

O-104-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3042340
BY HERE'S GREAT LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 35**



**heres
great.com**

AND

**AN OPPOSITION THERETO (NO. 402305) BY
HERE GLOBAL B.V.**

Background and pleadings

1. This dispute concerns trade mark application 3042340 which was filed by Here's Great Ltd ("the applicant") on 13 February 2014 and was published for opposition purposes on 14 March 2014. The mark and the class 35 services for which registration is sought are:



Advertising and marketing; Advertising and promotion services and related consulting; Advertising and publicity services; Advertising particularly services for the promotion of goods; Advertising through all public communication means; Advertising via electronic media and specifically the internet; On-line advertising on computer communication networks; Providing and rental of advertising space on the internet; Provision of advertising space by electronic means and global information networks; Rental of advertisement space and advertising material; Rental of advertising space on web sites; Preparing audio-visual presentations for use in advertising; Advertising and business services; Advertising and marketing services; Advertising and promotion services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising services provided via the internet; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Preparation and presentation of audio visual displays for advertising purposes; Promotional and advertising services; Provision of space on web sites for advertising goods and services; Provision of space on web-sites for advertising goods and services; Radio and television advertising; Rental of advertising material; Rental of advertising space on the internet; Advertising and commercial information services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks.

2. Here Global B.V. ("the opponent") opposes the registration of the mark under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). It relies upon the following eight community trade marks (CTMs):

- i) CTM Registration 012180873 which was filed on 30 September 2013 and completed its registration process on 22 October 2014. The mark and the services on which the opponent relies are:



Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on

communication media; sales promotion for others; computerized on-line retail store services in the field of software applications for use with computers, mobile phones, smart phones, tablets, spectacles, watches, household equipment and other electronic devices.

- ii) CTM 011859361 which was filed on 30 May 2013 and completed its registration process on 20 November 2013. The mark and the services on which the opponent relies are:



Maps for Life

Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on communication media; sales promotion for others. Computerized on-line retail store services in the field of portable electronic devices and apparatus and of software applications for use with computers, mobile phones, smart phones, tablets, spectacles, watches, household equipment and other electronic devices; providing fuel prices information.

- iii) CTM 011374808 for the mark **HERE Maps** which was filed on 26 November 2012 and completed its registration process on 1 July 2013. The opponent relies on the following services:

Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on communication media; sales promotion for others; Computerized on-line retail store services in the field of software applications for use on computers, mobile phones, smart phones, tablets, watches and other electronic devices; Providing information relating to employment services, business, advertising, commercial, foreign trade and data processing from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks; providing information relating to prices from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks.

- iv) CTM 011974821 for the mark **HERE Cloud** which was filed on 11 July 2013 and completed its registration process on 6 February 2014. The opponent relies on the following services:

Class 35: Compilation of information into computer databases; systemization of information into computer databases; location-based advertising services; advertising services; computerized on-line retail store services in the field of software applications for use with computers, mobile phones, smart phones, tablets, spectacles, watches, household equipment and other electronic devices; data search in computer files for others.

- v) CTM 011375037 for the mark **HERE Transit** which was filed on 26 November 2012 and completed its registration process on 1 July 2013. The opponent relies on the following services

Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on communication media; sales promotion for others; Computerized on-line retail store services in the field of software applications for use on computers, mobile phones, smart phones, tablets, watches and other electronic devices; Providing information relating to employment services, business, advertising, commercial, foreign trade and data processing from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks; providing information relating to prices from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks.

- vi) CTM 011374949 for the mark **HERE Drive** which was filed on 26 November 2012 and completed its registration process on 1 July 2013. The opponent relies on the following services

Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on communication media; sales promotion for others; Computerized on-line retail store services in the field of software applications for use on computers, mobile phones, smart phones, tablets, watches and other electronic devices; Providing information relating to employment services, business, advertising, commercial, foreign trade and data processing from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks; providing information relating to prices from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks.

- vii) CTM 011375268 for the mark **HERE Explore** which was filed on 26 November 2012 and completed its registration process on 1 July 2013. The opponent relies on the following services:

Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on communication media; sales promotion for others; Computerized on-line retail store services in the field of software applications for use on computers, mobile phones, smart phones, tablets, watches and other electronic devices; Providing information relating to employment services, business, advertising, commercial, foreign trade and data processing from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks; providing information relating to prices from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks

- viii) CTM 011375151 for the mark **HERE Connect** which was filed on 26 November 2012 and completed its registration process on 1 July 2013. The opponent relies on the following services:

Class 35: Location-based advertising services; advertising services; compilation and systemization of information and data into computer databases; compilation of statistics; on-line advertising on a computer network; presentation of goods on communication media, for retail purposes; rental of advertising space; rental of advertising time on communication media; sales promotion for others; Computerized on-line retail store services in the field of software applications for use on computers, mobile phones, smart phones, tablets, watches and other electronic devices; Providing information relating to employment services, business, advertising, commercial, foreign trade and data processing from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks; providing information relating to prices from searchable indexes and databases of information, including text, electronic documents, databases, graphic and audio visual information, by means of global computer information networks.

3. Given their dates of filing, all of the opponent's marks qualify as earlier marks. Given the dates on which they were registered, the proof of use provisions contained in Section 6A of the Act do not apply to any of them¹. The consequence of this is that all the marks may be relied upon in respect of the services set out above without the

¹ The provisions provide, in summary, that if an earlier mark has been registered for more than five years (as of the date of publication of the opposed mark) then the opponent must, if requested, prove that the mark has been used in order to rely on it.

opponent having to prove that they have been used. The opponent makes various claims as to why there is a likelihood of confusion, including that:

- a) The services are, self evidently, identical or highly similar.
- b) The marks are highly similar/similar.
- c) The element HERE is shared and that this is the most important part of the applicant's mark.
- d) The different colours used by the applicant separate the word heres from great.
- e) The fonts used are very similar.
- f) Both marks "are characterized by the word HERE".
- g) The opponent's mark has no significance in relation to its services so is averagely distinctive.

4. The applicant filed a counterstatement. It states that the opponent's claim that the public will assume that the services offered under the applicant's mark are connected with the opponent will not occur because its mark has been opposed, so no one is in possession of its services. This point is misconceived. The job of the tribunal is to assume notional and fair use of the respective marks/services and to decide whether, on that basis, there is a likelihood of confusion on the part of the average consumer. Other points made include:

- a) That the marks have different casing and the applicant's mark contains "heres" not here.
- b) The applicant's mark has the word great, makes reference to a dot com and has an exclamation mark. "Here's Great!" is a statement "suggesting somewhere is great, of which I believe the word GREAT is the more important word by the use of the exclamation mark".
- c) The business sectors are different, the opponent's business being that of mapping, the applicant's business is of recommending restaurants, cafes etc.
- d) There are other marks on the register more likely to cause to confusion.
- e) The font is not similar as the letters (in the opponent's mark) touch each other and are on a 45 degree angle.

5. The opponent is represented by Rouse IP Limited. The applicant is self-represented. Neither party filed evidence. Neither party asked to be heard. Neither party filed written submissions in lieu of a hearing.

Section 5(2)(b)

6. Section 5(2)(b) of the Act states 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.”

7. The following principles are gleaned from the judgments 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 great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

8. Eight earlier marks have been pleaded. I will make an initial assessment in relation to the mark that was pleaded first in the opponent's statement of case, namely CTM 012180873. However, if the opponent does not succeed on this basis, I will come back to whether its other earlier mark puts it in any better position.

Comparison of services

9. When making a comparison, all relevant factors relating to the services should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

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

10. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

(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.”

11. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

12. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

13. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

“..... 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) (IPTRANSLATOR) [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.”

14. The comparison to be made here involves just services, so I keep in mind the words of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 where he stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

15. The applicant seeks registration of its mark in relation to:

Advertising and marketing; Advertising and promotion services and related consulting; Advertising and publicity services; Advertising particularly services for the promotion of goods; Advertising through all public communication means; Advertising via electronic media and specifically the internet; On-line advertising on computer communication networks; Providing and rental of advertising space on the internet; Provision of advertising space by electronic means and global information networks; Rental of advertisement space and advertising material; Rental of advertising space on web sites; Preparing audio-visual presentations for use in advertising; Advertising and business services; Advertising and marketing services; Advertising and promotion services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising services provided via the internet; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Preparation and presentation of audio visual displays for advertising purposes; Promotional and advertising services; Provision of space on web sites for advertising goods and services; Provision of space on web-sites for advertising goods and services; Radio and television advertising; Rental of advertising material; Rental of advertising space on the internet; Advertising and commercial information services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks.

16. In its counterstatement, the applicant states that the businesses the parties operate in are different (mapping vs recommending restaurants/cafes etc). That may be so, but as stated earlier, the job of the tribunal is to consider the notional and fair use of the respective marks. Such use must be based upon the services listed in the

respective specifications. This is an important point because listed within the opponent's specification are the terms: "advertising services" and "sales promotion for others". It additionally lists some specific advertising services such as: "rental of advertising space; rental of advertising time on communication media; sales promotion for others". The relevance of this is that in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ("*Meric*"), the General Court 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 fur 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".

17. The vast majority of the applicant's services are identified as being advertising services of one form or another. I consider that they all fall within the ambit of the opponent's "advertising services" and must, in accordance with the above guidance, be considered as identical. Even if this were not so, the services must, given their nature, purpose, channels of trade etc be regarded as similar to a very high degree. The applicant's services also cover promotional services. This would fall within the ambit of "sales promotion" in the earlier mark and, so, identity also exists here. Again, if this were not so then promotional and advertising are so closely related that the services would, in any event, be similar to a very high degree.

Average consumer and the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

19. Advertising services, of one form or another, will be used by a business to advertise their wares or to seek advice on how best to advertise and to provide the means for doing so (advertising space etc). A member of the general public could also use an advertising service if they wish to advertise their own goods (or sometimes services) they wish to sell. However, certain forms of advertising services may also be directed at the recipient of the advertising. So, for example, a member

of the public looking for a product may use the advertising service to find what they are looking for. Whilst this would not apply to things such as advertising agency services, it would apply to advertising via trade directories and second hand sale advertising platforms etc. All of this will need to be borne in mind. For members of the general public, I consider a reasonable (neither higher nor lower than the norm) degree of care and attention will be deployed when choosing the service. For businesses, an advertising service will be crucial to its potential success, so the selection process may be somewhat higher. The same applies to promotional services, although, I think that business users are more relevant here.

20. The marks will be encountered visually on brochures, websites, visual media advertisements etc. However, the aural impact will not be ignored as the services could be accessed over the phone (e.g. phoning up to place an ad).

Distinctive character of the earlier trade mark

21. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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).”

22. The opponent stated in its statement of case that its mark has no relationship with its services and, thus, it is of an average level of distinctiveness. I disagree. The word here will have some significance in relation to advertising which is often local in nature, or at least relates to advertising in certain localities. Indeed, I note that the first term in the opponent’s specification reads: “location-based advertising services”. The word here therefore has some suggestive qualities as it is a word used to indicate a place or location. It is not, though, a directly descriptive word absent context of what is “here”. The stylisation of the earlier mark is noted, including its

orientation, but this does not, in my view, add significantly to the mark's distinctive character. Overall, I consider the inherent distinctive character of the mark to fall between low and moderate. No evidence has been filed to show what (if any) level of use has been made of the mark, so its inherent distinctive character has not been enhanced through use.

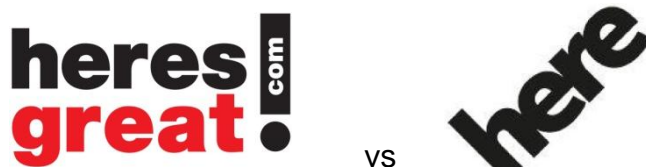
Comparison of marks

23. 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.”

24. 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.

25. The marks to be compared are:



26. The opponent's mark consists of the word "here" in a fairly unremarkable font, albeit presented on a slant. A small part of the letter "h" has been cut off. The word "here" itself makes a greater contribution to the overall impression than the presentation. In terms of the applicant's mark, it consists of the word "heres" presented above the word "great" with a large exclamation mark to the right of both words, which additionally contains the word "com" (as in .com). The two words are presented in contrasting colour, and are also in a fairly unremarkable font. The opponent's states that "heres" is the more dominant word, the applicant suggests that it is the word "great". In my view, neither is correct. The words play an equal role in the overall impression and will, despite the contrasting colour, be seen as a phrase "heres great" (as in "here is great"). The exclamation mark containing the word "com" also contributes to the overall impression, but to a lesser extent than the words "heres great".

27. Given that both marks clearly contain the word here/heres, there is some degree of visual similarity. However, there are also clear points of visual difference on account of, most notably, the additional (and contrastingly coloured) word “great”. The exclamation mark containing the word “com” adds to that difference. Whilst the letters in the opponent’s mark touch each other whereas they do not in the applicant’s mark, there is still some similarity in font, but as this is a fairly unremarkable font, this aspect should not be overplayed. The difference in orientation is also noted, this creates a further difference, but not one, in my view that is highly significant Overall, I consider there to be a degree of visual similarity that falls between low and moderate.

28. The presentation of the respective marks does not factor upon the aural comparison. The marks will be articulated in the customary way for the words here and here’s great (even absent the apostrophe, this is the likely pronunciation). The “com” in the exclamation mark may be overlooked or simply not verbalised There is somewhat more aural similarity than visual similarity, but still in my view of only a moderate level.

29. Conceptually, the applicant’s mark has a clear concept indicating a place or location which is great. The concept of the opponent’s mark is based on the word here per se, indicating the location of something. Whilst the word here forms part of the concept of both marks, as a whole, the applicant’s mark, whilst not changing the meaning of the word here, creates a conceptual difference.

Likelihood of confusion

30. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Before making a detailed analysis, I should say that the applicant’s statement that there are other marks on the register that are more similar to the opponent’s mark is not relevant in the assessment. That the opponent has taken no action against them is not pertinent. I must decide the matter on the basis of the two marks before me.

31. The services in question are either identical or at least similar to a very high degree. This is important because it is something that could make up for a lesser degree of similarity between the marks. I must also bear in mind the principle of imperfect recollection. However, in my view, the differences between the marks is more than sufficient to prevent the average consumer (be it a business user or a member of the general public) from directly confusing (mistaking) one mark for the other. However, confusion need not be direct and can, instead be indirect. The difference between the two forms of confusion was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where noted 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).”

32. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis are just illustrative – he stated that indirect confusion “tends” to fall in one of them. The categories should not, therefore, be considered a straightjacket. In my view there will be no indirect confusion, in any of the categories identified by Mr Purvis, or any other categories. The average consumer will realise that the applicant is simply making use of what will be seen an ordinary word “heres” (they will see this as “here’s” albeit without an apostrophe) in the context of the overall phrase “heres great”. It will not be assumed that the services are provided by the same (or related) undertaking as those provided under the here mark. They will see this is a simple, and unsurprising, coincidental use of a word which has some allusive qualities for the services at issue. I would have found the same if the marks in question had been just plain words, but the presentation makes the position, in my view, clear. There is no likelihood of confusion on the basis of CTM 012180873.

Other earlier marks

33. Given the above finding, it is incumbent upon me to comment on the other earlier marks relied upon by the opponent. For that purpose, it should be noted that all of the other marks contain identical services and that the same assessment regarding the average consumer applies. The other earlier marks and my comments are as follows:

34. CTM 011859361 is for the mark:



Maps for Life

35. The overall impression of the above mark is based on the slanted word “here”. The additional wording, given its descriptive nature and size, plays only a minor role in the overall impression of the mark. However, the additional words do reduce (even if it is only to a small degree) the similarity between the competing marks. In terms of direct confusion there is even less prospect here. The same applies to indirect confusion. I can see no greater prospect that the average consumer will see a shared economic origin than I have assessed above. There is no likelihood of confusion.

36. CTM 011374808 is for the mark **HERE Maps**. The overall impression is based on those two words, although they do not obviously hang together. Given the somewhat descriptive nature of the word Maps, I accept the opponent’s submission in its statement of case that the word HERE plays a greater role in the overall impression. However, notwithstanding that this earlier mark is not slanted nor stylised, the differences with the applied for mark are still apparent including the replacement of the word great for Maps and the exclamation mark containing the word com. When considered in totality, the commonality of the words heres/here still only creates a low to moderate level of visual similarity, a moderate level of aural similarity (at best) and there is still, in view, a conceptual difference. In terms of confusion, there is still sufficient difference to mean that there is no likelihood of direct confusion. Similarly, there will be no indirect confusion. I note the opponent’s submission that the applied for mark follows the two word structure of the earlier mark, but this does not materially assist. The marks as a whole have a different conceptual structure, with the words here/heres performing a different role in the marks. I can see no greater prospect that the average consumer will see a shared economic origin than I have assessed above. There is no likelihood of confusion.

37. The other earlier marks are for: **HERE Cloud**, **HERE Transit**, **HERE Drive**, **HERE Explore** and **HERE Connect**. All five of these marks fall in the same camp as **HERE Maps**, and the same assessment and findings apply. There is no likelihood of confusion.

Conclusion

38. The opposition has failed on all grounds. Subject to appeal, the applicant’s mark may proceed to registration.

Costs

39. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind, though, that the applicant was not professionally represented so would not have incurred any legal costs; for this reason, I have reduced by half what I may otherwise have awarded. I have, though, made an award at the higher

end of the scale given that the opponent pleaded eight earlier marks (and a correspondingly lengthy statement of case) when it is not clear why any more than two or three were needed. I award the applicant the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

40. I therefore order Here Global B.V. to pay Here's Great Ltd the sum of £300. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of March 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**