

O/623/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3420816

BY COLOURFULL LTD

TO REGISTER THE TRADE MARK:



IN CLASSES 35 AND 41

AND

OPPOSITION THERETO UNDER NO. 418510 BY

ROMANIAN SOFTWARE SRL

Background and pleadings

1. Colourfull Ltd (“the applicant”) applied to register the trade mark below¹ in the UK on 13 August 2019.



2. It was accepted and published in the Trade Marks Journal on 23 August 2019 in respect of the following services:

Class 35 Consultancy and advisory services for business management; Consultancy and advisory services in the field of business strategy; Consultancy and advisory services relating to business management; Consultancy and advisory services relating to personnel management; Consultancy relating to business management; Consultancy relating to business management and organisation; Consultancy relating to business organisation; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Consulting services in business organization and management; Human resources consultancy; Human resources consultation; Human resources management; Human resources management and recruitment services.

Class 41 Adult education services relating to management; Education and training; Education and training consultancy; Education and training services; Education and training services in relation to business management; Educational services relating to management; Entertainment; Entertainment in the nature of

¹ Due to a technical error, the mark was originally published with a black background and this was corrected retrospectively.

ethnic festival; Entertainment provided via the internet;
Multimedia publishing; Workshops for cultural purposes;
Workshops for educational purposes; Workshops for training
purposes; Writing and publishing of texts, other than publicity
texts; Writing services for blogs.

3. ROMANIAN SOFTWARE SRL (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the two classes of services in the application, Class 35 and Class 41. The opponent relies upon its EU trade mark, shown below, filing number 016002677, which has a filing date of 4 November 2016 and for which the registration procedure was completed on 17 February 2017.



4. The following goods and services are relied upon in this opposition:

Class 9 Recorded content; Software; Mobile apps; Application software.

Class 35 Business analysis, research and information services; Business assistance, management and administrative services; Commercial trading and consumer information services; Advertising, marketing and promotional services; Collection and systematization of business data; Market studies; Updating of business information on a computer data base; Human resources management and recruitment services; Administrative data processing; Business consultancy and advisory services.

Class 42 IT services; Science and technology services; Testing, authentication and quality control; IT consultancy, advisory and information services; Software development, programming and implementation.

5. In its notice of opposition, the opponent argues that the respective goods and services are identical or similar and that the marks are similar.
6. The applicant filed a counterstatement denying the claims made.
7. Neither party filed any evidence in this case.
8. No hearing was requested and so this decision is taken following a careful perusal of the papers. The applicant filed a written submission in lieu of a hearing. The opponent did not file a written submission.
9. The applicant is represented by Stratagem Intellectual Property Management Limited and the opponent is represented by Urquhart-Dykes & Lord LLP.

DECISION

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

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

(a)...

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

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

11. An earlier trade mark is defined in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

...”

12. Given the respective filing dates, the trade mark upon which the opponent relies qualifies as an earlier trade mark. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

13. 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:

(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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

14. The goods and services in question are as follows:

Opponent's goods and services	Applicant's services
<p><u>Class 9</u></p> <p>Recorded content; Software; Mobile apps; Application software.</p>	
<p><u>Class 35</u></p> <p>Business analysis, research and information services; Business assistance, management and administrative services; Commercial trading and consumer information services; Advertising, marketing and promotional services; Collection and systematization of business data; Market studies; Updating of business information on a computer data base; Human resources management and recruitment services; Administrative data processing; Business consultancy and advisory services.</p>	<p><u>Class 35</u></p> <p>Consultancy and advisory services for business management; Consultancy and advisory services in the field of business strategy; Consultancy and advisory services relating to business management; Consultancy and advisory services relating to personnel management; Consultancy relating to business management; Consultancy relating to business management and organisation; Consultancy relating to business organisation; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Consulting services in business organization and management; Human resources consultancy; Human resources consultation; Human resources management; Human resources management and recruitment services.</p>

<u>Class 42</u>	<u>Class 41</u>
IT services; Science and technology services; Testing, authentication and quality control; IT consultancy, advisory and information services; Software development, programming and implementation.	Adult education services relating to management; Education and training; Education and training consultancy; Education and training services; Education and training services in relation to business management; Educational services relating to management; Entertainment; Entertainment in the nature of ethnic festival; Entertainment provided via the internet; Multimedia publishing; Workshops for cultural purposes; Workshops for educational purposes; Workshops for training purposes; Writing and publishing of texts, other than publicity texts; Writing services for blogs.

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 of its judgment that:

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

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

17. 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."

18. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

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

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“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 for 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.”

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

22. 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.”

While 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.”

23. Only in the case of one term in class 35, “Human resources management and recruitment services,” does the applicant accept that there is an “overlap”. In all other cases, it denies that there is similarity between the respective goods and services.

24. The opponent regards the respective class 35 services to be identical or highly similar. It also considers the applicant’s class 41 services to be in conflict with its class 9 and class 42 goods and services.

25. I will now make my comparison with reference to the applicant’s services.

Class 35

26. I group the following of the applicant’s class 35 terms together: “Consultancy and advisory services for business management; Consultancy and advisory services in the field of business strategy; Consultancy and advisory services relating to business management; Consultancy relating to business management; Consultancy relating to business management and organisation; Consultancy relating to business organisation; Consulting services in business organization and management.” All of these terms relate to business consultancy/advice of one form or another and I consequently regard all of these services as *Merit* identical to the opponent’s more general category of “Business consultancy and advisory services” i.e. the services in this instance which are designated by the applicant are included in the opponent’s more general category. If I am wrong about this, the relevant

terms are highly similar to the opponent's "Business consultancy and advisory services."

27. I group the following of the applicant's class 35 terms together: "Consultancy and advisory services relating to personnel management; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Human resources consultancy; Human resources consultation." I consider "personnel" to be synonymous with "human resources". All of the relevant terms relate to consultancy/advice, either in personnel or human resources. Comparing these terms with the opponent's "Human resources management and recruitment services," the potential users are the same, as are the likely trade channels. However, the nature and uses are different in that consultancy is an advisory service and management services involve the delivery of a service on an organisation's behalf. There could be a degree of competition involved as the average consumer may make a choice between availing itself of consultancy/advice to assist in the running of its own HR/personnel services, or it may alternatively wish to outsource to a third party instead. There is a degree of complementarity. Consultancy/advice can be important for management services, in that consultancy can lead to a recommendation to outsource to, potentially, the same company. It is also important to recognise that the types of service have the same broad purpose – to help to run and provide assistance to an organisation's HR/personnel function. Overall, I see the above services as similar to a higher than medium degree, but not similar to the highest degree.

28. The applicant's "Human resources management" and "Human resources management and recruitment services" are identical to the opponent's "Human resources management and recruitment services."

29. Where the opponent's remaining class 35 terms have not been discussed, I do not see them putting the opponent in a better position, similarly with the opponent's other goods and services in class 9 and class 42. None of this assists the opponent any further.

Class 41

30. The applicant's "Adult educational services relating to management," "Education and training services in relation to business management" and "Educational services relating to management" have some potential linkage with the opponent's "Business assistance, management and administrative services" and "Business consultancy and advisory services." Management education and training services differ in their nature from business management/consultancy services. The trade channels would be the same whereby companies offer a broad spectrum of services which cover management education and training and business management/consultancy. It could also be said that management training and business management/consultancy share the same purpose of improving business performance. To that extent, competition may arise when the average consumer chooses between management training and business management/consultancy. There could be a degree of complementarity in that the deployment of business management/consultancy will sometimes give rise to identifying a need for management training. The user community would tend to be the same. Overall, I consider these services to be similar to a medium degree.
31. The applicant's broader "Education and training; Education and training consultancy" and "Education and training services," include and cover training/education relating to management (as assessed above) and, in the absence of any fall-back specification, the same outcome applies. I use the same rationale for the applicant's "Workshops for educational purposes" and "Workshops for training purposes". I find all of these services to be of a medium degree of similarity when compared with the opponent's "Business assistance, management and administrative services" and "Business consultancy and advisory services".

32. The applicant's "Workshops for cultural services" are further removed than workshops for educational or training purposes. Cultural services might be used in the context of workplace culture, but they could equally be interpreted as referring to the performing arts. But, even on the basis of the former, the similarity of purpose, and resultant competition and complementarity, is much weaker than the terms assessed in the previous two paragraphs. I therefore consider these services to be of low similarity when compared with the opponent's "Business assistance, management and administrative services" and "Business consultancy and advisory services".
33. The applicant's "Entertainment provided via the internet" service has a connection to the opponent's class 9 goods "Recorded content". This is broad term, albeit one that is capable of interpretation. In my analysis, it covers all content, which, in the internet age, is any content stored in a digital file as well traditional storage media like CDs and tape. This interpretation could be narrowed somewhat in that "content" in modern parlance is often taken to mean specifically created web pages, music, television and films that are available on a given provider's website. In any event, when viewed with the other opponent's terms set out here, it is difficult to conceive of somebody offering an entertainment service over the internet that did not rely on one or more of the opponent's goods in question. The entertainment via the Internet could be by way of streamed content as opposed to downloading the digital file comprising that content. There is consequently a high degree of complementarity (the content itself is important for the subsequent stream) and an element of competition (a consumer may choose between streamed entertainment content or downloading the digital file). The trade channels will also be highly similar. "Entertainment provided via the internet" differs in nature from the digital (or physical) file although the overall purpose is highly similar. Overall, I see a medium degree of similarity in this case. I have not dealt with the opponent's arguments based on software and apps here because, while there may be some similarity, this is likely to be of a lower degree.

34. The applicant's category of "Entertainment" covers and includes entertainment via the internet (as assessed above), and in the absence of any fall-back specification, the same outcome applies. I still consider the service and goods in this case to have a medium degree of similarity.
35. The applicant's "Entertainment in the nature of ethnic festival" could also involve recorded content, for example, the festival activities being provided virtually on a website. Such entertainment would, consequently, overlap with the opponent's goods (as discussed above). I therefore consider the service and goods in this case to have a medium degree of similarity.
36. The applicant's "Multimedia publishing" has potential overlap with the opponent's "Recorded content". It differs in nature to the extent that multimedia publishing is the professional process of creatively compiling and editing content and enhancing its presentation and distributing it through a variety of electronic media, while the opponent's goods provide finished content. There is a degree of complementarity as the content and the publishing often go hand in hand and the publisher's name is often associated strongly with the content published so that the relevant publics will think that the same economic entity is responsible for the publishing service and the opponent's goods. The overall purpose is to get end content to the end user. I find the respective service and goods to be similar to a medium degree. The same applies to the applicant's "... publishing of texts, other than publicity texts". I see no greater link with the applicant's software and apps.
37. The applicant's "Writing services for blogs" differs in nature to the opponent's recorded content to the extent that writing for blogs is the professional process of creating written content for blogs, while the opponent's goods provide finished content (albeit possibly including end product blogs) with a variety of purposes. The owners of blogging websites will use writing services for blogs, while the customer base for the opponent's goods will be the general public consuming the content. There is no material competition

from what I can see and, while it could be said that there is a connection or importance between a blog writing service and recorded content in the nature of blogs, there is no evidence to suggest that that it is in such a way that customers may think the responsibility for those goods lies with the same undertaking. I find no, or only a very low degree, of similarity. The same applies to the applicant's "Writing ... of texts, other than publicity texts".

38. The opponent's class 35 and class 42 services have not been discussed here as I do not see any of them putting the opponent in a better position than comparison with its class 9 goods.

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 respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

40. The applicant states that the market for business management services is a specialised one and that consequently any purchase would not be made casually. It argues that the "relevant public" would pay particular attention during the purchasing process.

41. The opponent makes no comment on the average consumer.

42. My analysis leads me to the view that, in many instances in this case, the average consumer will be a professional person in search of short-term or medium to long term support in the field of business and human resources management and consultancy, or education and training, or publishing and writing services. Short-term purchases will require consideration of terms and conditions and invoices, and medium to long term arrangements will usually involve entering into a formal contract. Cost will be a significant factor as will an analysis of quality standard, so the purchasing decision will be one over which there will be a period of deliberation. I therefore take the view that the average consumer will pay a reasonably high degree of attention where these services are involved. However, in respect of the applicant's entertainment services, the average consumer will be a member of the public who will pay no more than a medium degree of attention. While some of the services could involve consideration in regard to booking a ticket, or taking out a subscription, many transactions will be one-off purchases made without extensive deliberation.

43. There might be a verbal element in preliminary dialogue about recommended suppliers of business and human resources management and consultancy services, education and training, and publishing and writing services. However, visual scrutiny of the applicant's and opponent's marks on websites and marketing literature will predominate and will become even more important as correspondence is entered into and contracts are drawn up. Word of mouth could form an element of the purchasing process for entertainment, but visual selection would still predominate in these cases.

Comparison of the trade marks



44. 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.”

45. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

47. The applicant makes reference to there being a “distinctive device” in the opponent’s mark. It notes the different spellings of the words “color” and “colour”. It considers there to be two separate words, “colour” and “full”, in its

mark. It regards the words in the opponent's mark as having six syllables and the words in its mark as having three syllables. It states that the words in the applicant's mark are presented in different colours, while the wording in the opponent's mark is in plain black text. It comments on ".hr" as a point of differentiation. The applicant contends that, visually, aurally and conceptually, the average consumer is unlikely to perceive similarity between the two marks and that no likelihood of confusion exists between them.

48. While recognising the variations in spelling and the presence of ".hr" in its mark, the opponent considers the colour range and the arrangement of letters in the two marks to be visually similar. Aurally, the opponent sees the most likely pronunciation of its mark to be *colorful-h-r* without reference to the presence of a "dot" or full stop. It contends that this would render the first part – *colorful* - aurally identical to the applicant's *colour-full*. It considers the marks to be the same conceptually, based upon the dictionary definition of the word "colourful". It also notes that, for many English speakers, the letters "hr" are a well-used abbreviation for the term "human resources". Overall, the opponent states that the marks are highly similar.

49. I set out my analysis below.

50. The opponent's mark consists of the words "colorful" and "hr" in lower case bold black type, separated by a magenta dot or full stop, below a logo consisting of a series of overlapping circles of various sizes and in various colours. The word "colorful" is the American English spelling of the British English "colourful". The word "hr" would most likely be read as a well-known abbreviation for "human resources", albeit the letters are not capitalised. It could also be viewed as the country code suffix of a website. It is also possible, although less likely, that it could just be read as initial letters without any particular meaning. While the words are smaller than the logo, one's eye is drawn to the word element given that it can be read. The word element is not tiny by comparison to the picture. Consequently, I consider the two

elements (the words and the device) to play an equal role in the overall impression of the mark.

51. The applicant's mark consists of the words "colour" and "full" in lower case.

The word "full" is a half line space below "colour" and the "f" in "full" overlaps with the "ur" in "colour". If the words were read as one word, "colourfull", that would be an incorrect spelling of the British English "colourful". "Colour" is in multi-coloured text, all the colours and shades of which are present in the opponent's logo. The word "full" is in dark blue and the right-hand "branch" of the letter "f" is missing. The typeface is the same throughout. The words are on a plain background. The applicant's mark does not have a figurative element. It is the words that predominate the mark, however, the stylisation of the words still plays a role in the overall impression of the mark.

52. Visually, the marks contain the highly similar words "colorful" on the one hand and "colour full" on the other. They also have colours in common. However, the complete wording in the opponent's mark is "colorful.hr" whereas the applicant's complete wording is "colour full" and the fact that the word "hr" is present in the opponent's mark and absent in the applicant's mark is of relevance. The words in the respective marks are stylistically different, although the stylistic differences are not of major importance.

53. Continuing the visual comparison, the opponent's mark contains a logo, overlapping circles of various sizes and colours. By contrast, the applicant's mark does not contain a separate figurative element, simply having a stylised version of the words it is comprised of. The colourful nature of the logo reinforces the word "colorful" in the words "colorful.hr". The colourful text in the word "colour" in "colour full" reinforces the word "colour". Overall, I find the marks to be visually similar to a medium degree.

54. Aurally, the words "colorful.hr" in the opponent's mark will most likely be pronounced by the average consumer as *colorful-h-r* i.e. without the full stop. Alternatively, although less likely, the average consumer might say *colorful-dot-h-r*. The words "colour full" in the applicant's mark are phonetically

different when compared with the complete wording “colorful.hr” on either formulation. Even allowing for the words “colour full” being two separate words, they are aurally identical to “colorful”. If I am wrong, they are at least highly similar. Consequently, overall, I find the marks to be aurally similar to a higher than medium degree, but not similar to the highest degree.

55. Conceptually, the words “colorful.hr” could give rise to two concepts. The first possibility is that the suffix “.hr” stands for “HR” as in human resources, or some other initial letters, and that the first word, “colorful” is saying that the “HR” referred to is colourful, either literally or metaphorically. The second is that the quality of colourfulness, either literally full of colour, or in the sense of being vivid or lively in character, is just generally conceptualised and the “.hr” is simply the country code (or some other designator) for the proprietor’s associated website.

56. The words “colour full” simply give rise to the concept of colourfulness, either literally full of colour, or in the sense of being vivid or lively in character.

57. The use of colour in the opponent’s logo supports the concept of colourfulness in the opponent’s words. The overlapping circles in the opponent’s logo are neutral – they do not give rise to a different or conflicting concept. The use of colour in the stylisation of the applicant’s words supports the concept of colourfulness in the applicant’s mark.

58. Overall, the quality of colourfulness, either literally full of colour, or in the sense of being vivid or lively in character, is the key concept of both marks, even if the opponent’s colourfulness related to human resources or a country code. Conceptually the marks are highly similar.

Distinctive character of the earlier mark

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

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

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

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

61. I must make an assessment of the inherent distinctive character of the earlier mark. As noted above, I consider it likely that “hr” in the earlier mark would be viewed by the average consumer as a reference to human resources or a factual country code descriptor for a website. The word “colourful” is not descriptive nor suggestive of the goods and services for which the mark is registered. The colourful logo of overlapping circles, also not having any suggestive or allusive characteristics. However, the words and associated

logo are not highly distinctive in the way that they might be if one was dealing with an invented word. Consequently, I consider the mark to be inherently distinctive to a medium degree. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks², the words “colorful” / “colour full”. To that extent, I confirm that my view is that that the word is inherently distinctive alone to at least a medium degree.

Likelihood of confusion

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

63. I have found the parties’ marks to be visually similar to a medium degree and aurally similar to a higher than medium degree, but not similar to the highest degree. I regard the two marks as conceptually highly similar. I have identified the average consumer to be a professional person in relation to

² See, *Kurt Geiger v A-List Corporate Limited*, BL O-075- 13

business and human resources management and consultancy, or education and training, or publishing or writing services and a member of the public in the context of entertainment. While consideration of the services could involve an aural component, the predominant factor would be visual. I have concluded that the average consumer will be a professional person who will pay a reasonably high degree of attention when purchasing business and human resources management and consultancy, or education and training, or publishing and writing services. Where the purchase is of entertainment services, I have concluded that the average consumer will be a member of the public who will pay no more than a medium degree of attention. I have found the parties' goods and services to range from similar to no, or only a low degree, to identical (or, if I am wrong, highly similar). I have found the opponent's mark to have a medium degree of inherent distinctive character.

64. I consider that there are sufficient differences between the marks to avoid them being mistakenly recalled as each other. This is notwithstanding the principle of imperfect recollection and recognising that the lower case words "colorful" and "colour full" are present in the parties' respective marks, and that I consider those words to be the key contributors to the finding that the marks are highly similar conceptually, together with some conceptual reinforcement from the colours that are present.

65. The words in the marks are laid out differently, but, more notably, the complete words in the opponent's mark are "colorful.hr" which are different from "colour full", both visually and aurally. It is also an important factor that the opponent's mark contains a device consisting of multiple overlapping circles of various sizes and colours, while the applicant's mark has no device. These are notable differences, particularly the device element, which are likely to be recalled by the average consumer. I am therefore satisfied that there is no likelihood of direct confusion, even in relation to identical services.

66. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as

the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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.”

67. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will

also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

68. The words “colorful” and “colour full”, albeit spelled differently, are highly similar visually and identical aurally or, if I am wrong, are at least highly similar aurally. These words, “colorful” / “colour full” are the key components of a finding that the marks are highly similar conceptually. The presence of the word “hr” in the opponent’s mark is most likely to be regarded as an abbreviation for human resources, or could be a website country code, and, thus, even if this element is noted, this could be seen as a non-distinctive addition. The presence of multiple colours in each of the marks reinforces the concept of colourfulness.

69. Looking at the identical (or, if I am wrong, highly similar) services, those which are similar to a higher than medium degree, and those which are of medium similarity, I consider that the various factors set out above will lead

the average consumer to conclude that the parties' marks indicate goods and services sold by the same or economically linked undertakings. This is the case even where I consider the average consumer to be reasonably highly attentive. The differences that exist between the marks will be seen as symptomatic of a brand variation. I therefore consider that there is a likelihood of indirect confusion in respect of services which I have found to be identical (or, if I am wrong, highly similar), those which are similar to a higher than medium degree, or those of medium similarity. It is a step too far to find confusion between the marks where the services are of a low degree of similarity when the various factors are considered as part of the multi-factorial test that I must apply.

CONCLUSION

70. The opposition has succeeded in relation to the following services, for which the application is refused:

Class 35 Consultancy and advisory services for business management; Consultancy and advisory services in the field of business strategy; Consultancy and advisory services relating to business management; Consultancy and advisory services relating to personnel management; Consultancy relating to business management; Consultancy relating to business management and organisation; Consultancy relating to business organisation; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Consulting services in business organization and management; Human resources consultancy; Human resources consultation; Human resources management; Human resources management and recruitment services.

Class 41 Adult education services relating to management; Education and training; Education and training consultancy; Education and training services; Education and training services in relation to

business management; Educational services relating to management; Entertainment; Entertainment in the nature of ethnic festival; Entertainment provided via the internet; Multimedia publishing; Workshops for educational purposes; Workshops for training purposes; Publishing of texts, other than publicity texts.

71. The application will proceed to registration, subject to appeal, in respect of the following services:

Class 41 Workshops for cultural purposes; Writing of texts, other than publicity texts; Writing services for blogs.

COSTS

72. The opponent has been largely successful in its opposition. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to the opponent as below. My award reflects the fact that the opponent was not wholly successful.

Official fees:	£100
Preparing the Notice of Opposition:	£200
Total:	£300

73. I order Colourfull Ltd to pay ROMANIAN SOFTWARE SRL the sum of £300. 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 11th day of December 2020

JOHN WILLIAMS
For the Registrar