

O/617/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003241401 AND UK00003250915
BY ALCHEMIE IP LIMITED
TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASSES 35, 41 AND
45:

PURE IPR

AND

Pure IPR

AND

PUREIPR

AND

pureipr

AND IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 410564 AND 410661 BY
AVIDITY IP LIMITED

BACKGROUND AND PLEADINGS

1. These consolidated opposition proceedings concern two series of trade marks filed by Alchemie IP Limited (“the applicant”). Application number 3241401 was filed on 4 July 2017 and is for the series of marks **PURE IPR** and **Pure IPR**. It was published for opposition purposes on 21 July 2017 and the specification covers the following services:

Class 35 Business consultancy relating to intellectual property; business information relating to intellectual property; business enquiries relating to intellectual property; business investigations relating to intellectual property; business research relating to intellectual property; provision of business information and advisory services relating to intellectual property; record keeping services in relation to intellectual property.

Class 41 Education and training services within the field of intellectual property; arranging and conducting of seminars, workshops, conferences, symposia and exhibitions in relation to intellectual property; publication of texts in relation to intellectual property; consultancy and advisory services relating to the aforesaid; translation services in relation to intellectual property.

Class 45 Professional advisory and consultancy services relating to intellectual property; establishing, prosecuting, obtaining, protecting, maintaining and enforcing intellectual property rights; patent agency and patent attorney services; trade mark agency and trade mark attorney services; design attorney services; design and copyright advice services; legal, litigation, advocacy, arbitration, mediation, conciliation and alternative dispute resolution services provided in relation to intellectual property; research and searching services provided in relation to intellectual property; due-diligence services provided in relation to intellectual property.

2. Application number 3250915 was filed on 17 August 2017 and is for the series of marks **PUREIPR** and **pureipr**. It was published for opposition purposes on 1 September 2017 and the specification covers the following services:

Class 35 Business consultancy relating to intellectual property; business information relating to intellectual property; business enquiries relating to intellectual property; business investigations relating to intellectual property; business research relating to intellectual property; provision of business information and advisory services relating to intellectual property; record keeping services in relation to intellectual property.

Class 41 Education and training services within the field of intellectual property; arranging and conducting seminars, speeches, tutorials, workshops, conferences, symposia and exhibitions in relation to intellectual property; publication and electronic publication services in relation to intellectual property including texts, books, magazines, newsletters and educational material; photographic services in relation to intellectual property; translation services in relation to intellectual property; information, consultancy and advisory services relating to the aforesaid, including such services provided on-line from a computer network and/or via the internet.

Class 45 Intellectual property services; professional advisory, legal advisory and consultancy services relating to intellectual property, including such services provided online from a computer network and/or via the internet; establishing, filing, prosecuting, obtaining, protecting, maintaining and enforcing intellectual property rights including patents, registered designs, registered trade marks, utility models, copyrights and other forms of registered intellectual property rights; patent agency and patent attorney services; trade mark agency and trade mark attorney services; design attorney services; design and copyright advice services; representation services relating to intellectual property rights; renewal of intellectual property rights; legal, litigation, advocacy, arbitration, mediation, conciliation and alternative dispute resolution services

provided in relation to intellectual property; research, information, auditing, monitoring and searching services provided in relation to intellectual property; due-diligence services provided in relation to intellectual property.

3. The applications are opposed by Avidity IP Limited (“the opponent”). The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4. The opponent relies upon UK trade mark number 2543743 for the trade mark **PURE IDEAS** which has an application date of 1 April 2010 and a registration date of 16 July 2010.

5. The following services are relied upon in this opposition:

Class 41 Educational, instructional and training services in the field of intellectual property; organisation, conducting and presentation of speeches, classes, seminars, tutorials, workshops, symposiums, conferences and exhibitions; publishing and electronic publishing services including books, magazines, newsletters and educational materials; translation services; photography services; all relating to intellectual property; information, consultancy and advisory services relating to the aforesaid, including such services provided online from a computer network and/or via the internet.

Class 45 Intellectual property services; applying for or obtaining patents, registered designs, registered trade marks, utility models, petty patents, registered copyrights and other forms of registered intellectual property; filing and prosecution for registration of intellectual property rights; advisory and representational services relating to obtaining protection for intellectual property rights; maintenance and renewal of intellectual property rights; searching, monitoring, auditing and investigative services relating to intellectual property rights; services relating to advising on, supporting, enforcement and defending actions for infringement of intellectual property rights, passing-off, unfair

competition, false trade descriptions and anti-counterfeiting; services relating to licensing, franchising, transferring, mortgaging or dealing in intellectual property rights; professional and legal advisory services, all relating to intellectual property rights; legal services and consultancy relating to domain name disputes; information, consultancy and advisory services all relating to the aforesaid, including such services provided online from a computer network or via the Internet.

6. The opponent argues that the respective services are identical or similar and that the marks are similar.

7. The applicant filed Counterstatements in which it denies the basis of the oppositions (and requests that the opponent provides proof of use of its earlier trade mark relied upon).

8. The proceedings were consolidated. The opponent filed evidence in support of its opposition in the form of the witness statement of Kevin Parnham dated 16 March 2018. The applicant filed written submissions in the form of a letter dated 21 May 2018. No hearing was requested and so this decision is taken following a careful perusal of the papers.

THE EVIDENCE

9. As noted above, the applicant did not submit any evidence but did provide written submissions. I do not propose to reproduce those submissions here, but I will refer to them below as appropriate. The opponent's evidence consists of the witness statement of Kevin Parnham, with seven exhibits. Mr Parnham states that he is a Senior Attorney and employee of Pure Ideas. Mr Parnham states that Pure Ideas is a firm of Patent and Trade Mark Attorneys.

10. Exhibit 1 to Mr Parnham's Statement is a print out of a domain name search dated 22 September 2017. It confirms that the domain name pure-ideas.co.uk has been registered in the name of Avidity IP Limited and that registration does not expire until 17 February 2023.

11. Exhibit 2 to Mr Parnham's Statement is a collection of print outs of archived web pages which he states demonstrate use of the mark. The first two of these are dated 3 June 2010 and 15 April 2012 and appear to show the website under construction. These are both dated before the relevant period. The third is dated 18 May 2013 and shows the mark Pure Ideas used in the following variation:



12. The website offers a wide range of intellectual property services. It states that part of the service offered is that time will be spent "understanding your business so we can tailor our advice to meet your needs and objectives". The extract provides a '.co.uk' email address as the point of contact for any enquiries.

13. The fourth print out is dated 9 January 2016 and is in extremely small font and therefore difficult to read. Pure Ideas is used in the text on this page and, although it is cut off at the top of the page, it appears that a similar stylised variation of the mark as shown above was also displayed here. The mark as a whole is not visible, but it appears to be the same font as shown above, although this time in a white outlined box and combined with other words (although they are illegible):



14. The services advertised include "Innovation workshops", "Technology Roadmapping", "Outsourced Due Diligence", "Brand Design", "Digital & Physical Prototyping" and "Technical Project Management".

15. Exhibit 3 to Mr Parnham's Statement is a print out of an archived web page which Mr Parnham states was "the landing page following a re-direct from the domain 'pureideas.co.uk'". This is dated 24 December 2014 and, again, shows a variation of the earlier mark (although slightly different to the one shown above):



16. Pure Ideas is used on its own in the text of the page. The page offers services "beyond the traditional suite of Legal IP services". Pure Ideas claim to offer "technical, legal, marketing and commercial skillsets." The domain name (which as noted above is the site to which traffic would have been re-directed) is www.avidity-ip.com/pure-ideas. The second page of this print out provides the office address for Avidity IP Limited, which is located in Cambridge, United Kingdom.

17. Mr Parnham has provided, as Exhibit 4, ten invoices dated between 6 September 2016 and 21 June 2017 all displaying the mark Pure Ideas in varying forms. Six of the invoices are addressed to customers in the United States and four of them are addressed to customers in the United Kingdom. The invoices display the earlier mark in the following variations:

PURE IDEAS

PURE IDEAS
AVIDITY IP RENEWALS

PURE IDEAS

PURE IDEAS
EUROPEAN PATENT RECORDALS

PURE IDEAS
AVIDITY IP VALIDATIONS

18. Details of the invoices are as follows:

Date	Summary of services provided	Amount payable
21/06/2017	Preparing and filing papers at the French Patent Office, the German Patent Office, the Swedish Patent Office and the UK Patent Office.	USD 5,210.00
31/05/2017	Dealing with renewal of four European Patent Applications and dealing with registration fees for a trade mark in Turkey.	GBP 5,350.00
30/04/2017	Dealing with an opposition.	USD 1,740.00
21/03/2017	Dealing with a European Patent Grant Certificate.	GBP 125.00
20/02/2017	Dealing with renewal of a UK Trade Mark.	GBP 540.00
25/01/2017	Dealing with a request to record a Patent in Hong Kong.	GBP 1,545.00
31/12/2016	Dealing with US Trade Mark Registry objections.	GBP 811.20
08/11/2016	Dealing with trade mark applications in India.	GBP 774.00
05/10/2016	Dealing with renewal of an Australian Patent.	GBP 672.00
06/09/2016	Dealing with a European Patent Grant Certificate.	GBP 125.00

19. Five out of the six invoices addressed to customers in the United States are marked with the words “No services provided in the US”. A ‘co.uk’ email address is provided on all of the invoices as a point of contact.

20. Exhibit 5 to Mr Parnham’s Statement is a collection of three emails which he states were sent to clients of Avidity IP notifying them of the new offering provided by Pure Ideas. These are dated 4 June 2015, 24 August 2015 and 5 November 2015. The mark appears in the body of the emails as registered. The emails each refer the recipients to the website www.pure-ideas.co.uk. The identities of the recipients have been redacted. The first email does not identify exactly what the query related to. The second email related to a German Patent and the third related to a UK Patent Application.

21. Exhibit 6 is a flyer which Mr Parnham states was used to promote the services offered by Pure Ideas during October 2014. The flyer is undated and displays the earlier mark in the following variation:



22. This document also displays the mark 'avidity IP' in varying forms and is mainly used to convey information about that business. However, parts of the flyer are used to provide information about the services offered by Pure Ideas.

23. Finally, Exhibit 7 is a flyer that Mr Parnham states was used to promote the services of Pure Ideas during February 2015. The flyer is undated and utilises the earlier mark in the following variations:



24. Mr Parnham does not confirm who either of these flyers were distributed to, how many of them were distributed or where they were distributed.

PROOF OF USE

25. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

26. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

27. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] to [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not always the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

28. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the mark

29. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“the CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

30. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

31. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

32. As noted above, the mark appears in varying forms in the opponent’s evidence, specifically:



e) **PURE IDEAS**
AVIDITY IP RENEWALS

f) **PURE IDEAS**
AVIDITY IP RENEWALS

g) **PURE IDEAS**
EUROPEAN PATENT RECORDALS

h) **PURE IDEAS**
AVIDITY IP VALIDATIONS

i) pureideas^{IP}
Supporting Chartered Accountants

j) pureideas^{IP}
transforming innovation

k) pureideas^{IP}
an avidity ip initiative

33. In some circumstances the mark is used in the same format as it is registered, such as in the body of the text of the emails provided as part of the opponent's evidence. Clearly, this will be use upon which the opponent may rely. In variant a) the mark is used in a lower-case font which appears to utilise shading (although it is not clear from the evidence whether this is black and white shading or shading in a particular colour). It is used in combination with the words "Intellectual Property Specialists". It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. That applies here. The words "Intellectual Property Specialists" are likely to be seen as descriptive of the

services provided or the quality of those services and would be given no trade mark significance. I consider that the use of the mark in variant a) is use upon which the opponent may rely.

34. Variant b) is only partially visible in the evidence and so it is difficult for me to comment on whether it is an acceptable use of the mark. From what is visible, it appears that the mark has been used in the same font as in variant a) but is enclosed in a white square outline in combination with additional words (which are illegible). For the avoidance of doubt, in my view, the use of the mark in this form would be use upon which the opponent may rely as it does not alter the distinctive character of the mark (as explained in *Nirvana*).

35. In variant c) the mark is used in the same font as variant a) but with the addition of the letters "IP" in smaller font to the top right of the mark. Again, it appears that some use of shading has been applied. As noted above, use in conjunction with other matter falls within the ambit of genuine use. The letters "IP" will either not be recognised as having any meaning at all or will be recognised as representing the words "Intellectual Property", in which case they will be seen as descriptive of the services. Irrespective of whether the significance of "IP" is recognised, the mark itself appears as registered (subject to a change of font). I consider that the use shown in variant c) is use of the mark as registered upon which the opponent can rely.

36. In variant d) the mark is used in an upper-case font. Again, there appears to be some shading (although it is not clear from the evidence whether this is black and white shading or shading in a particular colour). I am satisfied that the use of the mark in variant d) is acceptable in terms of fair and notional use of the mark.

37. In variants e), f), g) and h) the same upper-case font is used as that used in variant d), but it is used in combination with additional words (specifically "Avidity IP Renewals", "European Trade Mark and Design Attorneys" (although the words are far from clear), "European Patent Recordals" and "Avidity IP Validation"). The additional words are displayed within two thin lines below the words "Pure Ideas". As in the case of variant a), I am satisfied that use of the mark in variants e), f), g) and h) is within the ambit of genuine use as set out in *Colloseum*.

38. In variants i), j) and k) the mark is used in the same lower-case font as in previous variations, but in combination with both the letters “IP” at the top right of the mark and other phrases appearing in smaller text below it, underlined by a thick black line. I have already found that use of the mark in combination with the letters “IP” and in the font shown is acceptable use of the mark upon which the opponent can rely. The additional words are all descriptive of the quality or characteristics of the services provided and so would not be considered to have any trade mark significance. I am, therefore, satisfied that use in this form is within the ambit of genuine use as set out in *Colloseum*.

Sufficient Use

39. I have no submissions from the applicant on the evidence provided by the opponent to prove use of the earlier mark.

40. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself¹.

41. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

42. The first three exhibits show the domain name initially used for the opponent’s website and the use of the mark (in varying acceptable forms) on the opponent’s website. Registration of a domain name alone is not sufficient to demonstrate genuine use of the mark. The webpages provided list the services purportedly offered. The emails at Exhibit 5 confirm that the website address was provided to potential

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

customers in 2015 (after the re-direct), although there is no evidence to confirm the volume of traffic that was re-directed via the pure-ideas.co.uk site.

43. Exhibit 4, as noted above, consists of 10 invoices addressed to various recipients, four of which are located in the United Kingdom and six of which are located in the United States. The invoices all display the mark (in acceptable variations) and were all issued within the relevant period. Sales have clearly been secured over a period of 10 months and the total income evidenced is USD 6,950.00 and GBP 9,942.20.

44. Exhibit 5 consists of three emails dated 4 June 2015, 24 August 2015 and 5 November 2015. The emails all offer the services available under the opponent's mark to potential customers.

45. Exhibits 6 and 7 are marketing flyers which introduce the services offered under the mark Pure Ideas. The flyers both include part of a picture of the United Kingdom which identifies the location of Avidity IP Limited's offices. This does not, of course, assist in confirming the area in which Pure Ideas has been marketed and no evidence has been provided as to the area in which these flyers were distributed, the method of distribution or the scale. However, Mr Parnham confirms in his statement that these flyers were "used to promote the 'Pure Ideas' services" in 2014 and 2015 respectively. His statement that they were used has not been challenged. This does demonstrate some use of the mark in marketing materials.

46. Print outs from the opponent's website and registration of a domain name, in isolation, would be insufficient to make a finding of actual use. However, the opponent has provided evidence of the mark being used in email correspondence to potential customers offering the services for sale, in marketing materials in the form of flyers used during two consecutive years and, importantly, invoices demonstrating actual sales. The evidence, in combination, creates a picture which is sufficient to establish genuine use of the mark by the opponent during the relevant period.

Fair Specification

47. I must now consider whether, or the extent to which, the evidence shows use for all of the services relied upon.

48. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

49. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

50. It is plain that the evidence does not support the claim for use in relation to all of the services claimed in the notice of opposition.

51. The evidence shows that the mark has been used in relation to a range of different services in class 45, specifically "applying for or obtaining patents, registered designs, registered trade marks, utility models, petty patents, registered copyrights and other forms of registered intellectual property", "filing and prosecution for registration of intellectual property rights", "advisory and representational services relating to obtaining protection for intellectual property rights", "maintenance and renewal of intellectual property rights", "maintenance and renewal of intellectual property rights", "searching, monitoring, auditing and investigative services relating to intellectual property rights" and "professional and legal advisory services, all relating to intellectual property rights".

52. "Intellectual property services" is a very wide term which covers a broad range of activities. The evidence shows use of the mark in relation to a wide variety of intellectual property services (as listed above), and I am therefore satisfied that the opponent can rely on "Intellectual property services". The evidence shows that the opponent offers a holistic approach to intellectual property services under the earlier mark. I am therefore satisfied that it can rely on "information, consultancy and advisory services all relating to the aforesaid, including such services provided online from a computer network or via the internet".

53. Although the opponent has provided only one invoice to demonstrate use in relation to "services relating to advising on, supporting, enforcement and defending actions for infringement of intellectual property rights, passing-off, unfair competition, false trade descriptions and anti-counterfeiting" and no evidence in relation to "services relating to licensing, franchising, transferring, mortgaging or dealing in intellectual property rights" and "legal services and consultancy relating to domain name disputes", I consider that to not allow the opponent to rely on these services would be to construe their specification too narrowly. Ultimately, all of these services fall within the broader category of "Intellectual property services" and I am satisfied that they have shown sufficient use to be able to rely on that.

54. The only evidence that the opponent has provided which relates to "Educational, instructional and training services in the field of intellectual property" and "organisation, conducting and presentation of speeches, classes, seminars, tutorials, workshops, symposiums, conferences and exhibitions" is the extract from its website dated 9 January 2016 which lists "Innovation workshops" as one of its services. However, the opponent has provided no evidence of actually carrying out or receiving payment for any such workshops. The listing of this service on its website alone is not sufficient to demonstrate use. The provision of educational services does not fall within the normal scope of providing intellectual property right services. The holistic approach taken by the opponent to the services it provides is focused on tailoring its advice to the business needs of its customers. This would not extend to educational services.

55. There is no evidence that the opponent has used the mark in relation to any of the other services in class 41.

56. Accordingly, I consider that a fair specification for the earlier mark is:

Class 45 Intellectual property services; applying for or obtaining patents, registered designs, registered trade marks, utility models, petty patents, registered copyrights and other forms of registered intellectual property; filing and prosecution for registration of intellectual property rights; advisory and representational services relating to obtaining protection for intellectual property rights; maintenance and renewal of intellectual property rights; searching, monitoring, auditing and investigative services relating to intellectual property rights; services relating to advising on, supporting, enforcement and defending actions for infringement of intellectual property rights, passing-off, unfair competition, false trade descriptions and anti-counterfeiting; services relating to licensing, franchising, transferring, mortgaging or dealing in intellectual property rights; professional and legal advisory services, all relating to intellectual property rights; legal services and consultancy relating to domain name disputes; information, consultancy and advisory services all relating to the aforesaid, including such services provided online from a computer network or via the Internet.

DECISION

57. Section 5(2)(b) of the Act reads as follows:

“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

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

58. 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.”

59. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

Section 5(2)(b)

60. 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 to mind the earlier mark, 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 the trade marks

61. 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in their 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.”

62. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

63. The respective trade marks are shown below:

Applicant's trade marks	Opponent's trade mark
PURE IPR Pure IPR ("the First Series") PUREIPR pureipr ("the Second Series")	PURE IDEAS

64. I have no submissions from the opponent on the similarity of the marks. In their written submissions, the applicant argues as follows:

"... there is a low degree of visual, aural and conceptual similarity between each mark of the marks, PURE IPR and PUREIPR and the mark PURE IDEAS when the marks are considered as a whole, as is required... the average consumer would recognise that the trade mark PURE IDEAS represents a grammatically correct blend of two known words providing a descriptive phrase, whereas it would perceive each of the trade marks PURE IPR and PUREIPR as being an abstract combination having no specific meaning. Accordingly, any perceived similarities between the marks are still further significantly diminished..."

Overall Impression

The First Series

65. The applicant's marks consist of the ordinary dictionary word "PURE" combined with the letters "IPR". In the case of the first mark in the series, these all appear in capital letters. In the case of the second mark in the series, the first letter of the word "Pure" and the last three letters – "IPR" – are capitalised, with the other letters being in lower case. As notional and fair use means that the applicant's mark could be used in any standard typeface, the differences created by the capitalisation are not relevant. Given the applicant's specification, some consumers will understand the letters "IPR" to be an abbreviation including the words "intellectual property" (such as intellectual property rights or intellectual property representatives). Other consumers, will recognise that the letters are an abbreviation for something but will not know what they stand for. For both groups of consumer, I consider the word "Pure" to be the element that has the greatest impact in the overall impression of the mark. A lesser role is played by the letters "IPR" which, coming at the end of the mark, will have a lesser impact, particularly for those consumers for whom the abbreviation has a meaning in relation to the services.

The Second Series

66. The applicant's marks consist of the seven letters – "PUREIPR/pureipr". In the case of the first mark in the series, these all appear in capital letters. In the case of the second mark in the series, these all appear in lower case letters. As notional and fair use means that the applicant's mark can be used in any standard typeface, the differences created by the capitalisation are not relevant. Some consumers may split these letters into the word "PURE" and the letters "IPR". Others will see the letters as a whole, either as an abbreviation or as a made up word with no particular meaning. There are no other elements to contribute to the overall impression, which is contained in the combination of the letters itself.

The Opponent's Mark

67. The opponent's mark consists of the two ordinary dictionary words "PURE" and "IDEAS" in capital letters. I consider that the overall impression is of the unit "PURE IDEAS" (as opposed to two separate and unrelated words), with neither word dominating.

Visual Comparisons

The First Series and the Opponent's Mark

68. Visually, the marks share the same first word "Pure" and the second element of both marks starts with the letter "I". As noted above, any difference created by the capitalised font used in the marks will not be relevant. The difference between the marks lies in the difference between the word "Ideas" appearing in the opponent's mark and the abbreviation "IPR" appearing in the applicant's marks. I consider there to be a medium degree of visual similarity.

The Second Series and the Opponent's Mark

69. Visually, both marks start with the first five letters "PUREI". As noted above, any differences created by the capitalised font used in the marks will not be relevant. The difference created by the marks lies in the separation of the opponent's mark into two separate recognisable dictionary words "PURE" and "IDEAS" and the applicant's marks being made up of seven letters which appear to be an abbreviation or made up word, albeit including the word "PURE" at the start. I consider there to be a low to medium degree of visual similarity between the marks.

Aural Comparisons

The First Series and the Opponent's Mark

70. Aurally, the word "pure" will be pronounced identically in each mark. There will, however, be a difference in the pronunciation of the word "Ideas" which is one word,

and the abbreviation “IPR”, which will be pronounced as three separate letters (I-P-R). I am, therefore, of the view that there is a medium degree of aural similarity.

The Second Series and the Opponent’s Mark

71. Aurally, the similarity of the marks will depend on whether the applicant’s marks are considered to be a made-up word or an abbreviation. If they are recognised as a made-up word then the first four letters will be pronounced identically. If the applicant’s marks are recognised as an abbreviation then they will be pronounced as separate letters (P-U-R-E-I-P-R). The opponent’s mark will be pronounced as the two ordinary dictionary words “PURE” and “IDEAS”. I am of the view that there is a low to medium degree of aural similarity between the marks.

Conceptual Comparisons

The First Series and the Opponent’s Mark

72. Conceptually, the word “pure” is a common dictionary word which will be recognised by the average consumer as meaning untainted or not mixed with anything else. The words “pure ideas” in combination, will either give the impression of the services focusing on ideas only and not being mixed with anything else or of ideas that are untainted. As intellectual property rights are closely allied with the concept of new ideas, this may be allusive of the services offered by the opponent. If the abbreviation “IPR” is recognised as relating to intellectual property then the use of the word “pure” will suggest that the services offered are limited to those relating to intellectual property. If the meaning of the letters is not recognised then there will be no particular relevance attributed to them by the average consumer. I, therefore, consider there to be a medium degree of conceptual similarity between the marks.

The Second Series and the Opponent’s Mark

73. As noted above, the conceptual impression created by the opponent’s mark will be either of services relating to ideas only and not mixed with anything else or of ideas that are untainted. There may, as explained above, be an allusive element to the

opponent's mark. If the applicant's marks are recognised as an abbreviation then it is likely to convey no conceptual meaning at all to the consumer as they will not know what the letters stand for. If the applicant's mark is recognised as the word "PURE" in combination with the letters "IPR" to form a made-up word then consumer is likely to view the inclusion of the word 'pure' in the mark as relating in some way to the type or characteristic of the services provided. I, therefore, consider there to be a low to medium degree of conceptual similarity between the marks.

The Opponent's best case

74. Having reached the above conclusions, it is the First Series which, in my view, offers the opponent's strongest case insofar as the competing trade marks are concerned. As a consequence, I shall now compare the opponent's services with the services for which the First Series has been applied for and I will go on to consider whether there is a likelihood of confusion in respect of these marks. If there is no likelihood of confusion between the opponent's mark and the First Series then, as this is the opponent's best case, it follows that there will be no likelihood of confusion between the opponent's mark and the Second Series.

Comparison of services

75. As a result of my finding at paragraph 56 above, the competing services are as follows:

Opponent's services	Applicant's services
<u>Class 41</u> Intellectual property services; applying for or obtaining patents, registered designs, registered trade marks, utility models, petty patents, registered copyrights and other forms of registered intellectual property; filing and prosecution for registration of intellectual	<u>Class 35</u> Business consultancy relating to intellectual property; business information relating to intellectual property; business enquiries relating to intellectual property; business investigations relating to intellectual property; business research relating to

property rights; advisory and representational services relating to obtaining protection for intellectual property rights; maintenance and renewal of intellectual property rights; searching, monitoring, auditing and investigative services relating to intellectual property rights; services relating to advising on, supporting, enforcement and defending actions for infringement of intellectual property rights, passing-off, unfair competition, false trade descriptions and anti-counterfeiting; services relating to licensing, franchising, transferring, mortgaging or dealing in intellectual property rights; professional and legal advisory services, all relating to intellectual property rights; legal services and consultancy relating to domain name disputes; information, consultancy and advisory services all relating to the aforesaid, including such services provided online from a computer network or via the Internet.

intellectual property; provision of business information and advisory services relating to intellectual property; record keeping services in relation to intellectual property.

Class 41

Education and training services within the field of intellectual property; arranging and conducting of seminars, workshops, conferences, symposia and exhibitions in relation to intellectual property; publication of texts in relation to intellectual property; consultancy and advisory services relating to the aforesaid; translation services in relation to intellectual property.

Class 45

Professional advisory and consultancy services relating to intellectual property; establishing, prosecuting, obtaining, protecting, maintaining and enforcing intellectual property rights; patent agency and patent attorney services; trade mark agency and trade mark attorney services; design attorney services; design and copyright advice services; legal, litigation, advocacy, arbitration, mediation, conciliation and alternative dispute resolution services provided in relation to intellectual property; research and searching

	services provided in relation to intellectual property; due-diligence services provided in relation to intellectual property.
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76. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, C-39/97, the court stated at paragraph 23 of its judgment that:

“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.”

77. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance,

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

78. 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.”

79. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

80. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated 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.”

81. For the purposes of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons (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]).

82. All of the class 35 services and the class 45 services in the applicant's specification are types of intellectual property service. They, therefore, plainly share a degree of similarity with "Intellectual property services" in the opponent's specification. They will have the same uses (the provision of support to those seeking to protect or maintain intellectual property rights), the same users (people concerned with protecting or maintaining their intellectual property rights) and the same trade channels (as customers would anticipate such services being offered by the same service provider). I, therefore, consider these services to be highly similar.

83. "Education and training services within the field of intellectual property" and "arranging and conducting of seminars, workshops, conferences, symposia and exhibitions in relation to intellectual property" in class 41 of the applicant's specification and "Intellectual property services" in class 41 of the opponent's specification may appear on a superficial level to share some similarity as they are both concerned with the field of intellectual property. However, the applicant's services are focused on education in the field of intellectual property whereas the opponent's "intellectual property services" is, in my mind, services directly related to intellectual property rights (such as registration, advice and maintenance of intellectual property rights). Their uses will, therefore, be different. The users of the applicant's services are likely to be those wishing to learn about intellectual property rights whereas the users of the opponent's services will be those seeking professional advisors to deal with intellectual property matters on their behalf. The applicant's services will be provided by specialist educational providers whereas the opponent's services will be provided by those specialising in intellectual property advice (such as attorneys). I therefore consider there to be no similarity between these services. If they are similar, then they will only be similar to a low degree.

84. In respect of “Publication of texts in relation to intellectual property” and “translation services in relation to intellectual property” in class 41 in the applicant’s specification, I have considered the nature, intended purpose, users, trade channels of the services and whether there is a competitive or complimentary relationship between them and the services listed in the opponent’s specification. Without the benefit of any submissions to assist me, I am not satisfied that there is any similarity between the services.

85. “Consultancy and advisory services relating to the aforesaid” in the applicant’s specification relates to the educational and publication services referred to above. As I do not consider there to be any similarity between “Education and training services within the field of intellectual property”, “arranging and conducting of seminars, workshops, conferences, symposia and exhibitions in relation to intellectual property” and “Publication of texts in relation to intellectual property” in the applicant’s specification and “intellectual property services” in the opponent’s specification (or any of the opponent’s other services) I do not consider that there will be any similarity between “Consultancy and advisory services relating to the aforesaid” and “intellectual property services” either. However, if I am wrong then they will only be similar to a low degree.

The average consumer and the nature of the purchasing act

86. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which these services are likely to be selected by the average consumer. 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.”

87. I have no submissions from the opponent on the average consumer or the purchasing process for the services at issue. In its written submissions, the applicant argues as follows:

“The average consumer of such services (i.e. an established business or an individual with a business plan) would, in all likelihood, perform strict due diligence of and evaluate potential service providers before selecting and engaging a particular provider; the average consumer would make direct comparisons between potential service providers; and, the average consumer would probably hold discussion(s)/meeting(s) with potential service providers before engaging a provider. The average consumer, in respect of intellectual property services, would therefore be considered as extremely well informed, observant and cautious/circumspect; the average consumer would therefore readily distinguish the services offered by one undertaking from those of another undertaking.”

88. The services are all specialist intellectual property services. The average consumer in these proceedings will be a member of the general public who has some business acumen (such as an entrepreneur seeking to secure intellectual property rights in anticipation of its new business) or an established business seeking to protect new or existing intellectual property rights. The cost of the services in issue will vary depending on the extent and the nature of the services sought although they are likely to be fairly high. A member of the public dealing with intellectual property rights for the first time (or at least dealing with them fairly infrequently) is likely to pay a high degree of attention when selecting the services given the costs likely to be incurred. A business user looking to protect its existing rights or create new ones (such as for a new product launch) will also pay a high degree of attention because of the commercial importance to its business. The average consumer will, therefore, pay a high degree of attention when selecting the services.

89. The services are likely to be purchased from specialist retail outlets or their online equivalents. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, on websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Distinctive character of the earlier trade mark

90. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

91. Registered trade marks possess varying degrees of inherent distinctive character ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

92. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. I have no submissions from either the applicant or the opponent on the distinctive character of the earlier mark.

93. I have found that the opponent's mark consists of two ordinary dictionary words. It will be construed as meaning a specialism or expertise in ideas or as ideas that are untainted. As noted above, intellectual property rights are closely allied with the concept of new ideas. The mark is, therefore, allusive to the services for which it is registered. I, therefore, consider that the earlier mark will be of fairly low distinctive character.

Likelihood of confusion

94. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

95. I have found the parties' marks to be visually, aurally and conceptually similar to a medium degree. I have found the earlier mark to be of fairly low inherent distinctive character. I have identified the average consumer as either a member of the public with some business acumen or a business user who will select the services primarily by visual means (although there will also be an aural component to the purchasing process). I have concluded that the degree of attention paid will be high. I have found the parties' services to be highly similar or similar to only a low degree. I will consider the likelihood of confusion in respect of those services that are highly similar as these represent the opponent's best case. If there is no likelihood of confusion in respect of those services that are highly similar, it follows that there will be no likelihood of confusion in respect of those services that are similar to only a low degree.

96. I consider that the visual, aural and conceptual differences between the marks are sufficient to ensure that the marks will not be misremembered or mistakenly recalled as each other notwithstanding the principle of imperfect recollection. This is particularly the case given the high level of attention that will be paid by the average consumer during the purchasing process. I am satisfied that the consumer will not simply mistake one mark for another and that there is no risk of direct confusion.

97. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

98. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

99. As noted above, the marks are visually, aurally and conceptually similar to a medium degree. The opponent’s mark is, for the reasons outlined above, of fairly low distinctive character. I have concluded that the average consumer will pay a high degree of attention when selecting the services. The nature of the services for which the marks are registered or applied for means that the average consumer will have some awareness of the concept of intellectual property. I therefore consider that they will recognise the letters “IPR” as an abbreviation relating to intellectual property and they will therefore consider the use of the word ‘pure’ in the mark to express a specialism or exclusivity in that particular area. In my view, the average consumer will not, therefore, assume that the services are provided by the same or economically linked undertakings just because both marks contain the word ‘pure’. It is more likely that they will assume that the word ‘pure’ has been used in both marks to identify the specialism of each respective undertaking. Even if the average consumer does not recognise the meaning of the letters ‘IPR’, the conceptual difference that that lack of recognition will create between the marks will be sufficient to avoid a likelihood of indirect confusion. At best, the later mark will merely call to mind the earlier mark.

100. As I have found that there is no likelihood of confusion in respect of the opponent’s mark and the First Series, I do not consider that there will be any confusion in respect of the opponent’s mark and the Second Series as they share a lower degree of aural, visual and conceptual similarity and are therefore less likely to give rise to direct confusion or an expectation on the part of the average consumer that the services are provided by the same or economically linked undertakings.

CONCLUSION

101. The oppositions have failed and the applications will proceed to registration for all the services for which registration has been sought.

COSTS

102. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, and taking into account economies achieved through consolidation of the proceedings, I award the applicant the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing counterstatements and considering the other side's statements	£200
Considering the other side's evidence and preparing submissions in lieu of a hearing	£500
TOTAL	£700

103. I therefore order Avidity IP Limited to pay Alchemie IP Limited the sum of £700. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 1st of October 2018

S WILSON

For the Registrar