

BL O/834/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3478581

BY

21 HOLDINGS LTD

TO REGISTER THE FOLLOWING TRADE MARK:

INFLO

AND

OPPOSITION NO. 421877 THERETO

BY

INFLO GROUP LIMITED

Background and pleadings

1. On 1 April 2020, 21 Holdings Ltd (the “applicant”) applied to register the trade mark INFLO in the UK, under number 3478581. The contested mark was accepted and published for opposition purposes in the Trade Marks Journal on 26 June 2020. Registration of the mark is sought in respect of the following goods and services:

Class 9 Computer software; computer software applications; electronic publications (downloadable); computer database management software; data processing software; computer document management software; computer application software; interactive computer software enabling exchange of information; downloadable computer software for the transmission of information; downloadable mobile applications for the transmission of information; software for accessing information on a global computer network; computer software for authorising access to databases; computer communication software to allow customers to access personal information and data; computer software for creating searchable databases of information and data; data banks; all of the aforementioned being for advertising, marketing, and publicity purposes.

Class 35 Marketing; marketing information; marketing research and analysis; business management and consultancy; business information; data processing management; administrative data processing; advertising services relating to databases; analysis of market research data; collection and systematisation of business data; consumer market information services; collection of personnel information; computer database management services; computerised data verification; information, advisory and consultancy services relating to all of the aforesaid services; retail service in connection with the sale of computer software products in the field of marketing, advertising and publicity.

Class 42 Design and development of software for database management; design and development of software for importing and managing data; software as a service (SAAS); software as a service (SAAS) relating to marketing,

advertising and publicity; information, advisory and consultancy services relating to all of the aforesaid services.

2. On 24 September 2020, Inflo Group Limited (the “opponent”) opposed the application under Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. Under Section 5(1) and Section 5(2)(a), the opponent relies upon the earlier United Kingdom Trade Mark (UKTM) (series of 3):

INFLO

inflo

Inflo

UKTM no. 3457108

Filing date 10 January 2020, and registered on 7 August 2020.

(The “first earlier mark”)

The entire list of goods and services for which the mark is registered are relied upon for the purposes of this opposition, i.e.:

Class 9 Software; software in the field of finance and accountancy; financial data analytics and visualisation software.

Class 36 Consultancy services in the field finance and financial analysis; financial data analysis services; computerised financial data analysis services.

Class 42 Design and development of software; software implementation services; software support and maintenance services; software and website hosting services; software consultancy services; the provision of software as a service (SaaS); the provision of software as a service (SaaS) featuring software in the field of finance and accountancy; the provision of software as a services (SaaS) featuring financial data analytics and visualisation software.

4. Under Section 5(2)(b), the opponent relies upon the following two earlier UKTMs:



UKTM no. 3454813

Filing date 31 December 2019, and registered on 7 August 2020.

(The “second earlier mark”)

The opponent relies upon all of the goods for which the mark is registered, i.e.

Class 9: Software.



UKTM no. 3146580

Filing date 27 January 2016, and registered on 22 April 2016.

(The “third earlier mark”)

The opponent relies on all of the goods for which the mark is registered, i.e.

Class 9: Software.

5. All of the opponent's marks are earlier in accordance with section 6 of the Act. However, as none of the marks have been registered for five years or more before the filing date of the application, the opponent is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon any or all of the goods and services for which the earlier marks are registered without having to establish genuine use

6. In its notice of opposition, the opponent submitted that all of the contested goods and services are identical or highly similar to those of its earlier rights.

7. The opponent contended that its earlier right 3457108, which contains the series of three marks: 'INFLO, inflo, Inflo', is identical to the contested mark. In addition, the opponent contended that its "prior stylised marks" are highly similar to the contested mark. The opponent contended that the word element 'Inflo' is the most prominent and distinctive element in the stylised marks, and that this element is phonetically, aurally and conceptually identical to the contested mark 'INFLO'.

8. The opponent contended that all of the goods and services in Classes 9 and 42 of the contested mark are identical to the registered goods and services of the earlier rights. The opponent contended that in the alternative, the contested goods and services in Classes 9 and 42 are at least highly similar to those of the earlier rights, insofar as they all have the same nature of software products and IT related services.

9. The opponent contended that the services in Class 35 of the contested mark, which the opponent summarised as being in "the nature of business consultancy services with an emphasis on marketing and data processing", are highly similar in nature to the "financial services and financial data analysis services" of the services in Class 36 of the earlier right 3457108, insofar as they are used by the same end users (namely businesses) and are complementary. The opponent further contended that the contested services in Class 35 are in general similar to the entirety of the goods and services of its earlier rights (as a collective), since the contested services are all "commonly provided by suppliers of 'business to business' or enterprise software solutions and related services, which may reasonably [be] regarded as complementary to or ancillary to such goods and services".

10. The opponent submitted that the contested mark should be refused either because it is identical to the earlier right 3457108, which is registered for identical goods and services, or because it is similar to a high degree to the “stylised marks” which are registered for goods which are similar to a high degree. The opponent contended that there would be a likelihood of confusion on the part of the public in the United Kingdom, which includes the likelihood of association.

11. On 5 January 2021, the applicant filed a counterstatement admitting that the contested mark is either identical to 34571108, or at least similar to 3454813 and 3146580. However, the applicant denied that the registered goods and services of the earlier rights are identical or similar to those of the contested mark. The applicant argued that the contested goods and services are of a different nature, and have a different purpose and use to those of the earlier rights. The applicant indicated that the evidence and submissions which will be filed in the proceedings will show that the contested goods and services are “dissimilar to the earlier right’s finance/accountancy specific goods and services”. The applicant requested an award of costs in its favour.

12. Neither side filed evidence. Only the opponent filed written submissions.

13. In its written submissions, the opponent referred to the fact that the applicant had admitted to the marks being identical, but had argued that the goods and services of the respective marks were not. The opponent submitted that such an assertion was patently and obviously incorrect. The opponent referred to the applicant’s previous statement which identified the earlier right’s goods and services as being finance and accountancy specific. The opponent argued that the applicant’s position was flawed as it was based on the wholly incorrect premise that the goods and services of the earlier rights are exclusively finance/“consultancy”¹ specific. The opponent argued that whilst 3457108 is registered for some finance and accountancy specific goods and services, it is clear that many of the goods and services are not finance or accountancy specific. The opponent argued that the mere fact that all of the contested goods and services in Classes 9 and 42 are identical to the registered goods and services of the earlier rights, based on the natural and ordinary meaning of the language used, means

¹ It is assumed that this is a typographical error, as the applicant had referred to *finance* and *accountancy*. The opponent focused its remaining submissions on *finance* and *accountancy*, not *consultancy*.

that any consideration of wider factors such as nature, purpose and use etc. is neither required nor relevant. The opponent contended that if the contested goods and services are not considered identical, then in the alternative they are at least highly similar.

14. The opponent submitted that the contested services in Class 35 are all marketing related. With this consideration in mind, the opponent argued that the contested services in Class 35 are highly similar to all of the goods and services of the earlier rights, most specifically the *consultancy services in the field of finance and financial analysis; financial data analysis services; and computerised financial data analysis services* in Class 36. The opponent referred to the earlier right's financial/financial analysis services on the one hand, and the contested mark's marketing and advertising services on the other hand, as all being "business to business services", which are complementary and frequently provided by the same supplier, particularly within the IT sector. The opponent provided a full comparison of the entire specifications, which it is not incumbent on me to include here as I shall conduct my own analysis later in this decision.

15. No hearing was requested and so this decision is taken following a careful perusal of the papers.

16. Both parties are professionally represented. The applicant is represented by Wilson Gunn, and the opponent is represented by Ward Hadaway Solicitors.

Decision

17. Section 5(1) of the Act is as follows:

"5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

18. Section 5(2) of the Act is as follows:

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

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

(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”.

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

20. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Comparison of goods and services

21. The opponent provided a detailed comparison of the respective goods and services. Whilst the opponent's comments are noted, the degree of similarity or identity as the case may be, is something which fundamentally contributes to whether there is

a likelihood of confusion. I must therefore conduct my own full analysis of the goods and services at issue.

22. In these proceedings the opponent is relying upon the three earlier rights shown in paragraphs 3 and 4 above. The first earlier mark is UK 3457108 and comprises the word “INFLO” solus. It has a broader specification than the other trade marks being relied upon, and does not contain additional figurative elements which have no counterpart in the contested mark. It is therefore this particular earlier mark which offers the opponent the best prospect of success, and which I shall use for the purposes of comparison. If the opponent does not succeed on the basis of UK 3457108, he will be in no better position in relation to the other trade marks which contain additional stylisation and figurative elements, and which have a narrower specification.

23. The parties’ respective specifications are:

First earlier mark	Application
<p><i>Class 9: Software; software in the field of finance and accountancy; financial data analytics and visualisation software.</i></p>	<p><i>Class 9: Computer software; computer software applications; electronic publications (downloadable); computer database management software; data processing software; computer document management software; computer application software; interactive computer software enabling exchange of information; downloadable computer software for the transmission of information; downloadable mobile applications for the transmission of information; software for accessing information on a global computer network; computer software for authorising access to databases; computer communication software to</i></p>

	<p><i>allow customers to access personal information and data; computer software for creating searchable databases of information and data; data banks; all of the aforementioned being for advertising, marketing, and publicity purposes.</i></p>
	<p><i>Class 35: Marketing; marketing information; marketing research and analysis; business management and consultancy; business information; data processing management; administrative data processing; advertising services relating to databases; analysis of market research data; collection and systematisation of business data; consumer market information services; collection of personnel information; computer database management services; computerised data verification; information, advisory and consultancy services relating to all of the aforesaid services; retail service in connection with the sale of computer software products in the field of marketing, advertising and publicity.</i></p>
<p><i>Class 36: Consultancy services in the field finance and financial analysis; financial data analysis services; computerised financial data analysis services.</i></p>	

<p>Class 42: <i>Design and development of software; software implementation services; software support and maintenance services; software and website hosting services; software consultancy services; the provision of software as a service (SaaS); the provision of software as a service (SaaS) featuring software in the field of finance and accountancy; the provision of software as a services (SaaS) featuring financial data analytics and visualisation software.</i></p>	<p>Class 42: <i>Design and development of software for database management; design and development of software for importing and managing data; software as a service (SAAS); software as a service (SAAS) relating to marketing, advertising and publicity; information, advisory and consultancy services relating to all of the aforesaid services.</i></p>
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24. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25. It has also been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 für 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”.

26. Class 9 - The contested *Computer software; computer software applications; computer database management software; data processing software; computer document management software; computer application software; interactive computer software enabling exchange of information; downloadable computer software for the transmission of information; software for accessing information on a global computer network; computer software for authorising access to databases; computer communication software to allow customers to access personal information and data; and computer software for creating searchable databases of information and data* are evidently all types of software. These goods fall within the general category of the earlier right's *software* registered in Class 9, and, in accordance with the *Meric* judgment, are therefore found to be identical.

27. In the case of *downloadable mobile applications for the transmission of information*, an *application* is a type of *software*, and is therefore found to be identical also.

28. The contested *electronic publications (downloadable)* are electronic versions of traditional media. They are commonly distributed in the form of electronic publications by means of software applications. The earlier right is registered for *software*, which would be the means by which the electronic publications are viewed. The users, and trade channels are likely to be the same, and are therefore considered to be similar to a low degree. In the alternative, they are complimentary. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

29. The *electronic publications (downloadable)* cannot be viewed without a software application, and therefore the earlier right’s *software* is indispensable or important for the use of the *electronic publications (downloadable)*, meaning that they are at least complimentary.

30. The contested *data banks* is a synonym for a database, which is a repository for data. A database, or *data bank*, typically stores information electronically in a computer system. Such a system is controlled by applications, which are a form of *software*. The users and trade channels of *data banks* and *software* are often the same, meaning there is a medium level of similarity. In the alternative, the contested *data banks* are at least complementary to *software*, as there is a close connection between the two, particularly with *software* being important, if not essential, to the control of the *data bank*.

31. The limitation in the contested goods of *all of the aforementioned being for advertising, marketing, and publicity purposes* does not affect the outcome of the

finding, as the scope of the software in the earlier right would extend to include advertising, marketing, and publicity specific software also.

32. Class 35: the opponent argued that the *financial services* in Class 36 of the earlier right and the contested services in Class 35, which it summarised as being in “the nature of business consultancy services with an emphasis on marketing and data processing”, are all “business to business services”, which are used by the same end users (namely businesses), are frequently provided by the same supplier (particularly within the IT sector), and are complementary.

33. Employing the relevant factors identified in *Treat* to the current comparison, I disagree with the opponent’s contention: a) The uses of the services are quite different - one is used for the purpose of analysing finances, whilst the other is used for advertising and marketing purposes; b) The respective users are not necessarily the same, as argued by the opponent, save for the fact that they could both be used by businesses, which is an extremely tenuous link. A bakery and a bank are both businesses, and yet as businesses they operate in entirely different industries; c) The physical nature of the services is not applicable in this instance; d) The trade channels through which the services reach market are different – the market of finance and advertising are not inter-reliant; e) The services are not self-serve from the perspective of the consumer; f) the services are not competitive, in so far as the provider of financial analysis is not competing with the provider of marketing for the same client - this is because the client in each respective trade has different needs.

34. I also disagree that the services are complementary. In my opinion there is no obvious close connection between finance and marketing, and one is certainly not indispensable for the use of the other.

35. The majority of the contested services in Class 35 which the opponent identified as being in “the nature of business consultancy services with an emphasis on marketing and data processing”, i.e. *Marketing; marketing information; marketing research and analysis; business management and consultancy; business information; data processing management; administrative data processing; advertising services relating to databases; analysis of market research data; collection and systematisation of business data; consumer market information services; collection of personnel*

information; computer database management services; computerised data verification; and information, advisory and consultancy services relating to all of the aforesaid services, are therefore considered to be dissimilar.

36. The contested *retail service in connection with the sale of computer software products in the field of marketing, advertising and publicity* is, however, complementary to the *software* of the earlier right. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree even 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.

37. *Software* in Class 9 of the earlier right is indispensable to the *retail service in connection with the sale of computer software*, in much the same way as *chickens* are indispensable to the *transport of chickens*.

38. Class 42: the contested *Design and development of software for database management; and design and development of software for importing and managing data* fall within the general category of the earlier right’s *design and development of software*, and are therefore identical.

39. The contested *software as a service (SAAS)*; and *software as a service (SAAS) relating to marketing, advertising and publicity* fall within the general category of the earlier right's *the provision of software as a service (SaaS)*, and are therefore identical.

40. The contested *information, advisory and consultancy services relating to all of the aforesaid services* are ancillary services which are undoubtedly provided during the provision of the services of the earlier right and are therefore identical.

Comparison of marks

41. It should be noted at this point that in relation to those services for which I have found there to be dissimilarity, a comparison of the marks will not be conducted. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

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

42. This overrides the principle of interdependency. Although the signs are identical, there would need to be some level of similarity between the goods and services in order for a global assessment to be required. I refer to *Canon*, paragraph 17 to support my position in this instance:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of

confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified [emphasis added].”

43. Therefore, in so far as the contested Class 35 services *Marketing; marketing information; marketing research and analysis; business management and consultancy; business information; data processing management; administrative data processing; advertising services relating to databases; analysis of market research data; collection and systematisation of business data; consumer market information services; collection of personnel information; computer database management services; computerised data verification; and information, advisory and consultancy services relating to all of the aforesaid services* are concerned, there will be no likelihood of confusion, regardless of the identity of the marks.

44. The earlier UK mark 3457108 consists of a series of three marks, all of which are the word ‘INFLO’, presented in standard font. The contested mark comprises the same plain word version ‘INFLO’.

45. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.” 44.

46. The first earlier mark and the contested mark are self-evidently visually, aurally and conceptually identical. In addition, the applicant has accepted the opponent’s contention as to the identity of these particular marks.

Average consumer and the purchasing act

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary

according to the category of goods or services in question: Lloyd Schuhfabrik Meyer, Case C-342/97.

48. 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.”

49. The contested goods at issue in Class 9 are limited to *all of the aforementioned being for advertising, marketing and publicity* purpose. The remaining contested services at issue in Class 35, which have not otherwise been found to be dissimilar, equally relate specifically to *advertising, marketing and publicity*. Certain contested services at issue in Class 42 also relate to *marketing, advertising and publicity*, whilst others focus on *databases and data*. I consider it a fair summarisation to categorise that, in general, the contested goods and services relate to *advertising, marketing, publicity, business and data*, and as a result will predominantly be purchased by consumers with a specific interest of, if not a professional need for, goods and services of such a particular nature.

50. The purchase process of the contested goods and services will invariably be a visual one. In relation to the goods, this is because they are tangible and can be examined in a store where they are sold. The goods will likely also be sold online using websites, which is also very much a visual process. In relation to the services, although their purchase does not result from a visual assessment of a tangible object, they are nevertheless invariably purchased online using websites, which is a visual process. In relation to both the goods and the services I do not discount the possibility that the marks may be spoken over the telephone, for example, in a conversation between a

consumer and a retail representative, and therefore there may be an aural element to the purchase process.

51. The level of attention of a professional in the particular market of *advertising, marketing, publicity, business and data* is considered to be high, as the goods and services could be used to fulfil specific technical and specialist tasks in the relevant field.

52. I do not consider it likely that the non-professional/average consumer would have an interest in the technical contested services in Class 42, which facilitate the *design and development of software for database management*. In relation to the remaining goods and services, I consider it likely that the level of attention of the interested non-professional/average consumer will vary. The *advertising, marketing, publicity and business* orientated goods and services could be used for a number of reasons, from creating and placing an advert for an old bicycle in the local small ads, to promoting a new business. Due to the level of attention fluctuating dependant on the non-professional/average consumer's intended use of the goods and services, it is considered that the level of attention will range from low to high in relation to the contested goods and services.

Distinctive character of the earlier trade mark

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

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

54. Neither side has provided a definition for the word ‘INFLO’, and I will continue my assessment on the basis that it has none, and that it is an invented term. It therefore follows that the words ‘INFLO, inflo, Inflo’, which make up the earlier UK right have at least a medium degree of inherent distinctive character.

Likelihood of Confusion

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

56. 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 (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

57. I have found the opponent's earlier mark UK 3457108 and the contested mark to be identical. I have found the goods and services at issue to be either identical, similar to a medium degree, complementary or dissimilar. I have also found the earlier mark to be inherently distinctive to at least a medium degree and that the average consumer's level of attention will range from low to high, but will generally be a medium degree during the selection and purchasing process. It follows that where I have found the goods and services to be identical, similar to a medium degree or complementary, then there must subsequently be a finding of a likelihood of direct confusion. In relation to the contested services in Class 35 which I have found to be dissimilar, there can be no likelihood of confusion, as at least some degree of similarity between the goods and services is a requirement for such a finding.

Conclusion

58. The opposition partially succeeds. Subject to appeal, the application may proceed to registration in respect of those contested services found to be dissimilar, i.e.

Class 35 *Marketing; marketing information; marketing research and analysis; business management and consultancy; business information; data processing management; administrative data processing; advertising services relating to databases; analysis of market research data; collection and systematisation of business data; consumer market information services; collection of personnel information; computer database management services; computerised data verification; information, advisory and consultancy services relating to all of the aforesaid services.*

59. Subject to appeal, the application shall be refused for the following:

Class 9 *Class 9: Computer software; computer software applications; electronic publications (downloadable); computer database management software; data processing software; computer document management software; computer application software; interactive computer software enabling exchange of information; downloadable computer software for the transmission of information; downloadable mobile applications for*

the transmission of information; software for accessing information on a global computer network; computer software for authorising access to databases; computer communication software to allow customers to access personal information and data; computer software for creating searchable databases of information and data; data banks; all of the aforementioned being for advertising, marketing, and publicity purposes.

Class 35 *Retail service in connection with the sale of computer software products in the field of marketing, advertising and publicity.*

Class 42 *Design and development of software for database management; design and development of software for importing and managing data; software as a service (SAAS); software as a service (SAAS) relating to marketing, advertising and publicity; information, advisory and consultancy services relating to all of the aforesaid services.*

60. The two other earlier marks on which the opponent relies, i.e. figurative UK 3454813 and UK 3146580, do not offer any better chance of success in relation to the contested services in Class 35 for which there has been no finding of a likelihood of confusion. This is because the specification of those earlier rights is limited to *Software* in Class 9, against which the contested Class 35 services have already been assessed.

COSTS

61. The opponent has been largely successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Fee for opposition	£100
Preparing a statement and considering the counterstatement of the other side	£200

Preparing written submissions in lieu	£300
Total	£600

62. I therefore order 21 Holdings Ltd. to pay Inflo Group Limited the sum of £600. 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 12th day of November 2021

Dafydd Collins
For the Registrar