

Neutral Citation Number: [2022] EWHC 2195 (Ch)

Case No: CH-2021-000218

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS
OF THE UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE
DECISION NO. O/655/21

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 19 August 2022

Before :

Ian Karet (sitting as a Deputy High Court Judge)

Between :

Revive A Phone Limited

Appellant

and

WeFix

Respondent

Daniel Selmi (instructed by **Clarke Willmott LLP**) for the **Appellant**
The **Respondent** did not appear

Hearing date: 30 June 2022

APPROVED JUDGMENT

Ian Karet:

Introduction

1. This is an appeal by Revive a Phone Limited against the decision of Rosie Le Breton, Hearing Officer for the Registrar of Trade Marks, dated 9 September 2021 (the “Decision”) invalidating UK registered trade marks No. 3267855 for the word WEFIX (the “Word Mark”) and No. 3281995 for the logo shown below (the “Logo Mark”).



2. The application to revoke the marks under Section 47(2)(a) of the Trade Marks Act 1994 (the “Act”) relied on section 5(2)(b) of the Act based on the Respondent’s earlier EU trade mark 14948343 (the “Earlier Mark”) shown below.



3. Section 5(2)(b) of the Act provides that:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

4. The Word Mark was applied for on 2 November 2017 and registered on 26 January 2018 for services in class 37 including repair and maintenance of computer, telecommunications hardware and smartphones and also repair of various devices and equipment.
5. The Logo Mark was applied for on 11 January 2018 and was registered on 14 December 2018 for services in class 36 including insurance and financial and monetary affairs and in class 37 for a range of repair services, including repair of telephones, tablets, communications systems and computers.
6. The Earlier Mark was registered on 15 July 2017, claiming the colours orange, black and white in classes 9, 35 and 36. The registration in class 9 includes cell phones, smartphones, tablet computers and similar devices. The registration in class 35

includes retailing both online and in shops of electronic and telecommunications apparatus, telephones and smartphones. The registration in class 36 includes repair of items including telephones, smartphones and tablets.

7. Mr Selmi appeared for the Appellant. The Respondent was not represented at the hearing. In a letter to the Appellant's solicitors dated 28 October 2021, the Respondent's solicitors said that the Respondent's position was that the Decision was correct, and they been instructed not to participate in the appeal.

The Decision

8. The Decision starts with a description of the marks and the evidence and makes findings on the goods and services concerned. These were that the Word Mark was similar to the Earlier Mark to a medium degree and that the Logo Mark was similar to the Earlier Mark to a medium or medium and high degree depending on the services concerned. The Appellant accepted these findings.
9. The Hearing Officer then made a comparison of the marks in issue. She found that the Earlier Mark comprised the two English words We and Fix, and that this was its dominant element. The orange box played a role in the overall impression of the mark, and the stylised 'X' was not negligible.
10. The Word Mark was filed as a single word comprising the words 'We' and 'Fix'. The Hearing Officer found that overall impression resided in the mark as a whole.
11. The Hearing Officer found that the wording was the most dominant element of the Logo Mark with the 'lightning strike' playing a slightly lesser role. The border played a lesser role.
12. The Hearing Officer then made visual, aural and conceptual comparisons of the marks. She found that the Word Mark was visually similar to a high degree to the Earlier Mark, and the Logo Mark was similar to a medium degree. The marks were aurally identical. The Word Mark was conceptually identical to the Earlier Mark, and the Logo Mark was conceptually highly similar.
13. Having considered the average consumer and the purchasing act, the Hearing Officer then considered the distinctive character of the Earlier Mark. She found that the Earlier Mark was inherently distinctive to a low degree, apparently accepting that it had only a or the minimum level of distinctiveness on the basis of its meaning as 'we repair'. In the context of the registration, the mark alluded to the fact that the goods on offer might be repaired, second hand items, or that the offeror might also offer repairs. The Respondent had not filed any evidence of use that might have enhanced distinctiveness.
14. The Hearing Officer then carried out a global assessment under the heading "GLOBAL ASSESSMENT" bringing in the relevant factors set out in the Trade Mark

Registry's summary of the principal decisions of the Court of Justice of the European Union relating to the likelihood of confusion. In this, she noted that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion; that may be less likely where that distinctive character is low; and that distinctiveness of the common elements is key.

15. The Hearing Officer found that there would be direct confusion between the Word Mark and the Earlier Mark, and there was also a likelihood of indirect confusion.
16. The Hearing Officer found that there would not be direct confusion between the Logo Mark and the Earlier Mark. She noted the low level of distinctiveness in the common element WE FIX and how this was at least allusive of the goods and services offered. Considering *L'Oréal SA v OHIM*, Case C-235/05 P and *Duebros Limited v Heirler Cenovis GmbH BL O/547/17* she found that there was a likelihood of indirect confusion between the marks.
17. Accordingly, the Hearing Officer found both the Word Mark and the Logo Mark were invalid.

The approach on an appeal

18. The parties relied on different authorities on the correct approach to an appeal.
19. The Appellant cited *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) (paragraphs 14 to 52) as approved by Mr Justice Arnold (as he then was) in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch) and cited in the context of an appeal from the UK IPO to the High Court by Mr Justice Carr in *Gap (ITM) Inc v Gap 360 Ltd* [2019] EWHC 1161 (Ch).
20. The Respondent's October 2021 letter cited the later case *Yellow Bulldog v AP & Co Ltd* [2020] EWHC 3558 (Ch). That has since been applied by this court in *Tik Tok International Ltd v Tiktok Information Technologies UK Ltd* [2022] EWHC 1220 (Ch) (18 May 2022).
21. For the purposes of this appeal, the approaches in these cases are the same. This court should conduct a review of the Decision. There is no suggestion of procedural or other irregularity. The court will therefore only allow the appeal if the Decision was wrong.
22. As Mrs Justice Falk said in *Tik Tok*:

“Where the court is asked to review an evaluative judgment based on a multi-factorial comparison, such as the similarity of marks or the existence of a likelihood of confusion, there will be real reluctance (but it has been said, "not the very highest degree of reluctance") to interfere in the absence of a distinct error of

principle. A significant degree of respect is shown to a Hearing Officer's specialised experience.”

The Appeal

23. Mr Selmi, for the Appellant, said that this was a simple appeal concerning the treatment of descriptive words under Section 5(2)(b) of the Act. The Hearing Officer had made two errors of principle.
24. First, she failed to take proper account of the fact that the common element between the marks was the words WE FIX, which is descriptive and of very low distinctiveness for the goods and services in issue. This should have influenced her analysis of the level of visual, aural and conceptual similarity between the respective pairs of marks.
25. Secondly, she failed properly to apply the principle that where the only similarity between the respective marks consists of a common element which has low distinctiveness, that will not normally give rise to a likelihood of confusion. Had she undertaken a proper analysis, she would have found no likelihood of confusion between the marks and would not have invalidated the contested marks.
26. The Appellant did not challenge to the Hearing Officer's assessment of the comparison of goods and services, the average consumer and the purchasing act, or the distinctiveness of the earlier mark.

The first ground

27. The Appellant developed the first ground as follows. It was accepted that the Hearing Officer correctly reminded herself 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, citing the CJEU in *Sabel BV v Puma AG* and *Bimbo SA v OHIM*.
28. By way of an example of how the assessment should be carried out, the Appellant referred to *JAC Travel Ltd's Application* (O/330/19). In that case, the opponent sought to oppose under Section 5(2)(b) of the Act an application for “JacHotels” in respect of various class 39 and 41 services, relying on an earlier trade mark for “AC HOTELS” for a wide range of services in classes 39, 41 and 43.
29. Iain Purvis QC sitting as the Appointed Person agreed with the Hearing Officer that since the word HOTELS was present in both marks and was non-distinctive in relation to the services in issue, the overall impression would be dominated by the initial letters “AC” and “Jac”. Given the relative unimportance of the word HOTELS, the Hearing Officer was correct to conclude that the marks had only a medium degree of visual similarity. Bearing in mind the entirely descriptive nature of the word HOTELS, the Hearing Officer was also correct to conclude that the marks had only a

low level of aural similarity. Finally, given the highly descriptive nature of the word HOTELS, any conceptual similarity because of the shared element was “*somewhat superficial*”, and the Hearing Officer was correct not to give it any real weight. Therefore, the Hearing Officer was correct to find that there was no likelihood of confusion between the marks, and the appeal was dismissed.

30. The Appellant said that the Decision only dealt with the question of distinctive character after the comparison of the marks; while this was common in decisions of the Trade Mark Office, it was an error. It was, further, only the distinctive character of the earlier mark that was assessed. When comparing the marks the Hearing Officer did not consider the distinctive character of the marks, despite reminding herself of the relevance of this point by citing *Sabel BV v Puma AG* and *Bimbo SA v OHIM*. The Appellant said that it had raised this point in its skeleton argument for the cancellation. It was therefore necessary for the court to undertake its own analysis of the distinctive character of the contested marks on appeal.
31. The Decision does, as the Appellant says, make an initial comparison of the marks and then deal with the distinctive character of the Earlier Mark. However, the Hearing Officer then brought together all of the matters she had considered under the heading “GLOBAL ASSESSMENT”. She had by then concluded that the Earlier Mark was inherently distinctive to a low degree. This approach allowed her to deal with the low level of distinctiveness of the element WE FIX in the Word Mark and the Logo Mark which followed as a consequence of her earlier findings. Neither the decision in *JAC Travel Ltd’s Application* nor the Appellant’s skeleton argument for the cancellation hearing approached the matter in this order.
32. The Hearing Officer first made a comparison between the marks and then applied to that her finding of the level of distinctiveness of the Earlier Mark so as to anchor her analysis. She found that the Earlier Mark was distinctive to a low degree, and that underpinned her conclusions on the similarity between the marks.
33. There was no error of principle in that approach.

The second ground

34. The second ground was that the Hearing Officer failed to properly apply the principle that where the only similarity between the respective marks consists of a common element which has low distinctiveness, that will not normally give rise to a likelihood of confusion. The Appellant relied on two cases not shown to the Hearing Officer, *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33 and *Nicoventures Holding Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch).
35. In *Nicoventures* the UK IPO upheld an opposition to the registration of UK trade mark no. 3193425 made under Section 5(2)(b) of the Act, based on the opponent’s earlier UK trade mark no. 3167398. The marks are shown below.



36. On appeal Mr Justice Birss, as he then was, said:

“20. It is relevant to note in particular that the decision specifically identifies the point that it is only the distinctiveness of the shared components which matter. This could be understood in different ways. It could be a reference to the appellant’s submission but it could also mean that there will be a likelihood of confusion if the only thing distinctive about either mark is a component that they share. If it has the latter meaning then it is incomplete because it does not consider the nature of the common element. The topic was addressed by Arnold J in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) at paragraphs 43-45 as follows: ...

44. ...It is not necessary for present purposes to go further into these questions, **for what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.**

45. In my judgment the hearing officer did err in failing to apply this principle. In fairness to the hearing officer, it seems clear that this error arose because of the error he made at the earlier stage of his analysis, which, as discussed above, may be attributable to the way in which the case was argued before him.”

[my emphasis in paragraph 44]

21. I respectfully agree with Arnold J in his statement of principle at the end of paragraph 44 of *Whyte and Mackay*. It may be that this is what the Hearing Officer was referring to in paragraph 34 but if it was then the appellant submits that the error by the Hearing Officer was to have lost sight of that principle. The respondent submits that the fourth (and fifth) bullet points in the quotation from the Common Communication are also correct in principle and are applicable in this case. I do not dissent from the proposition that these other factors can play a role in the overall multifactorial assessment.

...

27. Counsel for the respondent submitted that the first sentence of [paragraph 45 of *L'Oréal*] meant that the appellant's submission of law was wrong because it sought to give undue prominence to distinctive character, which is something the CJEU was rejecting in that passage. I do not agree. I have referred to *White and Mackay* above. If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive.

...

29. Having reviewed it in detail, I believe the decision contains an error of law.... What the Hearing Officer does not do in this section is consider whether the common elements between the two marks – that is VAPE and CO – are themselves elements with a low distinctiveness either alone or in combination.”

37. In my view, the Hearing Officer conducted the global assessment correctly.
38. In respect of the Word Mark, she noted that the Earlier Mark was inherently distinctive to a low degree and that the distinctiveness of the common element WEFIX was low. She therefore made the comparison required by *Nicoventures*. In her view there was “very little for the consumer to grasp onto to differentiate between the marks”.
39. In considering the Logo Mark, the Hearing Officer said that the Earlier Mark held a low degree of distinctiveness as a whole and that the distinctiveness of the common element was also undoubtedly low. She concluded that there would be no direct confusion as the consumer would notice and recall the differences between the marks.
40. Despite the low distinctiveness described she found that there would be indirect confusion in this instance because consumers would think the contested mark represented an updated version or variant of the earlier logo, or vice versa.
41. This again makes a comparison in line with *Nicoventures*. The principle in that case (and *Whyte and Mackay*) does not preclude a finding of confusion where there is a non-distinctive common element in the marks; that is a “relevant factor” that “may be decisive”.
42. The Hearing Officer did not make an error of principle in reaching her conclusion. She had the relevant issues in mind, albeit without the parties having cited *Nicoventures* or *Whyte and Mackay*.
43. Noting that I should have a real reluctance to interfere where there is no error or principle, I decline to do so. The Hearing Officer's decision is carefully reasoned and her conclusions do not warrant interference.

Conclusion

44. The appeal is dismissed.