

O/537/21

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001478123
DESIGNATING THE UNITED KINGDOM
BY FLOWBIRD TO PROTECT**



IN CLASSES 9, 35, 36, 37, 38, 39 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418791
BY APCOA PARKING HOLDINGS GMBH**

BACKGROUND AND PLEADINGS

1. FLOWBIRD ('the applicant') applied to protect the trade mark



on 25 October 2018 by way of an International Registration ('IR') designating the United Kingdom ('UK'). The applicant claimed priority from its French application dated 27 April 2018. It was accepted and published in the UK Trade Marks Journal on 1 November 2019 in classes 9, 35, 36, 37, 38, 39 and 42, covering the following goods and services:

Class 9: *Electronic terminals of information, of sale of goods and/or services; remote recognition terminals enabling the debiting of services sold; interactive information terminals; electronic machines for dispensing parcels and/or goods; electronic parking terminals including electronic terminals of car parks; memory cards intended for use with parking pay points; parking meters including electronic memory parking meters; parking meters operated by a magnetic card, coins or tokens; parking meters operated by electronic memory cards; parking meters for multi-media communication; parking meters operated by cards with microprocessors; time and date stamping machines including on-street time and date stamping machines; electronic parking tickets; electronic apparatus for vehicle parking management, especially on-street or in a closed park, especially automatic pay stations; electronic apparatus for access security apparatus for vehicle parking management; electronic apparatus for control of access for car parks; software, servers, computers and communication terminals for the management of car parks; electronic apparatus for communication between time and date stamping machines and a central computer; electronic apparatus for communication (sub-assemblies in communication) to be located in the time and date stamping machines; electronic apparatus for issuance of public transport tickets; software for use in issuance of public transport tickets; public transport tickets consisting of an electronic memory card; software, servers, computers and communication*

terminals for the management of electronic apparatus for issuance of public transport tickets; software, servers, computers and communication terminals for monitoring, management and delivery of parcels and goods; electronic reading and writing apparatus for memory cards for use in parking pay points, parking meters, time and date stamping machines, electronic apparatus for issuance of public transport tickets; Apparatus for transmitting data concerning vehicle parking, data in connection with the recharging of electric vehicles and e-ticketing data; electronic and/or computer apparatus for navigation, orientation, location and positioning of available parking spaces, vehicle recharging points, particularly by means of satellite geolocation; interfaces (computing) and software (recorded programs) for electronic payment transactions; computer software for document management; electronic payment instruments and apparatus; cash or ticket dispensers; magnetic or chip payment, credit or debit cards; software for accessing databases, telecommunication services, computer networks and electronic bulletin boards; downloadable software for the supply and monitoring of information relating to the distribution and delivery of coin-operated apparatus.

Class 35: *Business management assistance, efficiency experts in the field of parking, electric vehicle recharging points and e-ticketing; providing marketing and commercial information in the field of parking vehicles, recharging electric vehicles or e-ticketing; subscription services for third parties, namely, for subscription to a telephone service, subscription to a database, subscription to a database server; collection and systematization of data in a central file; computer file management; computer file management, in particular via the Internet, extranets or intranets; retail sale of gas cylinders, particularly via the Internet, intranets or extranets; promoting the goods and services of others by means of discount card schemes, discount vouchers; management of a discount program enabling participants to obtain discounts on goods and services; loyalty programs.*

Class 36: *Payment services by mobile telephone or Internet for parking spaces, electric vehicle recharging, transportation tickets; Provision of electronic funds transfer services; information and consultation in relation to payment; on-line*

payment services on an electronic communication network; financial services relating to bank cards, credit cards, debit cards and electronic payment cards; retail sale of parking spaces in particular via the Internet, intranets or extranets.

Class 37: *Maintenance services (servicing, repair) for electronic information terminals and/or sale of goods/services, remote recognition terminals allowing the debiting of services sold, interactive information terminals, electronic machines for dispensing parcels and/or goods, parking terminals, parking meters, time and date stamping machines, electronic apparatus for vehicle parking management, electronic apparatus for access security to apparatus for vehicle parking management, electronic apparatus for control of access for car parks, electronic apparatus for communication between time and date stamping machines and a central computer, electronic communication apparatus (communication sub-assemblies) to be located in time and date stamping machines, electronic apparatus for issuance of public transport tickets, electronic apparatus for writing/reading for memory cards used in parking terminals, parking meters, time and date stamping machines, electronic apparatus for issuance of public transport tickets.*

Class 38: *Transmission of data from parking pay points, parking meters, time recorders, automatic parking lot pay terminals, vehicle recharge points and electronic apparatus for issuing transportation tickets to a computer center (one or more computers), for real-time management of parking lots, electric vehicle recharging points and seats on public transportation; transmission and reception of information, messages, via mobile telephones; information transmission from a computer data bank; information transmission services concerning news via mobile telephone; call center services [electronic communications]; telecommunication services in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; information relating to telecommunications in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; electronic display services (telecommunications) in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing,*

car rental; transmission services relating to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental.

Class 39: *Providing car parks; services for reserving public transport tickets by public automatic electronic apparatus; vehicle parking services; services for reserving parking spaces provided online via the Internet or mobile telephone; providing information relating to available parking spaces; navigation (guiding) of vehicles to available parking spaces, parking pay points, electric vehicle recharging points; information relating to transport, travel or vehicle rental; rental of vehicle parking spaces; information services relating to vehicle parking, road traffic; information services relating to mobility, namely, car-sharing, carpooling, vehicle rental, recharge terminals for electric cars; vehicle rental; rental of bicycles; information services relating to the rental of vehicles and bicycles; vehicle equipment rental services; rental of parking spaces, namely, providing temporary use of parking spaces.*

Class 42: *Software and database development (design) intended for operating or controlling apparatus for vehicle parking management, apparatus for issuance of public transport tickets, interactive terminals; updating of software and databases, computer programming services for electronic memory cards intended for apparatus for vehicle parking management.*

2. APCOA Parking Holdings GmbH ('the opponent') oppose the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is made on the basis of two of its European Union ('EU') Trade Marks, which given that they have not been protected for five years or more at the date of UK designation, are not subject to the proof of use requirements specified within section 6A of the Act. The details of these marks, alongside the goods and services on which the opponent relies, are noted in the following table:

| | |
|---------------------------------------|---|
| First Earlier Trade Mark | EU Trade Mark no.17883605 for FLOW ¹ |
| Goods and services relied upon | <p>Class 9: <i>Computer programs and software for recognising and identifying vehicles and numberplates; Computer programs and software for detecting and identifying mobile communications devices and radio frequency identification tags (RFID); Computer programs and software for data transmission between devices over short distance via radio technology; Apparatus for the transmission of data; Computer programs and software for recognising parking manoeuvres; Computer software and software for automated calculations and payment services; Computer applications for automated vehicle parking control; Devices for automated parking checks and number plate recognition; Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces; Radio-frequency identification (RFID) tags; Labels and cards with integrated RFID chips; Readers for radio frequency identification (RFID) and recognition of data codes; Card reading equipment; Card reading equipment; Encoded cards; SIM cards; Electronic card readers; Software for card readers; Encoded cards for use in point of sale transactions; Cards bearing electronically recorded data; Encoded cards for use in relation to the electronic transfer of funds; Smart cards [integrated circuit cards]; Smart card readers.</i></p> <p>Class 35: <i>Business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations; Administrative management of multi-storey car parks, parking spaces and other parking facilities;</i></p> |

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice ('TPN') 2/200 for further information.

Professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof; Data processing for the collection of data for business purposes; Collection of data relating to parking manoeuvres about users and vehicles for commercial purposes.

Class 36: *Rental and leasing and management of properties; Financial affairs and payment collection in relation to parking charges and fines; Electronic payment services, including via the internet and mobile terminals (via SMS and application software or apps); Payment by means of radio frequency identification (RFID); Automated payment services; Money transfer services utilising electronic cards; Processing electronic payments made through prepaid cards; Bank card, credit card, debit card and electronic payment card services.*


Class 37: *Providing of information concerning electrical charging options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of electric charging bays on the internet, on telecommunications networks and via mobile telephone services and application software (apps).*

Class 38: *Telecommunications, mobile telephone services, radio communications and providing access to application software (apps) for providing information on the internet for searching for, reserving, use and paying for parking spaces; Delivery of messages and data by electronic transmission; Data transmission.*

Class 39: *Car park services; Car parking; Car park services; Provision of car parks and car parking services; Rental of multi-storey car parks, parking spaces and other parking facilities; Operation of multi-storey car parks and parking facilities; Rental, leasing and reservation of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities, on the basis of rental, leasing and business service agreements, in particular providing tailored services for parking customers; Rental and leasing of parking spaces; Arranging of parking spaces, for others, in particular via the Internet; Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of parking spaces on the internet, telecommunications networks and via mobile telephone and applications software (apps); Transport and traffic logistics, in particular operation and control of traffic and parking guidance systems for moving and stationary traffic; Traffic management services; Taxi management; Shuttle services.*

Class 42: *Technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities; Design and development of computer programs and apparatus for recognition of numberplates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services; Software design and development; Design and development of computer hardware.*

| | |
|-----------------------|---|
| | <p>Class 45: <i>Licensing of computer software for the use of Internet platforms for online and offline management of parking spaces; Licensing of software for the recognition of number plates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Monitoring of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities (security services); Monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services).</i></p> |
| Relevant dates | <p>Filing date: 4 April 2018 Date of entry in register: 15 August 2018</p> |

| | |
|----------------------------------|---|
| Second Earlier Trade Mark | <p>EU Trade Mark no.17770124 for </p> |
| Services relied upon | <p>Class 9: <i>Computer programs and software for recognising and identifying vehicles and numberplates; Computer programs and software for detecting and identifying mobile communications devices and radio frequency identification tags (RFID); Computer programs and software for data transmission between devices over short distance via radio technology; Apparatus for the transmission of data; Computer programs and software for recognising parking manoeuvres; Computer software and software for automated calculations and payment services; Computer applications for automated vehicle parking control; Devices for automated parking checks and number plate recognition; Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces; Radio-frequency identification (RFID) tags; Labels and cards with integrated RFID chips; Readers for radio frequency</i></p> |

identification (RFID) and recognition of data codes; Card reading equipment; Encoded cards; SIM cards; Electronic card readers; Software for card readers; Encoded cards for use in point of sale transactions; Cards bearing electronically recorded data; Encoded cards for use in relation to the electronic transfer of funds; Smart cards [integrated circuit cards]; Smart card readers.

Class 35: *Business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations; Administrative management of multi-storey car parks, parking spaces and other parking facilities; Professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof; Data processing for the collection of data for business purposes; Collection of data relating to parking manoeuvres about users and vehicles for commercial purposes.*

Class 36: *Rental and leasing and management of properties; Financial affairs and payment collection in relation to parking charges and fines; Electronic payment services, including via the internet and mobile terminals (via SMS and application software or apps); Payment by means of radio frequency identification (RFID); Automated payment services; Money transfer services utilising electronic cards; Processing electronic payments made through prepaid cards; Bank card, credit card, debit card and electronic payment card services.*

Class 37: *Providing of information concerning electrical charging options on the internet, on telecommunications networks and via*

mobile telephone; Reservation and booking of electric charging bays on the internet, on telecommunications networks and via mobile telephone services and application software (apps).

Class 38: *Telecommunications, mobile telephone services, radio communications and providing access to application software (apps) for providing information on the internet for searching for, reserving, use and paying for parking spaces; Delivery of messages and data by electronic transmission; Data transmission.*

Class 39: *Car park services; Car parking; Car park services; Provision of car parks and car parking services; Rental of multi-storey car parks, parking spaces and other parking facilities; Operation of multi-storey car parks and parking facilities; Rental, leasing and reservation of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities, on the basis of rental, leasing and business service agreements, in particular providing tailored services for parking customers; Rental and leasing of parking spaces; Arranging of parking spaces, for others, in particular via the Internet; Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of parking spaces on the internet, telecommunications networks and via mobile telephone and applications software (apps); Transport and traffic logistics, in particular operation and control of traffic and parking guidance systems for moving and stationary traffic; Traffic management services; Taxi management; Shuttle services.*

Class 42: *Technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities; Design and*

| | |
|------------------------------|--|
| | <p><i>development of computer programs and apparatus for recognition of numberplates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services; Software design and development; Design and development of computer hardware.</i></p> <p>Class 45: <i>Licensing of computer software for the use of Internet platforms for online and offline management of parking spaces; Licensing of software for the recognition of number plates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Monitoring of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities (security services); Monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services).</i></p> |
| <p>Relevant dates</p> | <p>Filing date: 2 February 2018 Date of entry in register: 6 June 2018</p> |

3. The opponent contends that the contested mark is similar to their earlier trade marks to an “*average degree*”. They argue, inter alia, that the average consumer will break the mark down into the words “*FLOW*” and “*BIRD*”, of which the former word coincides with their earlier marks. They submit that the contested mark mainly covers identical or highly similar goods and services, though there are “*a small number with a lower degree of similarity*”.

4. The applicant filed a counterstatement denying the grounds of opposition. They also submit that *“given that there are no arguments set out in the Form TM7 it is maintained that this must be the full extent of the opposition pleadings allowed to APCOA”*. The applicant states their mark *“differs as a whole”* from the earlier marks and that *“FLOWBIRD”* is meaningless, so is *“very distinctive and different”*. They further submit that there is a *“conceptual dissonance”* between the marks and that the marks are visually and phonetically different. The applicant additionally contends that *“FLOW is of low or no distinctiveness for any goods and services that assist or promote “flow” in car parks and parking structures”* and that *“if any of the goods and services are similar these are of a low level of similarity”*. The applicant denies that there is a likelihood of confusion and requests that a costs award is made in its favour.
5. The applicant successfully requested an extension of time to file their evidence/submissions and, respectively, filed them alongside 5 attachments. Both parties also filed final submissions in lieu of a hearing. Neither of these will be summarised, though I will refer to them as and where appropriate during this decision.
6. No hearing was requested and, so, this decision is taken following a careful perusal of the papers to which I refer, as necessary, below.
7. Both parties have had professional representation in these proceedings; the opponent by Laytons LLP and the applicant by Swindell & Pearson Ltd.
8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

PRELIMINARY ISSUES

Other proceedings

9. The applicant brought it to my attention that there has been an ongoing dispute between the opponent and applicant. They stated that, inter alia:


“The same parties have been in a dispute also at the EUIPO inter alia in Opposition B003102608 by APCOA Parking Holdings GmbH to the EU Designation of International Trade Mark No. WO0000001478123. We have not been provided with a copy of the decision, that has issued in Opposition B003102608 by APCOA Parking Holdings GmbH to the EU Designation of International Trade Mark No. WO0000001478123 and we assume that the Opponent will file it ...

We also note that the decision that we refer to in Opposition B003102608 by APCOA Parking Holdings GmbH to the EU Designation of International Trade Mark No. WO0000001478123 has been appealed (See Attachment V50). We also note that EU Trade Mark Opposition No B003102608 by APCOA Parking Holdings GmbH to the EU Designation of International Trade Mark No. WO0000001478123 is based in part on EU Trade Mark No. 017883605, which is one of the two earlier rights used in this opposition and we note that Flowbird has applied to cancel EU Trade Mark No. 017883605 on the basis that it is contrary to Article 7(1)c and therefore also contrary to Article 7(1)b EUTMR.”

10. As such, they requested either that the current proceedings were stayed “*whilst a decision is issued on this invalidity point*” or that it is held that the opposition proceeded only on the basis of the Second Earlier Trade Mark, or that it is held that the First Earlier Trade Mark is found to be devoid of distinctive character and descriptive. The applicant filed the following attachments alongside this request:

- a. Receipt of application for invalidity to EUTM No. 017883605
- b. Notice of Appeal in Opposition B003102608

11. In a letter dated 6 May 2021 the Tribunal wrote to the parties and confirmed that it did not consider it appropriate for the proceedings to be stayed. This was on the basis that since the EUIPO cancellation application was only received by the EUIPO on 23 April 2021, and as any decision is a considerable time away, a stay of these proceedings would result in a significant delay. The Tribunal confirmed that it was neither appropriate to only rely on the Second Earlier Trade Mark. Thus, in the event that the decision made by this Tribunal is reliant on the First Earlier Trade Mark only, it would be provisional pending the outcome of the EUIPO cancellation proceedings.

12. In their submissions the applicant also pointed towards two decisions issued by the Institut National de la Propriété ('INPI'), the Intellectual Property Office of France. They provided full copies of the decisions that are written in French and partial translations in English. Whilst the parties and earlier rights relied upon are the same, the applied for mark differs () and the applicant states the "*opposed goods and services are fundamentally the same*". Although I acknowledge and note these decisions, they are not binding upon me and their persuasive value is not high. In fact, given that there is some difference in the marks at issue, plus the languages of the average consumer will be different, their substance will have no real bearing on the present matter before me.

DECISION

Section 5(2)(b) and relevant case law

13. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"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”.

14. The opponent has based their opposition on two earlier marks. Due to the additional point of difference resulting from the stylised “F” in the opponent’s Second Earlier Trade Mark creating less similarity with the applied for mark than in comparison with the opponent’s First Earlier Trade Mark, I will analyse the opponent’s First Earlier Trade Mark to begin with. I will then analyse the opponent’s Second Earlier Trade Mark to the extent necessary.

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

The principles

- (a) The likelihood of confusion must be appreciated, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

16. The opponent contends that the contested mark covers mostly identical or highly similar goods and services to the opponent, though there are some with a lower degree of similarity. They provide several examples across each of the classes, including some terms of which they assert are complementary to one another. They summarise that *“all the goods and services of the contested trade mark are usually and typically offered in connection with services of parking and in aspects of the operation car parks”*.
17. The applicant states that *“the goods and services at issue are at very, very best only slightly similar, to a very low degree”*. Further, that *“a lot of the Opponent’s goods and services are provided to operators of car parks whilst a number of the Applicant’s goods and services are targeted toward the end consumer i.e. someone parking their vehicle [sic]”*. They submit that there are different channels of trade, consumers and operation.
18. In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, 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”.

19. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

“(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."

20. When construing words in specifications, I find it useful to highlight the following three excerpts. 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."

21. More recently, 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.”

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

“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.”

23. I also find it useful to point to *Gérard Meric v OHIM*, Case T- 133/05, where the General Court 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 fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

24. Regarding the complementarity of goods (and, by extension, services), 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. Also, in *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that ‘complementary’ means:

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

25. Additionally, in *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public 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.”

Whilst on the other hand:

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

26. With the above factors in mind, the goods and services for comparison are as provided above in paragraphs 1 and 2. For the avoidance of doubt, the specification of both of the opponent's earlier rights is the same.

27. I will make the comparison with reference to the applied for services, grouping them together when it is relevant to do so².

Electronic terminals of information, of sale of goods and/or services; remote recognition terminals enabling the debiting of services sold

28. These are electronic or remote terminals enabling the sale of services and/or goods. The function of these terminals relies upon software that calculates the cost of such goods/services and then debits the said method of payment accordingly. The opponent's "*Card reading equipment*" includes technical equipment/terminals used to read cards (such as debit cards that are used to pay for goods/services) and, therefore, appear to include the applicant's electronic terminals themselves. There is identity on the principle outlined in *Meric* between the applicant's above goods and the opponent's "*Card reading equipment*".

29. Alternatively, if it is considered there is no identity between these goods – then I find a high similarity on the basis that there is a shared use, user and trading channels. Whilst the goods are not complementary, they may be competitive.

Electronic parking terminals including electronic terminals of car parks; parking meters including electronic memory parking meters; parking meters operated by a magnetic card, coins or tokens; parking meters operated by electronic memory cards; parking meters for multi-media communication; parking meters operated by cards with microprocessors

30. Electronic parking terminals and parking metres are electronic devices/machines that facilitate parking to be arranged, reserved and/or paid for. The parking includes, but is not restricted to, use in car parks. The opponent's "*Computer*

²See the Appointed Person in *Separode Trade Mark* BL O-399-10 (AP)

applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces” similarly enable the reserving, use and payment of parking spaces. Whilst the use and user of both goods are shared, the nature and trading channels differ – terminals/metres are physically placed somewhere (for instance, in a car park) whilst apps are digital and available on an application store. The goods are competitive insofar as the average consumer may decide to pay/reserve etc their car parking space on an app or physically. They are also complementary where you can use an application and parking terminal in conjunction to reserve/facilitate and pay for the car parking space. Therefore, I find that the applicant’s above terms have a medium to high similarity to the opponent’s *“Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces”*.

31. The opponent also has coverage for *“Devices for automated parking checks and number plate recognition”*. I understand that this term covers devices that scan a vehicle’s numberplate upon access to and from a parking area and, at some point within the process, a payment is taken or a fine is levied. For instance, a credit/debit card is inserted upon entry to the parking area and then automatically debited or, alternatively, the checks/tickets are automatically designated to the vehicle’s numberplate, within which payment is made regarding the numberplate. The applicant’s electronic parking terminals and metres are wide enough to cover the ambit of the opponent’s devices and, therefore, there is identity between these terms on the principle outlined in *Meric*. However, if I am incorrect in this analysis and the nature of the applicant’s terms does not extend to automation and/or numberplate recognition, these devices at least share a related purpose, use, user, and trading channels. Alternatively, there is a high degree of similarity between these terms.

Interactive information terminals

32. These are terminals that specifically allow the user to interact with the information it displays. The information could pertain to anything, including in relation to parking. The opponent’s *“Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces”* are additionally

interactive and display information. Whilst the nature and trading channels between these respective goods differ, the use and users are shared – they could both be used by average consumers looking for information on parking. Nevertheless, I acknowledge the applications are likely to be used more so by the public as the average consumer whereas the average consumer of the terminal is a member of the trade. They are also competitive as the consumer may use one instead of the other, and both are complementary and are important/imperative for the other to work. The applicant's "*Interactive information terminals*" has a medium degree of similarity to the opponent's "*Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces*".

Memory cards intended for use with parking pay points; public transport tickets consisting of an electronic memory card

33. The above terms include memory card based public transport tickets and, also, memory cards for use with parking pay points. The opponent's "*Encoded cards*" are cards that store data and information, which can be used to pay at/operate parking meters and can also be used to access public transport. There is identity between with the opponent's "*Encoded cards*" on the principle outlined in *Meric* – in other words, the applicant's goods are a type of encoded card. Alternatively, if I am incorrect in finding the terms identical, they are otherwise highly similar on the basis of a shared nature, use, user and trading channel. They may also be complementary and competitive where they are used for the same purpose.

Electronic machines for dispensing parcels and/or goods

34. These electronic machines can dispense parcels and goods and would, therefore, be used for such a purpose by users in a variety of situations. The machines use software programmed to allow the item(s) to be dispensed when certain processes (maybe the entry of a passcode or payment etc) are completed. The opponent's "*Computer software and software for automated calculations and payment services*" and "*Encoded cards for use in point of sale transactions*" are similarly used in a variety of circumstances, including as part of a transaction to allow electronic machines to dispense items. Whilst the nature, trading channels and

purpose of the opponent's goods differ to the applicant's electronic machines, the users can overlap. Some technology companies may also design the computer software and machine itself. Whilst the parties goods do not compete, they are complementary where electronic machines rely upon computer software (such as that for automated calculations and payment services).

35. Overall, I consider the opponent's "*Computer software and software for automated calculations and payment services*" has a low to medium degree of similarity to the applicant's above goods whilst the opponent's "*Encoded cards for use in point of sale transactions*" has a low similarity.

Time and date stamping machines including on-street time and date stamping machines; electronic apparatus for communication between time and date stamping machines and a central computer; electronic apparatus for communication (sub-assemblies in communication) to be located in the time and date stamping machines

36. These are a range of electronic machines and associated apparatus offering time and date functions. They can be used for various time-monitoring purposes, for instance, including within parking meters to calculate how long the user has parked for. The opponent's "*apparatus for the transmission of data*" enables a range of data to be transmitted – including time and date information. Whilst there is a shared electronic nature allowing the transmission of data, the use differs as the applicant's above goods are specifically for use within/as part of time and date stamping machines whereas the opponent's goods are for the transmission of data. The users and trade channels may be shared where the opponent's goods are part of the applicant's goods, within which the goods would also be complementary. The goods do not compete. There is a low similarity between the applicant's above goods with the opponent's "*apparatus for the transmission of data*".

37. The above goods are also similar to the opponent's "*devices for automated parking checks and number plate recognition*". As parking checks are typically calculated on the basis of the timescale a vehicle has parked somewhere, for them to be automated it is expected the device would have a time and date function. The respective goods share the same use and user. Trade channels would also

overlap, though the nature differs. The goods do not compete, though they are complementary as they could require one another in order to operate. There is a low to medium similarity between the applicant's above goods with the opponent's "*devices for automated parking checks and number plate recognition*".

Electronic parking tickets

38. Electronic parking tickets are digital records/documents that confirm the purchase of a parking ticket. As described above in paragraph 33, the opponent's "*encoded cards*" similarly contains data and can be used as confirmation of a sale. Whilst the nature differs, there is nevertheless a shared use, user and trading channels when both goods are used in the realm of parking. Whilst the goods are not complementary, they may be in competition where the average consumer purchases an electronic parking ticket instead of using an encoded card to pay for/record their parking. There is a low similarity between the opponent's "*encoded cards*" and the applicant's "*electronic parking tickets*".

Electronic reading and writing apparatus for memory cards for use in parking pay points, parking meters, time and date stamping machines, electronic apparatus for issuance of public transport tickets

39. The above goods cover electronic reading and writing apparatus for memory cards for a variety of uses, most of which are associated with parking and public transport tickets. The opponent's "*card reading equipment*" encapsulates this term and, therefore there is identity on the principle outlined in *Meric*.

40. In the alternative, if it is considered the goods are not identical, then I find a high similarity between the respective goods on the basis that there is an overlap of use, user and trading channels; though the nature of the applied for term may be considered broader insofar as it covers writing apparatus, in addition to reading apparatus. Though the goods are not competitive nor complementary in a trade mark sense.

Electronic apparatus for vehicle parking management, especially on-street or in a closed park, especially automatic pay stations; electronic apparatus for access security apparatus for vehicle parking management; electronic apparatus for control of access for car parks

41. These are electronic apparatus for some form of vehicle management, with a particular association with vehicle parking. The opponent's "*Radio-frequency identification (RFID) tags*" are used to transfer data through radio frequency. They have many uses, including enabling cars affixed with RFID tags to access specific areas (for instance, car parks) that have RFID readers and antennas etc. RFID tags are a form of electronic apparatus and, thus, since the opponent's goods are encapsulated by the applicant's various electronic apparatus mentioned above, the terms are identical on the principle outlined in *Meric*. Alternatively, should it be considered the goods are not identical, then I find a high similarity between them on the basis of a similarity of use, user and trade channels. There is additionally a level of competition and, possibly, complementarity.

42. Additionally, for example, the opponent has coverage of "*Devices for automated parking checks and number plate recognition*". Such devices also enable vehicle parking management by issuing tickets and recognising vehicle numberplates in order to permit access to a car park, for instance. These devices are also forms of electronic apparatus, so there is identity between the opponent's coverage of "*Devices for automated parking checks and number plate recognition*" and the applicant's above goods. In the alternative, if not considered identical, I otherwise find a high similarity on the basis of an overlap of use, user and trade channels, with a level of complementarity and competition where the parties' goods may incorporate one another or be used together to issue parking tickets, for instance.

Software, servers, computers and communication terminals for the management of car parks

43. These are a range of computing and data processing goods used to manage car parks. A communication terminal is an apparatus for the transmission of data. Since the opponent has coverage of "*Apparatus for the transmission of data*", there

is identity between the respective goods. The opponent additionally has coverage of various forms of software in class 9, for instance “*Computer programs and software for recognising and identifying vehicles and numberplates*” and “*Computer software and software for automated calculations and payment services*”. The latter are similar to the applicant’s software for managing car parks insofar as both are of a similar nature and may have an overlapping use, user and trading channels. In managing the car parks, the software may enable payment and recognition of numberplates etc accessing the car park, thus the goods may be complementary and competitive. There is a high similarity between these goods.

44. The opponent additionally has coverage of “*Licensing of computer software for the use of Internet platforms for online and offline management of parking spaces*”. Whilst the nature between these services clearly differ to the opponent’s goods, they are complementary – the licensing of computer software managing car parks relies upon the software itself to be licensed. Both goods and services are used to manage car parks and, respectively, the use coincides. I also expect the same trading channels offer both parties’ goods and services. There is a medium to high degree of similarity between applicant’s software with the opponent’s services.

45. The opponent’s “*Apparatus for the transmission of data*” is also of a medium to high similarity to the applicant’s servers and computers aforementioned. Whilst the specific nature differs, the goods store and facilitate data transmission in one way or another. The goods are also complementary where a computer/server may rely on certain data transmission apparatus to function. The use, users and trading channels may be shared. Computers and servers are also of a medium similarity to the opponent’s software, as aforementioned in paragraph 43, insofar as all of the goods are in the realm of car park management so may be available in similar trading channels and used by car parks for a similar purpose.

Software, servers, computers and communication terminals for the management of electronic apparatus for issuance of public transport tickets; software for use in issuance of public transport tickets

46. These are various electronic apparatus affiliated with public transport tickets, including memory cards, software and terminals. The opponent's specification covers various electronic and computing goods in class 9, including "*Apparatus for the transmission of data*". In a similar vein to the above analysis in paragraph 43 – since the applicant's communication terminals and servers involve the transmission of data, they are forms of apparatus for the transmission of data and there is identity between these terms on the principle outlined in *Meric*.

47. The opponent also has coverage of "*computer software and software for automated calculations and payment services*". Since the applicant's software enables the issuance of public transport tickets, it is expected the software would calculate the cost of the tickets purchase. Thus, there is also *Meric* identity between the applicant's above terms with the opponent's "*computer software and software for automated calculations and payment services*". Alternatively, if it is considered there is no identity, I find the goods have a high similarity on the basis of an overlap of nature, use, user and trading channels.

Electronic apparatus for issuance of public transport tickets

48. These electronic apparatuses facilitate public transport tickets to be issued. Whether the apparatus is handheld or in vending style, it uses a software that enables its functionality and likely incorporates card reading equipment that permits ticket payment. This is similar to the opponent's "*Card reading equipment*" insofar as the goods are complementary and can have an overlap in use, user and trading channels. There is a generally shared nature, though the specifics do differ. The goods are not competitive, however. There is a low to medium degree of similarity between the respective goods.

Software, servers, computers and communication terminals for monitoring, management and delivery of parcels and goods

49. The applicant's above goods are a range of computing and data processing goods used monitor, manage and deliver parcels and goods. The opponent's "*Computer software and software for automated calculations and payment services*" similarly covers software broadly and, thus, the respective goods are identical on the principle outlined in *Meric*. If this finding is considered incorrect, the goods are highly similar based on them both including software and there being an overlap of use, user and trading channels.

Apparatus for transmitting data concerning vehicle parking, data in connection with the recharging of electric vehicles and e-ticketing data

50. Whilst the applicant's above apparatus transmit data concerning specific data, since the opponent has broad coverage of "*Apparatus for the transmission of data*", there is identity between these terms on the principle outlined in *Meric*.

Electronic and/or computer apparatus for navigation, orientation, location and positioning of available parking spaces, vehicle recharging points, particularly by means of satellite geolocation

51. These apparatuses enable various location-centric information to be transmitted by means of satellite geolocation to provide the information noted - for instance regarding navigation, orientation and location, relevant data is transmitted. The opponent's "*Apparatus for the transmission of data*" similarly enables the same function and since the applicant's above goods by their nature allow data to be transmitted, the respective parties goods may be deemed identical on the principle outlined in *Meric*. However, if a narrower interpretation of the opponent's apparatus is taken insofar as the apparatus are specifically for data transmission only, the goods are still similar. There is an overlap in use, user and the goods are of a similar nature. I also expect trading channels would overlap. Although the goods are not competitive, they are complementary insofar as the applicant's apparatus

require data transmission functionality. Alternatively, the goods may be deemed highly similar.

Interfaces (computing) and software (recorded programs) for electronic payment transactions; electronic payment instruments and apparatus

52. The above goods cover interfaces and software for electronic payment and such instruments and apparatus. The opponent's "*Computer software and software for automated calculations and payment services*" encapsulate the applicant's goods. Therefore, there is identity on the principle outlined in *Meric*. In the alternative, the nature may be considered different on the basis that interfaces are not software. However, as the use, user and trading channels may still overlap, and the goods are complementary – there is a high similarity between the respective goods.

Computer software for document management; Downloadable software for the supply and monitoring of information relating to the distribution and delivery of coin-operated apparatus

53. Whilst downloadable software for the supply and monitoring of information relating to the distribution and delivery of coin-operated apparatus is self-evidently to enable the management of the latter apparatus, computer software for document management is used to organise files and documents. The opponent has coverage for various types of software, including "*computer programs and software for data transmission between devices over short distance via radio technology; computer software and software for automated calculations and payment services; computer applications for automated vehicle parking control; computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces*". Whilst the opponent's software shares the same nature, the specificity is different and, likewise, is the use and user. Whilst some trading channels may be shared by the same producer, there is no competitiveness or complementarity between the goods. The respective parties' goods are of very low similarity.

Cash or ticket dispensers

54. Cash and ticket dispensers are used to enable the user to withdraw money and retrieve tickets. In doing so, they may use computer software that calculates the users bank balance or the fee due to buy a certain ticket, for instance. The opponent's "*Computer software and software for automated calculations and payment services*" enables a computer to operate with figures and facilitates payments to be made. Whilst the parties' respective goods differ in nature, the goods are complementary as such computer software may be imperative for the functioning of the dispenser. In the latter situation there is a shared use and user and trading channel. The goods do not compete.

55. There is a low level of similarity between the applicant's "*Cash or ticket dispensers*" and the opponent's "*Computer software and software for automated calculations and payment services*".

Magnetic or chip payment, credit or debit cards

56. The above cards all store data and enable payments to be made. The opponent has coverage of "*Encoded cards*", "*Labels and cards with integrated RFID chips*" and "*Cards bearing electronically recorded data*", each of which encapsulate the applicant's above goods. There is, therefore, identity between these terms on the principle outlined in *Meric*.

Software for accessing databases, telecommunication services, computer networks and electronic bulletin boards

57. The above goods are a range of software, including for telecommunication services. The opponent has coverage of "*Computer programs and software for data transmission between devices over short distance via radio technology*". Radio technology is a form of telecommunication and, thus, the respective terms insofar as in relation to telecommunication are identical on the principle outlined in *Meric*. However, in comparison with software for accessing databases, computer networks and electronic bulletin boards, the link and purpose is not as close. Whilst

there may be an overlap in trading channels, there is only a very general similarity in use and users. The similarity is otherwise considered very low.

Business management assistance, efficiency experts in the field of parking, electric vehicle recharging points and e-ticketing

58. These business management services are specifically in the field of parking, electric vehicle recharging points and e-ticketing. The opponent also has coverage of “*Business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations*” and “*Administrative management of multi-storey car parks, parking spaces and other parking facilities*”, both of which encompass the applicant’s above goods. There is, therefore, *Meric* identity between the services.

Providing marketing and commercial information in the field of parking vehicles, recharging electric vehicles or e-ticketing

59. These marketing and commercial information services are specifically in the field parking vehicles, recharging electric vehicles or e-ticketing. The opponent’s “*Professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof*” is similarly in the realm of parking and includes marketing and consultancy, within which commercial information is likely provided. There is *Meric* identity between these services. However, in the alternative, if it is considered the services are not identical, then there is a high similarity between them on the basis that the nature (and subject matter), use and user is similar. There is also a likely shared trading channel and the services are both competitive and complementary.

Subscription services for third parties, namely, for subscription to a telephone service, subscription to a database, subscription to a database server

60. The purpose of the service provider providing these services is to look after a third party's subscriptions. The opponent's "*Data processing for the collection of data for business purposes*" similarly involves the processing of data, which could include that pertaining to subscriptions. Whilst both services are generally to assist the user managing its business and share some trading channels shared, the specificity of the services differ in nature and use. They are not competitive, though the management of subscription services may include the collection of data and be important in that regard. The respective services have a low degree of similarity.

Collection and systematization of data in a central file

61. To collect and systemise data centrally, data is processed. There is identity with the opponent's "*Data processing for the collection of data for business purposes*".

Computer file management; computer file management, in particular via the Internet, extranets or intranets

62. These services involve collating and managing computer files into accessible formats. The opponent's "*Data processing for the collection of data for business purposes*" similarly collates and manages data. The services share a similar nature and usually coincide in trading channels, use and user. The services are not competitive, though they are complementary insofar as data processing is important in order to manage computer files since computer files contain data. I find these respective services have a medium degree of similarity.

Retail sale of gas cylinders, particularly via the Internet, intranets or extranets

63. Retail of gas cylinders facilitates the offering of gas cylinders for sale. As this term specifies "*particularly via*", it emphasises where the goods may be sold (via the internet, intranet or extranet) – though it is not limited to such avenues. The opponent's specification covers a wide range of goods and services, though I do

not find any of strong similarity. The opponent submits that such retail services may be offered, inter alia, *“in connection with the provision and operation of parking facilities”*. For instance, when I compare the above goods with the opponent’s *“business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations”* and *“car park services”*, there is generally a difference in nature, use and user and I consider the overlap in trading channels being particularly limited. The services are neither complementary nor in competition. I do not consider the applicant’s above goods are similar to any of the opponent’s goods or services.

Promoting the goods and services of others by means of discount card schemes, discount vouchers; management of a discount program enabling participants to obtain discounts on goods and services; loyalty programs

64. These services are specifically regard discount schemes and loyalty programs, some of which are provided for others. The opponent’s *“Professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof”* uses the word *“including”* in order to specify a range of example professional consultancy services provided, albeit this word does not limit the services to such examples. Whilst the nature of the respective services differ – the opponent’s services enable the management of a business whilst the applicant’s services are the advertising/promotional services themselves. Though there is a level of complementarity and some competitiveness where business consultants also advise on the remit of promotions and discounts. The services likely have an overlap in use, user and trading channels. The respective services have a medium level of similarity.

Payment services by mobile telephone or Internet for parking spaces, electric vehicle recharging, transportation tickets; Provision of electronic funds transfer services; on-line payment services on an electronic communication network; retail sale of parking spaces in particular via the Internet, intranets or extranets

65. These services are in some way affiliated to online financial services – whether by facilitating payment services, electronic transfer of funds or retail sale. The opponent’s “*Electronic payment services, including via the internet and mobile terminals (via SMS and application software or apps)*” thus encapsulates these goods and there is identity on the basis outlined in *Meric*.

Financial services relating to bank cards, credit cards, debit cards and electronic payment cards

66. These financial services are self-evidently identical to the opponent’s “*Bank card, credit card, debit card and electronic payment card services*”.

Information and consultation in relation to payment

67. The above services provide information and consultation regarding payment – this could include regarding different payment methods and electronic payments, for instance. The opponent’s “*Electronic payment services, including via the internet and mobile terminals (via SMS and application software or apps)*” likely coincides with the dissemination of information about the payment services provided. For example, information on how to make the electronic payments. Whilst the nature of the services differ, the user, use and trading channels may overlap. The services do not compete generally, though as part of the electronic payment service, information may be provided, so there is a level of complementary. There is a high degree of similarity between these respective goods.

Maintenance services (servicing, repair) for electronic information terminals and/or sale of goods/services, remote recognition terminals allowing the debiting of services sold, interactive information terminals, electronic machines for dispensing parcels and/or goods, parking terminals, parking meters, time and date stamping machines,

electronic apparatus for vehicle parking management, electronic apparatus for access security to apparatus for vehicle parking management, electronic apparatus for control of access for car parks, electronic apparatus for communication between time and date stamping machines and a central computer, electronic communication apparatus (communication sub-assemblies) to be located in time and date stamping machines, electronic apparatus for issuance of public transport tickets, electronic apparatus for writing/reading for memory cards used in parking terminals, parking meters, time and date stamping machines, electronic apparatus for issuance of public transport tickets.

68. These are a range of maintenance service for various terminals, including those for parking metres and vehicles, access to car parks and parking management. The opponent has coverage of a range of services affiliated with car parks, including “*Car park services*” and “*Operation of multi-storey car parks and parking facilities*”. Whilst the latter are for the provision of the car park services, they include facilitating and overseeing the management of terminals used to pay and access the car park itself. The nature between the parties goods and services clearly differ, and the use and user differ insofar as the public use the opponent’s goods whereas the applicant’s above goods are likely used by the car park business itself. The goods and services do not compete, though they are complementary. Overall, I find a low degree of similarity between the respective parties services.

Transmission of data from parking pay points, parking meters, time recorders, automatic parking lot pay terminals, vehicle recharge points and electronic apparatus for issuing transportation tickets to a computer center (one or more computers), for real-time management of parking lots, electric vehicle recharging points and seats on public transportation; transmission and reception of information, messages, via mobile telephones; information transmission services concerning news via mobile telephone; information transmission from a computer data bank; transmission services relating to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental.

69. The above services are for various types of data and information transmission. The opponent has broad coverage of “*data transmission*”, thus there is identity between this term and the above services on the principle outlined in *Meric*.

Call center services [electronic communications]

70. Call centre services execute a range of incoming and outgoing calls and are usually provided as part of a business or via a third party representing that business. The opponent has coverage of “*delivery of messages and data by electronic transmission*”, which likely refers to messages, such as via short message services (SMS). The respective services are of a very low similarity on the basis that whilst the specific nature and use differs, there may be some general overlap between the user and trading channels. The services are not complementary, but they may compete where a business delivers a message via SMS rather than via a telephone call at a calling centre.

Telecommunication services in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; information relating to telecommunications in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; electronic display services (telecommunications) in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental

71. These are a range of telecommunication services and the associated provision of information regarding various forms of transportation. Electronic display services are a form of telecommunication. The opponent has coverage of “*Telecommunications, mobile telephone services, radio communications and providing access to application software (apps) for providing information on the internet for searching for, reserving, use and paying for parking spaces*” within which there is a clear overlap in relation to the coverage of parking spaces. There is identity between such telecommunication services. Alternatively, if the terms are not considered identical, I find a very high similarity on the basis of a shared nature, use, user and trading channels. The services may also be in competition.

72. Since information relating to such telecommunication services is likely provided incidentally to the services themselves, whilst the nature differs, there is an overlap in use, user and trading channels. Whilst the services are not competitive, they are

complementary. There is, therefore, a high degree of similarity between the opponent's aforementioned term with the applicant's "*information relating to telecommunications in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental*".

Providing car parks; vehicle parking services

73. The applicant's above services are for vehicle parking and car park services - the opponent also has coverage of "*Provision of car parks and car parking services*", so these terms are self-evidently identical.

Services for reserving public transport tickets by public automatic electronic apparatus

74. The applicant's above services are used by the average consumer to reserve public transport tickets. The opponent has coverage of "*shuttle services*", which would encompass private and publicly run shuttles that transport passengers from one location to another. Part of this service would likely involve the reservation of tickets, whether by automatic electronic apparatus or otherwise. Whilst the nature and use of the services differ, there is an overlap in user and trading channels. The goods do not compete, but they may be complementary. The opponent's "*Computer software and software for automated calculations and payment services*" has a medium level of similarity to the applicant's above services.

75. The applicant's automated electronic apparatus would be reliant on software that enables automated services – for instance, the user selects the passenger(s) and travel destination and is then provided with a ticket cost and ability to reserve the ticket. Whilst the nature differs, the opponent also has coverage of "*Computer software and software for automated calculations and payment services*". These services facilitate the service that the applicant provides. There is a general overlap in use, user and trading channels – though I appreciate the opponent's software services can be used in a much broader remit. The goods and services do not compete, though they are complementary. Overall, I consider that the opponent's "*Computer software and software for automated calculations and payment services*" has a low to medium level of similarity to the applicant's above services.

Services for reserving parking spaces provided online via the Internet or mobile telephone; providing information relating to available parking spaces

76. The applicant's above services enable the reservation of parking services and providing associated information. The opponent has various coverage of car parking services, including "*Reservation and booking of parking spaces on the internet, telecommunications networks and via mobile telephone and applications software (apps)*". The latter services encompass the applicant's above terms and, therefore, the terms are identical on the principle outlined in *Meric*.

Information services relating to vehicle parking, road traffic

77. These services specifically cover the provision of information relating to vehicle parking and road traffic and, thus, the user would use the services for seeking information on the said subject matter. The opponent has coverage of "*Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone*" within which the aspect relating to parking options overlaps with and is, therefore, identical to the applicant's information relating to vehicle parking. There is, therefore, identity between the respective services.

Information relating to transport, travel or vehicle rental

78. These are a range of services providing information in relation to transport, travel and vehicle rental. The applicant's "*Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone*" are of a generally similar nature, use and user seeking information – however, the subject matter and exact purpose differs. Some trade channels may be shared. Coinciding the provision of information on parking, alternative methods of transport and information on traffic etc may be provided – though the services do not compete nor are complementary in a trade mark sense. The overall similarity between these services is low.

Navigation (guiding) of vehicles to available parking spaces, parking pay points, electric vehicle recharging points

79. These services cover a range of services available to vehicle drivers, either in relation to parking or electric vehicle recharging. Car park services include guiding vehicles to parking spaces and equipment that enables parking spaces to be paid for, some car parks also host electric vehicle recharging points. Thus, there is an overlap between the above services and the opponent's "*Provision of car parks and car parking services*", within which the two can be deemed identical on the principle outlined in *Meric*. In the alternative, if I am incorrect in making this finding, I find the services are of a very high similarity on the basis of an overlap of use, user, trading channels.

80. With regards to the provision of electric vehicle recharging points, the opponent also has coverage of "*Reservation and booking of electric charging bays on the internet, on telecommunications networks and via mobile telephone services and application software (apps)*". Whilst the navigation of such services differ in nature to the service itself, the general trading channels, use and user is shared. Although the services do not compete, they are complementary. There is, therefore, a high degree of similarity between these services.

Rental of vehicle parking spaces; rental of parking spaces, namely, providing temporary use of parking spaces

81. The above services enable the renting of parking spaces. They are self-evidently identical to the opponent's "*Rental and leasing of parking spaces*".

Information services relating to mobility, namely, car-sharing, carpooling, vehicle rental, recharge terminals for electric cars

82. These are information services pertaining to mobility, particularly in connection to cars. The opponent's "*Providing of information concerning electrical charging options on the internet, on telecommunications networks and via mobile telephone*" overlaps with the applicant's "*Information services relating to mobility, namely ...*

recharge terminals for electric cars". There is identity between these respective services in relation to electric charging.

83. The opponent also has coverage of information services, though specifically for *"Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone"*. There is an overlap in the nature and users who are seeking information to the applicant's above services (for instance, car drivers or passengers), though the subject matter differs other than a general overlap in the realm of cars. Some trading channels may be shared, though the services are neither complementary nor competitive. The respective services have a very low level of similarity.

Vehicle rental; vehicle equipment rental services; rental of bicycles; information services relating to the rental of vehicles and bicycles

84. These services are for the rental of vehicles, associated equipment, bikes and information relating to such rental. They are used by the average consumer looking for a temporary mode of transport. The opponent's *"shuttle services"* share some similarity to the applicant's above services insofar as both services enable the user to travel temporarily in one form or another. Whilst the general nature, use, user and trading channels can be shared (for instance, at an airport where a company offers various modes of transport), they differ to the extent that the applicant's services are for where the user rides or drives the mode of transport whilst the opponent's services are manned and the user is the passenger. The services are not complementary, but they may compete to a limited extent where the user decides one over the other, though I do not consider that particularly common. Overall, the applicant's above services are similar to the opponent's *"shuttle services"* to a low degree.

85. The opponent also offers rental services, though they are distinct – they are for the *"rental of multi-storey car parks, parking spaces and other parking facilities"*, of which there is no overlap. The opponent's *"shuttle services"* share a similar average consumer who is looking to use transport that is not their own. Some trade channels may be shared where a business offers various rental services. However,

the nature (parking vs vehicle and bicycle renting etc) differs, and besides a generic purpose of being for a rental period, the specific use differs. The goods do not compete, and they are not complementary. For the avoidance of doubt, I do not find that the applicant's above services are similar to the opponent's "*Rental of multi-storey car parks, parking spaces and other parking facilities*".

Software and database development (design) intended for operating or controlling apparatus for vehicle parking management, apparatus for issuance of public transport tickets, interactive terminals; updating of software and databases, computer programming services for electronic memory cards intended for apparatus for vehicle parking management

86. These services cover various software and database services for apparatus relating to vehicle parking and transport. The opponent has coverage of "*Software design and development*" in general, thus also covering the applicant's services. There is identity between these terms.

87. For the avoidance of doubt, whilst analysing each of the applicant's goods and services alongside the opponent's, I considered whether any of the opponent's other goods or services would improve their position. In my view they do not and, in fact, any similarity would be of an even lesser (or no) degree.

88. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion³, the opposition must fail in respect of the applicant's "*Retail sale of gas cylinders, particularly via the Internet, intranets or extranets*", of which I have found to be dissimilar to the opponent's goods and services.

Average consumer and the purchasing act

89. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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 and services in question⁴.

90. 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.”

91. The opponent submits that the cost of the goods and services depend on various factors such as *“the length of the stay of parking, journey time etc”* and that the general public use car parks and transportation fairly or very frequently, of which price is their most likely focus. They submit that the level of care and consideration is low or average, with a predominantly visual purchasing process.

92. The applicant submits that, inter alia, that the opponent's goods and services are *“provided to operators of car parks whilst a number of the Applicant's goods and services are targeted towards the end consumer i.e. someone parking their vehicle. These are technically different channels of trade with different customers and they operate in different ways”*. Further, that the level of attention varies and that *“business to business goods and services i.e. the goods/services provided to a parking structure”* require more attention to be paid to than *“car owners [who] will make a single business decision to use a single provider and use them for months or years and this will be a transaction worth potentially lots of money, it is suggested many thousands of pounds. On this basis, car park owners will display a very high degree of attention”*. However, for business to consumer goods, the consumer

⁴ See *Lloyd Schuhfabrik Meyer*, Case C-342/97.

pays “*little to almost no attention to the owner/operator of a car park or parking structure*”. Additionally, that drivers park their vehicles in car parks that are “*geographically closest to where they want to be, not on the basis of the relevant trade mark that the car park is provided under*”. They state that “*the level of attention paid whilst selecting the relevant goods and services [sic] would in our view high [sic]*” and that the purchasing process is “*balanced between visual, aural and conceptual*”.

93. The breadth of the competing goods and services are wide, so the average consumer varies. Where the goods and services in classes 9, 36 and 39 are affiliated with payments, cards, vehicle parking and public transport, the average consumer is predominantly members of the public (i.e. the end consumers using car parks and public transport etc). For the other goods and services in classes 9, 36 and 39 and the services in classes 35, 37, 38 and 42 are predominantly aimed at businesses (for instance, car park operators). The applied for goods and services range in price, from relatively low cost (such as public and electronic parking tickets) to high cost (for instance, business management assistance and software and database development). The regularity of the purchase is frequent or infrequent, depending on the goods and/or services purchased.

94. Where the average consumer is the general public, in making their purchase, they will mostly consider the cost and suitability of the goods and/or services to their desired purpose. Such goods and services are most likely provided at car parks or, where applications are involved, then via various application stores that enable applications to be downloaded. I consider that the selection of such goods and services will predominantly be made on a visual basis, though aural considerations have a role to play where consumers receive word of mouth recommendations. Overall, I consider the average consumer will pay a medium degree of attention to the selection of the respective goods/services.

95. Where business users are the average consumer, they are likely to consider the type of service offered, the reputation of the service provider and suitability of those services (including any experience the service provider has) to the user’s desired purpose. The level of attention paid by the average consumer selecting and

purchasing the services will be higher than the norm due to the importance in selecting a suitable service for their business and the likelihood that such services are of a higher cost. The services will likely be selected from websites and brochures etc so the visual element will be of most importance. However, word-of-mouth recommendations will mean that the aural element also has a role in the selection process.


Comparison of marks

96. 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.”

97. 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.

98. The respective trade marks are shown below:

| Earlier trade mark | Contested trade mark |
|--------------------|--|
| FLOW |  |

99. The opponent submits that the respective marks coincide visually and aurally with the word “*FLOW*”, which is the first element of the contested sign and will “*catch the consumer’s attention first*”. Conceptually, the opponent states that the marks share the same meaning conveyed by the word “*FLOW*” but differ with the word “*BIRD*”. They state that the marks are similar to an “*average*” degree.

100. The applicant states that the marks “*are really not that similar*”. They submit that the word “*FLOWBIRD*” is meaningless in English and, thus, is “*very distinctive and different*”. They further submit that the marks are conceptually different, neither do they look similar and, aurally, whilst the marks contain the word “*FLOW*”, the “*multi syllable word ‘BIRD’ in the contested mark serves to create a significant aural distinction*”.

Overall impression

The applicant’s contested mark

101. The contested mark is a black and white device comprising of the word “*FLOWBIRD*” in a thin uppercase typeface. Behind the “*FLOW*” element is a series of dots in grey, displayed in a circular burst. The words play a greater role in the overall impression, but the device element is far from negligible and still plays a role in the overall impression.

The opponent's First Earlier Trade Mark

102. The opponent's mark is a word mark consisting solely of the word "FLOW" in normal black font. The overall impression lies in the word itself.

Visual comparison

103. The marks both share the word "FLOW" as their first element, so there is clearly some similarity. Whilst the shared word is the whole of the earlier mark, it forms only half of the word in the contested mark. The contested mark is additionally lightly stylised, and it has the circular burst of dots. The visual similarity is of a medium degree.

Aural comparison

104. The opponent's mark will be articulated in one syllable as 'flow', whilst the contested mark has two – 'flow-berd'. Since both share the same beginnings, but differ on their endings, there is a medium aural similarity between them.

Conceptual comparison

105. The word 'flow' is typically understood to refer to the steady movement of something. In both marks, 'flow' will evoke a message surrounding this concept. However, in the contested mark, the addition of 'bird' to this element alters the conceptual hook as it also will be seen to reference to the flying animal. Whilst the average consumer may view 'flowbird' as a word without an obvious meaning, they may also still recognise the 'flow' and 'bird' elements as words with concepts earlier mentioned. Bearing this in mind, I consider the marks have a low degree of conceptual similarity.

Distinctive character of the earlier mark

106. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of

confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* 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).”*

107. Registered trade marks can possess various degrees of inherent distinctive character, ranging from the low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it. No evidence has been filed regarding enhanced distinctiveness, so I only have the inherent characteristics of the mark to consider.

108. The opponent submits that the earlier mark is distinctive to an average degree. The applicant contends that the word “*FLOW*” is of weak distinctiveness and a “*fairly common English word that can be defined in a number of ways in particular in relation to the “flow of traffic”*”. In respect of the goods and services associated

with managing the movement of something (such as vehicles, parking and payment), the earlier mark, “*FLOW*”, is somewhat suggestive and allusive of easing how such objects are moved/dealt with. For the goods and services where the suggestive message applies, the distinctive character is low (or low to medium) but for the remainder, the distinctive character is pitched at medium.

Likelihood of confusion

109. 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. I point particularly to the principles I referred above in paragraph 15. One of these 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, and vice versa.

110. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods 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.

111. There are two types of possible confusion: direct (where 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/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C.:

“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.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.)*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."*

For the avoidance of doubt, I acknowledge that these three categories are just illustrative – Mr Purvis QC stated that indirect confusion ‘tends’ to fall in one of them.

112. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

113. Additionally, 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.”

114. Earlier in this decision I concluded that the competing trade marks are visually and aurally similar to a medium degree and that they have a low degree of conceptual similarity. I consider that the differences between the marks are enough to enable the average consumer to differentiate between them – one is just “*FLOW*”, the other is a device with an equally dominant word (“*BIRD*”) plus other elements. This is notwithstanding the principle of imperfect recollection and regardless of the goods/services being identical or similar and if the average consumer pays a medium or high degree of attention during the purchasing process. I do not consider there is a likelihood of direct confusion.

115. I now turn to consider whether there is a likelihood of indirect confusion. Whilst the contested mark fully incorporates the earlier mark, when the average consumer views the contested composite mark, I do not consider this shared element (“*FLOW*”) has a distinctive significance independently of the whole. Instead, when the “*FLOW*” element is combined with “*BIRD*” in the way in which it is in the applied for mark, I consider that the combination will be read together and as a unit, albeit one which has no known meaning as a whole (other than possibly evoking a concept of a type of bird). The addition of “*BIRD*” to the word “*FLOW*” is a fairly unique combination and I do not consider it likely that the average consumer would think it is a natural brand extension or indication of a shared economic connection between the two parties/marks. Rather, even where the mark is used on identical goods and services, such as the provision of car parks, it is my view that the average consumer would think the parties merely share the “*FLOW*” element due to coincidence. For these reasons, I neither find a likelihood of indirect confusion. For the avoidance of doubt, I would still reach this finding even if “*FLOW*” is regarded as an independent element.

Comparison with the opponent's Second Earlier Trade Mark

116. As the opponent's First Earlier Trade Mark leads to the opposition being unsuccessful, I now consider the opponent's Second Earlier Trade Mark upon which the opposition is based. Due to the similarity between the opponent's two earlier marks, much of my earlier analysis is applicable. In terms of whether the Second Earlier Trade Mark creates a likelihood of confusion, my views are as follows:

- a. The earlier goods and services analysis still applies since the terms are identical
- b. The average consumer and the selection process remain the same.
- c. The overall impression of the earlier mark lies in the word "*FLOW*" and a green square with rounded corners encasing three horizontal white lines, of which is likely viewed as resembling the shadow of an "*F*". Comparing this to the contested mark, there is a reduced degree of visual and aural similarity (to a low degree). Though, the marks still have a low degree of conceptual similarity.
- d. The earlier distinctiveness analysis is heightened slightly by the use of a device (rather than a word only mark) that also incorporates a green and white stylised "*F*". The mark has a low to medium degree of inherent distinctiveness for goods and services where the slightly suggestive message applies, though a medium degree of inherent distinctiveness for the remainder. However, I keep in mind that this added distinctiveness does not reside in the common element.

117. Besides the opponent's Second Earlier Trade Mark having a slightly reduced similarity to the contested mark, the factors and assessment do not materially change. Neither does my finding. Therefore, I still do not find a likelihood of confusion, whether direct or indirect.

CONCLUSION

118. The opposition has been unsuccessful and the application may proceed to registration.

COSTS

119. As the applicant is successful in this opposition, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement: £200

Preparing evidence and considering and commenting on the other side's evidence £500

Preparing final written submissions in lieu of a hearing: £300

120. I therefore order Apcoa Parking Holdings GmbH to pay FLOWBIRD the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of July 2021

**B Wheeler-Fowler
For the Registrar**