

BL O/0911/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND IN THE MATTER OF:

**TRADE MARK APPLICATION 3672861 BY MUHAMMAD ALI
TO REGISTER THE TRADE MARK**

SMART_X

IN CLASS 9

**AND IN THE MATTER OF OPPOSITION 431102 BY
ABUS AUGUST BREMICKET SOHNE KG**

**APPEAL FROM THE DECISION OF SAM CONGREVE, HEARING OFFICER, ON
BEHALF OF THE REGISTRAR OF TRADE MARKS DATED 5 MARCH 2023**

DECISION OF THE APPOINTED PERSON

Introduction

1. The Applicant (Respondent to this Appeal) applied on 24 July 2021 to register the following device mark:

SMART_X

in class 9 for a range of goods.

2. The Opponent (the Appellant) opposed the mark under sections 5(2)(a) and (b) of the Trade Marks Act based on alleged likelihood of confusion with two earlier trade marks of its own for the word mark 'SmartX' registered for a range of goods in classes 6, 9, 12 and 42.
3. Neither party filed any evidence in the Opposition, but the Opponent filed written submissions during the evidence rounds. The parties were given the option of an oral hearing but declined this. The opponent served written submissions in lieu. The decision of the Hearing Officer was therefore made on the papers.

4. The Hearing Officer determined that there was a likelihood of confusion in respect of all those goods within the scope of the application which could be regarded as identical or similar to goods for which the Opponent's mark was registered. However, she determined that many of the goods within the scope of the application were not similar. The Opposition therefore succeeded only in part. Indeed, the number of categories of goods on which the Opposition succeeded were substantially smaller than the number of categories on which it failed (I would estimate the proportion to be something like 1:5).

5. I set out below the categories of goods of the Application in class 9 for which the Opposition succeeded and those for which it failed:

Opposition succeeded in respect of the following:

Mobile telephones; Mobile phones; Mobile telecommunications handsets; Encoded smart cards; Smart card readers; Camera cases; Waterproof camera cases; Visual display screens; LED screen displays; Screens; Visual display screens; Display screen filters; Touch screen pens; Computer stylus; Stylus [light pens]; Mobile data receivers; Overvoltage protectors; Surge protectors; Protectors (Voltage surge -); Voltage surge protectors.

Opposition failed in respect of the following:

Mobile phone battery chargers; Chargers for mobile phones; Battery chargers for mobile phones; Joystick chargers; Chargers for vaporizers; Chargers for smartphones; Smartphone battery chargers; Cell phone battery chargers; Chargers for electronic cigarettes; Chargers for electronic smokers' articles; USB chargers for electronic cigarettes; Battery chargers for tablet computers; Battery chargers for laptop computers; Fast chargers for mobile devices; Chargers; USB chargers; Portable chargers; Battery chargers; Electric battery chargers; Mains chargers; Wireless chargers; Battery compensation chargers; Wireless battery chargers; Solar battery chargers; Chargers for batteries; Car charger; Electric-car charger; Mobile phone covers; Mobile telephone covers; Mobile telephone cases; Mobile phone cases; Cases for mobile phones; Leather cases for mobile phones; Cases adapted for mobile phones; Carrying cases for mobile phones; Protective cases for mobile phones; Carrying cases for mobile telephones; Phone cases; Waterproof smartphone cases; Cases for smartphones; Waterproof cases for smart phones; Carrying cases for mobile computers; Tablet computer cases; Laptop cases; Cases for headphones; Sunglass cases; Eyewear cases; Glasses cases; Eyeglass cases; Memory card cases; Displays for mobile phones; Mobile phone display screen protectors in the nature of films; Display screen protectors in the

nature of films for mobile phones; Mobile phone speakers; Mobile phone straps; Selfie sticks used as smartphone accessories; Keyboards for mobile phones; Mobile phone docking stations; Mobile telephone batteries; Batteries for mobile phones; Headsets for mobile telephones; Headphones for smart phones; Headphones; Headphone consoles; Stereo headphones; Wireless headphones; Headphone amplifiers; Music headphones; In-ear headphones; Noise cancelling headphones; Ear pads for headphones; Adapter cables for headphones; Two-way plugs for headphones; Wireless headsets for smart phones; Tempered glass screen protectors for smartphones; Glasses; Smart glasses; Waling glasses; Protective glasses; Dustproof glasses; Sports glasses; Magnifying glasses; Glasses frames; Teeth protectors; Eye protectors.

6. It will be apparent from the above that the mark was applied for in a very large number of categories. The number of categories of goods for which the Opponent's mark was registered was also very large range. It will assist in understanding this Decision to set these out below (I only refer here to the goods of the '539 mark, since these duplicated the goods of the '257 mark):

Class 6

Goods of common metal included in class 6, namely locks, Keys, key blanks, Fittings, Safety chains, Doors hinges, Lock cylinders, Built-in cylinders, Dummy cylinders, Door cylinders, Striking plates, Closing hasps, Door chains, Door and window bolts, Door and window locks and parts thereof; Ironmongery, small items of metal hardware; Non-electric cables and wires of common metal; Mechanical locking systems; Mechanical locking installations; Tanks of metal; Closures of metal for containers; Containers, Goods of metal, namely, Containers.

Class 9

Measuring, checking (supervision), signalling and life-saving apparatus and instruments; Electric and electronic locks; Electric and electronic keys; Electric and electronic monitoring apparatus; Electronic locking installations; Alarms; Access control installations; Locks comprising fingerprint readers; Locks comprising biometric fingerprint scanners; Wireless locks; Electric and electronic locking and unlocking systems; Electric and electronic door security devices; Access control cards [encoded or magnetic]; Electronic key cards; Smart cards; Digital signal processing apparatus; Digital keys; Software development kit [SDK]; Mobile apps; Cameras [photography]; Radiocommunication apparatus; Apparatus for recording, transmission or reproduction of data, sound or images for security purposes; Facial recognition apparatus; Vein pattern recognition apparatus; Gesture control

apparatus; Speech recognition apparatus; Movement pattern recognition apparatus; Peepholes [magnifying lenses] for doors; Electronic speech and relay modules; Programming apparatus; Transmitters; electrical and electronic controllers; Contacts, electric; Electric cables and distributors; Integrated circuits; Data processing encoders; Data-processing equipment and computers; Monitors; Computer peripheral devices; Programs for data processing equipment; Software; Magnetic and voice-controlled encoders; Computer software applications, downloadable; Downloadable software applications for mobile devices (smartphones, smart watches, tablet computers, laptop computers); Computer software for interpreting fingerprints or palm prints; software for electronic lock and access control device data transmission via a global computer network, by wireless telephone network, or by radio transmission; Software for downloading application programs and for remote programming, control, monitoring, and management of electronic locks and access control apparatus via global computer network, wireless telephone network or radio transmission; Computer application software for computers, mobile devices (smartphones, smartwatches, tablet computers, laptop computers), namely software for programming, controlling, monitoring and managing electronic locks and access control apparatus.

Class 42

Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; design and development of software for e-commerce platforms; Design and development of software in the field of mobile applications; Hosting computer sites [web sites]; Cloud computing; Cloud hosting provider services; Consultancy relating to locks, security and locking systems; Software as a service [SaaS]; Access Control as a Service (ACaaS); Application service provider [ASP], namely, hosting computer software applications of others; Providing application software using a communication network.

7. The Opponent partially appeals the Decision on the basis that a substantial proportion of the categories of goods which the Hearing Officer found to be dissimilar ought in fact to have been found similar to goods within the scope of the Opponents' marks. On the logic of the Hearing Officer, registration should have thus have been refused in relation to those goods as well.
8. At this point it is useful to consider the way in which the case was raised and argued before the Hearing Officer.

9. In a case like this where the marks cover a multitude of different goods, it is obviously necessary for the Opponent to identify with precision, both in its pleaded case and in any submissions made to the Registry, which goods of its own registrations are alleged to be similar to which goods of the Application. If this is not done, it is unfair to the Applicant and it is extremely difficult if not impossible for the Hearing Officer to decide the case.

10. The Opponent's pleaded case in its TM7 made no real attempt to do this:

Under Q1, which is the question

'which goods or services covered by the earlier trade mark are relied upon for the opposition?'

the Opponent responded

'All goods and services in Classes 6, 9 and 42'.

Under Q4 which is the question

'Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?'

the Opponent responded

'All goods and services'.

11. The only part of the TM7 which provided any particularity as to the nature of the case being made on similarity was in answer to Q5 which states

'Use this space to supply any further information about which you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar'.

Here the Opponent made the following case on similarity:

'The Application covers a very broad range of goods in Class 9 which are either identical with or similar to the goods and services of the earlier mark. By way of example, but by no means comprehensive, "car charger" in the Application would be considered at least very similar to the classes 9 and 42 goods and services of the earlier mark'.

12. This was plainly a completely inadequate pleading. Even the 'car charger' point (the only specific instance relied on) was completely incomprehensible

without some attempt to identify the particular goods or service within the Opponent's long list of goods and services in classes 9 and 42 said to be '*at least very similar*' to a car charger and brief reasons why. The vast majority of the goods and services in classes 9 and 42 appear to have nothing to do with car chargers, and the Hearing Officer cannot be expected to sift through the long lists to work out what case might be being made out.

13. In its final written submissions to the Hearing Officer, the Opponent provided a little more detail on the question of similarity.
14. In paragraph 24 of those submissions, the Opponent listed all the goods of the Application and highlighted some of those goods (around half of them) in red. It also listed all the goods of the Opponent's marks and highlighted some of these in red (about ¼ of them). Under each list it stated '*Goods in red = identical*' and '*remaining goods = similar*'. In paragraph 25, it stated '*The identical goods are highlighted in red*'. There followed a set of submissions about why the goods were said to be 'identical' or 'similar'.
15. The argument as to why the goods marked in red were said to be identical was set out in paragraph 29 but amounted to little more than assertion (as well as being quite confusing). It stated that '*all*' the goods of the Application highlighted in red were

'either part of, or are components of 'electrical and electronic monitoring apparatus, in particular alarm systems and parts' in the 257 mark and also they are identical to 'Measuring, checking (supervision), signalling and life-saving apparatus and instruments; Apparatus for recording, transmission or reproduction of data, sound or images for security purposes' in the 539 Mark. They would be sold together in a retail location, used together in the normal course of operation and also in competition with each other.'

The final sentence of the paragraph appears to be a reference to similarity rather than identity. Furthermore, many of the categories of goods marked in red in the Opponent's marks are not mentioned here at all.

16. More importantly the paragraph made no real sense. The goods of the Application highlighted in red included things like *'battery chargers', 'batteries for mobile phones', 'mobile phone docking stations', 'displays for mobile phones', 'chargers for electronic cigarettes', 'music headphones', 'mobile phone screen protectors in the nature of films for mobile phones'*. It is far from obvious how these goods could be identical (or indeed why they were said to be 'sold together', 'used together' or 'in competition') with any of the goods of the Opponents' marks which had been highlighted.

17. Moving on to the goods marked in black, the Opponent made three points in the written submissions:

- (i) The (substantial number) of categories of goods in the Application marked in black which related to mobile phones were *'usually used in conjunction with alarm systems, alarm instruments and electric locks'*, because *'It is common feature now (sic) that phones are used together (sic) as a security device for cars, either to unlock, monitor or secure modern vehicles either via Bluetooth or internet connection'*.
- (ii) The goods which were accessories such as covers, cases, styluses, headphones and smartphone accessories would be sold in *'IT hardware superstores'* where goods such as *'cameras, radiocommunication apparatus, programming apparatus, transmitters, electrical and electronic controllers, integrated circuits'* are also sold.
- (iii) *'It is likely that a provider of locks, alarm apparatus, would sell the Contested Goods as part of its retail operation. This creates an obvious overlap with the Earlier Goods and the average consumers are likely to come across both type of services in the same manner and assume that both undertakings operate in the same industry'*.

18. Faced with this inadequate pleading and argument, the Hearing Officer did the best she could. She followed the correct practice, recommended by Geoffrey Hobbs QC sitting as the Appointed Person in Separode BL

O/399/10, dividing the goods of the Application into groups to which similar arguments could be applied and therefore the same general assessment of similarity could be made. As we have seen, having carried out that exercise, she found that some of the groups were identical to some goods of the Opponent's marks, some were similar, and some dissimilar.

19. It may be noted that the Hearing Officer was quite generous to the Opponent in carrying out this exercise.
20. First of all, she was prepared both to look for and to find points of similarity which the Opponent had neither pleaded nor argued. For example, she found that the group *'mobile telephones, mobile phones, mobile telecommunications handsets'* were similar to the Opponents' goods *'mobile apps, downloadable applications for mobile devices...'* because of the interdependence of these goods. She also found that *'encoded smart cards'* were identical to *'access control cards [encoded or magnetic]'* and *'smart cards'*, and that *'camera cases, waterproof camera cases'* were similar to *'cameras'*.
21. Secondly, she took a generous view on the complementarity of goods, again taking points in the Opponent's favour which had not been made in the TM7 or in the written submissions. Thus for example in paragraph 55 of her Decision, a group including *'visual display screens' 'touch screen pens' 'computer stylus'* was held to be similar to *'electric and electronic monitoring apparatus'* on the basis that such apparatus was *'likely to have built-in visual display screens with accompanying light pens etc.'* and *'it is possible that over time these screens or pens may need replacing, as such it seems likely that the same undertaking will provide replacements'*. A similar conclusion was drawn in paragraph 57 to the group including *'voltage surge protectors'*.

The Appeal

22. Despite what I have described as the generosity of the Hearing Officer, the Opponent now appeals on the basis that she did not go far enough and she

should have made findings of similarity in respect of various other groups of goods as well.

23. I will take the groups in turn.

'Charger' group (1)

24. This covers the following goods in the Application which are all chargers for various specific devices:

Mobile phone battery chargers; Chargers for mobile phones; Battery chargers for mobile phones; Joystick chargers; Chargers for vaporizers; Chargers for smartphones; Smartphone battery chargers; Cell phone battery chargers; Chargers for electronic cigarettes; Chargers for electronic smokers' articles; USB chargers for electronic cigarettes; Battery chargers for tablet computers; Battery chargers for laptop computers

The Hearing Officer dismissed the arguments for similarity of these goods in paragraph 47. First she noted that the Opponent's marks did not include any chargers, or batteries or any of the electronic devices listed here. She then turned to the arguments set out in the written submissions, based on the suggestion that mobile phones were used in conjunction with alarm systems and that these goods may be found in the same retail outlets as alarm systems. She considered that this was far too general given the essential dissimilarity in the nature of the goods.

25. The Opponent appeals against this finding on the basis that the Hearing Officer ought to have found that this group was similar to the following category of goods in its 539 mark:

Electric cables and distributors.

The Opponent contends on Appeal that all the devices in this group require electric cables of some kind in order to operate and therefore should be considered similar.

26. I do not consider that this argument is open to the Opponent. It was not pleaded in the TM7 and it was not raised in the written submissions. As we have seen, the only argument of complementary use which was made before the Hearing Officer concerned the potential use of mobile phones to operate car alarms, and the category '*electric cables and distributors*' had not been mentioned at all.

27. On behalf of the Opponent, Mr Wood of Brandsmiths fairly accepted that the point had not been made. However, he submitted that the TM7 pleading was wide enough to cover the point (since it relied on 'all' the goods of the earlier marks and alleged 'similarity' in respect of all of them). In the circumstances, he contended, the Hearing Officer was obliged to compare each category of goods in the earlier marks and each category of goods in the Application, and to consider any points of similarity which might exist between them whether or not those points had been actually identified or relied on by the Opponent.

28. I do not accept this. As I have said, it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.

29. Mr Wood cited Tribunal Practice Note 1/2018. This states (so far as is relevant) as follows:

Similarity of goods/services not obvious or explained

7. Where it is not self-evident why the goods/services covered by an earlier mark are claimed to be identical, or similar, to the opposed goods/services for the purposes of s.5(1) or (2), and this is not explained in the notice of opposition etc. The casework examiner may require the party filing the form TM7/26(I) to provide further information. Specifically, the caseworker may invoke the registrar's power under Rule 62 of the Trade Mark Rules 2008 to require the party to explain which goods/services are claimed to be identical/similar, and why. This requirement will always arise when it is not clear why any of the goods/services covered by the earlier mark are claimed to be similar to the goods/services covered by the grounds under s.5(1) or (2).

8. Where the same explanation applies to multiple comparisons of individual goods/services, the required information should be provided by reference to the relevant goods/services, grouped accordingly.

9. Depending on the degree of ambiguity, and as an alternative to taking this action at the pleadings stage, casework examiners may decide to serve the form TM7/26(I) on the other side and simultaneously direct the party bringing the case to provide further information about the claimed identity/similarity between the respective goods/services. In these circumstances, the required information will usually be required by the deadline for filing evidence in support of the opposition/application.

10. Either of the above courses of action will permit the other side to properly address the claimed identity, or similarity, of the goods/services in its own evidence of fact and/or written arguments (submissions) in response. This is fairer to the applicant/proprietor than revealing the reasons why the respective goods/services are claimed to be similar for the first time at a hearing, or in final written submissions in lieu of a hearing, i.e. after the other side's opportunity to file evidence or written submissions in response has passed.

30. Mr Wood pointed out that the casework examiner in the present case had not served a request for further particularisation of similarity under Rule 62. In the absence of such a request, he suggested, there was no reason why the Opponent should be prejudiced by the fact that it had failed to make any specific points on similarity in its pleaded case.

31. There are a number of points to be made about this:

- (i) Clearly this was a case where further particularisation was required. The TM7 was manifestly inadequate in identifying any case of

identity or similarity, and it was unfair on the Applicant and indeed on the Registry to expect it to deal with the Opposition on the basis of such a pleading.

- (ii) The failure of the casework examiner to demand further particularisation is unfortunate but not something which excuses the Opponent from the burden of pleading its case, nor gives it the right to raise unpleaded points on appeal. This is particularly the case where the Opponent is professionally represented.
- (iii) The case was in fact further particularised in the written submissions. The Hearing Officer must have considered that these gave her (and the Applicant) enough information about the Opponent's claim for her to be able to determine the Opposition without a hearing. That was a matter for her, although I have to say I find the written submissions extremely confused and unhelpful.
- (iv) The Hearing Officer should have considered the Opposition on the basis of the case put forward in the written submissions. This was the case which the Applicant would have understood was being put forward by the Opponent, and it can be assumed that he relied on this when decided that he was happy for the matter to be decided by the Hearing Officer without making further submissions of his own.
- (v) In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. But this has of course not happened and to this extent the Opponent has benefited from the Hearing Officer's generosity. However, it would obviously be perverse to say that the Hearing Officer ought therefore to

have taken every other unpleaded and unargued point in the Opponent's favour.

- (vi) In the circumstances, there is no basis on which the Opponent is entitled to complain on Appeal that this unpleaded, unargued point was not taken in its favour by the Hearing Officer.

32. I therefore dismiss this ground of appeal on the basis that it fails to identify any error in the Hearing Officer's approach, and that it would be procedurally unfair and abusive to allow the point to be made on Appeal when it was neither pleaded nor argued below.

Charger Group (2)

33. This covers the following goods of the Application which are chargers more generally:

Fast chargers for mobile devices; Chargers; USB chargers; Portable chargers; Battery chargers; Electric battery chargers; Mains chargers; Wireless chargers; Battery compensation chargers; Wireless battery chargers; Solar battery chargers; Chargers for batteries; Car charger; Electric-car charger

34. The Opponent makes the same point I have dealt with above under Charger Group (1), namely that these should have been found similar to *electric cables and distributors*. The Hearing Officer rejected the claim of similarity in paragraph 48 of her Decision, doing her best on the basis of the pleaded case and the written submissions before her (which of course did not include any reference to *electric cables and distributors*). I reject the Appeal for the same reasons given above in respect of Charger Group (1).

Various mobile phone related goods, headphones and smart glasses

35. This covers the following goods of the Application

Displays for mobile phones; Mobile phone speakers; Mobile phone straps; Selfie sticks used as smartphone accessories; Keyboards for mobile phones; Mobile phone docking stations; Mobile telephone batteries; Batteries for mobile phones; Headsets for mobile telephones; Headphones for smart phones; Headphones; Headphone consoles; Stereo headphones; Wireless headphones; Headphone amplifiers; Music headphones; In-ear headphones; Noise cancelling headphones; Ear pads for headphones; Adapter cables for headphones; Two-way plugs for headphones; Wireless headsets for smart phones; smart glasses

36. The Hearing Officer dismissed the Opponent's arguments on similarity in paragraphs 54 and 58. She found in 54 that mobile phone displays were not (as had been argued) components of electric and electronic monitoring apparatus, in particular alarm systems and parts. They were specifically intended for mobile phones and would not be used together with the Opponents' goods in the normal course of operation. In 58 she addressed the Opponents' arguments on similarity in relation to the rest of the goods. As we have seen, these arguments were founded solely on the fact that the goods would be sold in the same retail locations. She held that this was not persuasive because the shops would sell a vast range of totally different goods and the goods would not be found in the same aisles. Otherwise she pointed out that the Opponent had *'not provided any persuasive submissions in relation to the comparison between the competing goods other beyond its suggestion that they are identical or similar'*.

37. The Opponent seeks to argue on this Appeal that the goods should have been found similar to *'data processing equipment and computers'* or *'electric cables and distributors'*. I have dealt with the point based on *'electric cables and distributors'* above. This is the same point and I dismiss it on the same basis.

38. As for *'data processing equipment and computers'*, precisely the same points arise. It was argued before me that this group of goods involves data processing or can be regarded as complementary to computers. But no case on similarity or identity of goods based on *'data processing equipment or computers'* was raised either in the TM7 or in the written submissions. The case of complementarity was based on alarm systems and electric locks.

Even the common retailer argument was based on different goods. I therefore dismiss this ground of appeal on the same basis.

39. Mr Wood finally sought to rely on similarity with a further category of goods in the Application namely '*computer peripheral devices*'. This is not a point which was open to him given that it had not been raised in the Notice of Appeal. However, I would have rejected it on the same basis as the other points.

Conclusion

40. The Appeal is dismissed. The Opponent took no part in the Appeal so no question of costs arises.

**IAIN PURVIS KC
THE APPOINTED PERSON**

17 SEPTEMBER 2024