

o/428/19

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3289610  
BY EXPOLINK EUROPE LIMITED TO REGISTER:**

  
**SpeakingUp**

**AND**

 **SpeakingUp**

**AS A SERIES OF TWO MARKS IN CLASSES 9 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 412760  
BY COGNITIVE CONSULTING GROUP PTY LIMITED**

## Background and pleadings

1. On 12 February 2018, Expolink Europe Limited (“the applicant”) applied to register the marks shown on the cover page of this decision as a series of two marks for goods and services in classes 9 and 35. The goods and services are set out later in this decision.

2. The application was published for opposition purposes on 9 March 2018.

3. The application is opposed by Cognitive Consulting Group Pty Limited (“the opponent”). The opposition, which is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods and services in the application. The opponent relies upon its International Registration (IR) number 1381922 as its earlier right, relevant details of which are as follows:

IR number: 1381922

Mark:



International registration date: 2 November 2017

Designation date: 2 November 2017

Date of protection of the international registration in UK: 27 March 2018

4. The goods and services relied on are set out later in this decision.

5. The applicant filed a defence in which it denied the grounds of opposition.

6. The opponent’s IR is an earlier mark, in accordance with Section 6 of the Act, but had not been registered for five years or more at the publication date of the applicant’s mark, so it is not subject to the proof of use requirements, as per Section 6A of the Act.

7. In these proceedings the applicant is represented by Wood IP Limited. The opponent's changed its representative before the hearing and instructed their current representative, Wilson Gunn.

8. Only the applicant filed evidence. This will be summarised to the extent that it is considered necessary. Only the opponent filed written submissions dated 24 October 2018. A Hearing took place on 5 July 2019, with the applicant represented by Aaron Wood for Wood IP Limited and the opponent represented by Andrew Marsden for Wilson Gunn.

## **DECISION**

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

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

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

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

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

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

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

11. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

13. 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."

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he 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."

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 OHIM*, Case T-325/06, the General Court (GC) stated that "complementary" means:

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

16. In *Sanco SA v OHIM*, Case T-249/11, the GC 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 are 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 Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

17. 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”.

18. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. The goods and services to be compared are:

<b>Applicant's goods and services</b>	<b>Opponent's goods and services</b>
<p><b>Class 9:</b> Software, downloadable software and Internet based software; software, downloadable software and Internet based software relating to business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management; Software, downloadable software and Internet based software relating to case management; Software, downloadable software and Internet based software relating to whistleblowing; all for use with computers, hand held computer apparatus and mobile telephones; downloadable audio and audiovisual recordings; downloadable publications.</p> <p><b>Class 35:</b> Business management; business administration; management and operation of call centres for others; collection and compilation of business and personnel information, information relating to policy and regulatory compliance, and information relating to governance and risk; business information collection and processing services; marketing services;</p>	<p><b>Class 16:</b> Educational materials in printed form; printed matter for educational purposes; audiovisual teaching materials (printed matter); printed teaching aids; teaching manuals; teaching materials for education; teaching materials for information; teaching materials for instruction; printed matter relating to health education; printed matter relating to medical matters; periodical publications relating to medical research; booklets for information; instruction manuals relating to training seminars.</p> <p><b>Class 41:</b> Adult training; adult education services; adult tuition; advisory services relating to education; advisory services relating to training; arranging and conducting of seminars; arranging and conducting of workshops (training); arranging of exhibitions for training purposes; conducting training seminars; conducting workshops (training); consultancy services relating to education; consultancy services relating to training; employment training; medical education services; medical tuition services; mentoring (education and training); organisation of training courses; personal development courses; personal development training; provision</p>



<p><i>information, advisory and consultancy services in relation to all of the above.</i></p>	<p><i>of training; provision of training courses; staff training services; training; training consultancy; vocational training services; vocational education.</i></p> <p><b>Class 44:</b> <i>Health care consultancy services (medical); medical advisory services; medical analysis services; advisory services relating to health; health risk assessment surveys; consultancy relating to health care.</i></p>
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20. The assessment of the similarity of the goods and services is a crucial element in the consideration of an opposition based on Section 5(2)(b) of the Act. If there is not any level of similarity between the goods and services, i.e. the goods and services are wholly dissimilar, then Section 5(2)(b) of the Act cannot apply and it is not necessary to carry out the global assessment of the likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

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

*The opponent’s submissions*

21. As regards the similarity of the goods and services at issue, the opponent stated in its notice of opposition:

“The goods and services specified in the opposed trade mark are similar to those of the earlier mark including training and software for dissemination and

comprehension of company policies, regulatory standards and whistle-blowing and those of the earlier mark include printed educational material, mentoring (education and training) and advisory relating to health care. There is an overlap in the respective goods and services as the Opponent provides services to support whistle-blowing and software platform for this purpose”.

22. And in its written submissions:

“...the users and uses of the printed materials in Class 16 of the earlier specification overlap with the users and uses of the software, audio and audio-visual recordings, and downloadable publications of Class 9 of the later specification. They should be regarded as complementary and therefore similar to a degree notwithstanding that the nature of the respective goods may be different. Further, the opponent submits that having regard to the nature of the respective goods, the relevant public is liable to believe that the responsibility for the goods lies with the same undertaking or with economically connected undertakings.

Similarly, the opponent submits that the users and uses of the education and employment services of Class 41 and the health care and health risk assessment surveys and consultancy services of Class 44 of the earlier specification overlap with the information, advisory and consultancy services of Class 35 of the Later specification.”

23. The opponent’s submissions also included a table identifying “the most significant elements of the respective goods and services”, though it was not clear on which basis the claim was made. The table matched the goods and services as follows:

- a) The applied for “*software relating to business information including company policies and regulatory standards*” (in class 9) was matched with the opponent’s “*printed material (including audio-visual material)*” (in class 16);
- b) The applied for “*software relating to case management*” (in class 9) was matched with the opponent’s “*teaching materials for education, information or instruction*” (in class 16);

- c) The applied for “*software relating to whistleblowing*” (in class 9) was matched with the opponent’s “*printed matter relating to health education or medical matters*” (in class 16);
- d) The applied for “*audio and audio-visual recordings*” (in class 9) were matched with the opponent’s “*periodical publications relating to medical research*” (in class 16);
- e) The applied for “*downloadable publications*” (in class 9) were matched with the opponent’s “*instruction manuals relating to training seminars*” (in class 16);
- f) The applied for “*business management*” (in class 35) was matched with the opponent’s “*adult training and education including advisory services and training consultancy*” (in class 41);
- g) The applied for “*collection of information relating to policy and regulatory compliance, governance and risk*” (in class 35) was matched with the opponent’s “*employment training; medical education services; medical tuition services; mentoring (education and training)*” (in class 41);

24. In his skeleton arguments, the opponent submitted:

“There is a clear overlap in the respective nature, uses, and users of the class 16 and class 9 goods. Computer software is often accompanied by an instruction manual or booklet. The applicant’s downloadable audio and visual recordings may include audio books for example and so are similar to the opponent’s class 16 goods. Downloadable publications and booklets, instruction manuals share the same purpose and nature and so are similar. Software is a broad term and will encompass electronic versions of the opponent’s class 16 goods and so there is a similarity in the purpose and use and the goods may be in competition.

The purpose of the applicant’s services in class 35 may overlap with the opponent’s goods in class 16 and the class 35 services are complementary to the class 16 goods. On this basis there is at least a degree of similarity between the class 16 goods and the class 35 services.”

25. The argument was expanded at the hearing to the following submissions:

1) the applicant's goods in class 9, including the various software-based goods (both restricted and unrestricted), as well as "*downloadable audio*", "*audio and audio-visual recordings*" and "*downloadable publications*" were similar to a very high degree to the opponent's goods in class 16, including those consisting of "*educational material in printed form*" and "*instruction manuals relating to training seminars*" because, it was said, the applicant's goods could cover electronic versions of the opponent's printed goods, so the goods would have a similar purpose and would be competitive. Mr Marsden also identified the opponent's "*booklets for information*" as the closest category of goods on the basis that they were not restricted to any areas;

2) the applicant's services in class 35 were:

- a. complementary to the opponent's goods in class 16 insofar as they could be provided together, originate from the same source and have the same "ultimate purpose" (though it was not said what the "ultimate purpose" was);
- b. similar to the opponent's training and educational services in class 41, including "*staff training services*" and "*vocational education*" (and training) services, insofar as these services could be for business and management purposes. Concerning the complementary nature of the goods and services at issue, Mr Marsden said that the goods and services were ancillary and overlapped, though, again, it was not clear on what basis the claim was made.

### *The applicant's submissions*

26. The applicant, for its part, criticised the opponent's arguments because they lacked details and it was not clear how the goods and service overlapped. At hearing, Mr Wood reiterated those criticisms and said that Mr Marsden's arguments were expressed at such a level of abstraction and generality that were not helpful.

27. Nevertheless, Mr Wood conceded that the applied “*software, downloadable software and Internet based software; all for use with computers, hand held computer apparatus and mobile telephones; downloadable audio and audio-visual recordings; downloadable publications*” in class 9 (identified as category A) were similar to a low to medium degree to the opponent’s teaching and educational printed material in class 16<sup>1</sup> because they were not restricted to any specific content and could include items with educational content.

28. As regards the remaining “*software, downloadable software and Internet based software relating to business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management; software, downloadable software and Internet based software relating to case management; software, downloadable software and Internet based software relating to whistleblowing; all for use with computers, hand held computer apparatus and mobile telephones*” in class 9 (identified as category B), Mr Wood maintained that they were not similar to any of the opponent’s educational and teaching material (in class 9) or educational, training and health care related services (in classes 41 and 44) by reason of their specific nature and content which was different from that of the opponent’s goods and services. He also considered the argument, which he understood was suggested by Mr Marsden, that the opponent’s educational material (in class 16) could include, for example, teaching manuals and booklets in relation to the specific subjects contained within the applied for software in category B (in class 9). However, Mr Wood observed that the problem with that argument was that there is no suggestion in the specification that the contested software is educational software used for the purpose of teaching the subject matter to which it relates. In this connection, he argued that, for example, software relating to cost forecasting should be read as “cost forecasting software” for “doing” cost forecasting, not as educational software for “learning” cost forecasting; on that basis, he argued, the most that could be said was that someone who uses a cost forecasting application may be interested in learning cost forecasting, but that would not make the goods similar from a trade

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<sup>1</sup> The concession was made at the hearing but not in the skeleton arguments where it was maintained (paragraph 10) that the fact that the applicant’s software could include some educational content was not enough in itself to assume similarity of the goods.

mark perspective. In response to this point, and referring to the same example, Mr Marsden argued that the opponent's instruction manuals and booklets in class 16 could relate to the applied for cost forecast software in class 9. He also pointed to the fact that the opponent's specification in class 16 includes "printed matter relating to medical matters" and that the applied for software in category B, including cost forecast software, could relate to any industry including healthcare, so there would be an overlap between "printed matter relating to medical matters" and cost forecasting software for the healthcare sector.

29. As regards the applied for services in class 35, including business services and collection and compilation of information for others, Mr Wood argued that there is no clear complementary or competitive relationship between these services and any of the opponent's goods and services in classes 16, 41 and 44. In this connection, he said that there is no evidence on the fact that the competing services have converged in the market in such a way that it would be reasonable for a consumer to believe that they are provided by the same undertakings. Although Mr Wood accepted that the applied for business services in classes 35 and the opponent's staff training in class 41 could target the same business users, he contested Mr Marsden's submission that the applied for services in class 35 are similar to the opponent's training services in class 41 because the latter could cover training for business services. According to Mr Wood, it cannot be true that training services are similar to any goods and services because they could cover any subject, and Mr Marsden's argument must be dismissed.

### Findings on the similarity of the goods and services

#### **Class 9**

30. Category A: Software, downloadable software and Internet based software; all for use with computers, hand held computer apparatus and mobile telephones; downloadable audio and audio-visual recordings; downloadable publications. The applicant conceded that these goods are similar to a low to medium degree to the earlier (printed) educational material in class 16 to the extent that they include goods with an educational content which could be used for educational and teaching

purposes like the opponent's goods. I am more inclined to agree with the opponent on the point that the degree of similarity here is higher, but not to the very highest level.

31. The contested "downloadable publications" include e-books and online publications which are electronic versions of traditional media. The goods are not restricted to any field and so would cover downloadable publications relating to medical research. On that basis, I find that whilst the method of use and the nature of the goods, i.e. printed goods versus downloadable goods, is different from that of the opponent's "periodical publications relating to medical research", the users and uses would be the same, the goods would have the same purpose, would be competitive and there would be a complementary relationship of the type where "customers may think that responsibility for the goods lies with the same undertaking". **I consider that "downloadable publications" are similar to a high degree to the opponent's "periodical publications relating to medical research"**. By the same token, given that "downloadable publications" includes e-books, it is similar to a high degree to the opponent's "educational materials in printed form" which include books.

32. The contested "downloadable audio and audio-visual recordings" are also unrestricted and could cover the same subject matter covered by the opponent's "audio-visual teaching material (printed matter)". The users, uses and purpose of the goods is the same, the goods reach consumers through the same channels and are highly complementary in the sense that "customers may think that responsibility for the goods lies with the same undertaking". **I consider "downloadable audio and audio-visual recordings" to be highly similar to the opponent's "audio-visual teaching material (printed matter)"**.

33. The contested *software, downloadable software and Internet based software; all for use with computers, hand held computer apparatus and mobile telephones;* are not restricted in any way and it was accepted on behalf of the applicant that they could have an educational content. Software includes all the different software programs on a computer, such as applications and the operating system. On that basis, one could easily envisage a scenario where, for example, the opponent would provide teaching material in the form of a book containing practice questions and answers and the applicant would provide an interactive application or software to practice the same

questions. In my view “Software, downloadable software and Internet based software; all for use with computers, hand held computer apparatus and mobile telephones” are similar to a high degree to the opponent’s “educational material in printed form”.

34. Category B: Software, downloadable software and Internet based software relating to business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management; software, downloadable software and Internet based software relating to case management; software, downloadable software and Internet based software relating to whistleblowing. I agree with Mr Wood that these types of software are designed to be used for specific activities and assist business users in carrying out certain functions, namely business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management, case management and whistleblowing. The natural reading of the word ‘relating’ in the context of the goods listed in the specification is ‘for’ and I do not accept (and it was not seriously contended), that in the absence of any indication in the specification, these are types of software for training and educational purposes. The purpose of these goods is not educational and, I agree with Mr Wood, that there is a striking difference between offering the software to allow someone to carry out certain functions in specific fields and offering printed educational material (or information booklets) to teach or inform someone about the same field or subject matter. The users, uses, nature and purpose of the competing goods are different, it does not seem to me that there is any scope for the goods to be provided through the same trade channels, the goods are not competitive and it was not explained how the opponent’s printed goods are indispensable or important for the use of the contested software in such a way that consumers may think that the same undertaking is responsible for manufacturing them, so there is no complementarity.

35. I also understood Mr Marsden to claim that the above listed software goods are similar to the opponent’s instruction manuals and information booklets. Firstly, I note that the opponent’s specification does not cover instruction manuals *per se* but only



instruction manuals which are limited to training seminars, so I do not understand how the goods are said to overlap. If the submission was that information booklets include booklets giving information about the opponent's software, I also dismiss it. This is because although an undertaking providing software for others will also provide some sort of booklet for information about how to use the software, the booklet is part of the software rather than an item offered separately to the software itself. Consequently, I find that these goods are not similar to any of the opponent's goods in class 16.

36. As regards the similarity with the opponent's services, the opponent did not make any specific submissions to the effect that any of the applied for software could be used for some of the opponent's services in classes 41 or 44. Some of the evidence filed by the applicant (see below) shows that the opponent provides a training programme to healthcare organisations with a view to promote their staff accountability and encourage staff to report concerns about patients' safety. In this connection, the opponent submitted that "the Opponent provides services to support whistle-blowing and software platform for this purpose". Although the opponent's staff training services may result in an increased number of whistleblowing reports, I am not convinced that this would make the services similar to software for reporting and/or managing incidents. Whilst I accept that the users could be the same, i.e. business users, the uses, nature and purpose of the goods and services is different, the applicant's software goods and the opponent's training services are not fungible (or competitive) and the opponent's training services already exist, without the applicant's software so there is no complementarity. Having considered all of the above, my conclusion is that in the absence of any specific evidence that the opponent's training or healthcare related services are assisted by the applicant's software, I do not consider that the public would think that the same entity may both provide staff training and healthcare consultancy services and manufacture computer software relating to whistleblowing or any of the following: business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management. **Therefore, I consider that these goods are not similar to any of the opponent's goods and services.**

## Class 35

37. Business management; business administration; management and operation of call centres for others; collection and compilation of business and personnel information, information relating to policy and regulatory compliance, and information relating to governance and risk; business information collection and processing services; marketing services; information, advisory and consultancy services in relation to all of the above. The opponent submitted that on account of the complementarity between the class 16 goods and class 41 and 44 services covered by the earlier mark and the class 35 services covered by the applied for mark, as well as the fact that the goods and services could be aimed at the same business users, there was some similarity between the goods and services at issue. Although Mr Marsden also attempted to claim that, in some cases, the goods and services may be provided by the same undertakings, he did not, at any time explain how undertakings which manufacture printed goods and provide training and educational services (or healthcare consultancy services) may also be engaged in business management and administration services or information collection services (or related consultancy services). Furthermore, as Mr Wood correctly pointed out, it was not explained what was the “common ultimate purpose” that made the applied for services in class 35 similar to any of the earlier goods in class 16 or services in classes 41 and 44. If what Mr Marsden meant was that the opponent’s educational material and training services could be provided in relation to business related subjects, I agree with Mr Wood that this would not make the goods and services similar from a trade mark perspective and that there is no real similarity between (a) business management, information collection services and marketing services, which are intended to help companies manage/support their business and market their products and are usually rendered by providers specialised in this specific field such as business and marketing consultants and (b) educational material (and other printed matters) and educational and training services, which are rendered by educational institutions. The users may overlap on a superficial level as the services may all be used by businesses, but the uses, nature, purpose, methods of use and trade channels are different and there is no competition of complementarity of the type where “customers may think that responsibility for the goods lies with the same undertaking”. I have considered the opponent’s other services in class 44 but, in the absence of any submissions to assist

me, I see no further point of similarity which will put the opponent in a better position. **I consider that the applied for services in class 35 are not similar to any of the opponent's goods and services.**

38. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail in respect of the applicant's following class 9 goods and class 35 services:

**Class 9:** *software, downloadable software and Internet based software relating to business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management; Software, downloadable software and Internet based software relating to case management; Software, downloadable software and Internet based software relating to whistleblowing; all for use with computers, hand held computer apparatus and mobile telephones.*

**Class 35:** *Business management; business administration; management and operation of call centres for others; collection and compilation of business and personnel information, information relating to policy and regulatory compliance, and information relating to governance and risk; business information collection and processing services; marketing services; information, advisory and consultancy services in relation to all of the above.*

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

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

40. The goods at issue are software, downloadable audio and visual recordings and downloadable publications in class 9 and various printed goods in class 16. The average consumer may be either a member of the general public or a business user. These purchases can vary significantly in cost, with the cost of a software for business use likely to be significantly higher than the cost of a book. The level of attention paid by both business users and members of the general public is likely to be at least average, as attention will need to be paid to ensure that the goods satisfy the consumer’s particular requirements.

41. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from a sales assistant or representative.

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

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, 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).”

43. Registered 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.

44. 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. However, the applicant has filed some evidence in support of its claim that the words “Speaking up” are of low distinctive character. The applicant’s evidence consists of a witness statement from Anna Perry, a consultant at Wood IP Limited, the applicant’s representative. Attached to it are the following exhibits:

- 1) AP1: includes details of the following trade mark registrations incorporating the words “speaking up” namely: 1) UK2317186 “Speaking up for our age help the Aged” (classes 16 and 41); 2) UK2557080 “SPEAKING UP: PRESENTING TO EXECUTIVES” (class 41); 3) UK2557265 “SPEAKING UP” (X2) (class 41); 4) UK3134221 “Speaking up for cats” (classes 16 and 41); 5) UK3173424 “SUSO Speaking Up Speaking Out” (class 41); 6) IR 1381922: “Speaking Up for Safety” (Classes 16, 41 and 44);

2) AP2-6: are undated printouts from website pages including the following: 1) a page from [www.generationsworkingtogether.org](http://www.generationsworkingtogether.org) displaying the words “Speaking Up For Our Age”; 2) a page from [www.powerspeaking.com](http://www.powerspeaking.com), a provider of training services called “Power Speaking”, including the words “Speaking Up: Presenting to Decision Markers ®”; 3) a page from [www.cats.org](http://www.cats.org), an advocacy service which it is said to campaign in the UK to create a better environment for cats, including the words “Speaking Up for Cats”; 4) a page from [www.maccsuso.org.uk](http://www.maccsuso.org.uk) a self-advocacy group for individuals with learning disabilities, including the words “Speak Up Speak Out”; 5) a page from [www.cognitiveinstitute.org](http://www.cognitiveinstitute.org), about “Speaking Up for Safety”, a programme aimed at building a culture of safety and quality by empowering staff to support each other and raise concerns about patients’ safety. This, was explained at the hearing, is the opponent’s website;

3) AP7: are the results of a Google search dated January 2019 for the terms “speaking up” and “speak up”. I have gone through the list and whilst I do not intend to reproduce in detail all the results of the search, it suffices to say that it displays a number of titles, URLs and snippets which appear to relate to groups, alliances, forums, reports, campaigns and articles incorporating the words “speak up/speaking up”. Examples include references to:

- A “Speak Up” Forum that is said to bring together voluntary and community organisations for dialogue, information sharing and joint action about strategic planning (at [www.speakupforum.org.uk](http://www.speakupforum.org.uk));
- An organisation offering services to people with learning disabilities (at [www.bhdspeakout.org.uk](http://www.bhdspeakout.org.uk));
- An organisation called “Speak up against cancer” (at [www.speakupagainstcancer.org](http://www.speakupagainstcancer.org));
- An initiative from the Evangelical Alliance called “Speak Up” (at [www.eauk.org](http://www.eauk.org));
- English courses for visa students in London (at [speakuplondon.com](http://speakuplondon.com));
- A report called “Freedom to Speak Up review” (at [www.webarchive.nationalarchives.gov.uk](http://www.webarchive.nationalarchives.gov.uk))

- A leading producer of easy-read materials for people with learning disabilities called “Speak Up” (at [www.speakup.org.uk](http://www.speakup.org.uk));
  - Various initiatives relating to mental health (at [speakupcic.co.uk](http://speakupcic.co.uk)), older carers (“Speak Up for older carers” at [www.carers.org](http://www.carers.org)), schools (“Speak-up for schools” at [www.unison.org.uk](http://www.unison.org.uk)), fundraising (“Speaking up for fundraising” at [www.institute-of-fundraising.org.uk](http://www.institute-of-fundraising.org.uk)), safety (“Speak-up-stay-safe” at [www.britsafe.org](http://www.britsafe.org)); and climate (“Speak up week of action 2017” at [www.cafod.org.uk](http://www.cafod.org.uk));
- 4) AP7-9: are undated print-outs from various websites most of which show use of the phrase “speak up/speaking up” in the context of whistleblowing policies, programmes, charters and information aimed at encouraging staff working in the healthcare sector to report concerns. Other print-outs refer to
- a) “Speaking up” groups intended as local groups where people with learning disabilities can speak about issues that are important to them and
  - b) “Freedom to speak up guardians” who are appointed through the NHS and whose role is to provide advice and support to staff working in the healthcare sector in relation to concerns they have about patients’ safety;
- 5) AP10: is a printout from Cambridge dictionary (online) which confirms that the meaning of “speak up for someone or somebody” is “to express support for a person or idea”.

45. Mr Marsden accepted that the words “SPEAKING UP” are English words that can be used with the meaning illustrated by the dictionary definition exhibited at AP10, but he pointed out that “the issue before the Tribunal does not concern this use”.

46. I agree. Whilst the evidence suggests that the opponent provides staff training services in the healthcare sector relating to whistleblowing, which is a term used when a worker passes on information concerning wrongdoing, the term ‘SPEAKING UP’ is not a synonym for whistleblowing. Further, the fact that the term may be used in the sense of advocating for an idea or a person, does not take the mark within the provision of Section 3(1)(b) or (c), i.e. a mark devoid of distinctive character or

descriptive (which, in any event, have not been pleaded), neither does it make the mark low in distinctiveness. This is because as the applicant's own evidence shows, the significance of the words SPEAKING UP is too vague (e.g. "speaking up" intended as (i) speaking confidently; (ii) advocating; (ii) whistleblowing and (iii) reporting concerns about something) to be descriptive of the subject matter of the goods concerned, even in the context of educational material relating to whistleblowing. Further, although under Section 3(1)(b) it is sufficient that at least one of the possible meanings of the mark has the potential to designate a characteristic of the goods concerned, under Section 5(2)(b) one must assess the distinctiveness of the earlier mark taking into account the notional and fair use of the mark for the goods for which it is registered and, in the case of the opponent's specification in class 9, the goods are not restricted to educational material relating to whistleblowing (in relation to which the mark would be at most allusive in a loosely manner) and can relate to any subject matter.

47. As regards the claim that the opponent's mark has no, or little, distinctive character Mr Wood put forward the following argument:

"The unchallenged evidence of Anna Perry deals with the common usage of the term "SPEAK UP" and "SPEAKING UP". The term is one which is used by a variety of parties such that it may be reasonably be considered that the term is of limited or no distinctiveness".

48. Firstly, as regards the evidence relating to other marks incorporating the word SPEAKING UP, "state-of-the-register" evidence is, in principle, irrelevant and the only details provided of the trade marks in question are a few undated screenshots from third parties websites, which do not establish the position at the relevant date, so the presence or otherwise of such a trade mark on the register does not assist the applicant. Secondly, some of the use shown is not even trade mark use and the fact that the words SPEAKING UP might be used in relation to advocacy does not weaken the distinctiveness of the mark in the context of the goods concerned which have nothing to do with advocacy services. Finally, Mr Wood exhibited copies of two decisions in support of the proposition that when a verbal element of a composite mark is descriptive, that element will not be completely ignored but the lack of



distinctiveness of that element would be taken into account in any action of infringement and the likelihood of confusion would be ruled out. However, as Mr Marsden correctly pointed out, the decisions<sup>2</sup> exhibited relate to completely different marks and verbal elements and having already dismissed Mr Wood's claim that the words "SPEAKING UP" are of low distinctiveness, I cannot see how the legal principles established by these decisions apply to the facts of this case.

49. In my view, neither the words 'SPEAKING UP' or the words 'SPEAKING UP FOR SAFETY' are descriptive (or even allusive) of the goods concerned and the opponent's mark has a medium degree of distinctive character.

### **Comparison of marks**




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

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

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

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<sup>2</sup> *Supreme Petfood Ltd v Henry Bell & Co (Grantham) Ltd* [2015] EWHC 256 (Ch) at 61 and 185 and *Evegate Publishing Ltd v Newsquest Media (Southern) Ltd* [2013] EWHC 1975 (Ch)

Applied for mark (series of 2)	Opponent's mark
 <p data-bbox="323 427 667 495"><b>SpeakingUp</b></p> <p data-bbox="323 517 667 551">(First mark in the series)</p> <p data-bbox="467 573 523 607">and</p> <p data-bbox="284 622 703 723"> <b>SpeakingUp</b></p> <p data-bbox="300 741 691 775">(Second mark in the series)</p>	 <p data-bbox="879 416 1185 528"><b>Speaking Up for Safety</b></p>

52. Both marks in the applied for marks consist of the words ‘Speaking’ and ‘Up’, conjoined and written in a thick title case, in grey. Though the words are conjoined, they will easily be recognised by the average consumer as two separate words, particularly because the capital letters ‘S’ and ‘U’ make it possible to identify clearly the beginning of each word. The marks also incorporate a figurative element made up of two speech bubbles with opposing tails, one overlapping the other. In the first mark, the figurative element is positioned centrally above the words; in the second mark it precedes the words. The speech bubbles have a visual impact, but they are not dominant because they reinforce the idea of ‘speaking’ conveyed by the words themselves which are the most dominant and distinctive elements of the mark (the meaning of which is recalled above at paragraph 44(5)).

53. The opponent’s mark consists of the words ‘Speaking Up’ set above the words ‘for Safety’. The words are written in a dark navy blue in a thick title case and next to the words there is an abstract sky-blue device consisting of rounded squares diagonally set inside the outer edge of the device in an ever-decreasing paler blue tone. The most dominant element of the marks are the words because the device is an abstract shape and carries no conceptual meaning. Whilst ‘Speaking Up for Safety’ will be perceived as a phrase, the verbal element ‘for Safety’ will be seen as qualifying the first two words ‘Speaking Up’ which will be understood as a semantic and conceptual

unit on its own, having the meanings set out in paragraph 44(5) above. That is all the more so as the words are visually separated, being presented on two levels.

54. In relation to the figurative elements of the marks, it must also be borne in mind that (1) neither device is bigger in size than the word elements; (2) neither device is particularly fanciful or unusual and (2) where a mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, since the average consumer will more easily refer to the goods or services in question by citing the name rather than describing the figurative element of the mark.

### **Visual similarity**

55. Visually, Mr Marsden argued that the marks are visually similar to a high degree because of the presence of the identical words “Speaking Up” in both marks and because the figurative elements in each mark are of a similar shape and size. In this connection, Mr Marsden went as far as to say that the device element in the opponent’s mark is a speech bubble. Mr Wood accepted that there is a level of similarity by reason of the inclusion of the words “Speaking Up/SpeakingUp” in both marks, but maintained that the figurative elements are different because, he submitted, the device in opponent’s mark is an abstract device, and will not be understood as a speech bubble.

56. In my view, given the presence in both marks of the distinctive words “Speaking Up/SpeakingUp”, but taking into account the differences created by the other elements of the marks, namely, the words “for Safety” in the opponent’s mark and the devices, the marks are similar to a medium degree. The typefaces of the words are not the same, however, owing to their simplicity, they create differences which are hardly noticeable.

### **Aural similarity**

57. Aurally, the pronunciation of the marks at issue coincided in the sound of the word ‘Speaking’ and ‘Up’ and differed in the sound of the word ‘for Safety’ in the opponent’s

mark. The device elements will not be articulated. In my view the marks are similar to a medium to high degree.

### **Conceptual similarity**

58. Conceptually, the average consumer will perceive the words 'SpeakingUp/Speaking Up', in each mark as having the meanings set out in paragraph 44(5) above, with this being qualified in the opponent's mark by the word 'for Safety'. The element 'for Safety' could describe the subject matter of the opponent's educational and teaching material (printed), namely the field of safety, and will be perceived as subordinate to the element 'Speaking Up'. Since the figurative elements of the marks are likely to be perceived essentially as reinforcing the idea of 'speaking' conveyed by the words themselves or as a decorative element, they do not introduce a significant conceptual difference. In my view the marks are conceptually similar to a high degree.

### **Likelihood of confusion**

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

60. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

61. Earlier in my decision I found that the goods concerned are similar to a high degree. The goods will be selected visually by the general public or business users with a medium degree of attention. The marks are visually similar to a medium degree, aurally similar to medium to high degree and conceptually similar to a high degree. The earlier mark is distinctive to a medium degree and the word element ‘Speaking Up’ in the earlier mark retains independent significance and is the most distinctive element of the mark.

62. In view of the above, even if the marks in the application are not directly mistaken for the earlier mark and the average consumer would notice the differences between them, I consider that the presence of the word ‘SpeakingUp’ in the applied for marks will create an expectation on the part of the average consumer that the goods originate from the same or economically linked undertakings, for example the applied for marks could be seen alternative marks being used by the opponent (such as part of a different range or brand extension which is not related specifically to safety). **There is a likelihood of indirect confusion.**

## Conclusion

63. The opposition has been partially successful. The opposition is successful in respect of all of the goods which I have found to be similar to the earlier goods, namely:

**Class 9:** *Software, downloadable software and Internet based software; all for use with computers, hand held computer apparatus and mobile telephones; downloadable audio and audio-visual recordings; downloadable publications.*

64. These goods will be refused registration.

65. The goods against which the opposition fails (and which can proceed to registration) are the goods which I found to be not similar to the earlier goods. These are as follows:

**Class 9:** *software, downloadable software and Internet based software relating to business information, design, dissemination and comprehension of company policies and regulatory standards, workforce management, cost forecasting and estimation, resource requirements, quality and performance management; Software, downloadable software and Internet based software relating to case management; Software, downloadable software and Internet based software relating to whistleblowing; all for use with computers, hand held computer apparatus and mobile telephones.*

**Class 35:** *Business management; business administration; management and operation of call centres for others; collection and compilation of business and personnel information, information relating to policy and regulatory compliance, and information relating to governance and risk; business information collection and processing services; marketing services; information, advisory and consultancy services in relation to all of the above.*

## **COSTS**

66. Although both parties have achieved a measure of success, as the applicant has been substantially more successful than the opponent, it is entitled to a contribution towards his costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide and making a “rough and ready” reduction to reflect the measure of the opponent’s success, I award costs to the applicant on the following basis:

Filing a counterstatement:	£100
Attending a hearing:	£250
Total	£350

67. I order Cognitive Consulting Group Pty Limited to pay Expolink Europe Limited the sum of £350. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this day 24<sup>th</sup> July 2019**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**