

O-283-20

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3259395
BY WE BUY TEK LIMITED TO REGISTER THE TRADE
MARK**



IN CLASSES 9 AND 35

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 411031 BY
GROUP CEX LIMITED**

AND

**IN THE MATTER OF REGISTRATION NO. 3139077 IN THE NAME OF GROUP
CEX LIMITED IN RESPECT OF THE TRADE MARK IN CLASSES 9 AND 41**

WEBUY.COM

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 502386 BY WE BUY TEK LIMITED**

1) I issued a decision (BL O-277-20) dated 12 May 2020 (“the previous decision”) in respect of these proceedings on behalf of the Registrar. By e-mail on the same day, Wilson Gunn, on behalf of We Buy Tek Limited (“Party B”) stated:

“Please can you check the attached decision. My understanding is that the invalidation file by We Buy Tek Limited has failed AND the Opposition filed by Group CEX has failed.

But para 67 states that 5(2)(b) succeeds in the opposition. I think that this is a mistake and that it should read ‘fails’. This is because in para 60 the hearing officer states that there is no direct confusion and in para 66 states that there is no indirect confusion.

At para 75 it states that the invalidation fails and the opposition fails and that the application may proceed to registration. But I think that the party A and B references have been mixed up.”


2) I have reviewed the previous decision and identified the points identified by Wilson Gunn as administrative errors in the decision. This supplementary decision corrects these, as follows (deletions shown in strike out and corrections shown in bold):

67) In summary, having taken account of all the factors necessary for the global analysis, I find that the section 5(2)(b) ground ~~succeeds~~ **fails** in its entirety.

75) Party **A B**’s application to invalidate Party **B A**’s mark failed in its entirety. Party **B A**’s opposition to Party **A B**’s application to register its mark has also failed in its entirety and Party **A B**’s application may proceed to registration.

3) My review of the previous decision also identified numerous other typographical errors where the parties were referred to incorrectly. This supplementary decision also corrects these as shown below:

44) The respective marks are:

Party B A's mark	Party A B's mark
WEBUY.COM	

45) Party B A's mark consists of the words "WE" and "BUY" conjoined and appearing directly before the high level domain name ".COM". As discussed earlier, the ".COM" merely indicates that the mark consists of an internet address and the absence of a space between the words "WE" and "BUY" does not create any additional distinctive character. Whilst the distinctive character of "WEBUY" alone is very low, I find that the distinctive character of the mark resides in the combination of this term and the ".COM" element. Party A B's mark consists of an internet address and a device that, in context, is likely to be perceived as an electronic device such as a mobile phone. The mark is presented in such a way as to have three distinct visual elements. The first is the words WE and BUY conjoined, the second is the words "TEK.CO.UK" in white letters placed in a blue rectangular background and the third is the device. This get-up contributes to the distinctive character of the mark. The distinctive character of the verbal elements is only low, but none the less, it is these two elements that are dominant to an equal measure within the mark.

46) Visually, both marks present as internet addresses and both share the conjoined words “WEBUY”. They differ in that the get-up of Party A **B**’s mark is absent in Party B **A**’s mark as is the device. Further, they differ in that they include different high level domain names, namely “.COM” and “.CO.UK” respectively. As I noted above the get-up of Party A’s mark results in the conjoined “WEBUY” forming one of three visual elements. Taking all of this into account, I conclude that they share a medium level of visual similarity.

47) Aurally, the marks are both likely to be referred to as the internet addresses “we buy dot com” and “we buy tech dot co dot uk”. Consequently, they share the same first two syllables and the third syllable of Party B **A**’s mark also occurs in Party A **B**’s mark (as the fourth and sixth syllables). However, they are different in length, one containing four syllables, the other seven. The get-up of Party A **B**’s mark will not contribute to its aural characteristics. Taking all of this into account, I conclude that they share a medium level of aural similarity.

48) Conceptually, both marks present as an internet address, albeit with different high-level domain names. The “.co.uk” high-level domain name carries with it a message that the trader is a UK company. The “.com” high level domain name carries with it a message that the trader is a company, but any indication to location is absent. The presence of the high-level domain names identifies both marks as referring to online traders. Party B **A**’s mark creates a general message that the trader buys things. Party A **B**’s mark imparts a similar but more focussed message that the trader buys tech(nology). This is reinforced by the device of a technological item, possibly a mobile phone. Taking account of these similarities and differences, I conclude that the respective marks share a medium level of conceptual similarity.

54) Party A submits that its mark also benefits from an enhanced level of distinctive character associated with its extensive reputation as a high street brand. Its evidence illustrates that:

...

- It is stated that “whilst [Party B A’s] brand and company name is CEX, [it has] actively promoted [its] trade mark WEBUY.COM”¹ and is promoted independently from the CEX mark being identified separately on the hoardings of its shops². Examples of promotional material show a prominent CEX device mark that sometimes has WEBUY.COM appearing in smaller text directly below it and in other examples WEBUY.COM appears at the bottom right of the page³. Examples of the nature of the use are shown below:

55) Mr Orchard, in his evidence, also relied upon the fact that the EUIPO and accepted Party B A’s mark on the basis of acquired distinctiveness, stating that “[t]he evidence of use submitted is sufficiently convincing to support a finding of acquired distinctiveness...”⁴. The evidence presented to the EUIPO, dated 3 August 2018, is also provided⁵. This evidence related to use across the EU, however, the highlights of this (insofar as it relates specifically to the UK and supplements the evidence already referred to) are summarised below:

...

- Party B A operates a *YouTube* channel that has had over 45 million views since 3 October 2013. A screen shot shows its stylised CEX

¹ Mr Orchard’s first witness statement, para 7

² Ditto, para 8

³ Exhibit FO4

⁴ See letter from the EUIPO at Exhibit FO201

⁵ At Exhibit FO202

mark appearing on the top left of the screen with “WEBUY.COM” appearing directly underneath;

- In the UK, Party B A’s website receives 20 million visits per year (according to Google Analytics)

56) Party B A claims that whilst its brand and company name is CEX, it has actively promoted its mark WEBUY.COM. The evidence does not support a claim that it has been promoted as anything other than as an internet address. Merely because it appears independently to its CEX mark on hoardings does not necessarily indicate that it is intended to function as a mark or that it is perceived by the relevant public as anything other than internet address of Party B A. In respect of the promotional material WEBUY.COM often appears at the bottom right corner of the page in the position where contact details are often located. Such use reinforces use as being in the form of an internet address. Finally, there is no use shown other than with or in proximity of Party B A’s CEX mark. Whilst this, in itself, does not necessarily preclude a sign performing as a secondary mark (in this case, secondary to the CEX mark) the manner of the use and the nature of the mark as an internet address leads me to conclude that, in this case, it has not functioned independently as a trade mark but rather as an address from which Party B A provides its CEX branded services.

60) Firstly, the additional get-up present in Party A B’s mark is sufficient to avoid a likelihood of direct confusion. These visual differences will be immediately noticed by the relevant public and it is not likely that one mark will be mistaken for the other. This finding does not appear to be challenged by Party B A and at the hearing, Mr Silcock focused his submissions on the likelihood of indirect confusion.

61) Mr Silcock pointed to Party B A’s mark having the status as a high street brand and argued that this increases the likelihood of confusion. I have found

that its mark does not benefit from an enhanced level of distinctive character and, therefore, this argument does not assist Party B A.

70) When considering the issue of enhanced distinctive character, I found that the nature of the use combined with the nature of the mark itself was such that the relevant public is likely to perceive the mark as an internet address and not as an indicator of origin. For the same reasons, Party B A's undoubted goodwill does not attach to the earlier mark. For this reason, the ground based upon section 5(4)(a) fails.

Dated this 18th day of May 2020

**Mark Bryant
For the Registrar,
the Comptroller-General**