

BL O-228-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK00003171365
BY MTK IP LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 AND 42

CONNECT AUTO

AND

OPPOSITION THERETO (NO. 407698)
BY CONNECT PRODUCTIONS (EUROPE) LIMITED

Background and pleadings

1. On 24 June 2016 MTK IP Ltd (“the applicant”) filed UK trade mark application to register the word mark CONNECT AUTO for the following goods and services in classes 9 and 42.¹

Class 9

Computer programmes; computer programs; computer software; computer software [programmes]; computer software programs; computer hardware; electronic databases; software; software for computers; communications equipment; data capture apparatus; data collection apparatus; data processing equipment and accessories (electrical and mechanical); data storage apparatus; computerized vehicle engine analyzers; engine analyzers; engine diagnostic apparatus; measuring, counting, alignment and calibrating instruments; monitoring instruments; sensors and detectors; traffic sign recognition apparatus and instruments; traffic sign recognition systems; control apparatus and instruments; simulation apparatus; simulators.

Class 42

Computer analysis; computer design and programming services; computer hardware development; data migration services; data mining; computer systems development; computer research services; computer network services; design and development of electronic database software; development of computer systems; development of computer hardware; development of computer based networks; design and development of wireless data transmission apparatus, instruments and equipment; design and development of wireless data transmission apparatus; development of systems for the transmission of data; development of systems for the processing of data; development of systems for the storage of data; research in the field of data processing technology; research relating to data processing; software development, programming and implementation; advisory services relating to scientific research; provision of research services; research and development services; research services; technical data analysis services; advice

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

relating to the design of computer hardware; advisory services relating to computer systems design; advisory services relating to computer hardware design; computer hardware design services; computer systems design; creating and designing web pages for others; custom design services; database design; database design and development; database development services; design and development of networks; design (Computer system -); design of computer databases; designing of data processing systems.

2. The application was published on 15 July 2016, following which Connect Productions (Europe) Limited (“the opponent”) filed a notice of opposition against all of the goods and services in the application. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following mark:²

Mark	Services
<p>EUTM: 15698566</p> <p>CONNECT.COM</p> <p>Filed: 27 July 2016 Registered: 1 June 2018 Priority date: 11 April 2016 (Pakistan, from 416297, 416299, 416298 and 416300)</p>	<p>Class 25 Clothing; fashion garments; footwear and headgear; swimwear; sportswear and leisurewear.</p> <p>Class 38 Television, cable television and radio broadcasting services.</p>

3. Neither party filed evidence. The applicant filed written submissions on 10 January 2019. Neither party requested a hearing. This decision is made following a careful consideration of the papers.

² The opposition initially relied upon a wider range of goods and services. Its mark had been applied for but not yet registered. Following opposition at the EUIPO (under opposition number B2 806 761) the opponent’s goods and services were restricted to those I have provided in the table above.

4. The applicant is represented by Mathys & Squire LLP. The opponent represented itself.

The earlier mark

5. 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.

(b) a European Union trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

(ba) a registered trade mark or international trade mark (UK) which—

(i) has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark.

(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.”

6. The opponent’s mark constitutes an earlier trade mark within the meaning of the Act. The opponent is not subject to the requirement to provide proof of use of its earlier mark as it had not been registered for five years at the date on which the contested application was published.

Decision

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

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

8. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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;

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

(i) 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;

(f) 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 goods and services to be compared are:

Opponent's Goods and Services	Applicant's Goods and Services
	Class 9 Computer programmes; computer programs; computer software; computer software [programmes]; computer software programs; computer hardware; electronic databases; software; software for computers; communications equipment; data capture apparatus; data collection apparatus; data processing equipment and accessories (electrical and mechanical); data storage apparatus; computerized vehicle engine analyzers; engine analyzers; engine diagnostic apparatus; measuring, counting, alignment and calibrating instruments; monitoring instruments; sensors and detectors; traffic sign recognition apparatus and instruments; traffic sign recognition

	systems; control apparatus and instruments; simulation apparatus; simulators.
Class 25 Clothing; fashion garments; footwear and headgear; swimwear; sportswear and leisurewear.	
Class 38 Television, cable television and radio broadcasting services.	
	Class 42 Computer analysis; computer design and programming services; computer hardware development; data migration services; data mining; computer systems development; computer research services; computer network services; design and development of electronic database software; development of computer systems; development of computer hardware; development of computer based networks; design and development of wireless data transmission apparatus, instruments and equipment; design and development of wireless data transmission apparatus; development of systems for the transmission of data; development of systems for the processing of data; development of systems for the storage of data; research in the field of data processing technology; research relating to data processing; software development, programming and implementation; advisory services relating to scientific research; provision of research services; research and development services; research services; technical data analysis services; advice relating to the design of computer hardware; advisory services relating to computer systems design; advisory services relating to computer hardware design; computer hardware design services; computer systems design; creating and designing web pages for others; custom design services; database design; database design and development; database development

	services; design and development of networks; design (Computer system -); design of computer databases; designing of data processing systems.
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Comparison of goods and services – the legal principles

10. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11. In *British Sugar Plc v James Robertson & Sons Limited (Treat)*,³ Jacob J (as he then was) identified the following factors as relevant in the assessment of similarity:

- “(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.

³ [1996] RPC 281

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.”

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

“... 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”.

13. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. also 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.”

14. When making a comparison of competing goods or services in the respective specifications it is permissible to group together terms where they are sufficiently comparable that they can be assessed in the same way.⁴

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

16. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*:⁵

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

⁴ *Separode Trade Mark* BL O-399-10

⁵ BL O-255-13

Whilst on the other hand:

“...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

The opponent’s submissions regarding goods and services

17. The opponent’s position regarding the comparison of the parties’ goods and services is set out in paragraphs 9 to 15 of its Notice of Opposition and Statement of Grounds. The opponent’s pleadings pre-date the decision at the EUIPO which limited its specification to classes 25 and 38. I note that the opponent has not filed updated submissions and that its initial pleadings largely address the goods in 9 and 16 which are no longer part of these proceedings. Furthermore, paragraph 10 of the same document addresses education services, construction services, hospitality services, financial services and beauty services and the concept of ‘relevant permits’ and services in class 41 which are not and have never been part of either party’s specification.

18. What I will take from the opponent’s submissions on this point is that, in summary, it relies upon similarities in customers (being the general public), distribution channels and complementarity, including functional complementarity.

The opponent’s specification

19. The opponent has not provided reasons why any of its goods in class 25 should be considered similar to the applied for goods and services in classes 9 and 42. At best, it is argued within paragraph 14 of the Notice of Opposition and Statement of Grounds that there is an overlap in trade channels and (at paragraph 15) that there is an overlap in users (the general public)⁶. The claimed similarity is based on a very

⁶ Albeit paragraph 15 only claims similarity between *services* based on them having a mutual customer base, it does not actually mention goods.

broad brush analysis. I cannot see how the average consumer would perceive any similarity between articles of clothing, headwear and footwear and any of the applicant's goods or services in classes 9 and 42. Any overlap in users is at a very high level based on the fact that they may be members of the general public. Having considered the nature of the goods and services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods and services coincide. The opponent's goods in class 25 are dissimilar to all goods and services in the applied for specification.

20. The remaining assessment of goods and services will be based on the opponent's specification in class 38 which stands registered for 'Television, cable television and radio broadcasting services'.

The applicant's goods in class 9

21. "*Computer programmes; computer programs; computer software; computer software [programmes]; computer software programs; software; software for computers*" in the applied for class 9 specification are similar terms apt to be grouped together. Computer software is a broad term that refers to programs, data and other related files that are used to accomplish tasks in a computer or any other devices that perform computing tasks (such as smartphones and tablets).

22. "Computer software" (and the affiliated terms identified above) are extremely broad in scope and such software may be put to many and very varied uses. The users will be dependent upon the purpose of the specific software in question, with some being targeted at the general public, and more specialist software targeted at professional users. The distribution channels will include purchasing online (which would include within an 'app store'⁷ for software), more traditional physical purchases in a retail store,

⁷ An 'app' being a software application, most often relating to an application downloaded by a user to a mobile device.

or more high-end or specialist software (particularly bespoke software) may be bought directly from a software developer.

23. The ordinary, core meaning of television, cable television and radio broadcasting services is a service that delivers television, cable television, and radio programmes to viewers and listeners. The users are the general public who will access the service in various ways including via television sets, set top boxes and hybrid devices such as games consoles, tablets, computers, and mobile phones. The broadcasts are transmitted and received by various means including cable, satellite, radio waves, the internet, digital, and mobile phone infrastructure. Some broadcasting services are free⁸ if the user has an appropriate hardware device to receive them and the user selects the channel or downloads the appropriate application to facilitate the viewing/listening⁹. Some broadcasting services are bought as part of a package that may incorporate the purchase of hardware too, such as a set top box or satellite dish and may be bought online or in a retail store. Other broadcasting services are bought online, often as part of an ongoing contract with the provider, and sometimes may be bought and accessed via an application bought in an 'app store'.

24. In making this comparison I bear in mind the decision in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*¹⁰ which concerned a comparison between computer software and software design and development services in classes 9 and 42 as against a range of information, travel and reservation services in classes 39 and 42. The General Court upheld the finding of no similarity, including no complementarity, between the goods and services. It stated in its judgment:

“54. The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods

⁸ Subject to the necessary TV licence.

⁹ For example, the on-demand services provided by “free-to-air” broadcasters

¹⁰ Case T-316/07

and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

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

56. Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other...”

25. ‘Software at large’ is such a broad term that it offers little by way of clarity in terms of its nature, purpose, and methods of use when compared to broadcasting services. There is some overlap in users and channels of trade albeit at a very high level. Complementarity cannot be found simply because broadcasting services may make use of computer software in their transmission and receipt as the same could be said for most services¹¹.

26. In my experience, however, it is increasingly common for the general public to watch or listen to broadcasts on devices such as smart phones and tablets using specific ‘apps’. It is also common for media broadcasters to produce the ‘apps’ that facilitate such viewing or listening. In that very specific context there is some similarity

¹¹ *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T336/03* at paragraph 69 and *Commercy* summarised above.

between television and radio broadcasting services and specialist computer software designed to facilitate access to broadcasting services in terms of users, uses and channels of trade. There is also a degree of complementarity as specialist software 'apps' may be essential to access a broadcast on, for example, a mobile telephone. In such circumstances the average consumer may think that the responsibility for those goods and services lies with the same undertaking.

27. The opponent's term, however, is 'computer software at large' and I must assess similarity in that overall context. At its highest point, there is a low level of similarity between radio and television broadcasting and "Computer programmes; computer programs; computer software; computer software [programmes]; computer software programs; software; software for computers".

28. The applicant's '*Computer hardware*' is also a broad term, being the physical, tangible components that a computer system may need in order to function. The users are both members of the general public and professionals. The distribution channels will include purchasing online or in a retail store and may extend to bespoke commissions for specific hardware tailored to a particular need. '*Computer hardware*' is a very wide term that offers little similarity with broadcasting services when considering their respective natures, purposes and methods of use. These are not goods and services in competition with each other. However, the term will include some specific items on which broadcast services may be viewed or listened to, in conjunction with the required software, such as set top boxes or HDMI peripherals on which broadcasting services may be provided. I am aware that the reality of the market is that some broadcasters bundle their goods and services such that broadcast packages can include both the provision of the service and the set top box or other hardware device to facilitate viewing (along with the necessary software). When considering that very specific subset of computer hardware there is some similarity in nature, purpose, methods of use as well as users and trade channels. There is also a degree of complementarity as the hardware is important or necessary to access the broadcasting services and the experience of the average consumer, bearing in mind the bundling of goods and services in converging technologies, may mean they would

consider responsibility for the goods and services rests with the same undertaking. However, set within the context of 'computer hardware' at large I consider overall there is a low degree of similarity with the opponent's broadcasting services.

29. '*Communications equipment*' may relate to devices which enable communication between individuals, such as telephones, and may also include equipment which enables communication between devices: answering machines, fax machines and devices such as satellite dishes. Where the communication equipment may be used in relation to broadcasting services then there will inevitably be a degree of similarity between the users and uses of the applicant's class 9 goods and the opponent's services in class 38. Their natures are different, one being a piece of hardware and the other being a broadcasting service, and they are not in competition. However, there is a degree of complementarity as the consumer will need hardware to receive the opponent's broadcasting service and it is possible that the provider of the service may provide the relevant communications hardware, such as a satellite dish or modem, as part of a package and consequently, the average consumer of these goods and services may think that the service, and the goods on which to receive and access that service, are provided by the same undertaking. I bear in mind though that the broad term 'communications equipment' includes many more goods than those relating to broadcasting. Considering the terms as they appear, the overall similarity between these goods and the opponent's services is low.

30. '*Electronic databases*' are organised sets of data or information stored on a computing/electronic device. '*Data storage apparatus*,' '*data capture apparatus*' and '*data collection apparatus*' cover various types of equipment that will collect, capture or store data. '*Data processing equipment and accessories (electrical and mechanical)*' are devices for processing data including both manual devices, such as typewriters, and electrical equipment. These goods all have a different purpose, nature and method of use to the opponent's services. Broadcasting services and electronic databases are not in competition, nor are they complementary and there is no coincidence of trade channels. I find these goods and services to be dissimilar.

The remaining goods in class 9

Computerized vehicle engine analyzers; engine analyzers; engine diagnostic apparatus; measuring, counting, alignment and calibrating instruments; monitoring instruments; sensors and detectors; traffic sign recognition apparatus and instruments; traffic sign recognition systems; control apparatus and instruments; simulation apparatus; simulators.

31. '*Computerized vehicle engine analyzers*', '*engine analyzers*' and '*engine diagnostic apparatus*' are all devices with a specific purpose for examining engines and will be aimed largely at a specialist professional public.

32. '*Traffic sign recognition apparatus and instruments*' and '*traffic sign recognition systems*' are equipment and systems that will be used or installed in vehicles. The average consumer will be general public vehicle users or professional purchasers.

33. '*Simulation apparatus*' and '*simulators*' will cover simulation devices that are used, for example, in computer gaming, or flight or surgical training.

34. '*Sensors and detectors*' is a broad term that could cover, for example, intruder alert or smoke alarm devices in buildings, or sensors used for a variety of purposes in vehicles or industry. Given the breadth of the term, the consumer could be a member of the general public or a professional specialist purchaser, depending on the particular nature of the goods.

35. '*Measuring, counting, alignment and calibrating instruments*' is a broad term that would extend from simple measuring devices to technical calibration equipment.

36. '*Control apparatus and instruments*' is likewise a broad term that will cover devices that exercise control in some way. It would include remote controls for televisions or domestic heating and, at the other end of the scale, control equipment for large scale industrial machinery.

37. 'Monitoring instruments' is so broad a term, which will play a part in so many industries, that it is difficult to identify a single, or even a small number of average consumers'

38. I have borne in mind the decision in *Avnet* and the core meanings of these goods and the opponent's services and have considered the users, uses, respective natures, trade channels, any complementarity and whether or not these goods and services are in competition. Having done so, I can find no meaningful areas of similarity with the opponent's broadcasting services in class 38.

The applicant's services in class 42

39. '*Computer design and programming services*', '*computer hardware development*', '*computer systems development*', '*design and development of electronic database software*', '*development of computer systems*', '*development of computer hardware*', '*development of computer based networks*', '*development of systems for the transmission of data*', '*development of systems for the processing of data*', '*development of systems for the storage of data*', '*software development, programming and implementation*', '*advice relating to the design of computer hardware*', '*advisory services relating to computer systems design*', '*advisory services relating to computer hardware design*', '*computer hardware design services*', '*computer systems design*', '*database design*', '*database design and development*', '*database development services*', '*design and development of networks*', '*design (Computer system -); design of computer databases*' and '*designing of data processing systems*' are all services which involve advice about the design or the actual design or development of computers, computer software, computer programs, computer hardware, computer systems, computer networks, databases, and data storage, processing and transmission systems.

40. The users of such advice, design or development services are likely to be commercial/professional users. They may, in limited circumstances, be a broadcaster,

whereas the user of the opponent's broadcasting services is more likely to be a member of the general public. The respective services have different purposes, natures and methods of use. They are not competitive. The fact that broadcasting services may make use of, for example, computer hardware or software development services or the development of data transmission systems does not make them complementary. The average consumer will not consider an IT developer to be the same undertaking as a provider of broadcasting services of the type contained in the opponent's specification. These are dissimilar services.

41. *'Provision of research services', 'research and development services', and 'research services'* are very broad terms covering the delivery of research and development services at large. The applicant also has *'computer research services', 'research in the field of data processing technology'* and *'research relating to data processing'* which are more focussed research services for computers and data processing. These research services are most likely to be used by commercial users. There is no similarity with the opponent's broadcasting services when taking into account the different purposes, natures, methods of use, and end users. Further, the services are not competitive or complementary. These are dissimilar services.

42. *'Design and development of wireless data transmission apparatus, instruments and equipment'* and *'design and development of wireless data transmission apparatus'* involve the design and development of the apparatus which provides or facilitates the electronic communication of data between devices without wires or cables. The user of such design and development services is likely to be a commercial purchaser. Again, there is no similarity with the opponent's services as they have different purposes, natures, methods of use and end users. They are not competitive or complementary. The fact that a broadcaster may make use of a service to design or develop data transmission apparatus does not render that service similar or complementary to their delivery of broadcast services to the general public. I find these services to be dissimilar.

43. The applicant also has '*custom design services*' in its specification. This is a broad term covering bespoke design services potentially across many fields. These services may be targeted at both the general public and professional purchasers. There is no similarity between these services and the opponent's broadcasting services based on their differing natures, purposes, methods of use and trade channels. In addition, the services are not competitive or complementary. The core meanings of the respective services are different, and I find them to be dissimilar.

44. Applying the same tests, I also find the opponent's terms, '*creating and designing web pages for others*', '*computer analysis services*' and '*data migration services*' (the latter services being concerned with transferring data between data storage systems or computer systems), to be dissimilar to the opponent's services in class 38.

45. '*Computer network services*' are services to deliver or administer computer networks. '*Data mining services*' are services which look for patterns in large data sets. The applicant also has '*technical data analysis services.*' All of these information technology related services are likely to have commercial users. There is no similarity with the opponent's services having considered their differing natures, purposes, methods of use, users, trade channels and the fact that these services are not competitive or complementary. I find these services to be dissimilar.

46. Finally, there is no similarity between the applicant's '*Advisory services relating to scientific research*' and the range of broadcasting services in the opponent's class 38 specification. Their core meanings are self-evidently different and they have differing natures, purposes, methods of use, users and the services are not competitive or complementary.

Goods and services conclusion

47. I have found there to be a low degree of similarity between the opponent's television, cable television and radio broadcasting services and the applicant's 'computer programmes; computer programs; computer software; computer software

[programmes]; computer software programs; computer hardware; software and software for computers and communications equipment.’

48. I have found there to be no similarity between the rest of the applicant’s specification and any of the opponent’s goods and services. Where there is no similarity between the goods and services there can be no likelihood of confusion¹². The opposition therefore fails other than for the goods identified in the preceding paragraph.

49. For the sake of clarity, the rest of this decision relates to the likelihood of confusion only in respect of the applicant’s goods in class 9 where I have found some degree of similarity.

The average consumer

50. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

51. 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.

¹² *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

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

52. The opponent’s services are television, cable television and radio broadcasting services. The average consumer will be a member of the general public. Whilst it could be said these are everyday services and the consumer’s main focus will be upon the particular content they wish to access, attention will still be paid to the broadcaster in order that the desired programme is found. Further, with the advent of digital technology and the cost of subscription-based broadcasting, attention will be paid when tailoring a package of channels or content to view. Consequently, at least an average degree of attention will be paid during the selection process. Visual exposure to the mark will be of particular significance including on the particular viewing device or platform, online and in advertising and broadcasting publications. However, I do not discount the fact that there will also be aural exposure, particularly for radio broadcasting, and in advertising and oral recommendations.

53. The remaining goods, in brief, are computer hardware and software and communications equipment. The hardware and software will be purchased by the general public or by specialist/professional purchasers in retail stores, online, or as a bespoke purchase from a software or hardware developer. Communications equipment may also be bought by a member of the general public or a specialist/professional purchaser. For all of these goods the degree of attention paid will vary according to the nature of the software/hardware/communications equipment required and its cost will range from at least average (as the consumer will need to ensure that it is fit for purpose) to above average (for example, where bespoke software or equipment is commissioned). The nature of the purchases will be primarily visual being made from a retail shelf, online store, website or perhaps a catalogue.

54. However, I do not rule out aural considerations as advice may be sought from a professional advisor, sales assistant or consultant.

Comparison of the marks

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

56. It would be wrong, therefore, to dissect the trade marks artificially, 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.

57. The marks to be compared are:

Earlier Mark	Applied for Mark
CONNECT.COM	CONNECT AUTO

58. The opponent submits that the dominant element in both marks is CONNECT and that the overall impression of the marks is that they are highly similar based on visual, aural and conceptual similarity.

59. The applicant submits that CONNECT is descriptive and non-distinctive for the opponent's services in class 38 as it would be understood as meaning that the opponent's services provide access to and communication of television and radio programmes. They assert that the applied for mark, CONNECT AUTO, has no direct meaning for the applicant's goods and services and therefore affords the applied for mark an entirely distinct overall impression. In particular, they assert that CONNECT AUTO is an unusual configuration of the component words which affords the mark a striking, distinctive character.

60. The earlier mark is comprised of the word CONNECT conjoined with .COM. The .COM element is commonly used to indicate an internet address. In the context of the opponent's services in class 38, the mark as a whole will indicate an internet address where the average consumer can connect to the broadcasting services in question. Neither component in the mark plays a greater role in its overall impression and I find that the overall impression rests in the mark as a whole.

61. The applied for mark consists of two words CONNECT and AUTO. AUTO may be perceived as an abbreviation of AUTOMATIC or AUTOMOBILE. The applied for mark as a whole will therefore provide the average consumer with the message of an automatic connection or a connection made in relation to cars. I find the former to be more likely. In either case, in the context of the goods for which it is applied in class 9, the mark is fairly low in distinctiveness. Neither word in the mark plays a greater role in the overall impression and I find that the overall impression rests in the mark as a whole.

Visual Similarity

62. The opponent submits that the marks are visually highly similar bearing in mind that the marks share the identical component CONNECT which is at the beginning of each of the marks. It further submits that this common element will immediately catch the attention of consumers and that the applied for mark will be seen as a variation of the dominant element CONNECT in its own mark.

63. The applicant submits that the marks are visually dissimilar due to the different suffixes which would easily allow the average consumer to distinguish between the marks. It asserts that the average consumer will focus upon these visual differences due to the very low degree of distinctive character enjoyed by the word CONNECT, particularly in respect of the class 38 services.

64. Visual similarity between these marks lies in the word CONNECT which is the first part of both marks. I note that it also makes up seven out of eleven characters in both marks. Visual differences rest in the .COM element in the opponent's mark and the second word AUTO in the application. Overall, there is a medium degree of visual similarity between the marks.

Aural Similarity

65. The opponent submits there is aural similarity due to the common CONNECT component and that the additions of .COM and AUTO will not distinguish the marks. They assert that CONNECT will be emphasised when pronouncing the applied for mark which will be a more noticeable and distinctive sound.

66. The applicant submits that the average consumer will focus on the distinguishing suffixes which have different rhythms. They state that "dot" and "COM" have short, sharp natures encouraging a pause between the two words, whereas AUTO has two syllables which transition smoothly from one to the other. They assert the average consumer will easily distinguish the marks due to the phonetic differences.

67. Aurally, both marks comprise four syllables. The aural similarity lies in the identical first two syllables CON-NECT. The aural differences lie in the endings of the marks which are distinct, being DOT-COM in the opponent's mark and AWE-TOE in the application. I find there is a medium degree of aural similarity between the marks.

Conceptual Similarity

68. The opponent submits that .COM designates a top-level domain name that is assigned to a corporation or business. It further submits that CONNECT has a meaning of “bringing together or into contact so that a real or notional link is established.” It says that the absence of .COM in the applied for mark will not alter the meaning of the dominant element CONNECT. It concludes that its earlier mark could be seen as a variation, or simply the domain name of, the applied for mark.

69. The applicant provides a definition of ‘connect’ taken from the Oxford English Dictionary.¹³ Relying on that definition, it states that the average consumer will understand CONNECT as referring to something which brings together, or into contact, so that a real or notional link is established. It submits that .COM will be understood as relating to a generic top-level domain and that the conceptual meaning of the opponent’s mark will therefore be a website that brings things together or into contact so that a real or notional link is established.

70. The applicant states that AUTO will be understood as an abbreviation of “automatic” and that the conceptual meaning of the applied for mark would be something which brings things together automatically. It concludes that there is a clear difference between the conceptual meanings.

71. In the context of the opponent’s broadcasting services, CONNECT is an element with low distinctiveness as it will simply be seen as a reference to a broadcasting service connection. The .COM element does nothing to diminish this message as it will, in combination with the word CONNECT, be seen as the internet address where the average consumer can connect to the opponent’s broadcasting services.

72. AUTO, in the context of ‘computer programmes; computer programs; computer software; computer software [programmes]; computer software programs; computer hardware; software and software for computers’, will most likely be seen as an

¹³ An access date of 5 January 2017 is given but there is no indication of the edition from which the definition was taken.

abbreviation of the word “automatic.” CONNECT AUTO as a whole will be seen as referring to an automatic connection, either in the context of software and programmes which facilitate such a connection or in relation to automatically connecting pieces of computer hardware. I bear in mind the applicant’s submission that the consumer would normally expect to encounter the words the other way around, but I do not find that this would prevent the average consumer arriving at the conceptual message I have identified.

73. The opponent’s mark will be seen as an internet location where the consumer can connect to the opponent’s broadcasting services. The application will be seen as referring to software and hardware which provides connections automatically. Any conceptual similarity rests in the concept of ‘connectivity’. I find there to be a medium degree of conceptual similarity between these marks.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive,

geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

75. The opponent has not claimed to have enhanced the distinctiveness of its mark through the use made of it and I need only consider the inherent distinctive character of the mark. I have found above that the opponent’s mark will be seen as an internet location where the consumer can connect to the opponent’s broadcasting services. As such, in relation to the services for which it is registered, I find it to be of very low distinctiveness.

Likelihood of Confusion

76. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁴ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

77. I have found:

- There is low similarity between the opponent’s *television, cable television and radio broadcasting services* and the applicant’s *computer programmes; computer programs; computer software; computer software [programmes]; computer software programs; computer hardware; software; software for computers and communications equipment*.

¹⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

- The marks share a medium degree of visual, aural and conceptual similarity.
- The average consumer will pay at least an average degree of attention during selection processes for the goods and services which will be purchased primarily visually, but I do not discount an aural element.
- The opponent's mark has very low distinctive character for the services in class 38.

78. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁵ as follows:

“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”.

¹⁵ BL O/375/10.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

79. In *Duebros Limited v Heirler Cenovis GmbH*, the Appointed Person emphasised that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.¹⁶ Each case must be assessed on its own facts and the assessment must take account of the overall impression created by the marks. The Appointed Person emphasised the importance of envisaging the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. Ultimately, the assessment is whether the average consumer will make a connection between the marks and assume that the goods or services in question are from the same or economically linked undertakings. He stressed that a finding of indirect confusion should not be made simply 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 as this is mere association not indirect confusion.

¹⁶ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

80. The opponent argues that there are clear visual, oral and conceptual similarities between the marks and that the goods and services are highly similar and identical. They refer to the interdependency principle and argue that there is a clear likelihood of confusion and that the relevant consumer would not be able to differentiate between the services provided under the two marks. They state that consumers who encounter the marks will assume that the products come from the same company and that the earlier mark could be seen as a variation, or simply the domain name of the applied for mark or, vice versa, that the applied for mark could be seen as a variation of the dominant element of the earlier mark.

81. The applicant emphasises that the earlier trade mark possesses at most an average degree of inherent distinctiveness, that the goods and services are dissimilar and are not complementary or competitive, and that the marks are dissimilar. They assert that there is no likelihood of confusion or association.

82. In both marks the common CONNECT component has very low distinctiveness for the goods and services for which I have found any degree of similarity. As the Appointed Person explained in *Kurt Geiger v A-List Corporate Limited*,¹⁷ when assessing the likelihood of confusion, it is the distinctive character of the common element that is of most importance:

“...if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

¹⁷ BL O-075-1

83. I take into account that confusion may still be possible on the basis of a shared weak element.¹⁸ However, as Arnold J. noted in *Whyte and Mackay*¹⁹:

“what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

84. Each case must be assessed on its own facts, weighing all the relevant factors. I have found that the overall impression of both marks rests in their wholes. The average consumer will not seek to rely on one or other element of either mark, rather, they will rely on the combination of the very lowly distinctive CONNECT followed by .COM and the very lowly distinctive CONNECT followed by the word AUTO. The .COM and AUTO therefore are of significance in the overall impression of each mark and are visually and aurally very different from each other. That difference will be noticed.

85. In this case, I do not consider that an average consumer familiar with the opponent's mark for broadcasting services in class 38, when encountering the applicant's mark for (lowly similar) computer software or computer hardware goods in class 9 (or vice versa), would be directly confused between these marks and the same is true of the applicant's lowly similar communications equipment. Even taking into account imperfect recollection and the absence of a side by side comparison, the differences in the marks are sufficient to avoid a likelihood of direct confusion.

86. Turning to indirect confusion, I do not consider that an average consumer will make an assumption of shared economic origin on the basis of a common component that has very low distinctiveness for goods and services which are similar only to a low degree. The average consumer will not attach trade origin significance to CONNECT

¹⁸ See *L'Oreal SA v Office for the Harmonisation of the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P* at [45] and *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* at [71] to [75].

¹⁹ *Whyte and Mackay Limited v Origin Wine UK Limited* [2015] EWHC 1271 (Ch) and as approved in *Nicoventures Holdings Limited v The London Vape Company* [2017] EWHC 3393 (Ch)

alone in the context of either mark. The distinctiveness of both marks rests in their totalities. CONNECT is not the distinctive or dominant element in either mark in such a way that it would lead the consumer to conclude there is a same stable relationship between them. The average consumer will therefore consider that the two marks are the responsibility of two separate operators who have simply chosen to make use of the common, non-distinctive term CONNECT in their respective fields of activity. In my view, the average consumer will put any similarity down to coincidence and not to a shared economic connection.

Conclusion

87. The opposition fails and the applied for mark shall proceed to registration.

88. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind the relevant scale contained in Tribunal Practice Notice 2/2016, and award costs to the opponent as follows:

Considering the notice of opposition and Preparing a counterstatement	£250
Preparing submissions	£350
Total	£600

89. I order CONNECT PRODUCTIONS (EUROPE) LIMITED to pay MTK IP LTD the sum of £600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 01st day of May 2019

AI Skilton

For the Registrar