

O-518-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3144441
BY WOOD FOR TREES LTD**

TO REGISTER:

MYLIFE DIGITAL

AS A TRADE MARK IN CLASSES 9, 35 AND 42

AND

**THE OPPOSITION THERETO UNDER NO. 600000425
BY DIGI.ME LIMITED**

BACKGROUND

1. On 14 January 2016 Wood For Trees Ltd (“the applicant”) applied to register the mark shown on the cover page of this decision for the following goods and services:

Class 9: Computer software; computer software to enable data management, data manipulation, analysis, visualisation and strategic reporting; computer software and software tools to allow for database cleaning and cleansing; digital recording media; data processing equipment.

Class 35: Business management services; business administration; office functions; data processing services; data management services; provision of business information; advice and consultancy with respect to strategic business processes and efficiencies; consultancy and advice service in relation to all the aforesaid services.

Class 42: Industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services.

2. The application was published for opposition purposes on 19 February 2016 and a notice of opposition, under the fast track procedure, was subsequently filed by digi.me Limited (“the opponent”).

3. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the European Trade Mark (EUTM) registration no. 14493654 for the mark DIGITAL ME, which has a filing date of 24 August 2015 and was registered on 21 December 2015 in respect of the following goods and services:

Class 9: Software; archival software; backup software.

Class 38: Provision of access to computer databases; Provision of access to data or documents stored electronically in central files for remote consultation; Electronic exchange of data stored in databases accessible via telecommunication networks; provision of controlled access to data provided by third parties for persons authorised by the third party.

4. The opponent argues that the respective marks are similar in that they are conceptually the same and that the respective goods and services are identical or similar.

5. The applicant filed a counterstatement in which it accepts that the term “computer software” in its specification is identical to the term “software” covered by the earlier mark but argues that the mark are sufficiently different for confusion not to arise. It also denies that the respective services are similar.

6. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

8. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal

with the case justly and at proportionate cost. Otherwise written arguments will be taken.

10. A hearing was neither requested nor considered necessary. Both sides filed written submissions, which I will refer to as necessary, below.

DECISION

11. Section 5(2)(b) of the Act states:

“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”.

12. An earlier trade mark is defined in Section 6 of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

13. Given its date of filing, the opponent’s mark is an earlier mark in accordance with Section 6 of the Act. As the opponent’s mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. Consequently, the earlier mark may be relied upon without having to prove use.

Section 5(2)(b) case law

14. 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.

Comparison of goods and services

15. Some of the contested goods and services, e.g. *software and computer software*, are identical to the goods and services on which the opposition is based. For reasons of procedural economy, I will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier mark. If the opposition fails, even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade.

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 average consumer of the parties’ goods and services may be either a member of the general public or a business user. The purchasing process is likely to be primarily visual with the goods being self-selected from, for example, retail outlets or websites and the services being selected through perusal of marketing material, websites, advertisements etc. respectively. However, I do not discount aural considerations in the form of, for example, interaction with a sales assistant, orders placed by phone and (in particular for the services) personal recommendations.

19. As to the degree of care and attention taken during the selection process, the respective specifications in classes 9, 38 and 42 cover essentially software and IT equipment goods and related services. Accordingly, given the likely cost and relatively technical nature, the goods and services are likely to be selected with a slightly more than average level of care and attention since the consumer will have to consider factors such as system compatibility, capability and fitness for purpose (in relation to the goods) and/or reliability of the provider, limitations and capabilities

(in relation to the services). Whilst I accept that the cost of software products range from relatively low to quite high, even where the goods are not expensive, the same considerations apply. As to the class 35 business related services, again, the level of care and attention is likely to be slightly above average as the consumer will need to ensure that the particular package of services is selected correctly and is appropriate to the needs of their business.

Comparison of marks

20. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (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.”

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

22. The marks to be compared are:

MYLIFE DIGITAL v DIGITAL ME

Overall impression

23. The applicant states, inter alia, the following:

“In the Applicant’s Mark, “MYLIFE” is the dominant element, as it appears at the beginning of the mark. Furthermore, by joining the words together, the Applicant creates a novel and distinctive element. DIGITAL appears last and has an adjectival quality which merely alludes to the general nature of the goods and services to be offered under the mark. It is a common term in the sector at issue, and consumers will not consider it to identify the origin of the Applicant’s Goods and Services. [...]

DIGITAL is also a non-distinctive term in relation to the Opponent’s Goods and Services, which are also of digital nature. It is fair to say that consumers will not rely on the word DIGITAL to identify the origin of the Opponent’s Goods and Services. It is also uncontroversial to say that consumers will not confuse the goods and services of the parties with each other solely because of the coincidence of DIGITAL in the marks.

In fact, the particular use of DIGITAL in the Opponent’s Mark serves to distance it further from the Applicant’s Mark. DIGITAL appears at the beginning of the Opponent’s Mark and constitute close to 80% of that mark. DIGITAL is therefore dominant in the mark without being distinctive. This further helps to eliminate any likelihood of confusion. The word DIGITAL in the Opponent’s Mark does not serve as an indicator of origin for consumers, but it does largely shape the immediate overall impression....”

24. The applicant’s mark consists of the phrase MYLIFE DIGITAL, presented in capital letters. The words MYLIFE are presented as a single word, however, it naturally breaks down into two immediately recognisable words, MY and LIFE. The word DIGITAL acts as a qualifier of the words MYLIFE and the two components form a unit as a natural word combination. The phrase is most likely to be taken by the average consumer as a reference to his or her life integrating the use of digital

technology. In my view, both words are as important to the phrase that it produces as the other and the overall impression the mark will convey, lies in its totality.

25. Turning to the opponent's mark, this consists of the phrase DIGITAL ME presented in upper case. The word DIGITAL qualifies the pronoun ME to form a unit which is likely to be perceived by the average consumer as a reference to his virtual self (as opposed to his/ her physical one), i.e. his/her behaviour in the virtual/digital world. Once again, the distinctiveness and overall impression created will stem from the mark as a whole.

Visual and aural similarity

26. The applicant does not refer to the marks being visually or aurally similar although it refers to the marks sharing the component DIGITAL combined with "a first person possessive". The marks are of different length and coincide in the element DIGITAL, which is placed in different sides of the words. In my view the marks are visually and aurally similar only to a moderate degree.

Conceptual similarity

27. The applicant submits, inter alia, the following:

"In the Opponent's Mark "DIGITAL ME" provides the consumer with the concept of digital person.

In comparison, the conceptual effect of the Applicant's Mark is to make the consumer think of a "life" in the sense of a social, personal, or professional life and the activities taking place in the course of their "lives".

The marks at issue are therefore conceptually distinguished."

28. The Oxford English Dictionary contains the following definitions:

Digital: Adjective: (of signals or data) expressed as series of the digits 0 and 1, typically represented by values of a physical quantity such as voltage or magnetic polarization.

■ relating to, using, or storing data or information in the form of digital signals: digital TV | a digital recording.

■ involving or relating to the use of computer technology: the digital revolution.

29. As I have already said, DIGITAL ME will form a conceptual hook based on the idea of digital (virtual) identity. The applicant's mark conveys the concept of the user's life integrating digital technology, which creates a vaguer concept in term of what the average consumer will take from it. To the extent that the marks convey the concept of DIGITAL as referring to the user's identity or life, but taking into account the more precise meaning of the opponent's mark, there is a moderate degree of conceptual similarity.

Distinctive character of the earlier mark

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

31. These are fast track opposition proceedings in which it was not necessary for the opponent to provide any evidence of the use it may have made of his earlier mark, thus, I have only the inherent characteristics to consider.

32. In assessing the distinctiveness of the earlier mark, I bear in mind that a registered mark must be assumed to have ‘at least some distinctive character’¹. In the present case, the word DIGITAL is a relatively weak element for the goods and services at issue which relate, for the vast majority, to the duplication, storage, access and exchange of data stored or transmitted using digital technology. Whilst the element ME adds some distinctiveness, the mark is, at best, possessed of an average degree of distinctive character in relation to the goods and services covered by the specification.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

34. Earlier in this decision I have said that I intend to proceed on the basis that the respective goods and services are identical, which represents the best case for the

¹ *Formula One Licensing BV v OHIM*, Case C-196/11P

opponent. I found that the earlier mark enjoys, at best, an average degree of distinctive character and that the respective marks are visually, aurally and conceptually similar to a moderate degree. Confusion can be direct, in the sense that one mark is mistaken for the other, or indirect, in the sense that the average consumer will assume that the common elements in the marks (and the similarity of the goods/services) mean that the undertakings responsible for the goods and/or services are the same or are economically related. In terms of direct confusion, I conclude that when a slightly more than average degree of attention is deployed, and even making due allowance for imperfect recollection, the differences between the two marks stand out sufficiently enough and the average consumer will not directly confuse them. **There is no likelihood of direct confusion**

35. As to whether there is, nevertheless, a likelihood of indirect confusion, it is helpful to consider the comments of Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, case BL-O/375/10 where he stated:

“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).”

36. Bearing in mind that the DIGITAL element of the marks is inherently weak for the goods and services at issue and that the respective marks form different complete wholes, I consider that it is unlikely that the mark MYLIFE DIGITAL will be seen as a logical sub brand or brand extension of DIGITAL ME. Rather, the average consumer will attribute the similarity between the marks to coincidence not to economic connection. **There is no likelihood of indirect confusion.**

CONCLUSION

37. The opposition fails.

COSTS

38. As Wood For Trees Ltd has been successful, it is entitled to a contribution towards his costs. Awards of costs in Fast Track opposition proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. I award costs to Wood For Trees Ltd on the following basis:

Preparing a statement and considering the other side’s statement:	£200
Written submissions:	£200
Total:	£400

39. I order digi.me Limited to pay Wood For Trees Ltd the sum of £400 as a contribution towards its costs. This sum is to 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 3rd day of November 2016

Teresa Perks

For the Registrar

The Comptroller – General