

O-466-19

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 3302452

BY TIM MACKEW

TO REGISTER

ChefUber

IN CLASS 35

AND

OPPOSITION THERETO (UNDER No 413340)

BY UBER TECHNOLOGIES, INC.

Background and pleadings

1. The relevant details of the subject application are as follows:

Mark:	ChefUber
Filing date:	9 April 2018
Publication date:	4 May 2018
Applicant:	Tim Mackew

Class 35 - Recruitment (Personnel -); Recruitment advertising; Recruitment and personnel management services; Recruitment and placement services; Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultancy services; Recruitment consultants in the financial services field; Recruitment of airline personnel; Recruitment of airport ground staff; Recruitment of computer staff; Recruitment of executive staff; Recruitment of flight personnel; Recruitment of high-level management personnel; Recruitment of personnel; Recruitment of temporary personnel; Recruitment of temporary technical personnel; Recruitment services; Recruitment services for sales and marketing personnel; Advertising services relating to the recruitment of personnel; Advisory services relating to personnel recruitment; Assistance relating to recruitment and placement of staff; Business recruitment consultancy; Consultancy and advisory services relating to personnel recruitment; Consultancy of personnel recruitment; Consultancy relating to personnel recruitment; Dissemination of information relating to the recruitment of graduates; Employment recruitment; Executive recruitment services; Human resources management and recruitment services; Interviewing services [for personnel recruitment]; Management advice relating to the recruitment of staff; Model recruitment agencies; Office support staff recruitment services; Permanent staff recruitment; Personality testing for recruitment purposes; Personnel placement and recruitment; Personnel recruitment; Personnel recruitment advertising; Personnel recruitment agency

services; Personnel recruitment consultancy; Personnel recruitment services; Personnel recruitment services and employment agencies; Professional recruitment services; Providing information relating to employment recruitment; Providing information relating to personnel recruitment; Providing recruitment information via a global computer network; Provision of advice relating to the recruitment of graduates; Provision of information relating to recruitment; Staff recruitment; Staff recruitment consultancy services; Staff recruitment services.

2. Registration is opposed by Uber Technologies, Inc. ("the opponent"). Its grounds are based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act"). In relation to the section 5(2) ground, the opponent relies on the following marks:

- i) European Union Trade Mark ("EUTM") 010460442* for the mark **UBER** which was filed on 1 December 2011 and registered on 24 April 2012 for a range of goods and services in classes 9, 38, 39 & 42.
- ii) EUTM 013004809 for the mark **UBERX** which was filed on 17 June 2014 and registered on 16 October 2014 for a range of goods and services in classes 9, 38, 39 & 42.
- iii) EUTM 13759394 for the mark **UBEREATS** which was filed on 20 February 2015 and registered on 23 June 2015 for a range of goods and services in classes 9, 35, 38, 39 & 42.
- iv) EUTM014414221 for the mark **UBERPOOL** which was filed on 27 July 2015 and registered on 25 November 2015 for a range of goods and services in classes 9, 38, 39 & 42.
- v) EUTM 015099278 for the mark **UBERRUSH** which was filed on 11 February 2016 and registered on 14 July 2016 for a range of goods and services in classes 9, 35, 38, 39 & 42.
- vi) UK registration 3171549* for the mark **UBER** which was filed on 27 June 2016 and registered on 30 December 2016 for a range of goods and services in classes 9, 35, 38, 39 & 42.

- vii) EUTM 13009171 for the mark **UBERPOP** which was filed on 18 June 2014 and registered on 22 January 2015 for a range of goods and services in classes 9, 38, 39, 42 & 45.

3. Under section 5(2)(b), the opponent claims that there is identity/high similarity between the applied-for services and the goods and services of the earlier marks. It makes particular reference to certain goods and services covered by UK registration 3171549, although these are just examples. It states that the marks are highly similar particularly bearing in mind that the word Chef in ChefUber is not distinctive. It adds that there is a further point of conceptual similarity between ChefUber and UBEREATS because of the food-based connotations they possess.

4. Under section 5(3), the opponent relies on the two marks asterisked in the above list. It states that the use of the applicant's mark would, without due case, take unfair advantage of the opponent's reputation and that there would be dilution and tarnishing.

5. Under section 5(4)(a), the opponent relies on the use of the word **UBER** in the UK since 2012 in connection with a variety of goods and services. It claims that the use of the applied-for mark is capable of restraint under the common law tort of passing-off. It refers to an intention to pass off on the part of the applicant given that on his website he outlined his "hope to revolutionise the hospitality industry in the same way Uber has revolutionised the Taxi and Courier industry".

6. Under section 3(6), the opponent claims that the applicant must have been fully aware of the opponent's reputation and has actively tried to ride on the coattails of the opponent.

7. All of the opponent's marks were filed before the applicant's mark, so meaning that they qualify as earlier marks in accordance with section 6 of the Act. All of the marks save one (EUTM 010460442) were registered within the period of 5 years ending on the date the applicant's mark was published for opposition purposes, so meaning that the use conditions set out in section 6A do not apply; they may be relied upon for the specifications as registered. In relation to EUTM 010460442, the opponent made a

statement of use that this mark has been used in relation to all of the goods and services for which it is registered.

8. The applicant filed a counterstatement denying the various grounds of opposition. It did not put the opponent to proof of use in relation to earlier mark 010460442, so meaning that this mark may also be relied upon for its goods and services as registered. The applicant made a number of points in defence, as summarised below:

- That the reference on its website to Uber was “in reference to the disruptive business models to historic and existing practice in the relevant and unrelated business sectors”. The applicant accepts that the reference may have been confusing so it has now been removed.
- ChefUber is a matching service for freelance chefs and hospitality establishments.
- ChefUber is a single word – the capitalisation is for balance – “there is no element so there is no emphasis”.
- Uber is descriptive/non-distinctive in many dictionaries.
- The services are not delivery services, so there is no conceptual similarity with UberEats.
- There is already an UberChef in kitchenware sales so there is no reason to object to this application.
- There is no similarity in the business sectors of the parties.
- Items 7 and 8 [it is not clear what the applicant is referring to] is unreasonable.
- The claim to Uber is baseless and the opponent is using bullying tactics to lay claim and force people off.

- Reference by the opponent to its Google ranking is not relevant as Google rankings can be purchased.
- The opponent's statement regarding its brand character and reputation are just matters of opinion.
- Since 2008 there have been 150 trade marks registered containing UBER, 25 of which have been refused or withdrawn. A list of some Uber derivate marks is then given. It considers the opponent's statement [I assume its comments that it is pro-active in keeping the register and marketplace free of confusingly similar Uber marks] is inconsistent and made in bad faith.

9. Only the opponent filed evidence. This will be summarised to the extent necessary. Neither side requested a hearing. Both sides filed written submissions (the applicant's being filed at evidence stage). The opponent has been represented by Lane IP Limited, the applicant has represented itself.

Section 5(4)(a)

10. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

11. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and iii) damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Goodwill

12. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), where the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

13. The opponent’s evidence is given by way of witness statement by Mr Samuel Gutierrez, the opponent’s Director of Intellectual Property. UBER is a software application/service which allows users to request transportation services. There are numerous articles and website prints about the app/services. Basically, customers use

the app to request a ride (from an Uber partner driver) to a particular destination. The customer is given a quote and payment is made via the app. In terms of the position in the UK, the service was launched in 2012. Various exhibits from local and national press show that before the relevant date, customers could use UBER in at least the following major towns and cities in the UK: Birmingham, Belfast, Bristol, Cardiff, Edinburgh, Glasgow, Leeds, Leicester, London, Manchester, Liverpool, Nottingham, Newcastle, Sheffield and York. Annual turnover figures for the opponent's UK subsidiary (Uber London Limited) rose from over £11 million in 2014 to over £59 million in 2017. In 2017 there were 40k Uber partner drivers in London alone, with over 3.5 million users of the service. In 2015, there were more than 3 million Uber trips per month in London.

14. The evidence contains many other statistics. As many relate to the global business of the opponent, I do not record them here. However, I note that the UK-specific Twitter page has nearly 38k followers and that the analytics website App Annie "almost always ranks Uber's app as the number one "Maps and Navigation" app in the UK between 2014 and 2016". In its written submissions, the applicant states that the opponent's claim to the word UBER is baseless and the opposition represents a bullying tactic. It says the opponent's evidence contains merely press cuttings, web pages etc about the success of UBER. Whilst noting these comments, there is no submission as to why goodwill will not have been generated by the opponent. It is in my view absolutely clear that the opponent's business would have generated a very strong goodwill by the relevant date (the filing date of the application) associated with the name UBER in connection with its app and transport service.

15. The evidence also refers to the use by the opponent of other UBER derivative signs. In its pleaded case, it only entered the word UBER when identifying the sign the use of which was being relied upon. It did, though, go on to state in its statement of case that all of the marks it relied upon under section 5(2) had been used and that this contributed to its case. However, there is no material use in the UK of UberPool, UberPop and UberRush. There is some use of UberX (a sign which indicates that a standard car will be used as part of the transport services), but the use is less and it is difficult to see why this takes the opponent further forward.

16. Reference is also made to UberEats (paragraph 17 of the witness statement and Exhibit RG9) which is a food delivery service from local places near a person's location. The reference comes in an article from the Financial Times dated March 2017 which suggests that "Uber is expanding its restaurant delivery service UberEats to more than 40 towns and cities across the UK"; it appears that at the time of writing the article it was available in only three. The article records that UberEats is so far linked to more than 2000 restaurants in the UK. There is no evidence from the witness about whether the plan to expand this aspect of the business was followed through and what impact it had. I consider that UBEREATS will, at the relevant date, have generated some goodwill in connection with food (from third party restaurants) delivery services via an app, but the absence of more detailed evidence means that I cannot hold the goodwill is as strong as that for UBER *per se* in relation to transport.

Misrepresentation

17. The relevant test for misrepresentation was dealt with in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, where Morritt L.J. stated:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

18. In the same case, Morritt L.J. explained that it was the plaintiff's (in the case before me the opponent's) customers or potential customers that must be deceived:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

19. In a passing-off case, it is not necessary for the competing services to be similar. I note, though, what Millet L.J. stated in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie

although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any

member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”

20. There is clearly some similarity between the sign UBER and the applied-for mark ChefUber on a visual and aural level. There is also a degree of overlap in concept given that both use the meaning of the word UBER (a superlative) (although, I accept, as I say in more detail later, that not everyone will be aware of the meaning of the word) albeit the applied for mark also makes mention of a chef. In terms of where the opponent's goodwill lies (an app with associated transport services), this is, on face value, far removed from the recruitment type services the subject of the application. However, it is apparent from the applicant's counterstatement that the services applied for relate to what is described as a “matching service for freelance chefs and hospitality establishments”. It is fair to assume that the recruitment services it seeks are intended to cover this, or are ancillary services that relate to it in some way. It is also clear that

the intention was to mirror the way in which UBER operates. It matches freelance chefs and potential clients, similar in model to the matching of passengers and Uber partner drivers. There is no reason why the applied-for service could not be facilitated by the use of an app. In my view, the strong goodwill the opponent enjoys in association with the word UBER, together with the potential similarity in business model, will suggest to at least a substantial number of customers/potential customers that ChefUber is a new venture being offered by the undertaking responsible for the UBER app/transport service. The move from one to the other would not strike those members of the public as so unusual that it must be a different company offering the services.

21. The opponent submits that there was an intention on the part of the applicant to pass off, something which would reinforce my finding. However, there is insufficient evidence to suggest that the intention was to pass off, as opposed to an intention to bring to mind the UBER name. Irrespective, it does not follow that an absence of intention means that there is no misrepresentation. I also note the applicant's point that the word uber is descriptive and appears in a number of dictionaries, that the opponent has not opposed all UBER marks being registered, and that a number have indeed been registered. There is, though, no evidence of such other marks, let alone any evidence of actual use by others of UBER derivate marks (something which is far more important than marks simply being on the register). In terms of the descriptiveness points, the manner of use of UBER in ChefUber does not lend itself to being seen purely as descriptive matter. A substantial number of people will see UBER in this context as signifying a brand name, especially of the opponent.

22. I have considered whether my finding of misrepresentation should apply to all, or just some, of the applied-for services. This is because some relate to the recruitment of people other than chefs, and some are for recruitment consultancy services (and other ancillary services) as opposed to recruitment *per se*. However, I consider that the strong goodwill enjoyed by the opponent is sufficient still to inform a substantial number of members of the public that the services are those of the opponent. In any event, it is also clear that the applicant filed for the services as part of its desire to protect its chef-matching business model and, as such, all the services may be assumed to form part and parcel of its business offering.

Damage

23. In *Harrods Limited v Harrodian School Limited* Millett L.J. described the requirements for damage in passing-off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

24. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

25. Put simply, if the services provided by the applicant were not as reliable as those of the opponent, this could negatively impact upon members of the public availing themselves of the latter. Potential damage is made out. The section 5(4)(a) ground succeeds in full.

Section 5(2)(b)

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

“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.”

27. 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;

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

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

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

28. I will focus, for the time being, on whether there will be confusion with the opponent's UK registration 3171549. This is the mark on which the opponent exemplified areas of conflict between the goods/services. Of course, I appreciate that

these were just examples of conflict, so I will come back to the other earlier marks, to the extent required, later in this decision.

Comparison of goods/services

29. All relevant factors relating to the goods/services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”), Case C-39/97, stated at paragraph 23 of its judgment:

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

30. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

31. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM*, Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

32. The applicant seeks registration in relation to:

Class 35: Recruitment (Personnel -); **Recruitment advertising**; Recruitment and personnel management services; Recruitment and placement services; Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultancy services; Recruitment consultants in the financial services field; Recruitment of airline personnel; Recruitment of airport ground staff; Recruitment of computer staff; Recruitment of executive staff; Recruitment of flight personnel; Recruitment of high-level management personnel; Recruitment of personnel; Recruitment of temporary personnel; Recruitment of temporary technical personnel; Recruitment services; Recruitment services for sales and marketing personnel; **Advertising services relating to the recruitment of personnel**; Advisory services relating to personnel recruitment; Assistance relating to recruitment and placement of staff; Business recruitment consultancy; Consultancy and advisory services relating to personnel recruitment; Consultancy of personnel recruitment; Consultancy relating to personnel recruitment; Dissemination of information relating to the recruitment of graduates; Employment recruitment; Executive recruitment services; Human resources management and recruitment services;

Interviewing services [for personnel recruitment]; Management advice relating to the recruitment of staff; Model recruitment agencies; Office support staff recruitment services; Permanent staff recruitment; Personality testing for recruitment purposes; Personnel placement and recruitment; Personnel recruitment; **Personnel recruitment advertising**; Personnel recruitment agency services; Personnel recruitment consultancy; Personnel recruitment services; Personnel recruitment services and employment agencies; Professional recruitment services; Providing information relating to employment recruitment; Providing information relating to personnel recruitment; Providing recruitment information via a global computer network; Provision of advice relating to the recruitment of graduates; Provision of information relating to recruitment; Staff recruitment; Staff recruitment consultancy services; Staff recruitment services.

33. I have emboldened and underlined certain of the above terms for a particular reason. This is because the opponent's submissions refer to certain goods and services in its specification that it considers to be similar. It highlights that its class 35 specification contains the term "advertising" which consequently encompasses any advertising services applied for. I agree. The terms I have emboldened in the applied for list of services are identical on what is known as an inclusion basis¹, as they are all advertising services.

34. In relation to the services I have underlined, the opponent's specification (as it highlights in its submissions) contains the terms "business management and business administration". It says that this is similar to the applied-for recruitment services because this is a crucial aspect of managing/running a business. I agree that there is some similarity. A business management service will involve the day-to-day running of a business on behalf of another. Such management services will involve the recruitment and placement of personnel. There is therefore similarity of purpose. The services may well be offered to the same customers, through similar trade channels. I consider there to be a medium degree of similarity.

¹ See, for example, Case T- 133/05, of the General Court.

35. I will now go through the remaining applied-for services.

Personnel management services; Human resources management

36. I consider the above services to have a reasonably high degree of similarity to the opponent's business management and administration services. They all relate to providing a business with the running and management of particular functions, they could all be provided by the same undertakings and there is a degree of complementarity.

Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultancy services; Recruitment consultants in the financial services field; Advisory services relating to personnel recruitment; Business recruitment consultancy; Consultancy and advisory services relating to personnel recruitment; Consultancy of personnel recruitment; Consultancy relating to personnel recruitment; Management advice relating to the recruitment of staff; Personnel recruitment consultancy; Provision of advice relating to the recruitment of graduates; Staff recruitment consultancy services; assistance relating to recruitment and placement of staff; interviewing services [for personnel recruitment]; Personality testing for recruitment purposes; dissemination of information relating to the recruitment of graduates; Providing information relating to employment recruitment; Providing information relating to personnel recruitment; Providing recruitment information via a global computer network; Provision of information relating to recruitment

37. All of the above services relate to recruitment consultancy and the provision of information in respect of recruitment, or are services relating to recruitment. In my view, what I have said in paragraph 34 regarding recruitment *per se* is applicable here. In comparison to business management/administration there is a medium degree of similarity.

38. Given the above findings, it is not necessary to make any further findings in respect of the other goods/services of the earlier mark. They either have less similarity, or no similarity.

Average consumer and the purchasing act

39. 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. 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 average consumer of the contested services includes businesses. They could be using recruitment services to help find members of staff, or using consultancy and information services to seek advice on such matters. This is not a casual choice. The cost is unlikely to be low. I come to the view that such average consumer will pay an above average level of care and attention when selecting the services, although I do not place this at the highest degree of consideration. All of this applies in equal measure to management/administration services.

41. The average consumer could also be a member of the general public, looking for work and who wishes to use a recruitment service (or information/consultancy) to gain employment. This, again, is unlikely to be a casual selection, although in this case the choice is more likely to be made with an average degree of care, no higher or lower than the norm.

42. Marks in this field are likely to be seen on brochures, advertising material on the web etc., all of which suggests that the visual impact of the marks will play an important

role in the selection process and will likely take on most significance. However, I do not discount the potential for the verbal use of the marks through word-of-mouth recommendations etc. Aural similarity must not, therefore, be excluded from the assessment.

Comparison of marks

43. 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 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.”

44. 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. The marks to be compared are:

ChefUber v **UBER**

45. The earlier mark has just one element, so that is the only thing that contributes to its overall impression. The applied-for mark comprises the words Chef and Uber conjoined. The conjoining does not affect its ability to be seen as those two words.

Neither word stands out more than the other, so both make a roughly equal contribution to the mark. I bear in mind the opponent's comments that Chef is descriptive, and the applicant's comments about Uber's descriptiveness; I return to the significance of these points later.

46. From a visual and aural perspective, the commonality of Uber/UBER creates a degree of similarity. There is, though, a difference on account of the presence/absence of Chef. The case of the marks creates no difference because marks can be used in both upper, and upper- and lower- case lettering. I consider there to be a medium degree of similarity.

47. Conceptually, I accept, as a matter of fact, that Uber might appear in some dictionaries, as a superlative. However, there is no evidence of how well known and used that word is. Although I have heard of it, it does not strike me as a word which is obviously in common parlance. I come to the view that some average consumers may have heard of it, but others not. This means that for some consumers the presence of the word Uber/UBER creates a point of conceptual similarity, but this does not apply to everyone. The word Chef, on the other hand, is a well-known word, the absence/presence of which in the respective marks creates a point of distinction.

Distinctive character of the earlier trade mark

48. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”²

49. From an inherent perspective, the word UBER, as per the above findings, will be known by some, but not all. For those that have not heard of the word, they will regard it as highly distinctive, it would strike them as an unusual word.

50. For those that know of the word then it clearly makes a nod towards the quality of the goods/services. However, without knowing more about the degree of use and recognition of the word as a word, I cannot find that it only has a low level of inherent distinctiveness. I consider it to have a level of distinctiveness between low and medium.

51. In terms of the use made of the mark, this does not assist because I am considering the earlier mark in relation to services which do not correspond to the services for which the mark has been used.

Likelihood of confusion

52. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average

² C-342/97, paras. 22-23

consumer and determining whether they are likely to be confused. Confusion can be direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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”.

53. In my view, it is probable that that an average consumer paying the level of attention outlined earlier in this decision will notice the main difference between the marks (the presence/absence of the word Chef) and, so, would not directly confuse them, even when identical services are being considered. However, noticing the difference does not prevent indirect confusion. The opponent points out that Chef is a descriptive word and its combination with Uber would therefore not prevent it from being confused with its UBER mark. With one slight hesitation, which I will come to, I agree. In relation to the majority of the applied-for services, they could all relate to the recruitment (etc.) of chefs. In this regard, and whilst not all of the services are identical, the degree of similarity that does exist, coupled with the level of distinctiveness of the word UBER, would lead the average consumer to believe that ChefUber is some form of offshoot of the UBER business. This certainly applies to average consumers who do not know of the dictionary meaning of the word UBER; this is because it will strike

them as an unusual word, and the sharing of such a word in both marks will be put down to economic connection not coincidence. However, even for those who know of the meaning of the word, it is still distinctive and the combination with Chef would still lead to an assumption of economic connection.

54. My slight hesitation is that, for some of the services, it is difficult to see how they could relate to chefs, e.g. recruitment of computer staff. However, even though the use of the word Chef within ChefUber may be slightly odd and not obviously descriptive, that oddness means that Uber within that mark would stand as a clear and obvious independent element of the mark. Its identity to Uber, with its level of distinctiveness, would still lead the average consumer to assume that ChefUber and UBER must be related, irrespective of the addition of Chef. There is a likelihood of (indirect) confusion for all of the applied-for services in respect of earlier mark 3171549.

55. For sake of completeness, I comment on the other earlier marks:

- Earlier EUTMs 010460442 (**UBER**), 013004809 (**UBERX**), 014414221 (**UBERPOOL**) and 13009171 (**UBERPOP**) do not cover services in class 35. I accept that confusion may arise in relation to goods or services in other classes, but it is difficult to see what goods and services would give rise to similarity. Some of the marks cover “computer software” in class 9, with the opponent arguing that this is similar to recruitment services because the software could be for recruitment. However, there is no evidence which explains how, and in what way, software could relate to recruitment. There is insufficient basis, in my view, to find that there is any similarity. These earlier marks put the opponent in no better position, indeed, my view is that the opposition under section 5(2)(b) would have failed in relation to them.
- EUTM 13759394 (**UBEREATS**) presents a different scenario. It does cover services in class 35 (as per the UBER mark, the main focus of this ground thus far) and, as the opponent submits, the use of the word EATS gives the mark at least a food-related concept. I find that there would be confusion here. The

average consumer will note the common use of the word UBER and that both marks have a food related concept. Given the similarity between the services, the similarity between the marks, and the distinctiveness of the common element UBER, they will assume that the same (or related) undertaking is responsible for both.

- EUTM 015099278 is for the mark **UBERRUSH**. It also contains services in class 35. It is difficult to see how this earlier mark improves the opponent's position over and above UBER and UBEREATS. However, for the record, and although it is a more finely balanced outcome, the commonality of UBER within both marks is still likely to be put down to a shared economic connection.

Section 5(3)

56. Section 5(3) states:

“5(3) A trade mark which (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

57. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*.

58. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Saloman, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a

characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

Reputation

59. The opponent's submissions provide a large amount of detail and reference to its evidence to explain why its marks (it relies on the UBER marks) possess the requisite reputation. I have already touched on the evidence in the assessment made under section 5(4)(a) of the Act, so I will not repeat that here. In summary, I am easily persuaded that the opponent's UBER mark has a reputation (a strong one at that) in the field of transport apps/services.

The link

60. The factors that need to be considered are set out in paragraph 58(d), most of which have been assessed already. One point to bear in mind is that any overlap in the services must be based on the reputed services (essentially transport services), as opposed to the full width of the opponent's specification. I consider the reputed services to be dissimilar to those applied for. That said, the similarity between the marks, coupled with the strong reputation and distinctiveness (through use) of the earlier marks, is in my view more than sufficient to bring the earlier mark to mind.

61. In relation to unfair advantage, I have found (under section 5(4)(a)) that a substantial number of the public would believe that the services offered under the applied-for mark were being offered by the opponent (or were in some way linked to it). This in my view creates an inevitable finding that the applied-for mark does take advantage of the earlier mark's reputation, as the opponent submits. However, even if no such assumption were made, I still believe that such an advantage would be taken. This is because the average consumer would assume that the services are meant to operate and work in the same or similar way to those of the opponent. Sending such a message (by making use of the opponent's mark in the applicant's mark) will provide an advantage because the applicant will save on marketing costs and it will create an immediate impact in the market via an investment in promotion that it did not have to make itself. They will still be gaining a leg up. In terms of whether this is unfair, it is clear in my view that the applicant, at the very least, wanted to use the name Uber to send a message to its potential customers that it operates like UBER. Although the applicant's website may now have been changed, going to the trouble of explaining that the desire was to revolutionise the market in the same way UBER had, in circumstances where it uses Uber in the applied-for mark, leads to no other plausible conclusion, irrespective of the applicant's point that the word uber has some descriptive connotations. This in my view makes any advantage gained unfair. The ground under section 5(3) succeeds.

62. Given the opponent has succeeded under this ground, I comment only briefly about the two other forms of potential damage, dilution and tarnishing.

63. I reject the claim of tarnishing. Absent evidence to show that the applied for services are low in quality or otherwise that the applicant's use of the mark could have negative characteristics, the test is essentially whether there is something inherent to the nature of the applied for services which could negatively rub off on the opponent. I see nothing that even gets close. That leaves dilution. This argument has more legs because as things stand there is only evidence of one UBER based brand (the applicant mentions others but provides no evidence), it has a strong reputation in the name and the use of the name by the applicant will at the very least cause people to wonder if the businesses are connected. The result of all this is that the distinctiveness of the opponent's brand could start to become diluted.

Section 3(6)

64. Section 3(6) of the Act provides for the refusal of a trade mark "...if or to the extent that the application is made in bad faith". The law was summarised by Arnold J in the *Red Bull* case, as follows:

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35]. 2 *Red Bull GmbH v Sun Mark Ltd & Anr* [2013] ETMR 53 20

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185]. 21

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, *inter alia*, Joined Cases C- 456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)".

65. Given the other grounds have so far succeeded, I deal with this ground only briefly. It is clear that the applicant knew of the opponent's use of UBER. I have also found that the applicant was attempting to use that word Uber as part of his name to inform consumers that his services use a similar business method. There is insufficient evidence to find that the applicant was intending to mislead consumers. In my view, the applicant's actions would be perceived as naive, but not as an act of bad faith. He was attempting to get close, too close, but that is no reason itself to uphold this ground.

Conclusion

66. The opposition succeeds. As such, and subject to appeal, the applied-for mark is refused registration.

Costs

67. I have determined these proceedings in favour of the opponent. It is, therefore, entitled to an award of costs. I award the applicant the sum of £2000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee: £200

Considering the statement of case and filing a counterstatement: £300

Considering and filing evidence: £1000

Preparing written submissions: £500

68. I therefore order Tim Mackew to pay Uber Technologies, Inc. the sum of £2000. The above sum should be paid within 28 days of the expiry of the appeal period or, if there is an appeal, within 28 days of the conclusion of the appeal proceedings.

Dated 12 August 2019

Oliver Morris

For the Registrar

the Comptroller-General