

**O-263-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3150592**

**BY**

**DREAM IT GET IT LIMITED**

**TO REGISTER AS A TRADE MARK**

**visii**

**IN CLASSES 9, 35 AND 42**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 407005**

**BY**

**VERO UK LIMITED**

## BACKGROUND

1. On 19 February 2016, Dream It Get IT Limited (the applicant) applied to register the above trade mark in the following classes:<sup>1</sup>

**Class 9**

Software.

**Class 35**


Online advertisements.

**Class 42**

Software as a service [SaaS]; Search engines (providing-) for the internet.

2. The application was published on 6 May 2016, following which Vero UK Limited (the opponent) filed notice of opposition against all of the goods and services in the application.

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and relies upon the following trade mark:

Mark details and relevant dates	Goods and services relied upon
<p>Mark:</p>  <p>Filed: 16 February 2011 Registered: 22 March 2012</p>	<p><b>Class 9</b> Computer software for design and manufacture.</p> <p><b>Class 16</b> Operating manuals and documentation for computer software for design and manufacture.</p> <p><b>Class 41</b> Educational and training services relating to computer software for design and manufacture.</p> <p><b>Class 42</b> Design and development of computer software for design and manufacture.</p>

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<b>Class 45</b> Licensing of computer software for design and manufacture.
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4. The opponent states:

*“The applied for trade mark is highly similar to the registered earlier right. The marks only differ in one additional ‘1’ at the end, which is furthermore situated where it receives less consumer attention. The applied for goods and services are near identical in classes 9 and 42. The class 35 services are also similar, because the advertising services are only to be delivered online, which involves software. As a consequence, confusion on behalf of the relevant consumers is very likely.”*

5. The applicant filed a counterstatement in which it denies the grounds on which the opposition is based. It states:

*“The opposition was filed without the prior meeting which we requested with [the opponent]. As such, we are unsure as to the more nuanced objections beyond what has been written. We have already stated to [the opponent] that we do not believe our application for a trademark in Visii encroaches on their role for the following reasons;*

- 1. We operate in completely different markets, meaning there is no risk of any confusion or misdirection amongst customers...*
- 2. The services offered are so completely different that even if we ever had the same clients, we wouldn't be speaking to the same departments.*
- 3. The trademark is not the same and, given the differences detailed in points 1 & 2 above, is sufficiently different to avoid confusion and/or misdirection.*

*4. Trademark UK2651984 has already been granted allowing EDF Energy to use the mark Visi (which is exactly the same as the other party) for their product, post the granting of the other party's trademark."*

6. Both sides filed evidence. The opponent filed a skeleton argument and was represented by Mr Don Pennant of Wynne-Jones IP, who attended a hearing at the Newport Intellectual Property Office 9 May 2017. The applicant attended by video conference and was represented by Mr David Libertalis.

## **EVIDENCE**

### **Opponent's evidence**

Witness statement of Julie Randall and exhibits Vero1 and Vero 2

7. Ms Randall is the finance director of the opponent. Her statement is dated 24 February 2017. Exhibits attached to her statement consist of prints from the UK and EUIPO trade mark registers.

### **Applicant's evidence**

Witness statement of David Libertalis and exhibits 1-4

8. Mr Libertalis is the founder and Chief Executive Officer of the applicant. His statement is dated 27 December 2016. The exhibits attached to his statement consist of letters and emails between the opponent and the applicant and include a letter marked 'without prejudice'.

### **Preliminary issues**

Without prejudice correspondence

9. It has long been established law that communications between parties, genuinely aimed at a settlement between those parties, attract 'without prejudice privilege'.<sup>2</sup> The doctrine applies to exclude 'without prejudice' documents from being given in

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<sup>2</sup> *Walker v Wilsher* [1889] LR 23 QBD 335

evidence, in order to protect a litigant from being embarrassed by any admission made purely in an attempt to achieve a settlement. Such privilege can only be waived in limited circumstances.<sup>3</sup> It is clear from decided cases<sup>4</sup> that without prejudice privilege rests with both parties and can be waived with the consent of those parties.

10. The applicant filed a document marked 'without prejudice' as an exhibit to its witness statement, clearly waiving its privilege in the process. The opponent did not seek to challenge its inclusion. Mr Pennant, for the applicant, confirmed at the hearing that whilst the applicant found the filing of the document unusual, it was content for it to remain as part of the opponent's evidence.

11. The content of the document relates to the applicant's submission that the opponent has negotiated with proprietors of trade marks not relevant to these proceedings, but failed to reach agreement with the applicant in this case. I deal with this point at paragraphs 16, 17 and 18 below, but suffice to say, the content of this document is not relevant and I will say no more about it.

12. The points raised in the applicant's counterstatement are arguments which are often put before this Tribunal. However, they have no bearing on the outcome of this decision. Before I continue with the merits of the opposition it is necessary to explain why this is so.

13. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act kick in), it is entitled to protection in relation to all the goods/services for which it is registered. Consequently, the opponent's earlier UK mark must be protected for the services for which it is registered in class 9, 16, 41, 42 and 45 without the opponent needing to prove any use of its mark in relation to those services. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the goods and services listed in the register. This concept of

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<sup>3</sup> See *Unilever v Procter & Gamble* [2000] FSR 344 for a list of some exclusions.

<sup>4</sup> See *Walker v Wilsher* [1889] LR 23 QBD 335 for explanation of the rule; *Cutts v Head* [1984] All ER 597 and *Rush & Tompkins v Greater London Council* [1989] AC 1280 for explanation of the rationale for its operation.

notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>5</sup> as follows:

"22. ...It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

14. So far as the applicant's proposed use of his mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>6</sup>, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

15. Furthermore, in *Devinlec Développement Innovation Leclerc SA v OHIM*,<sup>7</sup> the CJEU stated that:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and

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<sup>5</sup> [2004] RPC 41

<sup>6</sup> Case C-533/06

<sup>7</sup> Case C-171/06P

depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

In other words, the way in which the applicant is actually using its trade mark at this point is not a factor which is relevant to the decision. Rather I must consider all normal and fair uses of the applicant’s mark. The same applies to the opponent’s earlier mark.

16. With regard to point 4 of the counterstatement, at the hearing the applicant made a considerable number of submissions regarding other ‘similar’ marks on the UK and EU trade mark registers. In particular, Mr Libertalis focused on a mark held by EDF, referred to above. Mr Pennant, for the opponent, confirmed that negotiations were held and limitations added to the relevant classes in the aforementioned mark before it proceeded to registration. Mr Pennant also provided reasons and explanations in respect of his client’s position regarding all of the other marks raised by the applicant.

17. It is not clear from the evidence which of the third party marks are being used and in what context. Some of the marks contain additional matter and in one case an extremely large device. Consequently, they are not on all fours with the matter to be decided in this opposition.

18. It was clear to me at the hearing that the applicant referred to these other marks to highlight the different ways in which the opponent had dealt with other marks and their proprietors. The parties in this case did not reach an agreement and the matter has fallen to this Tribunal to make a decision under section 5(2)(b). How the opponent has chosen to deal with other trade marks and their respective proprietors which are extraneous to these proceedings is not a factor which is relevant to this case.

## DECISION

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

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

(a)...

(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.”

20. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

21. The opponent's earlier mark is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>8</sup>

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

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<sup>8</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.



22. 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.

(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.

### **The average consumer and the nature of the purchasing act**

23. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

24. 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*<sup>9</sup>, 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

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<sup>9</sup> [2014] EWHC 439 (Ch)

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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

25. The applicant submitted at the hearing that the average consumers for both parties’ goods and services were completely different because they currently operate in different fields of activity. As I have outlined above, I must consider the full range of goods and services contained within the parties’ respective specifications. I must then consider who the average consumer for those goods and services will be.

26. The parties’ specifications include a wide range of goods and services for which the average consumer may be a member of the public or a business/professional. The purchase of a downloadable piece of software by a member of the general public will be less expensive, more frequent and require a lower level of attention to be paid than the commissioning of software design and development for a business, which will be infrequent, more expensive and likely to involve a far longer process. The selection process is likely to be primarily visual, being made from a website or brochure, though I do not discount the fact that there may be an aural element, particularly given that some of these services may be purchased as a result of recommendation.

27. That said, the level of attention paid during the selection of all of the respective goods and services will be at least ‘average’ as the average consumer, whether an individual or a commercial undertaking, will need to take note of, inter alia, the type of product or service, the cost, its capabilities, and so on.

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

28. The goods and services to be compared are as follows:

<b>The opponent’s goods and services:</b>	<b>The applicant’s goods and services:</b>
<b>Class 9</b>	<b>Class 9</b> Software.

<p>Computer software for design and manufacture.</p> <p><b>Class 16</b> Operating manuals and documentation for computer software for design and manufacture.</p> <p><b>Class 41</b> Educational and training services relating to computer software for design and manufacture.</p> <p><b>Class 42</b> Design and development of computer software for design and manufacture.</p> <p><b>Class 45</b> Licensing of computer software for design and manufacture.</p>	<p><b>Class 35</b> Online advertisements.</p> <p><b>Class 42</b> Software as a service [SaaS]; Search engines (providing-) for the internet.</p>
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29. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the 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”.

30. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

31. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 für 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”.

32. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] 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) (IP TRANSLATOR)* [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”.

33. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“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”.

34. With regard to the complementary nature of the goods and services, in *Kurt Hesse v OHIM*,<sup>10</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,<sup>11</sup> the General Court (“GC”) stated that “complementary” means:

“...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”.

35. In *Sanco SA v OHIM*,<sup>12</sup> the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, e.g. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

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<sup>10</sup> Case C-50/15 P

<sup>11</sup> Case T-325/06

<sup>12</sup> Case T-249/11

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:<sup>13</sup>

“18. [...] It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

36. Whilst on the other hand:

“19. [...] 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”.

37. In the same case, Mr Alexander also warned against applying too rigid a test when considering complementarity:

“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*”.

38. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.<sup>14</sup>

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<sup>13</sup> *BL O/255/13*

<sup>14</sup> See *Separode Trade Mark BL O/399/10 and BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ETMR 35 at paragraphs [30] to [38]*.

39. The applicant submits that the goods and services which the parties actually trade in are completely different from each other. For reasons outlined above, I must consider notional use of the respective trade marks for all of the goods and services in their specifications. The opponent provided a table of comparison in its skeleton argument which I have taken into account when making the following findings.

40. The applicant's specification includes software in class 9. The opponent has computer software for manufacture and design which is included within the broader term 'software'. In accordance with the decision in *Meric*, these must be regarded as identical goods.

41. The applicant has applied for 'online advertisements' in class 35 of its specification. The opponent states that its own computer software for design and manufacture in class 9 and its design and development of software in class 42 are similar goods and services. It states:

*"These services are both similar and complementary to each other, as computer software and the design and development of such will have considered and included facilities for featuring online advertisements. Computer Software is necessary for enabling online advertisements. Computer software for design in particular is an essential tool for creating advertisements to be featured online. Additionally, the broad term 'Online advertisements' includes advertisements in respect of software and other related products and services."*<sup>15</sup>

42. In considering this point, I bear in mind the decision in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>16</sup> which concerned a comparison between computer software and software services in classes 9 and 42, respectively, and a range of information, travel and reservation services in classes 39 and 42. The General Court upheld the finding of no similarity, including no complementarity, between the goods and services. It stated in its judgment:

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<sup>15</sup> Taken from the table at paragraph 18 of the opponent's skeleton argument.

<sup>16</sup> Case T-316/07



“54. The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55. Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

[...]

60 [...] The commercial origin of the software and the computer services which enable the intervener’s website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener’s website is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61. If, however, some of the intervener’s customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener’s website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services

relating to the tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62. The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely what constitutes the services covered by the mark at issue. The goods and services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned".

43. Similarly, in this case, the opponent has offered a false correlation based on the premise that software and related services are ubiquitous in nearly all sectors of the market. The provision of software and the design and development of software cannot be held to be similar to online advertisements simply because both involve software at some level. The core meaning of these goods and services is different. The applicant provides online advertisements, the relevant parts of the opponent's specification are the provision of software and the design and development of software. The users, uses and natures are different, the trade channels are different and the goods and services are not in competition. The goods are not complementary in the sense required by the case law. I am not persuaded that a consumer wishing to place an advertisement online would expect the services to be provided by a seller or developer of software. I find these goods and services to be dissimilar.

44. In class 42 the applicant has 'software as a service' [SaaS]. The opponent claims that this service is identical to 'licensing of computer software for design and

manufacture', as its own services are, 'essentially the same as a subscription based service being the offer of software as a service'. Neither side has provided an explanation or definition of SaaS. My own understanding of the term is that SaaS is a software delivery and licencing system which allows users to pay subscriptions or one off payments which enable them to access software. In my view, that could include the licensing of computer software for design and manufacture. On that view, the services are identical. However, even if I wrong about that, the users, uses and nature of these services are likely to overlap: both allow access to software, which could include software for design and manufacture. The trade channels could also coincide and they could be in competition. There is a degree of complementarity, to the extent that the average consumer would consider a suite of software, accessible as a service from the applicant, could originate from the same undertaking as the software being licenced from the opponent. I find these services to be at least highly similar. The opponent's 'design and development of computer software for design and manufacture' services could also be viewed as an alternative to 'software as a service' for use in design and manufacture. These services are therefore also highly similar.

45. Finally, the applicant has applied for 'search engines (providing-) for the internet' in class 42. The opponent states that its computer software for design and manufacture in class 42 and its educational and training services in class 41 are similar as:

*"...search engines are a form of computer software for the retrieval of information. This software can be used within computer design and manufacture, as information retrieval will be necessary.*

*Search engine technology is an essential way of helping educate and train people including relating to computer software for design and manufacture."*

46. I do not have any sympathy with the opponent's view, provided by its table of comparison referred to above, that its training and education services are similar to the applicant's provision of search engines because "search engine technology is an essential way of helping train people..." The core meaning of these services is

completely different and having considered all of the relevant factors, I find no other areas where the services coincide.

47. The opponent's class 42 specification includes 'design and development of computer software for design and manufacture'. The natural meaning is software used for the purpose of design and manufacture, for example CAD<sup>17</sup> and CAM<sup>18</sup> software. Search engines for the internet, on the other hand, are computer programs which search the internet and retrieve information which is presented to the user. The core nature of these services is different, as are the uses. There may be some overlap in the users of the services but this will only be at the highest level. In other words, most users of computers will use search engines and some of those users may also access design and manufacturing software but that is the high point of similarity. The trade channels are different and the average consumer is unlikely to believe that search engines and design and manufacturing software are provided by the same undertaking. They are also not in competition. I find these services to be dissimilar.

48. Where there is no similarity between the parties' goods and services, there can be no likelihood of confusion<sup>19</sup>. In *eSure Insurance v Direct Line Insurance*,<sup>20</sup> Lady Justice Arden stated that:

"49...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

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<sup>17</sup> *Computer Aided Design*

<sup>18</sup> *Computer Aided Manufacture*



<sup>19</sup> *Waterford Wedgwood plc v OHIM – C-398/07 P (CJEU)*

<sup>20</sup> [2008] ETMR 77 CA

49. Consequently, there can be no likelihood of confusion in respect of ‘online advertisements’ in class 35 or ‘search engines (providing) for the internet’ in class 42 of the application and the opposition fails in respect of these services.

### Comparison of marks

50. The marks to be compared are as follows:

The opponent’s mark	The applicant’s mark
	

51. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>21</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

52. The opponent states:

*“...The addition of the letter ‘i’ following the letter ‘i’ makes a minimal difference to the overall visual appearance of the application. It is understood that consumers will take least notice of supplementary letters within a trade mark when placed at the end of the word, and this applies here. Additionally, placing the ‘i’ next to an identical element ‘i’ means that visually this makes even less impact on the consumer. The stylization of the earlier mark is minimal and the application is filed as a word mark,*

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<sup>21</sup> *Sabel v Puma AG, para.23*

*meaning it could be stylised in any format...The additional 'i' is so insignificant that, bearing in mind these factors, it is inevitable that the high level of similarity between the marks will result in [the] consumer recalling these marks as, at the very least, confusingly similar, if not identical."*

53. At the hearing the applicant submitted that the number of letters in the respective marks is different, the dot on the letter V of the opponent's mark 'creates a different design element' and that its own mark is presented in lower case and is therefore completely different to the opponent's mark.

54. The opponent's mark comprises the letters 'VISI'. The first letter has a break in the left stroke of the letter V. The mark is presented in a mid grey tone. None of the stylisation of the mark takes away from the fact that the average consumer will see it as VISI, and it is these letters which dominate the overall impression.

55. The applicant's mark is the letters 'visii', presented in lower case. There is no additional stylization. The overall impression rests in the totality of the mark.

56. It is clear from cases such as *Sadas*<sup>22</sup> and *Peek & Cloppenburg v OHIM*<sup>23</sup> that normal and fair use of a word trade mark includes use in a range of fonts and cases. Accordingly, the fact that the applicant's mark is applied for in a plain black font in lower case does not prevent its use in a different font or in, for example, upper case.

57. The colouring in the opponent's mark does not have a bearing on the issue of similarity as neither party's mark is limited to any particular colour. The matter must be assessed on the similarity between the respective marks without regard to colour.<sup>24</sup>

59. In this case the first four letters of the applicant's mark are the entirety of the letters making up the opponent's mark. Only an additional letter 'i' at the end of the applicant's mark distinguishes them in terms of the letters used within the marks, along with a

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<sup>22</sup> *Sadas SA v OHIM*, T-346/04

<sup>23</sup> T-386/07

<sup>24</sup> *Specsavers International Healthcare Ltd v Asda Stores Ltd (No.2)* [2011] FSR 1, Mann, J.

minimal degree of stylisation in the earlier mark. With regard to the additional letter ‘i’ in some cases it may not be even noticed by the average consumer.

60. Taking all of these factors into account, I find the respective marks to be visually similar to a fairly high degree.

61. Aurally, the opponent submits that the marks are identical. I agree. I do not find that the average consumer would try to pronounce the second ‘i’ at the end of the applicant’s mark.

62. The opponent submits, in its skeleton argument, that neither sign has any particular meaning in relation to the goods or services. At the hearing, the applicant stated that its mark was chosen to reflect the intelligent nature of its systems. In its oral submissions in reply, the opponent stated that the same meaning could apply to its own mark.

63. In any case, the suggested meaning is not one which would be apparent to the average consumer until he or she had been educated to see it that way, and with no evidence to that effect I cannot make such a finding. The average consumer will consider both parties’ marks to be invented words and as such, they are conceptually neutral.

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

64. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.<sup>25</sup>

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<sup>25</sup> *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

65. I have only the inherent distinctiveness of the mark to consider since no evidence has been filed to show use of the mark. The opponent's earlier mark is VISI, with a small degree of stylisation. In terms of its inherent distinctiveness it makes no descriptive nor allusive reference to the goods or services and will be seen by the average consumer as an invented word. Consequently, it possesses a high degree of inherent distinctive character.

### **Likelihood of confusion**

66. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>26</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

67. I have identified the average consumer, namely a member of the general public or a professional and have concluded that the level of attention paid to the purchase will vary. That said, all of the respective goods and services will require at least an average degree of attention to be paid to the selection and purchase as the average consumer, whether an individual or a commercial undertaking, will take note of, inter alia, the type of product or service, the cost, its capabilities, etc. The purchase will be made, for the most part, visually, though I do not rule out an aural element where advice is sought or a recommendation made.

68. I have found the respective goods and services to vary from 'not similar' to 'identical' and have found the marks to be visually fairly highly similar, aurally identical and conceptually neutral.

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<sup>26</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27



69. I am mindful of the general rule that the average consumer pays more attention to the beginnings of marks. This has been established in a number of cases, including, *El Corte Inglés, SA v OHIM*.<sup>27</sup>

70. What is evident is that each case must be decided on its merits. In this case the fact that both parties' marks begin with the same four letters is one of a number of significant factors, as is the fact that the additional letter in the application is simply a repeat of the fourth letter and may go unnoticed by the average consumer.

71. The distinctive character of the earlier mark is high. I bear in mind the comments of Mr Iain Purvis Q.C. as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*,<sup>28</sup> in which he 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."

72. 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

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<sup>27</sup> Cases T-183/02 and T-184/02. See also: GC cases: *Castellani SpA v OHIM, Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*,<sup>27</sup> (similar beginnings important or decisive), *CureVac GmbH v OHIM*,<sup>27</sup> (similar beginnings not necessarily important or decisive) and *Enercon GmbH v OHIM*,<sup>27</sup> (the latter for the application of the principle to a two word mark).

<sup>28</sup> BL O-075-13

character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

73. It is clear here that the distinctive character of the earlier mark rests, for the most part,<sup>29</sup> in the four letters 'VISI'. Given that the application is for the same first four letters with the only addition being a repeat of the fourth letter 'i', to create the fifth letter of the mark, then it is clear that the high distinctive character of the earlier mark is another factor which I should bear in mind.

74. Taking all of these factors into account, even where the level of attention to be paid to the purchase is high, I find that where there is any similarity between the goods and services, the similarity of the respective marks is such (bearing in mind the concept of imperfect recollection, along with the fact that the average consumer does not normally compare marks side by side), that there is a likelihood of confusion.

## **CONCLUSION**

75. The opposition fails in respect of 'online advertisements' in class 35 and 'Search engines (providing) for the internet' in class 42, as these services are not similar to any goods and services contained in the opponent's specification.

76. I find that the opposition succeeds, prima facie, under section 5(2)(b) of the Act against the following goods and services.

### **Class 9**

Software.

### **Class 42**

Software as a service (SaaS).

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<sup>29</sup> I have taken account of the minimal stylisation of the earlier mark in making this finding.

77. The applicant has applied for the broad term 'software' in its specification which, given that it includes the type of software found in the opponent's specification, is bound to found to be identical<sup>30</sup>. However, not all software within that term will be identical or even similar to that contained within the opponent's specification. In the *Mercury Communications*<sup>31</sup> case Laddie J made the following comments with regard to these particular goods:

"In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under The 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."

78. The Registry's practice with regard to the partial refusal of trade marks includes the following paragraph taken from Tribunal Practice Notice (TPN) 1 of 2012 at paragraph 3.2.2(b) which states:

"b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective."

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<sup>30</sup> *In accordance with the decision in Meric.*

<sup>31</sup> *Mercury Communications Limited v Mercury Interactive (UK) Limited [1995] FSR 850*

79. Taking my findings above into account, along with the guidance provided by case law and practice, I find that the application for software can proceed to registration if limited to 'search engine software' in class 9, which is suitably distinct from the design and manufacturing software present in the opponent's registration, to avoid a likelihood of confusion.

80. With regard to the term 'software as a service', I do not propose to limit the specification as the term does not lend itself to suitable limitation which would avoid a likelihood of confusion. I bear in mind paragraph 3.2.2(d) of the TPN referred to above:

"d) ...Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

81. Consequently, the application may (subject to the outcome of any other proceedings) proceed to registration for:

**Class 9**

Search engine software

**Class 35**

Online advertisements

**Class 42**

Search engines (providing) for the internet

## **COSTS**

82. The opposition having largely failed, the applicant is entitled to a contribution towards its costs, reduced to take account of the fact that the opposition was partially successful in class 42. I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Commenting on the other side's evidence and filing submissions:	£200
Preparation for and attending a hearing	£300
Total:	£700

83. I order Vero UK Limited to pay Dream It Get It Limited the sum of £700. 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 2<sup>ND</sup> day of June 2017**

**Ms AI Skilton  
For the Registrar,  
The Comptroller-General**