

**O-452-16**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 112 075



IN THE NAME OF FLAMMA CORPORATION (UK) LTD AND  
GLOCAL IDEAZ & SERVICES LIMITED

AND IN THE MATTER OF OPPOSITION THERETO IN THE NAME OF O2  
WORLDWIDE LIMITED

## Background and pleadings

1. Flamma Corporation (UK) Ltd and Glocal Ideaz & Services Limited (the



applicant) applied to register the trade mark under No 3 112 075 in the UK on 05/06/2015. It was accepted and published in the Trade Marks Journal on 03/07/2015 in respect of the following services in Class 38:

*Telephone telecommunications services provided via prepaid telephone calling cards; telecommunications routing and junction services.*

2. O2 Worldwide Limited (the opponent) opposes the trade mark on the basis of, amongst others, Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, its earlier European Union (formerly Community) Trade Mark No 1 303 1869 INDIGO. A large number of different goods and services are relied upon in this opposition, with the pertinent ones being “*telecommunications*” in Class 38:
3. The opponent argues that the respective services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Both sides filed evidence in these proceedings. This will not be summarised but will be referred to where necessary.
6. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## **DECISION**

### **Section 5(2)(b)**

7. Section 5(2)(b) of the Act is as follows:

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

### **Comparison of goods and services**

8. The contested services are: *Telephone telecommunications services provided via prepaid telephone calling cards; telecommunications routing and junction services*. The earlier services are *telecommunications* which is the wider term which includes the contested services. They are self evidently identical.

### **Comparison of marks**

9. 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 Court of Justice of the

European Union 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.”

10. 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.

11. The respective trade marks are shown below:

INDIGO	
Earlier trade mark	Contested trade mark

12. The earlier sign is word only and comprised of a single element: INDIGO. The contested sign is a composite trade mark which includes the word INDIGO as part of a slogan: Indigo calls follows wherever you go. There is also a graphical element which appear to be two hands in a cupping motion. Indigo in the contested trade mark is central and appears in a larger font and size than any of the other remaining elements. It is considered therefore that it will have greater relative weight.

13. Visually, the signs clearly coincide in respect of INDIGO and differ in respect of the additional visual elements already described. Though the additional elements in the later trade mark have a visual impact, INDIGO is central within the trade mark. They are considered to be visually similar to a moderate degree.
14. Aurally, there are clearly differences, but the presence of indigo in each leads to the conclusion that there is at least a low degree of aural similarity.
15. Conceptually, the earlier sign will be understood as referring to the colour in between purple and blue. The later sign is a slogan and is most likely to be understood as meaning that telephone calls from the company indigo are flexible and that the service will be uninterrupted. While these are not the same in concept, it is considered that the entire meaning of the later slogan leads in any case back to the word INDIGO. Whilst this does not make the marks (clearly) conceptually similar, it does not create an obvious conceptual gap either.

## **Average consumer and the purchasing act**

16. 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*.
17. 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.”

18. The relevant services are telecommunications. The relevant public can therefore be mixed: the general public and the business sector. For either, the acquisition of such services is likely to involve price comparisons and also noting particular incentivising features. As such, it is likely to be a fairly considered purchase; perhaps not the very highest degree but not the lowest either.

## **Distinctive character of the earlier trade mark**

19. 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).”

20. As already discussed, Indigo is the name of the colour between purple and blue. It is meaningless in respect of telecommunication services and is distinctive to an above average degree.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

### **The principles**

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

22. The following guidance is also taken into account:



In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

23. Bearing in mind the foregoing, it is noted that the earlier trade mark INDIGO is distinctive to a more than average degree. It is also noted that this element is clearly present in the later trade mark. It is true that the trade marks are visually similar to a moderate degree and aurally similar to a low degree. The position conceptually is more subtle; however it has already been found that the message conveyed by the slogan emphasises the word INDIGO. The services here are identical and so the interdependency principle is in full effect. It is also true that the purchase of these particular services will be fairly considered and this can negate against the impact of imperfect recollection. However, even if this were the case, this does not mean there is no likelihood of confusion. In this regard, the following is taken into account: in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person 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).”

24. INDIGO in the earlier trade mark is clearly distinctive and despite the fact that it appears as part of a slogan in the later trade mark, it is considered that the impact of the word is not lost as it remains central to the message being conveyed. It is considered likely that a consumer, upon seeing the later trade mark, will view it simply as another brand of the owner of the earlier trade mark.

25. The opposition therefore succeeds in its entirety.

## **Final Remarks**

26. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based.

27. As the opposition is successful in its entirety based upon this ground, there is no need to consider the remaining grounds as they do not materially improve the opponent’s position.

## **COSTS**

28. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee and Notice of Opposition - £500

Preparing and filing evidence and considering evidence - £500

TOTAL - £1000

29. I therefore order Flamma Corporation (UK) Ltd and Glocal Ideaz & Services Limited to pay O2 Worldwide Limited the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28th day of September 2016**

**Louise White**

**For the Registrar,**