

**O-133-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3185274  
BY INASIGHT LTD TO REGISTER:**

**Inasight**

**AS A TRADE MARK IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408731 BY SABRE GLBL INC.**

## **BACKGROUND & PLEADINGS**

1. On 12 September 2016, Inasight Ltd (“the applicant”) applied to register the trade mark **Inasight** for services in class 42 (shown in paragraph 9 below). The application was published for opposition purposes on 9 December 2016.

2. The application has been opposed in full by Sabre GLBL Inc. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon United Kingdom trade mark registration No. 3173306 for the trade mark **INSTASITE** which was applied for on 7 July 2016 and registered on 7 October 2016. The opponent indicates that it relies upon all the goods and services for which the trade mark is registered, shown in paragraph 9 below.

3. Although in its counterstatement the applicant “admits that the services in class 42 of the trade mark application are the same or similar to services specified in class 42 of the opponent’s mark” (paragraph 2), it denies there is a likelihood of confusion.

4. In these proceedings, the opponent is represented by J A Kemp and the applicant by Dummett Copp LLP. Although neither party filed evidence or submissions during the course of the evidence rounds, the opponent elected to file written submissions in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

## **DECISION**

5. The opposition is based upon section 5(2)(b) of the Act which reads 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,

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

6. 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), 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.”

7. In these proceedings, the opponent is relying upon the UK trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely it without having to demonstrate genuine use.

### **Section 5(2)(b) – case law**

8. The following principles are gleaned from the decisions of the courts of the European Union 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

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

9. The competing goods and services are as follows:

<b>Opponent's goods and services</b>	<b>Applicant's services</b>
<b>Class 9</b> - Computer software, in particular for design, development, testing, installation, maintenance, updating, hosting and customization of web sites.  <b>Class 35</b> - Advertising services; marketing services; advertising and marketing services, namely, promoting the goods and services of others in the field of hotel	<b>Class 42</b> - Information technology consultancy; Information technology support services; Information technology consulting; Information services relating to computers; Information services relating to information technology; Information services relating to the application of computer networks; Information services

<p>and hospitality services in class 35; rental of advertising space; search engine optimization of web sites for advertising and marketing purposes; business information services; business administration services; business consulting services; organization, administration, maintenance and searching of data in computer databases; information and consultancy regarding the aforementioned services.</p> <p><b>Class 42</b> - Design, development, testing, installation, maintenance, updating, hosting and customization of web sites for third parties; design, development, testing, installation, maintenance, updating, hosting and customization of databases for third parties; design, development, testing, installation, maintenance, updating, hosting and customization of computer software for third parties; providing temporary use of non-downloadable computer software for design, development, testing, installation, maintenance, updating, hosting and customization of web sites; providing temporary use of non-downloadable computer software for design, development, testing, installation, maintenance, updating, hosting and</p>	<p>relating to the application of computer systems; Information services relating to the development of computer networks; Information services relating to the development of computer systems; Software as a service; Software as a service [SaaS]; Software engineering services for data processing programs; Software authoring; Software consultancy services; Software consulting services; Software customisation services; Software design for others; Software development services; Software engineering; Software maintenance services; Software research; Software creation; Software (updating of computer-); Software (Updating of computer -); Software design (Computer - ); Software design (computer-);Software (Rental of computer -); Software (rental of computer-);Software design; Software development; Software installation; Software design and development; Consulting services relating to computer data handling; Consulting services relating to computer software; Consulting in the field of cloud computing networks and applications; Cloud computing; Data mining; Data warehousing; Data migration services; Database design and development; Data conversion of computer programs and data, not physical</p>
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<p>customization of databases for third parties; providing temporary use of non-downloadable computer software for design, development, testing, installation, maintenance, updating, hosting and customization of computer software for third parties; website design and development for others; website design consultancy; storage of data in computer databases; information and consultancy regarding the aforementioned services.</p>	<p>conversion; Data conversion of computer programs and data [not physical conversion]; Database design; Data conversion of electronic information; Data encryption and decoding services; Database development services; Data security services; Data recovery services; Data encryption services.</p>
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10. As I mentioned earlier, in its counterstatement, the applicant “admits that the services in class 42 of the trade mark application are the same or similar to services specified in class 42 of the opponent’s mark.” It does not, however, identify what services in its application it considers to be identical to those of the opponent and explain why, nor does it identify which services in its application it considers to be similar to those of the opponent and explain why. In its submissions, the opponent states:

“2.2...It is arguable that all of the opponent’s services in class 42 are entirely encompassed by the class 42 services of the application...”

11. The opponent goes on to argue that in addition, the applicant’s services in class 42 are similar to its goods and services in classes 9 and 35. As the opponent argues that its services in class 42 are to be regarded as identical to the applicant’s services in that class, it is that claim I shall consider first, only going on to consider the opponent’s other goods and services if it necessary to do so. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated:

“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”.

12. The applicant’s specification includes a range of consultancy, information and support services relating to information technology i.e. “Information technology consultancy”, “Information technology support services”, “Information technology consulting”, “Information services relating to computers”, “Information services relating to information technology”, “Information services relating to the application of computer networks”, “Information services relating to the application of computer systems”, “Information services relating to the development of computer networks”, “Information services relating to the development of computer systems”, “Consulting services relating to computer data handling”, “Consulting in the field of cloud computing networks and applications” and “Cloud computing”. However, the opponent’s specification in class 42 also includes a range of, broadly speaking, information technology related services as well as “information and consultancy regarding the aforementioned services”. As the applicant’s consultancy, information and support services are broad enough to encompass the opponent’s “information and consultancy” services relating to its information technology related services, the competing services are to be regarded as identical on the *Meric* principle.

13. The applicant’s specification includes “Database design and development”, “Database design”, “Database development services”, which would be encompassed by “design, development, testing, installation, maintenance, updating, hosting and customization of databases for third parties” in the opponent’s specification and, as a consequence, they are identical on the *Meric* principle. The opponent’s specification also includes “storage of data in computer databases”, whereas the application also includes a range of data related services i.e. “Data mining”, “Data warehousing”, “Data migration services”, “Data conversion of electronic information”, “Data encryption and



decoding services”, “Data security services”, “Data recovery services” and “Data encryption services”. As such services are, in my view, an integral part of the opponent’s database and data related services mentioned, they are, once again, to be regarded as identical on the *Meric* principle.

14. The opponent’s specification includes a range of software related services, for example, “design, development, testing, installation, maintenance, updating, hosting and customization of computer software for third parties”, “providing temporary use of non-downloadable computer software for design, development, testing, installation, maintenance, updating, hosting and customization of computer software for third parties” and “information and consultancy regarding the aforementioned services”. These are literally identical to, analogous with or broad enough to include (and as a consequence identical on the *Meric* principle) the following services in the application:

“Software as a service”, “Software as a service [SaaS]”, “Software engineering services for data processing programs”, “Software authoring”, “Software consultancy services”, “Software consulting services”, “Software customisation services”, “Software design for others”, “Software development services”, “Software engineering”, “Software maintenance services”, “Software research”, “Software creation”, “ Software (updating of computer-)", “Software (Updating of computer -)", “Software design (Computer -)", “Software design (computer-)", “Software (Rental of computer -)", “Software (rental of computer-)", “Software design”, “Software development”, “Software installation”, “Software design and development”, “Consulting services relating to computer software”, “Data conversion of computer programs and data, not physical conversion” and “Data conversion of computer programs and data [not physical conversion].”

15. In summary, I have concluded that all of the applicant’s services in class 42 are identical to the opponent’s services in the same class.

## **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 services in class 42; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

17. The average consumer of the services at issue in these proceedings is, as the opponent suggests, both members of the general public and business users. As to how such services are selected, the opponent suggests that visual considerations will be important as such services are often selected from websites; I agree. I also agree that aural considerations in, as the opponent suggests, the form of word-of-mouth recommendations should be kept in mind. As to the degree of care with which such services will be selected, the opponent suggests at least an average degree of care will be displayed during the selection process. Given the technical nature of many of the services at issue and the need for the average consumer to ensure, for example, any services selected are compatible with existing hardware and software, I would expect both sets of average consumers to pay a fairly high degree of attention to the selection of the services at issue.

## Comparison of trade marks

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade 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.”

19. It would be wrong, therefore, artificially to dissect the trade 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 they create. The trade marks to be compared are:

<b>Opponent’s trade mark</b>	<b>Applicant’s trade mark</b>
INSTASITE	Inasight

20. In reaching the conclusions which follow, I have taken into account (but do not intend to record here), all of the parties’ competing submissions on this aspect of the case.

21. Both parties’ trade marks consist of a single word presented in a conventional font i.e. in block capital letters (the opponent’s trade mark) and title case (the applicant’s

trade mark). As no part of either word is highlighted or emphasised in any way, the overall impressions they convey and their distinctiveness lie in the single words of which they are composed.

22. The competing trade marks are nine and eight letters long respectively, contain the letters “IN”/”In” at the beginning and the letters “ASI”/”asi” in the same order (but in the fifth to seventh and third to fifth letter positions respectively). The opponent’s trade mark contains the letters “ST” in the third and fourth letters positions and ends with the letters “TE”, whereas the applicant’s trade mark contains the letter “a” in the third letter position, the letters “gh” in the sixth and seventh letter positions and ends with a letter “t”. In its counterstatement, the applicant states:

“4. Visually the marks look quite different from one another, the only similarity being the first two letters IN. Overall, the marks are visually dissimilar.”

23. In its submissions, the opponent argues that the differing elements “become lost in the overall visual comparison and do not outweigh the similarities...” (paragraph 1.3) and “the marks are visually similar to a high degree” (paragraph 1.4). Contrary to the applicant’s submissions, the competing trade marks do not only coincide in respect of the first two letters. Balancing the similarities and differences I have outlined above, results in a degree of visual similarity I would characterise as higher than medium, but not high.

24. In relation to aural similarity, the applicant states:

“5. Aurally the marks are pronounced very differently from one another. Whilst both marks end in a suffix which is pronounced “SITE”, pronunciation of the prefix “INA” sounds very different from the pronunciation of the prefix “INSTA”. Overall the marks are aurally dissimilar.”

25. The opponent states:

“1.6. Both the beginning and endings of the respective mark have **identical** pronunciation: “IN” and “ASITE”/“ASIGHT”. The only differences aurally is the additional letters “ST” in the middle of the opponent’s mark which create a sound that becomes lost overall, particularly given the fact that the “s” and “t” sounds are subsequently repeated in both marks.”

26. Both trade marks consist of three syllables i.e. IN-STA-SITE and In-a-sight. The first and final syllables are identical. Although the middle syllables differ, the opponent concludes (and I agree) that the competing trade marks are aurally similar to a high degree.

27. Finally, the conceptual comparison, in relation to which the applicant states:

“6. Conceptually the marks are very dissimilar. The trade mark application INASIGHT is an invented word which has no conceptual meaning. The opposing mark INSTASITE, on the other hand, comprises the prefix “INSTA”, which is commonly used for goods or services which can be produced quickly or instantly. Together with the suffix “SITE” the opposing mark alludes to a service for quickly producing web-sites i.e. services for which the opposing mark is registered. Therefore, overall the marks are conceptually dissimilar.”

28. The opponent argues that as “both marks are invented words there can be no conceptual comparison” (paragraph 1.8). While it accepts that its trade mark is registered for, inter alia, website design services, it points out that: (i) there is no evidence to support the applicant’s interpretation of the meaning of the prefix “INSTA”, and (ii) nothing to show that it is relevant in the context of all of the services in class 42 upon which it relies in any case.

29. Both parties appear to agree that the applicant's trade mark will be treated as an invented word; I am content to proceed on that basis. Whilst it is possible that "INSTA" may be understood by some average consumers in the manner the applicant submits (and there is no evidence to support such a conclusion), it is, in my view, equally likely that a significant number of average consumers will accord the opponent's trade mark no conceptual significance at all, even in relation to website related services, let alone in relation to other services upon which the opponent relies. While those in the former group may identify a conceptual message in the opponent's trade mark which is absent from the applicant's trade mark, for those in the second group, the conceptual position will be neutral.

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

30. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

31. In its submissions, the opponent states:

“4.2...Given that the opponent's mark comprises an invented word, we submit that it must enjoy at least an average level of inherent distinctiveness for all of its goods and services.”

32. As the opponent has filed no evidence of any use it may have made of its earlier trade mark I have only its inherent characteristics to consider. Even if the average

consumer construes the opponent's trade mark in the manner the applicant suggests, it would consist of what is, at worst, a shortening or corruption of the word "INSTANT" conjoined to the word "SITE" with no part of the trade mark emphasised in any way. Considered on that basis in respect of website related services, it is, at worst, as the applicant accepts, an allusive trade mark and, in my view, possessed of a moderate (between low and medium) degree of distinctive character. Considered in relation to the other services upon which the opponent relies, it would be deserving of at least an average degree of distinctiveness as the opponent suggests. However, as I mentioned above, in my view it is equally likely that a significant number of average consumers will not even detect an allusive message, leading, in turn, to a fairly high degree of distinctive character.

### **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 trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

34. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

35. Earlier in this decision, I pointed out that in its counterstatement, the applicant admitted that the competing services in class 42 are the “same or similar”. Having conducted an analysis, I found them to be the “same” i.e. identical. Although that is a point in the opponent’s favour, I shall return to this issue below. Having assessed the competing trade marks, I found them to be visually similar to an above medium degree, aurally similar to a high degree and, for a significant number of average consumers, conceptually neutral. I proceed on the basis of an average consumer paying a fairly high degree of attention during the selection process who is, as a consequence, less prone to the effects of imperfect recollection. I am satisfied that for a significant number of average consumers the opponent’s trade mark will be distinctive to at least an average degree. That, combined with the degree of visual and aural similarity I have identified and, for what will be a significant number of average consumers, the lack of any conceptual hook to assist them in distinguishing between the competing trade marks is, in my view, likely to result in direct confusion and the opposition succeeds accordingly.

36. For the sake of completeness, I should point out that even if it is found I have been too generous to the opponent in my analysis of the competing services in class 42 i.e. by regarding them all as identical, the fact remains that the applicant has admitted that the competing services in class 42 are the “same or similar”. That clearly indicates that the applicant considers all of its services to be at least similar to those of the opponent. Notwithstanding my earlier finding, even if the competing services are considered similar to only a low degree, that would still, when combined with the other factors mentioned above, result in a likelihood of direct confusion.

### **Overall conclusion**

**37. The opposition has succeeded and, subject to any successful appeal, the application will be refused.**



## Costs

38. As the opponent has been successful, it is entitled to a contribution to its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Written submissions:	£200
Official fee:	£100
<b>Total:</b>	<b>£500</b>

39. I order Inasight Ltd to pay to Sabre GLOBL Inc. the sum of **£500**. 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 28<sup>th</sup> day of February 2018**

**C J BOWEN**  
**For the Registrar**