

O/875/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003590406

BY ZAMBON S.P.A

TO REGISTER:



AS A TRADE MARK IN CLASSES 9, 16, 41 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001790 BY

PHILIPP C. GAJZER

BACKGROUND AND PLEADINGS

1. On 30 November 2020, ZAMBON S.p.A. (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the European Union. The applicant subsequently applied for the same mark in the UK on 4 February 2021. In accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, by filing an application for the EU mark in the UK within nine months of the end of the transition period, the applicant is entitled to rely on the priority date of the EU mark in UK proceedings. Therefore, the date of the application in these proceedings is considered to be 30 November 2020.
2. The applicant’s mark is applied for in respect of the following goods and services (as amended by a Form TM21B dated 7 September 2021):

Class 9: Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media; downloadable electronic publications; downloadable software applications; all of the aforementioned goods relating to the healthcare field.

Class 16: Printed matter; books, magazines, brochures, leaflets; all of the aforementioned goods relating to healthcare.

Class 41: Educational services provided to healthcare practitioners, healthcare professionals, patients and caregivers; providing of training to healthcare practitioners, healthcare professionals, patients and caregivers; sporting and cultural activities provided to healthcare practitioners, healthcare professionals, patients and caregivers .

Class 44: Medical services; telemedicine services.

3. The application was published for opposition purposes on 21 May 2021 and, on 25 June 2021, it was opposed in full by Philipp C. Gajzer (“the opponent”) under the fast track opposition procedure. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following mark:

move now

UK registration no: 914456453

Filing date 10 August 2015; registration date 10 May 2016

Relying on some goods and services, namely:

Class 9: Recorded data, in particular music sound recording carriers, music recordings, music video recordings, downloadable music recordings, downloadable digital music, in particular via the internet, via MP3 websites or via a computer database; Information technology and audiovisual apparatus, In particular photographic apparatus, Cinematographic apparatus, Apparatus for recording and reproduction of sound and images, Compact discs, DVDs.

Class 41: Education; Education; Providing of training; Entertainment; Sporting and cultural activities; In particular conducting courses in the field of telecommunications; Musical education services; Musical education services; Musical education services; Producing and conducting exercises for music classes and programmes; Musical sound recordings; Production of music; Music recording services; Production of musical videos; Consultancy on film and music production; Production of sound and music recordings; Post-production of music, video and music recordings for broadcast by others; Music publishing and recording; Organisation of fashion shows for entertainment purposes; Publishing and reporting; Translation and interpretation.

4. The opponent submits that the applicant’s mark is so obviously similar to the opponent’s mark that the likelihood of confusion is a given. It was upon receipt of

the notice of opposition that the applicant filed its Form TM21B to amend its specification, as referred to above. Despite this, the opponent maintained the opposition. The applicant then filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. The opponent is unrepresented and the applicant is represented by Mathys & Squire LLP. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. While neither party filed written submissions in lieu of a hearing, the opponent did file an email with reference to previous EUIPO marks and made comment as to costs. While it is not clear whether the opponent meant to file this email as his written submissions, it was filed after the deadline and will, therefore, not be considered as such. However, even if the opponent’s comments had been filed as submissions within the appropriate period, I would not have been able to take the EUIPO marks into account as they were not specifically pleaded in the opponent’s notice of opposition, nor was a request made during the proceedings to add them retrospectively.

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 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 ISSUE

9. In its counterstatement, the applicant stated that:

“The word “MOVE” is not particularly distinctive in relation to any of the Opponent’s Goods and Services, particularly those in Class 41 that could all relate to movement of one form or another. This is backed up by the fact that there are 409 trade marks on the UK register in Class 9 and 41 that contain the word move.”

10. Here, the applicant is arguing that as ‘MOVE’ is a term used in 409 trade marks in classes 9 and 41, the distinctiveness of the opponent’s mark has been weakened due to its frequent use in the marketplace. However, for reasons that I will now explain, the applicant’s point regarding the alleged widespread use of the term ‘MOVE’ has no bearing on the outcome of this opposition.

11. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865,

paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). “

12. The fact that there may be a multitude of entities using the word ‘MOVE’ as part of their trade marks is not a relevant factor to the distinctiveness of the opponent’s mark. The applicant has filed no evidence regarding any marks on the register or any evidence to demonstrate that these marks are actually in use in the marketplace. The outcome of this opposition will be determined by making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

DECISION

Section 5(2)(b): legislation and case law

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

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

(a) ...

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

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

14. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

16. The opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services it has identified.

17. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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.

Comparison of goods and services

18. The competing goods and services are as follows:

The opponent's goods and services	The applicant's goods and services
<p><u>Class 9</u> Recorded data, in particular music sound recording carriers, music recordings, music video recordings, downloadable music recordings, downloadable digital music, in particular via the internet, via MP3 websites or via a computer database; Information technology and audiovisual apparatus, In particular photographic apparatus, Cinematographic apparatus, Apparatus for recording and reproduction of sound and images, Compact discs, DVDs.</p> <p><u>Class 41</u> Education; Education; Providing of training; Entertainment; Sporting and cultural activities; In particular conducting courses in the field of telecommunications; Musical education services; Musical education services; Musical education services; Producing and conducting exercises for music classes and programmes; Musical sound recordings; Production of music;</p>	<p><u>Class 9</u> Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media; downloadable electronic publications; downloadable software applications; all of the aforementioned goods relating to the healthcare field.</p> <p><u>Class 16</u> Printed matter; books, magazines, brochures, leaflets; all of the aforementioned goods relating to healthcare.</p> <p><u>Class 41</u> Educational services provided to healthcare practitioners, healthcare professionals, patients and caregivers ; providing of training to healthcare practitioners, healthcare professionals, patients and caregivers ; sporting and cultural activities provided to</p>

<p>Music recording services; Production of musical videos; Consultancy on film and music production; Production of sound and music recordings; Post-production of music, video and music recordings for broadcast by others; Music publishing and recording; Organisation of fashion shows for entertainment purposes; Publishing and reporting; Translation and interpretation.</p>	<p>healthcare practitioners, healthcare professionals, patients and caregivers .</p> <p><u>Class 44</u></p> <p>Medical services; telemedicine services.</p>
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19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

20. 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.

21. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods (though it equally applied to services) are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

22. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.

23. I have comments from the applicant in respect of the goods and services comparison. As mentioned above, the applicant filed a Form TM21B during these proceedings to amend its specification. The applicant states that the amendments “will ensure that all of these goods and services are entirely dissimilar from those

of the Opponent.” I do not intend to reproduce the remainder of the comments from the applicant in full here but will, if necessary, refer to them below.

Class 9 goods

24. As a result of a limitation, all of the applicant’s class 9 goods are limited to goods relating to the healthcare field. While the limitation is noted, the opponent’s class 9 goods contain no limitation so are not limited to any particular field. Therefore, the limitation alone does not render the parties’ class 9 goods dissimilar.

25. “Apparatus and instruments for recording, transmitting, reproducing or processing sound [or] images” in the applicant’s specification, in my view, covers goods including those in the opponent’s specification, being “information technology and audiovisual apparatus, in particular [...] apparatus for recording and reproduction of sound and images” in the opponent’s specification. As per paragraph 24 above, the opponent’s goods contain no limitation and can, therefore, be used in relation to the healthcare field. These goods are, therefore, identical under the principle outlined in *Meric*.

26. Like my finding at paragraph 25 above, I consider that “apparatus and instruments for recording, transmitting, reproducing or processing [...] data” in the applicant’s specification also falls within “information technology and audiovisual apparatus, in particular [...] apparatus for recording and reproduction of sound and images” in the opponent’s specification. This is on the basis that data is a very broad term that can be said to include images and sound. These goods are, therefore, identical under the principle outlined in *Meric*. However, if I am wrong in this finding, then I consider the goods are similar to a high degree. While there may be a difference in end purpose in that one good records data whereas the other only records sound or images, I consider there is a general overlap in purpose in that both goods aim to record and reproduce. Further, the goods share nature in that they both cover apparatus for recording and/or reproducing. They also overlap in method of use as it is my understanding that they will, at least generally, be used in the same or a similar way. As for user, there is also likely to be an overlap in that both goods will be used by the same public, be that the general public or business users. Further,

the goods are likely to be produced by the same undertakings and be available via the same specialist electronic stores meaning that there is an overlap in trade channels.

27. “Recorded and downloadable media” in the applicant’s specification covers downloadable videos and/or audio goods such as videos or podcasts that focus on healthcare. In my view, given the limitation to these goods, they are unlikely to cover music. While the opponent’s term, being “recorded data, in particular music sound recording carriers, music recordings, music video recordings, downloadable music recordings, downloadable digital music, in particular via the internet, via MP3 websites or via a computer database” makes reference to certain goods “in particular”, it is not limited to them. However, bearing in mind the more restrictive approach signaled by the case of *Sky v Skykick* [2020] EWHC 990 (Ch), I do not consider it appropriate that “recorded data” is equated to every permutation of its potential function. If this was the case, the opponent’s term would cover all types of recorded data and, in my view, this interpretation is too broad. Instead, I consider the opponent’s term to be one that is unclear or imprecise. As a result, and in line with the guidance set out in *Skykick*, I will interpret the term narrowly as so to extend it to only those goods it clearly covers, being the goods listed after ‘in particular’. As a result, I do not consider that these goods are identical. However, they are similar to a degree. While I do not consider the purposes to overlap in that the applicant’s goods are for healthcare purposes whereas the opponent’s are likely to be for entertainment or recreation, there is an overlap in nature and method of use on the basis that both terms cover digital media that is watched and/or listened to. There is also likely to be a general overlap in user in that both goods, even taking into account the healthcare purpose of the applicant’s goods, will be used by members of the general public, though I accept that the applicant’s will also be accessed by dedicated healthcare practitioners. There may also be an overlap in trade channels in that both sets of goods will be available via online platforms which routinely offer video, music and podcasting services. Overall, I consider these goods to be similar to a high degree.

28. As I have set out above, I consider it appropriate to interpret “recorded data, in particular music sound recording carriers, music recordings, music video

recordings, downloadable music recordings, downloadable digital music, in particular via the internet, via MP3 websites or via a computer database” in the opponent’s specification narrowly in that it covers those goods after the words ‘in particular’ only and doesn’t extend to all types of recorded data. As a result, even though “downloadable electronic publications” and “downloadable software applications” in the applicant’s specification are likely to consist of recorded data or are made using recorded data, the opponent’s term does not cover such goods. I am of the view that these goods will overlap in user but only on the basis that both goods will be used by members of the general public, meaning that any overlap is general. As for the remaining factors, I see no obvious reasons as to why they would overlap. Therefore, despite a general overlap in user, I do not consider there to be any obvious level of similarity between these goods. They are, therefore, dissimilar.

Class 16 goods

29. I note that at paragraph 27 above, I have applied the principle outlined in the case of *SkyKick* so as not to equate protection to the opponent for every permutation of “recorded data”. I do not consider the same to be appropriate for the class 41 services of the opponent. This is on the basis that these services are capable of being readily interpreted by the average consumer, whereas, in my view, recorded data is not. Further, the applicant’s class 16 goods contain the same limitation as those discussed in respect of its class 9 goods above.

30. “Printed matter” and “books, magazines, brochures, leaflets” in the applicant’s specification are goods that may be used as teaching materials relating to the healthcare field and can, therefore, cover textbooks or leaflets provided during educational courses. While the nature and method of use of these goods are different to “education” in the opponent’s class 41 services, there is an overlap in purpose. This is on the basis that the applicant’s goods relate to healthcare and may be used to educate the user in relation to the same. As for the services of the opponent, while they may be, in particular, for conducting courses in the field of telecommunications, they are not limited solely to that field and may, therefore, also be used for healthcare purposes. There is also a broad overlap in user on the

basis that both goods and services may be used by those who are looking to obtain an education, though the fields may be distinct. As for trade channels, it is possible for education providers to also provide their own printed materials like those covered in the applicant's specification meaning that there may also be an overlap in trade channels. On that point, I also consider there to be a complementary relationship between the goods and services on the basis that the average consumer attending an educational course will consider the printed materials provided as being important to those services and is likely to believe that the undertaking responsible for the educational service is also responsible for the printed matter supplied.¹ Overall, I consider that the applicant's goods in class 16 are similar to a medium degree with "education" in the opponent's specification.

Class 41 services

31. As I have set out above, despite the opponent's class 41 services containing a term that they are 'in particular' for conducting courses in the field of telecommunications, they are not limited solely to that field. Therefore, they can cover any type of educational service.
32. "Educational services provided to healthcare practitioners, healthcare professionals, patients and caregivers" in the applicant's specification falls within the broader category of "education" in the opponent's specification. These services are, therefore, identical under the principle outlined in *Meric*.
33. "Providing of training to healthcare practitioners, healthcare professionals, patients and caregivers" in the applicant's specification falls within the broader category of "providing of training" in the opponent's specification. These services are, therefore, identical under the principle outlined in *Meric*.
34. "Sporting and cultural activities provided to healthcare practitioners, healthcare professionals, patients and caregivers" in the applicant's specification falls within the broader category of "sporting and cultural activities" in the opponent's

¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

specification. These services are, therefore, identical under the principle outlined in *Meric*.

35. Even if my finding at paragraph 29 above is wrong and it is appropriate to limit the opponent's services to those for telecommunication purposes, there would be at least a medium degree of similarity between the parties' class 41 services. This is on the basis that they would still overlap, to a degree, in nature and method of use as the services would still be the same type of services used in the same way, be that educational, training or sporting/cultural activities. While it could be said that their end purpose would differ in that the applicant's service is for healthcare whereas the opponent's is for telecommunications, the core purpose would be the same in that both parties' services aim to educate, train or provide sporting/cultural activities. Further, they may also overlap in trade channels as educational, training and activity providers are likely provide those same services for a wide range of topics, including those covered by both parties' specifications.

Class 44 services

36. I do not consider there to be any obvious level of similarity between the applicant's "medical services" and "telemedicine services" and any of the goods or services in the opponent's specification. These services are, therefore, dissimilar.

37. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services I have found to be dissimilar will fail.² For ease of reference, the opposition fails against the following goods and services in the applicant's specification:

Class 9: Downloadable electronic publications; downloadable software applications; all of the aforementioned goods relating to the healthcare field.

Class 44: Medical services; telemedicine services.

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

38. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

39. In my view, the average consumer for a majority of the goods at issue will be members of the general public and professional users (being those in the healthcare industry for the applicant's goods). However, I note that the average consumer for some goods, such as apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, may be business users. As for the services, these may be selected by both members of the general public, professional users, such as healthcare professionals and business users looking to educate their staff in regard to telecommunications, for example.

40. For the member of the general public, the goods are likely to be available through a range of retail shops and their online equivalents. As for the goods selected by professional and business users, these are likely to be available via specialist providers and their online equivalents. Where the goods are selected at physical premises (be that via a retailer or specialist provider), they will be displayed on shelves and self-selected by a consumer. A similar process will apply to websites where the consumer will select the goods having viewed an image displayed on a website. For specialist providers, the goods may also be selected after a discussion

with a salesperson. The selection of the goods by members of the public will be primarily visual but I do not discount the aural component playing a part. However, for the goods selected by the professional and business user, I am of the view that the selection of these will be both visual and aural (in equal measure) depending on the method of sale used.

41. As for the services at issue, these are likely to be available via specialist providers and their websites. The services are likely to be chosen after viewing a list of them in a catalogue, leaflet or on placards. For certain services, they may also be selected after a discussion with a salesperson. The selection of the majority of the services will be primarily visual with the aural component playing a part. However, for some services, I consider it likely that the selection process will be equally visual and aural.

42. The goods and services at issue will range from inexpensive items such as printed materials like books to relatively expensive services such as educational services. The goods and services are likely to range from being purchased/selected frequently to infrequently, depending on which goods/service is being purchased/selected. Depending on what is being chosen the average consumer will bear in mind a wide range of factors such as materials used and print quality for the class 16 goods to a more measured thought process for educational services. For example, educational services for healthcare practitioners would be an important choice for a professional user looking to ensure that they receive the best quality of education as it pertains to their profession. The user of these services would want to ensure that the services will be provided professionally and meet their particular needs. The level of attention paid by both the member of the general public and business user for the goods and services will, generally, be medium. However, I recognise that it will range to a higher degree of attention for some educational services aimed at healthcare practitioners, for example.

Distinctive character of the opponent's mark

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

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

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

44. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not submitted that its mark has been enhanced through use, nor has it filed any evidence to that effect. Therefore, I have only the inherent position to consider.

45. The opponent’s mark is a word only mark that consists of two ordinary dictionary words, being ‘move’ and ‘now’. When viewed in combination, the words will be seen as a unit, being ‘move now’. To the average consumer, this will be understood as an ordinary instructional phrase. The applicant has stated that the ‘MOVE’ element of the mark is relatively non-distinctive. This may apply to the opponent’s services of sporting activities on the basis that they may be used to encourage their users to ‘move now’ in order to keep fit or lose weight, for example. While the opponent’s mark may be considered allusive on that particular service and,

therefore, of low inherent distinctive character, I find that for all other goods and services, the same does not apply. For the remaining goods and services, I do not consider that the mark has any allusive or descriptive qualities. Despite this, I do not consider it to be particularly remarkable from a trade mark perspective. I, therefore, consider the opponent's mark to enjoy a medium degree of inherent distinctive character for the remaining goods and services.

Comparison of marks


46. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

47. 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.”

48. 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.

49. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
move now	

Overall Impression

50. The applicant's mark consists of a word element and a device element. The word element is 'MoveON'. This will be seen as two conjoined words, being 'Move' and 'ON'. The average consumer will view these words in combination and see them as a unit. The words are followed by a device element of a profile view of a stylised human head. The device is made up of dots and lines, one of which extends back to underline the word element. Given that the eye is naturally drawn to the parts of marks that can be read, I consider that the word element will play a greater role in the overall impression of the mark, with the device element playing a lesser role. I also find that the use of colour in the mark will play a role, albeit a minimal one.

51. The opponent's mark is a word only mark consisting of the words 'move' and 'now' that will be viewed together as a unit. There are no other elements that contribute to the overall impression of the mark that lies in the words themselves.

Visual Comparison

52. Visually, the marks share the word 'Move'. This is followed by a different word in each mark, being 'ON' in the applicant's mark and 'now' in the opponent's. Further, the device element that is present in the applicant's mark is absent in the opponent's and despite its lesser role, it still constitutes a point of visual difference. As for the use of typeface and colour in the applicant's mark, I note that as a word only mark in black and white, the opponent's mark is permitted to be used in any standard typeface and in any colour. While this may be the case, use of the opponent's mark does not extend to contrived colour splits, such as putting the first part in one colour and the rest in another. While I have found the colouring in the applicant's mark to have a minimal impact, it still constitutes a slight point of visual

difference between the marks. Taking all of the above into account, I find that these marks are visually similar to no more than a medium degree.

Aural Comparison

53. Aurally, the opponent's mark consists of two syllables that will be pronounced 'MOOV-NAO'. The applicant's mark consists of two syllables that will be pronounced 'MOOV-ON'. The first syllable of the marks is identical, but the second syllable is different. Given that the average consumer tends to focus on beginnings of marks,³ being where the identity lies, I consider that the marks are aurally similar to a high degree.

Conceptual Similarity

54. Firstly, I do not consider that the device element in the applicant's mark will convey any conceptual message to the average consumer on the basis that it will be seen as a decorative element only. This leaves the conceptual comparison as being between the word elements of both marks.

55. I note that both marks include the word 'Move'. Despite being the same word, I am of the view that, in the context of each mark as a whole, its conceptual impact is not identical. I make this finding whilst bearing in mind the conceptual impact of each mark as a whole. For example, I consider that the concept of 'Move ON' in the applicant's mark is that of someone moving on to something new or to convey that they are progressing. As for the opponent's mark, being 'move now', I am of the view that this conveys a reference to a physical and immediate movement. This, in my view, limits any shared concept but not to the point where the marks are conceptually dissimilar. Overall, I consider the marks to be conceptually similar to a medium degree.

Likelihood of confusion

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and/or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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 some of the applicant's goods and services to be identical or similar to a medium degree and above with the opponent's goods and services. I have found the average consumer for the goods and services to be either members of the general public, professional or business users. I have found that some goods and services will be selected through primarily visual means (although I do not discount an aural component) whereas others will be selected by visual and aural means (in equal measure). I have concluded that the average consumer will generally pay a medium degree of attention but that this may be higher (but not the highest) for some of the services at issue.

58. I have found the applicant's mark to be visually similar to no more than a medium degree, aurally similar to a high degree and conceptually similar to a medium degree with the opponent's mark. I have found the opponent's mark enjoys a medium degree of inherent distinctive character for a majority of the goods and services but low for its service of "sporting and cultural activities". I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

59. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and conceptual differences between the marks

are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks, even on goods and services that are identical.

60. It now falls to me to consider whether there is a likelihood of indirect confusion. Indirect confusion involves recognition by the average consumer of the differences between the marks. In the present case, simply because the marks share the common word 'Move', there is no plausible basis for an average consumer to believe that the applicant's mark is another brand of the owner of the opponent's marks.⁴ This is because the common element is not so strikingly distinctive where the average consumer would consider that only the opponent would use it. Further, the differences in the marks do not lend themselves to a natural brand extension or sub-brand, nor are the different elements indicative of a logical re-branding. For example, when noticed I do not consider that the average consumer would think that 'Move ON' was a logical sub-brand or brand extension of 'move now' or vice versa, especially given the conceptual differences between those phrases. While I note that the examples of indirect confusion given in *L.A. Sugar* (cited above) are not exhaustive and are instead intended to be illustrative of the general approach, I can see no additional reasons as to why the average consumer would be indirectly confused by the marks. Taking all of this into account and considering the marks as wholes, there will be no indirect confusion. I make this finding even on goods and services that are identical.

CONCLUSION

61. The opposition has failed in its entirety. The application may, therefore, proceed to registration for all goods and services.

COSTS

62. I note that in the opponent's email referred to at paragraph 7 above, he stated that he refuses to bear any costs or expenses created by the opponent. Given that he is the opponent in these proceedings, it is understood that he is referring to costs

⁴ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

or expenses created by the applicant. While this is noted, the powers granted by section 68 of the Act and Rule 67 of the Trade Mark Rules 2008 provide that the Tribunal may award any party such costs that may be considered reasonable. It is an established practice in the majority of proceedings that are decided before the Tribunal that the unsuccessful party be ordered to contribute to the costs of the successful party. In the present case, being a fast track opposition, those costs are based upon the scale published in Tribunal Practice Notice 2/2015. Liability for costs is discussed further at paragraph 5.1 of the Tribunal section of the Trade Marks Manual.⁵

63. As the applicant has been successful, it is entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of **£200** as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and preparing a counter statement:	£200
Total	£200

64. I therefore order Philipp C. Gajzer to pay ZAMBON S.p.A. the sum of £200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of November 2021

A COOPER
For the Registrar

⁵ <https://www.gov.uk/guidance/trade-marks-manual/tribunal-section>