

O/0823/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF
TRADE MARK APPLICATIONS NOS. 3745345,
3745333 AND 3745354

IN CLASS 9

BY JONATHAN MARK KENDRICK

TO REGISTER THE FOLLOWING TRADE MARKS, RESPECTIVELY:

ROKIT EYE Q

ROKIT



ROKIT EYE Q

AND OPPOSITIONS THERETO

(UNDER NOS. 433414, 433417 AND 433419, RESPECTIVELY)

BY GIBSON BRANDS, INC.

BACKGROUND AND PLEADINGS

1. These consolidated proceedings concern three UK trade mark applications by Jonathan Mark Kendrick (“the applicant”). Details of the applications are set out below:

Trade Mark no. UK00003745345 (Opposition no.433414)

ROKIT EYE Q

Filing date: 20 January 2022

Class 9: *Smart glasses; Wearable speakers; Wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Wearable computer peripherals; Wearable audio equipment; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable portable media players; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices; Wearable digital electronic devices capable of providing access to the Internet.*

Trade Mark no. UK00003745333 (Opposition No. 433417)

ROKIT

Filing date: 20 January 2022

The specification of this mark is identical to that of the UK00003745345 mark.¹

Trade Mark no. UK00003745354 (Opposition no. 433419)

The logo consists of the word "ROKIT" in a bold, sans-serif font, followed by the word "EYE" in a similar font, and then a stylized "Q" symbol. The "Q" is a circle with a diagonal line through it, resembling a camera lens or a stylized letter. The entire logo is set against a light grey background.

Filing date: 20 January 2022

The specification of this mark is identical to that of the UK00003745345 mark.

2. All three applications were published in the Trade Marks Journal on 11 February 2022 and a notice of opposition was later filed, on 11 May 2022, against each of them

¹ There is a slight difference in the order the goods are listed, but the terms listed are identical.

by Gibson Brands, Inc. (“the opponent”). The opponent claims that the applications offend its earlier mark under Section 5(2)(b) of the Trade Marks Act 1994 (‘the Act’). The opponent relies upon a single earlier mark in respect of all of the registered goods in class 9, as shown below:

UK00912055604²



Filing date: 09 August 2013

Registration date: 07 January 2014

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Computer software; Fire-extinguishing apparatus; Loudspeakers and studio monitor loudspeakers and parts therefor.*

3. The opponent claims that the marks are similar as the common element ‘ROKIT’ plays an independent distinctive role within each mark, and the goods are identical or similar, resulting in a likelihood of confusion.

4. The trade mark relied upon by the opponent is an ‘earlier’ mark, in accordance with Section 6 of the Act. As it had been registered for more than five years at the filing date of the contested applications, it is subject to the proof of use conditions, as per Section 6A of the Act.

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

5. The applicant filed a counterstatement in defence of each application denying that there is any likelihood of confusion and putting the opponent to proof of use of the earlier mark. In particular, the applicant states that the earlier mark is descriptive in nature *“having connotation of speed, despite the deliberate misspelling of Rokit [...] compared to the word Rocket”*.

6. Subsequent to the filing of the counterstatements, the three cases were consolidated.

7. The opponent is represented by A&O Shearman. The applicant is a litigant in person without legal representation. Only the opponent filed evidence, both in chief and in reply; the applicant filed submissions dated 22 September 2023. Neither party requested a hearing, and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of all papers on file.

RELEVANCE OF EU LAW

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

EVIDENCE

9. The opponent filed evidence in the form of two witness statements from Mat Koehler who is the Vice President of Product for the opponent. Mr Koehler’s first witness statement was filed as evidence in chief, is dated 24 July 2023 and is accompanied by 12 exhibits, being those labelled MK1-MK12. Mr Koehler’s second witness statement was filed in reply to the applicant’s submissions, is dated 16 November 2023 and is accompanied by three exhibits being those labelled MK13-MK16.

DECISION

Proof of use

10. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

11. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the contested applications: 21 January 2017 to 20 January 2022. As the earlier mark subject to proof of use is a comparable mark, use within the EU (including the UK) is relevant for the part of the relevant period which falls prior to IP Completion Day (i.e. 31 December 2020).³ Only use in the UK will be relevant after that date.

³ See paragraph 7 of Part 1, Schedule 2A of the Act.

13. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. With regards to assessing use within the EU (which is relevant due to the earlier mark being a ‘comparable mark’), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, “*all facts and circumstances*” should be considered including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.⁴

The evidence

15. Mr Koehler says that Gibson (i.e. the opponent) is an American company with headquarters in Tennessee and that since its origin in 1902, the business has become a world-renowned manufacturer and retailer of guitars, musical instruments and audio equipment. Mr Koehler says that some of the most iconic instruments sold by Gibson have become synonymous with the musicians who play them, listing Eric Clapton, Bob Dylan, Noel Gallagher of Oasis, Jimi Hendrix, Keith Richards and Ronnie Wood of the Rolling Stones, Bob Marley, Jimmy Page of Led Zeppelin, Elvis Presley, John Lennon and Paul McCartney as some.

⁴ See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, *TVR Automotive Ltd v OHIM* (paragraph 57)

16. Mr Koehler explains that the trade mark “ROKIT POWERED” is used by the opponent in relation to a line of studio monitors which are produced under the brand “KRK Systems” which, Mr Koehler says, belongs to the Gibson’s family of brands. Gibson’s precise turnover figures for the ‘ROKIT POWERED’ products are said to be highly confidential, however, Mr Koehler provides the following “range of sales figures” for the UK for the years 2017 to 2022:

2017: USD 1,500,000 – 2,000,000

2018: USD 500,000 – 1,000,000

2019: USD 2,000,000 – 2,500,000

2020: USD 1,000,000 – 1,500,000

2021: USD 1,500,000 – 2,000,000

2022: USD 2,000,000 – 2,500,000

17. The aggregate total of the above sums is \$8.5million (at the lowest value of the sales) and \$11.5million (at the highest value of the sales). Mr Koehler confirms that all of these sales relate to “ROKIT KRK” speakers which bear the earlier mark on the product and/or the packaging of the products.

18. Mr Koehler’s narrative evidence is supported by the following:

- copies of webpages from the opponent’s website www.gibsonfoundation.org dated 16 February 2021 (obtained via the Wayback machine). It confirms that “KRK systems” is a “*member of the Gibson’s family of brands*” and that the trade mark is used in relation to goods described as “*studio gear that amplifies the power of music*” (MK1);
- copies of webpages from KRK’s website www.krkmusic.com dated 2 November 2020 (obtained via the Wayback machine) showing use of the trade mark “ROKIT POWERED G4” in relation to goods described as “*professional monitors*” (MK2):



- copies of webpages from KRK’s website dated 20 October 2020 (obtained via the Wayback machine) listing KRK distributors in Europe; the list includes 35 countries, but the UK is not listed (MK3);
- copies of webpages from the UK eBay website showing “KRK ROKIT RP8” studio monitors available for sale with the price in pound sterling. The pages are undated, with the only visible dates being those of the “*last update*” which are 7 and 9 November 2022. The goods offered for sale are second-hand goods allegedly purchased five or six years before they were offered for sale by the sellers. The exhibits (MK4-MK6) include the enlarged images of goods displaying the following trade marks on the front and back of monitors, as well as on packaging:





- copies of webpages from the website www.gear4music.com, which Mr Koehler says, it is the largest UK based online retailer of musical instruments and music equipment. The webpages show studio monitors bearing the following trade marks available for sale with the price in pound sterling (MK7):



Mr Koehler states that this evidence shows goods available for sale as at the date of 10 November 2022;

- copy of a webpage from YouTube showing an image of a video titled “*KRK ROKIT 10-3 G3 Overview*”. Mr Koehler points out that the video was uploaded in October 2015;
- copies of webpages from UK retailers (www.thedjshop.co.uk and Amazon UK) showing ROKIT POWERED studio monitors available for sale (MK9-10). One of the product description states: “*The KRK ROKIT RP10-3 G3 Powered Studio Monitor is the latest powered studio monitor to the ROKIT series. It has been designed with the upmost attention to provide high quality performance and definition for mixing, recording, mastering and playback*” and “*The KRK ROKIT RP10-3 G3 active speaker is the largest monitor of the ROKIT series*”. Mr Koehler points out that the “*Date First Available*” in the Amazon listing is 13 November 2018.

19. The applicant made a number of criticisms of the opponent’s evidence, including that the sale figures are not supported by invoices, that evidence about second-hand goods does not establish that the goods were sold in the UK during the relevant period, and that the evidence about UK retailers is outside the relevant period.

20. In response to the applicant’s criticisms, Mr Koehler filed a second witness statement, introducing extracts from a catalogue (MK14) and sample of invoices dated between 2018 and 2020 (MK13 and MK15-16).

21. The pages from the catalogue are in English and shows use of a coloured version of the registered mark (see below) in relation to studio monitors. The pages are undated, but the last one carries a copyright date of 2015:



22. The invoices exhibited are for studio monitors and headphones sold in the UK and in the EU by a company called “Gibson Europe BV”; however, as the purchaser’s details have been redacted, it is no possible to determine who bought these goods. Further the brand ROKIT does not appear anywhere in the description of the goods (or in the product code); neither is ROKIT listed in the brands that appear at the top of the invoices which include, among others, Gibson and KRK Systems.

23. If the aim of Mr Koehler’s evidence in reply was to prove that ROKIT branded goods were sold or marketed in the UK during the relevant period with a view of supporting the sale figures contained in his first witness statement, that evidence fails to do so. The invoices exhibited simply do not show that the goods were sold under the ROKIT brand. As for the pages from the catalogue, whilst this evidence proves some promotional use of the earlier mark, in the absence of information about how many catalogues were distributed or made available in the UK during the relevant period, it does not establish that the goods were promoted in the UK.

24. That said, in his first witness statement, Mr Koehler clearly states that the UK sales figures relate to “ROKIT KRK” speakers which bear the earlier mark, and provides images showing how the relevant trade marks appear on the goods and their packaging. That evidence is unchallenged. There is no rule that sales figures must always be supported by documentary evidence, and in particular by invoices. Further, Mr Koehler gave firsthand evidence of fact and said that all the facts and matters set out in his statement are within his own knowledge, except where he indicates the source of any information, in which case he would confirm that he has received that information in good faith, and he believes it to be true. Since Mr Koehler did not say that the UK turnover figures came from a different source, I am inclined to conclude that they came from the company’s records to which Mr Koehler must have had access, having been employed by the opponent for over seven years before he gave evidence in these proceedings.⁵ I also bear in mind that whilst the applicant identified a number of gaps in the opponent’s evidence, which Mr Koehler attempted to fill with his evidence in reply, it did not seek to challenge Mr Koehler’s evidence about the

⁵ Mr Koehler states that he has held his current position since May 2023 but he had worked for Gibson for over seven years.

sales figures in cross-examination and did not argue that they are fabricated. Finally, the evidence of UK sales is not manifestly incredible, and although the UK is not listed as one of the countries with a KRK distributor (the ROKIT trade mark being a sub-brand of KRK), that is not sufficient to disbelieve what Mr Koehler said about the value of the goods sold in the UK.

25. Finally, as regards the form in which the earlier mark has been used, most of the evidence shows use of the registered mark in conjunction with a number, which indicates a product series, as well as with the trade mark KRK. It is well-established that the 'use' of a mark encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark, and that a registered trade mark that is used as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use'.⁶ In this case the addition of an edition/series number and the use in conjunction with the mark KRK does not affect the ability of the earlier mark to be perceived as indicative of the origin of the products and, as such, it counts towards genuine use.

26. Admittedly, there are some gaps in the evidence. For example, there is no indication of marketing spend and there is no evidence of promotional activity. However, in order to examine whether use of the earlier mark is genuine I must take into account all the relevant factors. By making an overall assessment of all the evidence produced by the opponent, I am satisfied that the lack of information about promotion and marketing of the earlier mark is compensated for by the substantial turnover generated by the sale of goods marketed under that mark during the relevant period, which is indicative of a reasonable high intensity and a consistency in time of the use of that mark. In light of those considerations, I find that the opponent has demonstrated genuine use of the earlier mark.

Fair specification

⁶ See Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*

27. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

28. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

29. In respect of a fair specification, the opponent relies on all of the goods for which the mark is registered, namely, *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Computer software; Fire-extinguishing apparatus; Loudspeakers and studio monitor loudspeakers and parts therefor.*

30. In the context of the above terms, I note that the evidence only shows use of "*studio monitor loudspeakers*".

31. In its written submissions, the opponent argues that a fair specification should be "*Apparatus for recording, transmission or reproduction of sound; Loudspeakers and studio monitor loudspeakers and parts therefor*".

32. I find that the opponent's use in relation to *studio monitor loudspeakers* does not warrant the opponent relying on the broad term *Apparatus for recording, transmission or reproduction of sound* since that term includes loudspeakers as well as other categories of goods capable of being viewed independently, such as, for examples, digital audio recorders, telephones and radios.

33. Turning to the term *loudspeakers and studio monitor loudspeakers and parts therefor*, I am satisfied that the use shown is sufficient for the opponent to rely on the terms *loudspeakers* and *studio monitor loudspeakers*. However, since there is no evidence of the opponent selling parts of loudspeakers, and since I consider that the sale of parts of loudspeakers is capable of being viewed independently from the sale of loudspeakers, I am not persuaded that use of the earlier mark in relation to loudspeakers justifies the opponent relying on the full term "*loudspeakers and studio monitor loudspeakers and parts therefor*". Consequently, I will proceed on the basis that the opponent can rely upon *loudspeakers and studio monitor loudspeakers*.

Section 5(2)(b)

34. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

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

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

36. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

37. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

38. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

39. In *Gérard Meric v OHIM* Case T- 133/05, 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 for 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.”

40. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

41. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

42. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

43. In light of my findings above, the competing goods are as follows:

The applicant's goods	The opponent's goods
<i>Class 9: Smart glasses; Wearable speakers; Wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Wearable computer peripherals; Wearable audio equipment; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable portable media players; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Downloadable mobile applications for use with wearable</i>	<i>Class 9: Loudspeakers and studio monitor loudspeakers</i>

<i>computer devices; Computer application software for use with wearable computer devices; Wearable digital electronic devices capable of providing access to the Internet.</i>	
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The approach

44. In its submissions in lieu, the opponent states that the applicant's *wearable speakers; wearable audio equipment; wearable portable media players* are identical to its *loudspeakers and studio monitor loudspeakers* as the goods are all speakers.

45. I am not persuaded that the principle outlined in *Meric* can apply to the comparison between loudspeakers and wearable speakers.

46. Oxford English dictionary defines "*loudspeaker*" as "*a piece of equipment that changes electrical signals into sound, used in public places for announcing things, playing music, etc.*". Collins English dictionary provides a similar definition, namely "*a device that changes electrical signals into sounds loud enough to be heard at a distance*". "Wearable speakers" are a form of wearable technology; they are electronic devices designed to be worn on the user's body. Whilst there is no evidence as to what feature wearable speakers possess, being the term "wearable" indicative of the fact that the goods incorporate wearable technology, it is reasonable to assume that they are small electronic devices that are worn by the user to listen to music by being linked with other electronics, such as mobile phones and tablets using Bluetooth technology or connectivity to the internet. In *Swatch v Samsung Montres Breguet SA v Samsung Electronics Co. Ltd* [2023] EWCA Civ 1478 Lord Justice Arnold explained at [12] that smartwatches function more like a wearable computer or mobile phone than like a traditional watch. He stated:

"A smartwatch is a wearable electronic device with a digital interface that provides operational controls through software apps. Smartwatches tell users the time, but also come with a number of additional features not provided by traditional watches, such as the ability to make calls, listen to music, read

messages or emails, make payments and track health and activity levels. Thus Samsung smartwatches function more like a wearable computer or mobile phone than like a traditional watch.”

47. I am, therefore, of the view that the term “loudspeakers” refers to traditional loudspeakers, such as for example, those used in public places or at home to amplify sound, such as music, and does not logically encompass wearable speakers. Besides that, it is likely that wearable speakers were not even contemplated by the opponent when the earlier mark was filed in 2013, since, from my experience, the popularity of wearable technology has accelerated only in the most recent years and the opponent has not provided any evidence that shows how loudspeakers could include wearables. Finally, I consider that if I were to allow the opponent’s argument that loudspeakers and wearable speakers are identical, the logic development of that finding would be that the opponent could also rely on wearable speakers (based on the argument that they are encompassed by the registered term “loudspeakers” based on *Meric*); that would create an unacceptable artificial similarity with the remaining goods in the applicant’s specification which consist of other items of wearable technology.

48. With these considerations in mind, I now turn to the comparison of the goods.

Wearable speakers; Wearable audio equipment.

49. The opponent’s *loudspeakers and studio monitor loudspeakers* and the applicant’s *wearable speakers and wearable audio equipment* (the latter term includes wearable speakers as well as wearable headsets, headphones and earphones), perform a similar function insofar as they are all pieces of equipment through which sound comes out and which can be used, for example, to listen to music. The goods might use the same wireless technology, for example, Bluetooth/WiFi, to connect to a sound system or a mobile phone, respectively. However, the nature and method of use of the goods are different: the opponent’s goods come in the form of various types of units for use at home (e.g. desktop speakers), in professional settings (e.g. studio monitors which are speakers designed particularly for professional purposes, such as recording studios), or in public places and cannot be worn, whereas the applicant’s goods are small devices that are designed to be worn and carried by the user. The goods target

the same public, i.e. members of the general public or professionals; however, they are neither complementary nor in competition. As regards the distribution channels, I am not persuaded that the goods necessarily share them. The only evidence the opponent has produced indicates that its loudspeakers are sold through special distributors or retailers of music equipment; the invoices are not helpful in this regard because they have been redacted making it impossible for me to determine who are the retailers who have bought the opponent's goods for re-sale to end-consumers. Finally, there is no evidence that *loudspeakers and studio monitor loudspeakers* move in the trade channels which I consider to be normal for *wearable speakers* and *wearable audio equipment*, such as electronic stores. Overall, I consider these goods to be similar to a medium degree.

Wearable portable media players.

50. A media player is “a computer program that can store, copy, and play sound and picture files”. The applicant's term “*wearable media players*” is sufficiently broad to include audio players that can play music and other sounds; however, the primary function of these goods is not the same as that of the opponent's goods. *Loudspeakers and studio monitor loudspeakers* turn electrical audio signals into acoustic sounds that can be heard, but do not have any storing or playing function. On the contrary, wearable media players can store and play music files; whilst they might have a built-in function for audio output, that does not mean the goods have the same purpose, nature and method of use of the opponent's goods. However, I accept that at a very general level there is an overlap, insofar as the competing goods can be used for audio output, for instance, to listen to music, although performing different functions. The goods are neither complementary nor in competition and are unlikely to be sold through the same distribution channels. Overall, I consider these goods to be similar to a low degree.

Wearable computers; Wearable displays; Wearable monitors; Wearable computer peripherals; Wearable computer hardware; Wearable computer peripheral devices; Wearable digital electronic communication devices; Wearable video display monitors.

51. In relation to these goods, the opponent states that they are similar to the registered terms "*Apparatus for recording, transmission or reproduction of sound*". It states:

"The Opponent's goods "*Apparatus for recording, transmission or reproduction of sound*" is a term which encompasses a range of goods that make up the physical components of a computer system such as computer case, monitor, keyboard etc. – these can also be described as "computer peripherals" and "computer components and parts", which include / consist of "electronic data processing equipment", "micro-processors" and "electronic control apparatus" – these goods encompass the Applicant's goods listed above, and are therefore considered identical (*Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29). Indeed in *Aida Cruises v Aido International* (O-535-17), the UKIPO Comptroller-General held that "Computer hardware; computer peripherals; computer components and parts" were identical to "apparatus for reproduction of sound or images" (paragraph 21)"

52. Significantly, the opponent did not make any alternative argument about the similarity with the goods in relation to which the earlier mark has been used, i.e. *loudspeakers*. Even if I were to agree with the conclusion of the Hearing Officer in BL-O-535-17 (which I do not), the similarity in that case was founded upon the premises that the term "*apparatus for reproduction of sound or images*" would include a computer monitor, speakers and microphones and would encompass the terms "*computer hardware; computer peripherals; computer components and parts*" which were found to be identical under *Merica*. That finding cannot apply in this case. First, I have concluded that the opponent's specification is subject to a fair specification and cannot rely on the term *Apparatus for recording, transmission or reproduction of sound*. Second, it seems to me that in BL-O-535-17 the Hearing Officer was comparing the term "*apparatus for reproduction of sound or images*" with computer goods of a traditional kind, rather than with items of wearable technology. Lastly, the core meaning of the earlier term "*apparatus for recording, transmission or reproduction of sound [or images]*" is that of audio and video equipment that records, transmits or reproduces sound and images and would include microphones, radio receivers, TV receivers, CD

and DVD players, tape and video recorders, amplifiers, headphones, and speakers. That would not include a computer or computer peripherals.

53. Comparing the applicant's *Wearable computers; Wearable displays; Wearable monitors; Wearable computer peripherals; Wearable computer hardware; Wearable computer peripheral devices; Wearable digital electronic communication devices; Wearable video display monitors* with the opponent's *loudspeakers and studio monitor loudspeakers*, the goods have a different nature, purpose, use and method of use. As it will be recalled, in the previous comparison I found that there was an overlap to the extent that the competing goods could be used to listen to sound or music, however, the primary function of these goods is not that of listening to sound or music. The goods are neither complementary, nor in competition and do not share distribution channels. The fact that the goods might target the same public is not sufficient, in itself, to conclude that the goods are similar. Overall, I consider these goods to be dissimilar.

Smart glasses; Wearable smart phones; Smart bracelets; Smart rings; Smart watches; Wearable activity trackers; Smart phones in the form of eyewear; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable communications devices in the form of wristwatches; Wearable digital electronic devices capable of providing access to the Internet.

54. The opponent argues that these goods are similar to the opponent's goods for reasons similar to those I have rejected in the previous paragraph:

“The Applicant's goods listed above are broadly smart tech telecommunications / communications goods. These goods could be used for Voice over Internet Protocol (VoIP) services which, by their nature, are identical to “Apparatus for recording, transmission or reproduction of sound.” Additionally, the respective goods share a common nature and purpose, are sold through the same trade channel, target the same consumer, and are sold in the same shops – most likely side by side. Indeed, in *Aida Cruises v Aido International* (O-535-17), the UKIPO Comptroller-General held that “computer networking and data communications equipment; telephones; aerials; wires for communication”

were identical to “Apparatus for recording, transmission or reproduction of sound or images” (paragraph 22).”

55. The above goods are various type of wearable electronic devices that integrate computer and telecommunication technology, can connect to the internet and use software apps. The nature, purpose, uses and method of use of the goods are different from those of the opponent’s loudspeakers, the goods are neither complementary nor in competition and do not share distribution channels. The fact that the goods might target the same public is not sufficient, in itself, to conclude that the goods are similar. Likewise, the fact that these goods can use music apps to listen to music and that the opponent’s loudspeakers can be connected to equipment that also use music software/apps does not make the goods complementary. Overall, I consider these goods to be dissimilar.

Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices.

56. In relation to these goods, the opponent argues that they are similar to the opponent’s goods because they would be sold through the same outlets, be purchased by the same consumers, and travel through similar trade channels. Further, the opponent states that the goods are interlinked, as the opponent’s equipment would involve computer software. Finally, the opponent refers to the decision in BL-O-535-17 and the finding that “*Computer software*” was identical to “*Apparatus for recording, transmission or reproduction of sound or images*”. I have already explained why I do not find BL-O-535-17 persuasive. Further, the opponent did not provide any evidence of software for use with loudspeakers. Lastly, the contested software is for use with wearable computer devices, not with loudspeakers and I found that loudspeakers do not include wearable speakers. Based on similar reasons to those I have set out above, I find that the goods are dissimilar.

57. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

58. Accordingly, I find that there is no likelihood of confusion in relation to the goods which I found to be dissimilar, namely:

Smart glasses; Wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Wearable computer peripherals; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices; Wearable digital electronic devices capable of providing access to the Internet.

Average consumer

59. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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. (as he then was) 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.”

60. The average consumer for the parties’ goods will be members of the general public or professionals. The goods are likely to be self-selected from retail outlets or specialist stores, websites and catalogues. Therefore, visual considerations are likely to dominate the purchasing process. However, I do not discount that there are aural considerations, as the average consumer may seek advice from a sales assistant or receive word of mouth recommendations.

61. When selecting the goods, the consumer will take a number of factors into account such functionality, features, compatibility and price. I consider that members of the general public will pay a medium degree of attention when purchasing the goods. Professionals might display a higher degree of attention, between medium and high.


Comparison of marks

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

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

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

64. The respective marks are shown below:

The applicant's marks	The opponent's mark
<p>ROKIT</p> <p>ROKIT EYE Q</p> <p>ROKIT EYE Q</p>	

The applicant's marks

65. The applicant's ROKIT mark is in word-only format and consists of the word ROKIT presented in capital letters. As there are no other elements, the overall impression of the mark lies in the word itself.

66. The applicant's ROKIT EYE Q mark is also in word-only format and consists of the word ROKIT followed by the word EYE and the letter Q all presented in capital letters. Although the words are presented next to each other, they do not form a meaningful unit. In particular, the element ROKIT is not a dictionary word and will be perceived as invented with an above average degree of inherent distinctiveness; further, the fact that this element is placed at the beginning of the mark and that beginning of marks tend to be more focused upon, will result in the element ROKIT playing the greatest role in the overall impression. The element EYE and the letter Q are likely to be perceived independently from the element ROKIT and understood as a reference to IQ (see below) creating a combined meaning different from each individual word; although they also contribute to the overall impression, they have less weight than the dominant and distinctive element ROKIT.

67. Similar considerations apply to the stylised version of the ROKiT EYE Q mark with the caveat that the presentation and stylisation also contributes to the overall impression, but to a lesser degree than the word elements.

The opponent's mark

68. The opponent's mark is a figurative mark consisting of the word ROKIT presented in capital letters; the letters are slightly stylised but still in a standard typeface. The word ROKIT is presented in a large size (with the initial R letter being bigger in size compared to the rest of the letters) above the word POWERED which is comparatively smaller. Due to its size and position, the word ROKIT plays the greatest role in the overall impression. The image of a flame coming out from the letter R of ROKIT, contributes to the overall impression but to a lesser degree than the word ROKIT; nevertheless, this element reinforces the evocative power of ROKIT, assisting the perception of the word as a misspelling of ROCKET.

Visual similarity

69. Visually, all of the marks share their dominant and distinctive element ROKIT in a prominent position. The earlier mark and the two ROKIT EYE Q marks contain other verbal elements, namely the word POWERED in the earlier mark and the word EYE and letter Q in the applicant's marks. The earlier mark and the stylised version of the ROKIT EYE Q mark also contain some figurative elements, however, they are less impactful than the common and dominant word ROKIT. Taking the similarities and differences into account, I find that the earlier mark and the contested ROKIT mark are visually similar to a high degree; the earlier mark and the contested ROKIT EYE Q word-only mark are visually similar to a medium to high degree, and the earlier mark and the contested ROKiT EYE Q stylised mark are visually similar to a medium degree.

Aural similarity

70. The element POWERED in the earlier mark is unlikely to be pronounced due to its size. If the element POWERED is not articulated, the level of aural similarity between the marks is as follows: the earlier mark and the contested ROKIT mark are aurally

identical; the earlier mark and the contested ROKIT EYE Q marks are aurally similar to a medium to high degree, the only difference between the marks consisting in the elements EYE and Q which will be pronounced as I (as the sound of the vowel I when it is spelt in English) and KJU.

71. If the element POWERED is articulated, the earlier marks will be pronounced as a whole as ROKIT PAU-UH-RD. In that scenario, the earlier mark and the ROKIT mark are aurally similar to a medium to high degree, whereas the earlier mark and the ROKIT EYE Q marks are aurally similar to a medium degree.

Conceptual similarity

72. Conceptually, the word ROKIT is not a dictionary word and has no meaning. The opponent filed evidence showing that ROKIT is an acronym for “Republic Of Korea Indigenous Tank”. It also exhibited an online extract from Wiktionary showing the meaning of ROKIT in Finnish and Polish as “*nominative plural of rokki*” (in Finnish) and “*genitive plural of rokita*” (in Polish). I suspect this evidence was file to counteract the applicant’s argument that ROKIT is descriptive in nature, having connotation of speed and being a misspelling of ROCKET.

73. I doubt that the UK average consumer for the goods in question will understand ROKIT as being a word of Finnish or Polish origin. Though there might be some consumers who speak Finnish or Polish in the UK, there is no evidence that they represent a significant proportion of the relevant public. In any event, whilst the dictionary definitions explain the grammar aspect of the word in Finnish or Polish, they are not clear, and they do not provide an equivalent meaning in English.

74. The word ROKIT is an invented word with no meaning. Admittedly, the evocative content of ROKIT is reinforced in the earlier mark by the figurative element of a flame which brings to mind the concept of a rocket as a missile that moves very fast by forcing out burning gases. Whilst the evocative force of the word ROKIT is not as strong in the applicant’s marks as it is in the opponent’s mark, due to the absence of any element that reinforces the concept of a rocket, it cannot be said that there is a conceptual difference. This is because the evocative force of the identical element

ROKIT derives primarily by its closeness with the word ROCKET. In my view, a significant proportion of the relevant public will construe the element ROKIT in the applicant's marks as a misspelling of ROCKET (similarly to the earlier mark), however, I accept that some consumers might treat it as a made-up word with not identifiable meaning.

75. The word POWERED in the earlier mark will be understood as having its ordinary meaning of "*denoting a specified source or form of energy that a machine needs in order to work*", so that the overall mark will be perceived by the consumers as conveying the message that the goods are powered by ROKIT, ROKIT being the main identifier of the origin of the goods, and POWERED being perceived as descriptive.

76. The word EYE and the letter Q in the ROKIT EYE Q marks introduce additional concepts, namely that of an organ of the human body used for seeing, and that of the letter Q, respectively, although I agree with the opponent that the combination EYE Q will be seen as a play on the abbreviation IQ (which stand for intelligent quotient) particularly since the applicant's goods are smart tech-related goods.

77. Hence, any conceptual difference between the mark resides in elements which are either descriptive or allusive, and will be independently perceived from the dominant element ROKIT.

Distinctive character of earlier mark

78. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

79. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

80. The earlier mark consists of the word ROKIT POWERED and the figurative element of a flame. Notwithstanding its evocative power, the word ROKIT is an invented word which is neither descriptive nor allusive in relation to the goods, as speed is not a characteristic of the goods concerned, i.e. loudspeaker. The earlier mark is, in my view, inherently distinctive to an above average degree.

81. Whilst I have accepted the evidence as sufficient to prove genuine use of the earlier mark, I have already highlighted the gaps in the evidence, in particular with reference to promotion and marketing. I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use needs not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular

undertaking. I do not intend to repeat my assessment of the evidence here but will simply state that in light of this higher burden, I find that the evidence before me is insufficient to prove that the opponent's mark enjoys an enhanced degree of distinctive character.

Likelihood of confusion

82. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

83. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

84. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

85. Earlier in this decision I found that the goods are similar to a medium and low degree. The goods will be selected visually by member of the general public or a professional paying a medium or medium to high degree of attention. The earlier mark

and the applicant's marks are (a) visually similar to a high degree, and aurally identical (or, alternatively, aurally similar to medium to high degree) (the ROKIT mark), (b) visually and aurally similar to a medium to high degree (or, alternatively, aurally similar to a medium degree) (the ROKIT EYE Q word-only mark) and (c) visually similar to a medium degree and aurally similar to medium to high degree (or, alternatively, aurally similar to a medium degree) (the ROKIT EYE Q figurative mark) respectively. The earlier mark is inherently distinctive to an above average degree.

86. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite

mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

87. Taking all of the above into account, in particular the coincidence of the identical element ROKIT, the above average degree of distinctiveness of that element and the independent distinctiveness it retains within the competing marks as well as the fact that the differences between the marks are created by elements which are less distinctive than the shared element, I have no hesitation in finding that there is a likelihood of both direct and indirect confusion, even where goods which are only similar to a low degree are involved, and even with regard to a public with a higher than medium level of attention.

88. Admittedly, I found that the evocative force of the word ROKIT is more pronounced in the earlier marks than in the contested marks. I also found that a minority of consumers will see the element ROKIT in the contested marks as invented. However, even in relation to this group of consumers, I find that the fact that the word ROKIT has less evocative force in the applicant's marks is unlikely to prevent them from recollecting the identical element ROKIT of the earlier marks.

89. Hence, my conclusion is that the differences between the earlier mark and the ROKIT word-only mark are likely to go unnoticed and lost in the imperfect recollection of the marks; there is likelihood of direct confusion between these marks.

90. Turning to the ROKIT EYE Q marks, admittedly, the differences between these marks and the earlier mark are more noticeable, however, the added elements in the applicant's marks are likely to be perceived as a laudatory reference to the contested

goods and are likely to be seen as consistent with the use of variant marks. Consequently, when faced with the image of the marks applied for, the relevant public will perceive these marks as updated and modernised versions of the earlier mark, rather than as separate trade marks with a different commercial origin. There is a likelihood of indirect confusion.

OUTCOME

91. The oppositions against the trade mark applications nos. 3745345, 3745333 and 3745354 are successful in relation to the following goods which, subject to any successful appeal of my decision, will be refused registration:

Class 9: *Wearable speakers; Wearable audio equipment; Wearable portable media players.*

92. The oppositions against the trade mark applications nos. 3745345, 3745333 and 3745354 fail in relation to the following goods which, subject to any successful appeal of my decision, can proceed to registration:

Class 9: *Smart glasses; Wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Wearable computer peripherals; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices; Wearable digital electronic devices capable of providing access to the Internet.*

COSTS

93. While the oppositions have succeeded in part, I am of the view the applicant enjoyed the greater degree of success and ordinarily would be entitled to a contribution towards its costs. As a matter of practice, litigants in person are asked to complete a costs proforma. As the applicant has not instructed professional representatives, on 14 December 2023 it was advised that if it intended to request costs it needed to complete and return a costs pro-forma, a copy of which was provided by the Tribunal. However, the applicant has not provided a completed cost proforma, notwithstanding the invitation from the Tribunal to do so. On this basis, no costs are awarded.

Dated this 28th day of August 2024

TERESA PERKS
For the Registrar