to be identical goods.

36. Each of the types of apparatus described in class 10 of the earlier specification is essentially an 'activity tracker'. The applicant's 'wearable activity trackers' are included within the broader category.

37. The applicant's navigational instruments and the opponent's GPS watches share users and uses in that they may be used to find one's global position and navigate to one or more locations. Their natures may be identical where the applicant's navigational instruments take the form of a watch. They may share trade channels and be located in similar areas of stores or websites and may be in competition. I find these goods to be at least highly similar.

38. The opponent's 'watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information', are essentially smart watches, which is a term included in the application. I find these to be identical. Similarly, the same goods in the opponent's specification are a type of 'telecommunication apparatus in the form of jewellery', the form being a watch in this case. I find these to be identical goods. I also find that the opponent's goods could be termed 'wearable computers' and find these also to be identical goods.

39. With regard to the term 'smart band' in the application, as I understand it, and as indicated by the evidence in this case, it is a band typically worn around the wrist which records activity data and uses smart technology to communicate information. It is not uncommon for 'smart bands' to link another device to share data. I find these goods to be highly similar to the opponent's 'watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information'. Both goods are typically worn on the wrist and provide the user with collected and shared data. The users and uses are the same, their natures are very similar, they are likely

to use the same trade channels and be displayed in close proximity and are in competition.

40. The applicant has 'wearable smart phones' in its specification. The opponent has 'watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information'. The users of these goods are likely to overlap and both types of goods allow the user to wear a piece of technology which enables them to communicate with others, by email/text and be able to access information and data. They may be in competition to some extent and may be displayed in similar areas of stores or websites. They are not complementary in the sense that one is necessary for the other, but they may be seen as the types of goods which originate from the same undertaking. I find these goods to be similar to at least a medium degree.

41. I note that the opponent's goods in class 10 are limited to goods for medical purposes. However, the applicant's goods will include such use as well as non-medical use, so represent the broader category of goods defined in *Meric*.

The average consumer and the nature of the purchasing act

42. 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*¹¹, 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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

¹¹ [2014] EWHC 439 (Ch)

43. The average consumer for all the goods is a member of the general public. The respective goods are made available through a variety of trade channels. They may be bought in a store or online or from catalogues. The purchase of such goods is primarily visual, though I do not discount an aural element.

44. The level of attention paid to the purchase will vary depending on the nature of the goods. The goods range in price from fairly inexpensive to quite expensive and are not likely to be frequent purchases. The level of attention paid will be that necessary to achieve, inter alia, the correct features, aesthetic, size and range of functions. Accordingly, the average consumer will pay at least a medium level of attention to the purchase of the goods.

Distinctive character of the earlier mark

45. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.¹²

46. The opponent's VIVO mark will be seen by most consumers as an invented word and is possessed of a high degree of inherent distinctive character.

47. The opponent claims an enhanced distinctive character through the use made of its marks. Since I have already found a high degree of inherent distinctive character in the earlier mark, I will not make a further assessment at this point, which will not make a material difference to the outcome.

¹² Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

Likelihood of confusion

48. I have found the parties' marks to be identical. Clearly, where I have found the goods to be identical then there will be a likelihood of confusion. The remaining goods are either highly similar or similar to a medium degree. Given the fact that these marks are identical and having paid careful attention to the average consumer, the nature of the purchase and the goods, I find that where there is any similarity between the goods, even at a medium level, the consumer will directly confuse the trade marks, resulting in a likelihood of confusion.

The opposition under 5(2)(a) of the Act succeeds.

49. I will go on to deal with the opposition under section 5(3) of the Act which 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 European Union trade mark or international trade mark (EC), in the European Union) 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”.

50. 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, *Adidas-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 on 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*.

51. In *General Motors*,¹³ the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

¹³ Case C-375/97

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

52. Under this section of the Act the opponent relies upon its EU trade marks for VIVO, VIVOMOVE, VIVOACTIVE, VIVOFIT, VIVOSPORT and VIVOSMART.

53. The conditions of section 5(3) are cumulative. First, 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 marks will cause the public to make a link between them, in the sense of the earlier mark(s) 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.

Opponent's evidence of reputation

54. Mr Etkind claims that the 'VIVO family of products' has been sold throughout the UK since early 2014 and describes them in the following terms:

"6. Garmin offers a wide range of activity tracking devices and smartwatch devices. The Garmin product offerings include basic activity trackers, activity tracking fitness bands, GPS-enabled smartwatches, and fashion-forward hybrid smartwatches with analogue style displays. The activity tracking and smartwatch devices offered by Garmin are set out below. Each activity tracking and smartwatch device offered has unique features, all to enhance and promote healthy and active lifestyles. Features of the activity tracking and smartwatch devices, depending on the series and model, include Garmin Pay, music storage capabilities, and 24/7 health monitoring.

*The products are sold in approximately 100 countries (including the UK) through a large worldwide network of independent retailers, online retailers, specialty dealers, and distributors.*¹⁴

55. The current range of products is shown at <https://explore.garmin.com/en-GB/vivo-fitness/> and is shown below. The range has developed over time since its introduction in 2014.¹⁵



56. Mr Etkind has collated the figures given in each of his witness statements to provide the number of units sold in the UK, the value of sales (in US\$) and the marketing spend for each of the VIVO products from launch to 2019 (in US\$, with one exception). He states that all the figures have been rounded down.

57. For ease of reference I present the data for each of the opponent’s products by listing the sales figures, followed by the number of units sold (in brackets) followed by marketing spend in US\$ *in italics*.¹⁶

	2014	2015	2016	2017	2018	2019
VIVOFIT	534,900 (54,600) <i>592,092</i>	4,389,200 (61,100) <i>210,000</i>	4,052,800 (70,400) <i>200,000</i>	3,444,000 (55,000) <i>28,000</i>	7,100,000 (118,000) -	5,500,000 (90,000) -
VIVOSMART	1,939,400 (13,900) -	4,820,400 (103,400) <i>201,000</i>	8,367,200 (86,000) <i>429,700</i>	5,736,500 (50,000) <i>83,600</i>	2,975,000 (33,000) -	2,293,400 (27,000) -
VIVOACTIVE	-	5,268,900 (28,900)	10,766,600 (65,100)	10,500,000 (53,000)	13,900,000 (63,000)	22,000,000 (129,000)

¹⁴ See Mr Etkind’s witness statement dated 20 November 2020.

¹⁵ See paragraph 8 of Mr Etkind’s witness statement dated 2 November 2020.

¹⁶ The marketing spend for the VIVOFIT mark for 2014 was provided in £ rather than USD.

		263,400	538,300	114,495	-	-
VIVOMOVE	-	-	401,000 (4,000) -	460,000 (4,500) -	4,600,000 (32,000) -	8,200,000 (52,000) -
VIVOSPORT	-	-	-	1,500,000 (11,000) -	2,700,000 (21,500) -	£2,100,000 (23,000) -

58. Mr Etkind has provided sample invoices as follows (the cost of each transaction has been redacted):

Invoice date:	Customer:	Product purchased:	Quantity:
9/01/2015	Maxim – East Kilbride	Garmin VIVOSMART Large Garmin VIVOSMART Small	1,536.00 960.00
14/02/2014	Halfords - Coventry	vivofit Slate bundle vivofit Blue Bundle vivofit Teal Bundle vivofit Black vivofit Purple vivofit Teal vivofit Blue vivofit Slate vivofit Black Bundle vivofit Purple Bundle	10,000 10,000 10,000 10,000 10,000 10,000 10,000 10,000 10,000 10,000
08/09/2014	Amazon – UK stock	Vivosmart activity tracker	2
20/06/2014	Cotswold Outdoor	Vivosmart Large Black Vivosmart Small Black Vivosmart Small Berry	70 70 70
24/03/2014	Sports Direct	Vivofit	800

59. A further invoice is provided for sales to Harvey Norman Ireland at twelve locations in Ireland. Each location ordered twelve vivofit products, in each of the six colours available (144 items in total). The invoice is not dated but was included in Mr Etkind's witness statement written in 2016.

60. Mr Etkind's 2016 statement provides market share for the opponent's 'VIVO family' in the UK based on units sold and sales value. Market share for the opponent's activity trackers and smart watches was 9% in December 2014 and 5% in January 2015.

61. Mr Etkind claims that the opponent, third party sellers, trade experts and trade reviewers refer to the opponent's products as, inter alia, 'the VIVO series', 'the VIVO range' or 'the VIVO family':¹⁷

40. The family of products has been sold since early 2014, and VIVO has also been used by Garmin, separately, to designate the various products in the family. Garmin as well as third party resellers, technology and trade experts or trade review specialists have for some time referred to Garmin's range of products under the various "VIVO" trade marks set out above as the "VIVO series", the "VIVO range" or something similar to designate the products as a "VIVO Family".

Opponent's use of 'VIVO'

62. Evidence has been provided in the form of prints taken from waybackmachine.¹⁸

63. Pages dated 30 October 2014 show the opponent's website. The sidebar provides headings of ranges of goods and the number of goods in that range in brackets. 'VIVO' is listed under 'watches/wearable technology' and indicates that there are seven products in the range.

64. Pages from, inter alia, 15 March 2015, 6 September 2015 and 8 January 2020 show the opponent's website and show the goods listed as 'VIVO series'. Pages taken from 20 March 2016 list the goods under the heading 'VIVO fitness'.

65. Pages from, inter alia, 10 July 2017, 31 October 2018 and 25 September 2019 show the opponent's homepage. On the right-hand side is an advertising box which

¹⁷ See exhibit AE9.

¹⁸ See exhibit AE9

also appears to function as a radio button and includes the words, 'Vivo Family Minisite'.

Third party references to the opponent's goods

66. Further pages from waybackmachine have been provided by the opponent to show how its VIVO goods are referred to by third parties. Examples are as follows:

- Fitness Today magazine, 9 September 2017, 'Garmin announce Alesha Dixon As Their New Wellness Ambassador'. Within the text of the article reference is made to Garmin's 'Vivo range'.
- www.phonearena.com, 27 August 2019, 'Best Garmin smartwatches 2019: Fenix, Forerunner, Vivo series, and all the differences.'
- amazon.co.uk feature, 23 October 2019, 'Garmin vivo series activity trackers and smart watches provide fitness and health monitoring tools, including wrist-based heart rate and stress tracking.'
- www.t3.com, 9 December 2019 – lists 'Garmin Vivo fitness trackers'.
- www.watcho.co.uk – The watch and clock shop, undated, Garmin Vivo Series highlighted.

Advertising and marketing

67. The marketing figures provided above, which I included with the turnover figures provided by Mr Etkind, were taken from paragraphs 18 to 34 of his 2016 witness statement and paragraphs 11 to 21 of his 2018 statement. He further states:

"37. We have not set out updated figures for marketing from 2017, but the numbers are substantial because each of our dealers in various territories is required to spend a certain percentage of total revenue from VIVO

products to advertise the products, whether online or in print. The actual amount is typically not less than 10% of total revenue, and it effectively amounts to a rebate or discount to the retailers in order to facilitate the significant amounts of advertising that is carried out consistently in relation to VIVO products since their introduction.”

68. Exhibit AE8 filed with Mr Etkind’s 2020 witness statement includes invoices for advertising in print media, namely, the *Metro*, *Time Out London*, *Stylist*, *Shortlist* and *Sport Magazine*.¹⁹ They are dated for the period 1 October 2014 to 31 October 2014 and 1 November 2014 to 30 November 2014 and total to £96,396.50 and £45,184.05, respectively. The *Metro* advertisement appears as follows and is shown on the front page of two editions of the *Metro*.



69. The advertisement in *Time Out London* is a full page and makes up the back cover of one of the magazines and front and back covers of the other.

70. Photographs are provided of a stand in the concourse of a train station. The stand is branded GARMIN **vivosmart** alongside banners advertising the **vivofit** product. The photographs are from Victoria Station (12 November) and Waterloo Station (23 October) in London. The year is not evident from the exhibit but the pages have a print date of 1 April 2016.

71. Also included are photographs of lift wraps, an A3 poster campaign and a London underground advertising campaign. An invoice for the campaigns is dated 14-30 November 2014. Lift wraps, which are posters which cover the whole of the doors of

¹⁹ This exhibit appears to be made up of multiple exhibits attached to Mr Etkind’s 2016 witness statement.

a lift, were placed in 37 shopping centres throughout the UK, at a cost of £75,387.50. They appear as follows:



72. A list of poster sites is provided and includes 70 locations throughout the UK:

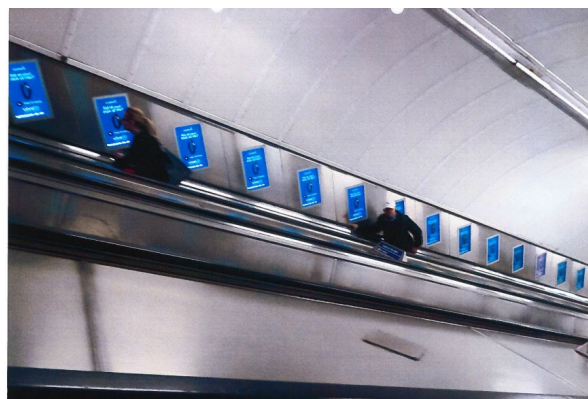


73. The poster is an advertisement for vivofit and is as follows:



74. The invoiced cost for this campaign in November 2014 was £28,675.00.

75. The following advertisement was placed on escalators in underground stations:



76. The cost of this campaign in November 2014 was £61,512.50.

Online sales

77. Mr Etkind provides evidence of vivo products for sale on the opponent's website and on third party websites. Examples are given for each of the opponent's vivo products with dates ranging from 2014 to the present. The examples have been accessed using waybackmachine. A few examples follow:

www.johnlewis.com, Garmin vivosport, £89.99, 4 December 2019

www.currys.co.uk, Garmin Vivosport, £99.99, 25 October 2019

www.amazon.co.uk, Garmin Vivosport, £88.00, 14 July 2019

www.amazon.co.uk, Garmin Vivomove, £126.71, 14 November 2019

www.amazon.co.uk, Garmin Vivoactive, £229.00, 13 July 2018

<https://buy.garmin.com/en-GB/GB>, vivosport, £149.99, 8 November 2019

<https://buy.garmin.com/en-GB/GB>, vivomove, £139.99, 2 December 2017

78. In addition, Mr Etkind provides details of 'official' YouTube videos which are created by the opponent and made available on both YouTube and the opponent's own website. There are many examples of these videos throughout the evidence and they span the period 2014 to the present. Examples show Vivoactive, Vivomove and Vivosport and include launch videos as well as help videos, explaining, inter alia, how to configure the face of the device, and how to use the opponent's Garmin Pay function. For example:

- Garmin **vivoactive** – posted 8 January 2015 – 'GPS smartwatch for the active lifestyle' – 1,259,315 views by 27 October 2020
- Garmin vivoactive 3: 'The Smartwatch That Lets You Pay and Play' – posted 31 August 2017 – 801,272 views

79. Mr Etkind also provides evidence of reviews by third parties, a few examples of which can be seen below:

- UK PC mag, 1 April, 2015, Garmin Vivoactive review

- Trusted Reviews, 11 August 2016, Garmin Vivomove review
- Trusted Reviews, 20 October 2017, Garmin Vivosport review
- WHICH? Magazine review of Garmin Vivoactive 3 dated December 2017
- www.expertreviews.co.uk, 31 Jan 2018, Garmin Vivosport review
- WHICH? Magazine review of Garmin Vivomove HR dated January 2018
- Techradar UK reviews, 4 May 2018, 'Garmin Vivomove HR review, Perhaps the best looking Garmin'
- Techradar uk news, dated August 2019, 'Six new Garmin smartwatches are on their way, including Vivoactive 4'
- www.coachmag.co.uk, 26 September 2019, 'Garmin has updated Its Vivomove Hybrid Fitness Tracker Line with Four New Models'

80. Mr Etkind also provides details of 'notable mentions', such as:

- Wareable.com, 2017, Hybrid Watch of the Year – Garmin Vivomove HR
- www.t3.com, 2020, Garmin Vivosport shortlisted for 'Best Fitness Tracker'.

Reputation

81. The applicant denies that the opponent has a reputation in the UK or the EU.²⁰ It claims that on the contrary, it is the applicant who has the reputation and not the opponent. In her witness statement for the applicant Ms Lian submits:

"[The applicant] was founded in 2009 and is headquartered in Dongguan, Guangdong, China. The company is part of BBK Electronics Corporation, a Chinese multinational specializing in electronic goods. The Applicant is involved in the design and development of smart phones, smartphone accessories, headphones and headsets, and related software and online services. The Applicant also provides apps for its phones, distributed through its V-Appstore. These products are sold under the "vivo" brand. The Applicant is now a global leader in the production of smartphones and

²⁰ See paragraph 9 of the applicant's counter statement.

is ranked as the sixth largest smartphone company in the world with around 8% of the global market...”.

82. The exhibits attached to Ms Lian’s statement are a company brochure, evidence of the applicant at trade shows in China, evidence of the applicant sponsoring sporting events in China and India, examples of the applicant’s goods for sale on *Amazon* and prints of trade mark registrations. Ms Lian submits that the applicant’s goods were first put on the UK market on 20 October 2020 (some eight months after this case began).

83. There are two reasons why this evidence does not help the applicant. The first is that the goods shown in the applicant’s evidence are not the goods for which the application is made. The second is that the success of the applicant’s business is not relevant to the matter to be decided. For the purposes of this ground, I must determine in which goods the opponent’s reputation rests and in light of those findings, I must determine whether the use of the applicant’s mark, across the full range of goods contained within its specifications would cause detriment to the opponent’s reputation, dilute the distinctiveness of the opponent’s marks or take unfair advantage.

84. I note that the opponent has included extracts from previous EU decisions concerning its own level of use, enhanced distinctiveness and reputation. This is not something I can rely on *prima facie*. The evidence filed in those cases is not the same as the evidence before me - those cases were decided some years ago and may have relied on different facts. I must make a decision in this case in the manner I have identified above, based on all of the material before me.

85. Turnover in the UK for 2019 for the opponent’s VIVO goods amounted to approximately \$40 million. Advertising spend for that year was at least \$421,000.²¹ Unit sales, turnover and marketing spend for each of the marks (in the table at paragraph 58 above) show a pattern of turnover which has been consistent since 2014. The opponent has updated its range of goods and introduced new models at fairly regular intervals throughout the period, each of which has been sold by its own name, for example ‘Vivosmart’ and under the umbrella of the VIVO series of fitness

²¹ Figures are given variously in Euros, US dollars and £ sterling.

bands, watches and trackers. The opponent operates a website and social media pages which it uses to promote and sell its goods. The website also hosts videos of new models and provides helpful guides such as how to use the opponent's proprietary payment software 'Garmin Pay', and how to configure the face of one of the opponent's trackers. Again, the evidence shows consistent use of the opponent's website throughout the period for both the promotion of products and guidance for the use of those products. The opponent's goods are also available through third party retailers, such as *Cotswold Outdoor*.

86. The opponent's VIVO and VIVO prefixed marks have been promoted at London train stations, underground stations, national shopping centres and in national publications such as *Time Out* and the *Metro*. In each case the size and reach of the advertising has been significant, for example the front and back covers of *Time Out London* in 2014 and advertising covering lift doors in 70 shopping centres around the UK, also in 2014. I note that detailed evidence concerning the opponent's advertising is taken from a period just after launch of the first VIVO products. However, the evidence as a whole indicates that marketing spend has been fairly consistent from 2014 to the date these proceedings commenced and there is supporting evidence of product launches, videos and third party reviews, throughout the period.

87. The wearable technology market which relates to smart watches and fitness trackers is likely to be considerable, though I have no evidence on this point. Market share figures have been provided for December 2014 and January 2015 at 9% and 5% respectively. Without any knowledge of the size of the market, this is not especially helpful, but what is clear from the evidence is that the opponent's VIVO goods form part of that market. They are regularly reviewed by online and print media and feature often in comparisons of similar goods.

88. Given the level of turnover, press coverage, advertising and marketing efforts, I have no hesitation in concluding that the opponent has established a considerable reputation for its VIVO and VIVO+ marks. In making such a finding, I have taken account of the fact that the evidence filed by the opponent is somewhat difficult to navigate, having been prepared for three different sets of proceedings including this

one. However, the evidence as a whole is consistent with a high level of trade under the VIVO and VIVO+ marks since each of the products was launched.

89. VIVO solus is used consistently to describe the range of the opponent's goods both by the opponent themselves and by third party sellers and reviewers. The marks which consist of VIVO and another word, relate to particular models of goods and have also been used consistently throughout the relevant period by the opponent on its website, advertising, official videos and by third parties selling and reviewing the goods. I bear in mind that use in relation to the goods as well as use on the goods contributes to use of the marks and is taken into account for the purposes of showing the opponent's reputation.

90. I find that the earlier marks have a strong reputation in the UK (and therefore in the EU too)²² in relation to wearable technology in the form of fitness/activity trackers and smart trackers/monitors.²³ I have considered, in detail, the specifications for the earlier marks and find that the use shown is sufficient to show that each of the marks has a reputation for all of the goods in its specification.²⁴

91. The opponent claims that its VIVO and VIVO prefixed marks are a "family" of marks. The leading case on this point is *Il Ponte Finanziaria SpA v OHIM ("Bainbridge")*,²⁵ in which the CJEU said:

"64 [...] in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market".

²² See *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), Geoffrey Hobbs QC, as a Deputy Judge of the High Court, paragraph 76.

²³ I will define this further in the goods comparison section of this decision.

²⁴ The specifications for each of the goods can be found in the opponent's evidence as follows: VIVOFIT at exhibit AE3, VIVOSMART at exhibit AE4, VIVOACTIVE at exhibit AE5, VIVOMOVE at exhibit AE6 and VIVOSPORT at exhibit AE7.

²⁵ case C-234/06 P, EU:C:2007:514

92. In the earlier decision of the General Court,²⁶ two conditions had been laid down for the establishment of a “family” of marks, neither of which was interfered with on appeal:

“126. Firstly, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a series'. For there to be a likelihood of the public's being mistaken as to whether the trade mark applied for belongs to the series, the earlier marks forming part of that series must necessarily be present on the market. [...]

127. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That could not be the case where, for example, the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content”.

93. I am satisfied that each of the earlier marks was, at the relevant date, present on the market for the goods identified in the annex to this decision. One of the marks is VIVO solus, whilst the others all begin with the prefix “VIVO” used with a second, descriptive word. FIT, ACTIVE, MOVE and SPORT all indicate a type of healthy activity, whilst SMART indicates the nature of the device, which includes smart technology. I find that the considerable use of these marks by the opponent since their launch in 2014 will have created in the mind of the relevant public the belief that these marks are a family of marks indicating a common origin.

Link

94. In addition to the earlier marks having a reputation, a link must be made between the mark applied for and the earlier marks. In *Intel Corporation Inc v CPM (UK) Ltd*²⁷

²⁶ Case T-194/03, EU:T:2006:65

²⁷ C-252-07

(“*Intel*”) the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

95. Those factors include:

The degree of similarity between the conflicting marks

96. In *Intra-Press SAS v OHIM*,²⁸ the CJEU stated that:

“72...The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

97. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

²⁸ Joined cases C-581/13P & C-582/13P

98. The similarity of signs under sections 5(2) and 5(3) of the Act is assessed in the same way.²⁹

99. I have already found at paragraph 35 above that the opponent's earlier VIVO mark and the application are identical.

100. The remaining earlier marks relied on by the opponent all begin with the common element VIVO which is the same as the application. The additional conjoined words are, in each case, words which describe a use or characteristic of the goods, namely, FIT, ACTIVE, MOVE and SPORT which describe the fitness, activity, movement and sport for which the goods are used; and SMART which describes watches and bands which include smart technology. The presentation of the marks does not include a break between the elements, but the fact that VIVO has no meaning and that the second element in each case is a well-known word, means that an obvious break is created and would be readily identified by the average consumer.

101. The opponent claims the application and its earlier marks which are made up of VIVO and another word are highly similar. The applicant denies any similarity between the parties' marks.

102. The earlier rights share the same first four letters as the application, namely VIVO. Each then has an additional word. I find the parties' marks to be visually similar to a medium degree.

103. With regard to aural similarity the whole of each mark will be pronounced by the consumer. However VIVO is articulated, it will be the same for all marks. I find them aurally similar to a medium degree.

104. Conceptually, VIVO has no obvious meaning to most UK consumers. Some may be aware that it has meanings relating to 'life' in Spanish and Italian languages. However, I have no evidence on this point and I suspect the numbers of consumers seeing such meanings would be small. For most of the relevant public the application

²⁹ See *Addidas-Salomon*, Case C-408/01

and the first four letters of the earlier marks will have no meaning. The earlier rights contain known English words as their second element and it is these words which would provide a concept, albeit a non-distinctive one, to the extent that there is one at all.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

105. For the purposes of detriment and/or unfair advantage under section 5(3) of the Act it is not a requirement that there must be identity or similarity between the respective goods, however, the issue remains relevant to the overall analysis. In the current case, I have found the opponent to have a reputation for all of the goods in the specifications of its earlier trade marks. The specifications are somewhat repetitive but essentially the reputation in the opponent's marks is in respect of wearable technology in the form of fitness/activity trackers and smart trackers/monitors. These take the form of watches and wrist bands the functions of which include, inter alia, activity monitoring,³⁰ uploading, storing, and sharing data,³¹ heart rate monitoring,³² sleep monitoring, GPS functionality and smart pay systems,³³ access to music,³⁴ smart phone pairing³⁵ and smart notifications.³⁶

106. The application is made for “telecommunication apparatus in the form of jewellery; Smart watches; Wearable computers; Navigational instruments; Global positioning system (GPS) apparatus; Wearable activity trackers; Wearable smart phones; Smartbands.”

³⁰ The evidence shows that all of the opponent's goods include activity monitoring such as step counts, floor counts and movement reminders.

³¹ See exhibit AE9, page 101, dated 10 July 2017, Vivomove monitors sleep, synchs to Garmin Connect allowing uploading, planning and sharing progress.

³² See exhibit AE9 at page 95, dated 7 January 2016. Vivosmart HR, wrist heart rate technology.

³³ See exhibit AE9 at page 96, dated 20 March 2016, Vivoactive GPS smart watch.

³⁴ See exhibit AE9 at page 105, dated 12 July 2018, Vivoactive 3 Music, GPS smartwatch with Garmin Pay and music storage.

³⁵ See exhibit AE9 at page 35, vivomove – pairing with a compatible smartphone video, posted four years before page date of October 2020.

³⁶ See exhibit AE8, page 35, banner at a train station shows vivoactive tracker with smart notifications.

107. I have outlined the relevant case law at paragraphs 28-34 above.

108. The opponent's specifications for the VIVO marks which include a second element are wider than the specification for the VIVO solus mark which I considered under the 5(2)(a) ground above, as they include a number of goods in class 9. Accordingly, I will make an assessment here based on the reputation shown by the opponent in accordance with the guidance in *Intel*.

109. The applicant's 'smart watches', 'wearable activity trackers' and 'smartbands' are clearly identical to the opponent's goods in classes 9 and 10 for all of the marks which take the form VIVO and another element. GPS is a regular feature of the opponent's goods and can be used to track workouts and record data as well as to navigate, for example on a walk or run. These goods are identical to 'Global Positioning System (GPS) apparatus', in the application and are included within the applicant's broader term 'navigational instruments'.

110. The applicant has the term 'wearable computers' in its specification. Neither party has defined the term 'computer' so I rely on my own understanding.³⁷ A computer is any electronic device which can process and/or store data. On that basis, the opponent's goods in classes 9 and 10, which include devices and apparatus which collect and process data and present it to the user, can also be considered 'wearable computers'. I also find that the opponent's 'wearable digital electronic devices in the form of a wristwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information' and 'electronic devices in the form of a wristband or bracelet incorporating a display screen and/or software for viewing, sending and/or receiving texts, emails, data or other information' are a form of wearable computer and are also identical goods to the same term in the application.

111. The applicant's 'telecommunication apparatus in the form of jewellery' can clearly include smart watches. The parties have not defined telecommunication but, in my view, it is communication via a wire, broadcast or by digital means. The opponent's goods in classes 9 and 10 can provide GPS connectivity, a link to a mobile phone,

calendar syncing and many other features which require telecommunication in order to function. These are identical goods.

112. The final term in the application is 'wearable smart phones'. The opponent's specifications do not include smart phones and consequently, there is no use of such goods shown and no reputation in those particular goods. However, that said, the opponent's 'watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information', do share some similarities with wearable smart phones. For example, they can, in some cases, sync to a smart phone to provide email alerts, calendar updates and phone notifications, contain GPS software, hold music files and can provide social media updates.³⁸ They can also be used to pay for goods and services and monitor health data. Whilst these are not identical goods they share a large number of users and to some extent uses. Their natures are the same in that both types of goods are wearable smart technology. They may be in competition, and may appear in similar, though not identical areas of shops or websites. Taking all of these factors into account, I find these goods to be similar to at least a medium degree.

The strength of the earlier mark's reputation

113. For the reasons I have already given, each of the opponent's marks and its family of VIVO marks had a strong reputation at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

114. The earlier marks are distinctive to high degree and the use shown by the opponent of its VIVO family of marks has enhanced that distinctiveness further, such that the opponent's VIVO marks are very highly distinctive of the opponent.

The existence of the likelihood of confusion on the part of the public

³⁸ For example see exhibit AE5 which shows a page from the opponent's website, dated 11 January 2018 describing the VIVOACTIVE 3 smart watch which pairs with a smartphone to display alerts, incoming calls, allows text and email functions, social media updates and calendar updates.

115. I have already found there to be a likelihood of confusion between the opponent's VIVO mark and the application.

116. With regard to the remaining marks and the VIVO family as a whole, I have found some of the goods in the application to be identical to the earlier goods and I found others to be similar to lesser degrees - the lowest level being a medium degree of similarity. Taking all of the relevant factors into account, I have no doubt that use of the applicant's mark would be directly confused with the opponent's earlier marks.

117. I find that when the applicant's mark is encountered, even for the wearable smart phone goods which are the least similar to the opponent's goods, the opponent's reputation is such that the applicant's mark will cause the opponent's VIVO marks to be brought to mind. In other words, the relevant public will make a link between the opponent's family of marks and the application.

Damage

118. The opponent has claimed that the applicant's trade mark will take unfair advantage of its earlier rights. It also pleads that there will be a detriment to its reputation and that the distinctive character of its earlier rights will be diluted. I will deal first with unfair advantage.

119. In *Jack Wills Limited v House of Fraser (Stores) Limited*³⁹ Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of

³⁹ [2014] EWHC 110 (Ch)

Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

120. In effect, the opponent’s complaint is that the applicant is unfairly exploiting its marketing efforts and investment and is free-riding upon the coat tails of the opponent's reputation. I agree. The success of the earlier marks and their standing amongst users of wearable technology, such as fitness/activity trackers and smart watches, will make it easier for the attraction of the earlier mark to be projected on to the applicant’s mark. I find that *prima facie* there is a risk, which is not hypothetical, that use of the contested mark will make it easier for the applicant to offer its goods to a section of the relevant public. I find that unfair advantage is made out.

121. As I have found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the remaining heads of damage pleaded. This is particularly the case as the opponent’s pleadings in relation to dilution and tarnishing go no further than restating the wording of the act.

122. Having found the 5(3) ground to have been made out the only defence left for the applicant is to show that it has due cause to use the mark applied for. The opponent submits that the applicant does not have due cause. The applicant does not appear to have specifically pleaded the point but has alluded to the fact that the extent of its own business and reputation mean that it has a right to use the contested application.

123. It is for the applicant to prove its case, as is clear from *Leidseplain Beheer BV v Red Bull*⁴⁰ in which the CJEU held:

⁴⁰ C-65/12

“44. Onus is on the third party using a sign similar to the mark with a reputation, to establish that he has due cause for using such a sign.”

124. The applicant has not done so and so I need consider it no further.

CONCLUSION

The opposition has succeeded under the 5(2)(a) and 5(3) grounds for all of the goods in the application.

125. The remaining 5(2)(b) ground and the opponent’s case under the 5(4)(a) put the opponent in no better position than its case already decided under the 5(2)(a) and 5(3) grounds. I decline to consider these remaining grounds.

Costs

126. Garmin Switzerland GmbH has been successful under 5(2)(a) and 5(3) and is entitled to a contribution towards its costs which I award on the following basis, bearing in mind that there was no hearing and that a large part of the opponent’s evidence was prepared for proceedings other than these.

Official Fee -	£200
Preparing statements and considering the other side’s statements -	£400
Filing evidence and considering the other side’s evidence -	£500
Total	£1100

127. I order Vivo Mobile Communication Co., Ltd to pay Garmin Switzerland GmbH the sum of £1100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of September 2021

Al Skilton

For the Registrar,

the Comptroller General

Annex 1

VIVO – EUTM 014240048

Class 10

Devices (for medical purposes) for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments (for medical purposes) for calculating, monitoring, tracking, recording or display purposes; devices (for medical purposes) incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for medical use for calculating, monitoring, tracking, recording or display purposes; and parts and fittings for all the aforesaid goods.

Class 14

Watches incorporating a Global Positioning System (GPS) or incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Horologic instruments being in the nature of or incorporating a Global Positioning System (GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.

VIVOACTIVE – EUTM 013263009

Class 9

Monitoring devices (not for medical purposes); tracking devices; devices for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for calculating, monitoring, tracking, recording or display purposes; devices incorporating a horological functions and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments incorporating a horological function for calculating, monitoring, tracking, recording or display purposes; Wearable digital electronic devices in the form of a wristwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information; Global Positioning Systems (GPS); software and hardware for use in navigation or for use in GPS; GPS incorporating a watch, GPS being in the nature of or incorporating watches or horologic instruments; watches or horologic instruments incorporating or being in the nature of GPS; and parts of and fittings for the aforesaid goods.

Class 10

Devices (for medical purposes) for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments (for medical purposes) for calculating, monitoring, tracking, recording or display purposes; devices (for medical purposes) incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on

past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for medical use for calculating, monitoring, tracking, recording or display purposes; and parts and fittings for all the aforesaid goods.

Class 14

Watches incorporating a Global Positioning System (GPS) or incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Horologic instruments being in the nature of or incorporating a Global Positioning System (GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.

VIVOMOVE – EUTM 015918543

Class 9

Monitoring devices (not for medical purposes); tracking devices; devices for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for calculating, monitoring, tracking, recording or display purposes; devices incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments incorporating a horological function for calculating, monitoring, tracking, recording or display purposes; Wearable digital electronic devices in the form of a wristwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information; electronic devices in the form of a wristband or bracelet incorporating a display screen and/or software for viewing, sending and/or receiving texts, emails, data or other information; Global Positioning

Systems (GPS); software and hardware for use in navigation or for use in GPS; GPS incorporating a watch, GPS being in the nature of or incorporating watches or horologic instruments; watches or horologic instruments incorporating or being in the nature of GPS; and parts of and fittings for the aforesaid goods.

Class 10

Monitoring devices for medical or therapeutic purposes; Devices (for medical purposes) for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments (for medical purposes) for calculating, monitoring, tracking, recording or display purposes; devices (for medical purposes) incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for medical use for calculating, monitoring, tracking, recording or display purposes; and parts and fittings for all the aforesaid goods.

Class 14

Horological apparatus and instruments; horological apparatus or instruments or watches incorporating calculating, monitoring, tracking, recording or display functions; Watches incorporating a Global Positioning System (GPS) or incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Watches with wireless communication function; Horologic instruments being in the nature of or incorporating a Global Positioning System (GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.

VIVOSPORT – EUTM 017133547

Class 9

Monitoring devices not for medical purposes used to monitor body movements and speed; GPS tracking devices; monitoring devices for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for calculating, monitoring, tracking, recording or display purposes, namely, activity trackers; devices incorporating a horological function and being used for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns, namely, activity trackers; apparatus or instruments incorporating a horological function for calculating, monitoring, tracking, recording or display purposes, namely, activity trackers; Wearable digital electronic devices in the form of a wrist smartwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information; electronic devices in the form of a wristband or bracelet incorporating a display screen and/or software for viewing, sending and/or receiving texts, emails, data or other information, namely, activity trackers; Global Positioning Systems (GPS); software and hardware for use in navigation or for use in GPS; GPS incorporating a watch, GPS incorporating watches or horologic instruments; GPS incorporating watches or horologic instruments; and parts of and fittings for the aforesaid goods.

Class 10

Monitoring devices for medical purposes for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for medical purposes for calculating, monitoring, tracking,

recording or display purposes, namely, heart rate monitors (HRM); devices for medical purposes incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns, namely, heart rate monitors; apparatus or instruments for medical use for calculating, monitoring, tracking, recording or display purposes, namely, heart rate monitors; and parts and fittings for all the aforesaid goods.

Class 14

Horologic apparatus and instruments; watches incorporating a Global Positioning System (GPS) or incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Horologic instruments incorporating a Global Positioning System (GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.

VIVOFIT – EUTM 014240055

Class 9

Monitoring devices (not for medical purposes); tracking devices; devices for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for calculating, monitoring, tracking, recording or display purposes; devices incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments incorporating a horological function for calculating, monitoring, tracking,

recording or display purposes; Wearable digital electronic devices in the form of a wristwatch for providing software and display screens for viewing, sending and receiving texts, emails, data and information; electronic devices in the form of a wristband or bracelet incorporating a display screen and/or software for viewing, sending and/or receiving texts, emails, data or other information; Global Positioning Systems (GPS); software and hardware for use in navigation or for use in GPS; GPS incorporating a watch, GPS being in the nature of or incorporating watches or horologic instruments; watches or horologic instruments incorporating or being in the nature of GPS; and parts of and fittings for the aforesaid goods.

Class 10

Devices (for medical purposes) for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments (for medical purposes) for calculating, monitoring, tracking, recording or display purposes; devices (for medical purposes) incorporating a horological function and being for calculating, monitoring, recording or displaying physical activity levels, and/or physical inactivity periods, and/or steps walked or ran, and/or distances covered in exercise, and/or exercise levels achieved compared with exercise level goals, and/or calories burned, and/or exercise goal levels based on past exercise, and/or the quality of rest and sleep patterns; apparatus or instruments for medical use for calculating, monitoring, tracking, recording or display purposes; and parts and fittings for all the aforesaid goods.

Class 14

Watches incorporating a Global Positioning System (GPS) or incorporating a GPS function; watches incorporating software and display screens for viewing, sending and receiving texts, emails, data and information; Horologic instruments being in the nature of or incorporating a Global Positioning System (GPS); Watches incorporating a GPS; parts and fittings for all the aforesaid.

VIVOSMART – EUTM 014240063

The same specification as the VIVOFIT mark above.