

BL O/1084/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3680841

BY

VTAIL LTD

TO REGISTER THE FOLLOWING TRADE MARK:

vtail.com

AND

OPPOSITION NO. 429847 THERETO

BY

VTAIL HEALTHCARE TELECOMMUNICATIONS LIMITED

Background and pleadings

1. On 12 August 2021, Vtail LTD (the “Applicant”) applied to register the word only trade mark **vtail.com**. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 1 October 2021. Registration of the mark is sought in respect of the following goods:

Class 9 *Downloadable software for providing access to, management of, and communication to others of licensed digital collectibles, digital tokens, financial transactions, images and projects in the field of children's games and entertainment; downloadable augmented reality software for integrating electronic data with real world environments for use in the field of children's games and entertainment; Downloadable software for providing access to, management of, and communication to others of licensed digital collectibles, digital tokens, financial transactions, images and projects in the field of children's games and entertainment; downloadable augmented reality software for integrating electronic data with real world environments for use in the field of children's games and entertainment.*

Class 35 *Providing an online marketplace for buyers and sellers of crypto collectibles; providing an online marketplace for buyers and sellers of blockchain-based non-fungible assets; operating on-line marketplaces featuring crypto collectibles and blockchain-based non-fungible assets.*

Class 42 *Creation of online retail stores for others in the nature of web-based service that allows users to create hosted crypto collectible and blockchain-based non-fungible token stores; creation of a web site in relation to technology that enables internet users to create, bookmark, annotate, and publicly share data; creation of a members-only website in relation to technology which provides members with the ability to access multiple databases for the purpose of purchasing crypto collectible and blockchain-based non-fungible tokens.*

2. On 4 January 2022, vTail Healthcare Telecommunications Limited (the “Opponent”) opposed the application under Section 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purposes of the opposition, the Opponent relied upon one earlier United Kingdom Trade Mark (UKTM):

UKTM No. 3603240

VTAIL

Filing date: 2 March 2021

Registration date: 9 July 2021

3. For the purposes of this opposition, the Opponent relied upon all of the goods and services for which the earlier mark is registered in Classes 9, 35, 38, 41, 42 and 45 (see **Comparison of goods and services**).

4. Since the filing date of the earlier mark predates that of the contested application, the Opponent’s mark is considered to be an “earlier mark” in accordance with section 6 of the Act. However, as the mark has not been registered for a period of five years or more before the filing date of the application, it is not subject to the 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 mark is registered without having to show that it has used the mark at all.

5. The opposition is aimed against all of the goods and services in the contested application. The statement of grounds is separated into three main arguments under Section 5(1), 5(2)(a) and 5(2)(b) respectively.

5(1)

6. The Opponent contended that despite the inclusion of the suffix ‘.com’, the marks are identical. This is because it is apparently settled in case-law that a ‘.com’ element will be perceived to be a mere generic top-level domain without any trade mark significance. The Opponent went further and submitted that the element ‘.com’ is in fact non-distinctive because it simply indicates the provision through which the contested goods are offered/delivered. The Opponent referred to a decision from the

European Union Intellectual Property Office (EUIPO) Board of Appeal (R 305/2001-3 PETS.COM) and EUIPO Opposition Division (B 2 425 703 PHOTOS.COM) to support this position. The Opponent argued that the contested goods in Class 9 are identical to the goods in Class 9 of the earlier mark. The Opponent argued that given the identity of the marks and the contested goods in Class 9, the contested mark should be refused under Section 5(1). No submissions were made in relation to the contested services under Section 5(1).

5(2)(a)

7. The Opponent contended that the marks are identical (for the same reasons as above), and that the contested goods and services are at least highly similar to those of the earlier mark. The Opponent argued that there is therefore a likelihood of confusion under Section 5(2)(a).

5(2)(b)

8. The Opponent contended that the marks are at least highly similar, and that the contested goods and services are either identical or similar. The Opponent argued that the marks coincide in the dominant and distinctive element 'vtail', which is at the beginning of the mark, and which is where consumers pay more attention. Accordingly, the marks are visually, aurally and conceptually highly similar. The Opponent argued that there is therefore a likelihood of confusion under Section 5(2)(b).

9. The Opponent provided further submissions regarding the identity or similarity of the goods and services at issue, but these shall not be summarised here, rather they will be introduced into the decision wherever I consider them to provide assistance and clarity.

10. On 15 March 2022, the Applicant filed a counterstatement. The Applicant referred to the principle of honest concurrent use, and submitted that it had taken steps to ensure that its trade mark would be registered for goods that are distinctive [from those of the Opponent] and would not lead to the consumer being deceived. The Applicant also referred to the principle of honest concurrent use for the purposes of refuting the Opponent's claim that its mark is non-distinctive for the goods applied for. The Applicant argued that the contested mark vtail.com indicates that the relevant business

is one of “pure technology”, which is different from the healthcare-specific business of the Opponent. The Applicant submitted that the respective goods and services travel in different channels of trade and are completely different, with the relevant consumers for each respective list of goods and services also being different. The Applicant argued that there can therefore be no likelihood of confusion. In addition, the Applicant argued that the Opponent does not have a monopoly over the entire class of the respective goods and services at issue. The Applicant provided more detailed submissions regarding the goods and services comparison but, as with those of the Opponent, they shall not be summarised here, rather they will be relied on wherever I consider them to provide assistance and clarity.

11. On 31 May 2022, the Opponent filed its submissions, which were predominantly in direct response to the “spurious and/or misguided claims made by the Applicant in its defence and counterstatement”. The Opponent submitted that it is unclear which earlier mark owned by the Applicant it is referring to and relying upon to support the claim of honest concurrent use. The Opponent submitted that even if it did own an earlier right (which the Opponent argues it does not), the Applicant had failed to demonstrate any period of concurrent use that would give rise to a discussion of honest concurrent use. In light of the above, the Opponent argued that the claim should be disregarded. The Opponent clarified that it had in fact not claimed the contested mark was non-distinctive, rather it had argued that the suffix ‘.com’ is non-distinctive.

12. In relation to the submission made by the Applicant regarding the scope of the earlier mark’s protection, the Opponent referred to *Sky Ltd & Ors v Skykick, UK Ltd & Anor (Rev2) [2021] (EWCA)*, which found use of broad terms such as computer software to be entirely legitimate and consistent with good faith practice. The Opponent maintained its position that the contested goods and services are either identical or highly similar.

13. On 21 June 2022, the Applicant filed written submissions together with the witness statement of Mr Jacob Elmon, Director of Vtail Ltd. The witness statement was accompanied by exhibits JE1 – JE14. In its submissions, the Applicant refuted the Opponent’s submission that it does not have an earlier right. The submissions explained that Mr Jacob Elmon’s father, Mr Brandon Jay Elmon, funded and

developed a Vtail genesis project in 2007, and had used both the mark 'VTAIL' and the domain name vtail.com (registered on GoDaddy.com on 19 August 2007, exhibited at JE1) since then. The submissions explained that Mr Brandon Jay Elmon was the Director of Virtual Freehold Limited (hereafter referred to as "VFL"), which had registered the European Union Trade Mark (EUTM) No. 6528285 'VTAIL' on 13 May 2009 (erroneously stated as registered on 18 May 2009).¹ The submissions explained that Mr Brandon Jay Elmon had used the EUTM for almost a decade, until it expired on 19 December 2017. The submissions explained that Mr Brandon Jay Elmon is also a Director of Vtail LTD, the Applicant in the current proceedings. The above submissions appeared under the heading **Honest concurrent use under Section 7 TMA**, and were intended to support the Applicant's position in this regard.

14. The Applicant reiterated that whilst the contested goods and services fall in the same classes as those of the earlier mark, they are actually "completely different from one another", with the Applicant being involved in NFT and blockchain technology, whereas the Opponent is involved in the healthcare profession. The Applicant provided further submissions in relation to the similarity, or lack thereof, of the goods and services at issue, which again shall not be summarised here, but will be referred to if and when they are considered to provide assistance and clarity. I consider it a fair reflection to state that the Applicant's submissions focused mostly on arguing that the respective goods and services at issue are different, rather than commenting on the levels of similarity of the marks themselves, other than to state that although there is phonetic similarity the "logo adopted by both parties is different".

15. The witness statement of Mr Jacob Elmon echoed the points made in the submissions around the use of VTAIL and registration of vtail.com, as well as the now expired EUTM registration 'VTAIL'. The accompanying exhibits JE1 and JE8 have already been mentioned. The remaining exhibits only be briefly summarised, as I do not consider them to provide anything more that confirmatory information: JE4 – JE7 – invoices for maintaining the domain vtail.com from 2008 – 2022; JE9 – details regarding the company name of Virtual Freehold Limited; JE12 - details regarding the company name of Vtail LTD; JE15 – a snapshot of vtail.co, claimed to be the

¹ The Applicant included JE8 (erroneously referred to in the submissions as JE7), being a snapshot of the EUTM register. The current status of EUTM 6528285 is 'Expired'.

Opponent's website. The information on the website states "The platform for healthcare professionals to connect with the healthcare industry".

16. On 22 August, the Opponent filed submissions in reply. The Opponent submitted that the Applicant's claim of honest concurrent use is entirely without merit, as the supposed existence of the earlier VTAIL mark is not supported by fact. The Opponent submitted that the Applicant's loose application of the principles of personal and corporate legal personality is problematic, i.e., as a Limited Company, the Applicant cannot have a "father". The Opponent argued in addition that as a Limited Company the Applicant, Vtail LTD, was not incorporated until January 2020 and therefore cannot have used the supposedly earlier VTAIL mark or domain name vtail.com, because they were both first used years prior in 2007. The Opponent argued that aside from Mr Brandon Jay Elmon being at different times a Director of both VFL and Vtail LTD, there is no legal relationship between the companies. Put simply, the Opponent argued that the "actions of VFL are irrelevant to these proceedings". The Opponent also referred to the fact that the EUTM is expired, and therefore no longer in force.

17. On 5 September 2022, the Applicant filed further submissions in which it stated that Mr Brandon Jay Elmon is the founding member and co-Director of both companies Vtail LTD and Virtual Freehold Limited. The Applicant stated that Messrs Brandon and Jacob Elmon "revived" the EUTM in 2020. Providing further submissions as to the relationship between the companies, the Applicant submitted in the following terms:

"It is a well-established fact that the Director is the agent of the Company for the conduct of the business of the company. The Director of a company has fiduciary relationship between the company as well the shareholders where he can act as an agent or office of the company. It is needless to state any other legal relationship between both companies in light of above submitted arguments. The above submitted arguments obviate the need to establish any further legal relationship. Thus, it is evident from previous submitted arguments dated 21st June 2022 that the previous mark was actively registered at the EUIPO until the year 2019 which undoubtedly and clearly establishes prior use of the mark by the Applicant".

18. The Applicant argued anew that trade marks of a similar nature can be registered for goods which fall within the same class if they are not identical to those of a previously registered mark. The Applicant reiterated that the trade channels of each respective mark are “drastically different”, and that an “average man of ordinary intelligence would not associate the goods and services of the Applicant with those of the Opponent”.

19. No Hearing was requested, and neither party filed submissions in lieu of a Hearing.

20. The Applicant is unrepresented. The Opponent is represented by Cooley (UK) LLP.

Decision

21. 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.

Section 5(1) and 5(2)(a)

22. Section 5(1) of the Act states:

“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.

23. Section 5(2)(a) of the Act reads as follows:

(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 trade mark is protected

24. For the purposes of both Section 5(1) and 5(2)(a) of the Act, the marks at issue have to be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union 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 an average consumer.”

25. I note the Opponent’s position that, essentially, the suffix ‘.com’ is non-distinctive and therefore does not constitute an element that differentiates the marks. The issue of whether the suffix ‘.com’ possesses concept or not shall be visited later in the decision. However, it cannot be denied that it possesses both a visual and aural presence that will be seen and spoken, and therefore creates an obvious difference between the marks at issue which prevent a finding that they are identical.

26. It should be noted that the decisions referred to by the Opponent in support of the claim that the element ‘.com’ is non-distinctive are non-binding, as neither are judgments of the Court. The Opposition therefore fails under Section 5(1) and 5(2)(a).

Section 5(2)(b)

27. Section 5(2)(b) of the Act is 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 of association with the earlier trade mark”.

28. 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.

Comparison of goods and services

29. Both parties have provided submissions in relation to the respective goods and services at issue, and whether they are in the same channels of trade. Whilst the parties' comments are noted, the degree of similarity or identity of the specifications, 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. I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity.

Earlier mark	Application
<p><i>Class 9: Computer software; computer application software; communications software; computer software applications for database management in the field of business development, and relationship building; computer software that provides web-based access to applications and services through a web-operating system or portal interface; mobile application software; downloadable electronic publications; downloadable software in the nature of a mobile application; downloadable computer software for the collection, editing, organizing, modifying,</i></p>	<p><i>Class 9: Downloadable software for providing access to, management of, and communication to others of licensed digital collectibles, digital tokens, financial transactions, images and projects in the field of children's games and entertainment; downloadable augmented reality software for integrating electronic data with real world environments for use in the field of children's games and entertainment; Downloadable software for providing access to, management of, and communication to others of licensed digital collectibles, digital tokens, financial transactions, images and</i></p>

<p><i>bookmarking, transmission, storage and sharing of data and information.</i></p>	<p><i>projects in the field of children's games and entertainment; downloadable augmented reality software for integrating electronic data with real world environments for use in the field of children's games and entertainment.</i></p>
<p><i>Class 35: Advertising; business management; business administration; online business networking services; advertising, marketing and promotion services for businesses; advertising, marketing and promotion services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes; providing information about and making referrals concerning products, services, events and activities; providing business information, namely, making business referrals concerning products, services, events and activities of others; providing consumer information about and making referrals concerning products, services, events and activities; providing business and business networking information from searchable indices and databases of information by means of global computer information networks or other communication networks; promoting the goods and services of others via computer and communication networks; electronic commerce services, namely, providing information about products via</i></p>	<p><i>Class 35: Providing an online marketplace for buyers and sellers of crypto collectibles; providing an online marketplace for buyers and sellers of blockchain-based non-fungible assets; operating on-line marketplaces featuring crypto collectibles and blockchain-based non-fungible assets.</i></p>

telecommunication networks for an on-line community for advertising and marketing; electronic commerce services, namely, providing an on-line community for advertising and marketing; market research and compilation of business data; preparing business reports; business consulting and information services; business management consulting; business organization consulting.

Class 38: Telecommunications services, namely electronic transmission of data, messages and information between and among computers, mobile and handheld devices and wired and wireless communication devices; telecommunication services, namely, enabling users to transmit messages, comments, multimedia content, videos, movies, films, and photos, audio content, animation, pictures, images, text, information, and other user-generated content via a global computer network and other computer and communications networks; providing online communications links which transfer users to other websites; providing online forums, chat rooms and electronic bulletin boards for users to post, search, watch, share, critique, rate, and comment on subjects of interest; providing access to computer, electronic

and online databases; providing telecommunication facilities that enable the creation and updating of personal electronic web pages featuring user-provided content; transmission of database information via telecommunication networks; organizing, maintaining a forum for the exchange of information among businesses, governments, educational institutions and communities through the use of a global computer network; providing access to platforms on the Internet to facilitate the exchange and sale of services and products of third parties via computer and communication networks.

Class 41: Entertainment and education services; providing online training; providing and hosting seminars, presentations and discussion groups and distribution of informational course material in connection therewith; organizing and conducting online educational and training events; providing of training; hosting of conferences and seminars for business purposes, business consulting, business development; hosting of virtual conferences and seminars for business purposes, business consulting, business development.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via the Internet or other communications networks; hosting virtual communities for registered users to organize groups, events, participate in discussions, and engage in social, business, and community networking; hosting of digital content online; hosting computer software applications of others; hosting an interactive website and online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content; providing non-downloadable software enabling users to search, locate and communicate with others via electronic communications networks for networking; providing non-downloadable software for users to create and update personal electronic web pages featuring

Class 42: Creation of online retail stores for others in the nature of web-based service that allows users to create hosted crypto collectible and blockchain-based non-fungible token stores; creation of a web site in relation to technology that enables internet users to create, bookmark, annotate, and publicly share data; creation of a members-only website in relation to technology which provides members with the ability to access multiple databases for the purpose of purchasing crypto collectible and blockchain-based non-fungible tokens.

user-provided content in the fields of business networking, business marketing, and advertising; application service provider services; providing temporary use of non-downloadable software; providing temporary use of online, non-downloadable software enabling users to search, locate and communicate with others via electronic communications networks for networking; hosting of customized web pages featuring user-defined information, personal profiles, audio and images; computer programming; computer services, namely, on-line personalized information services; creating and maintaining websites that provide an on-line community for advertising and marketing.

Class 45: Internet-based social introduction and networking services; online social introduction and networking services; social introduction and networking services; online social networking services, allowing registered users to share information, photos, audio and video content and engage in communication and collaboration between and among themselves, to form groups and to engage in social networking; licensing services.

30. 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”.

31. 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.

32. 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 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”.

33. 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”.

34. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e., chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander K.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.

Class 9

35. The earlier mark is registered for *Computer software* in Class 9. This is a broad and general category of good that could and would encompass a large number of types and sub-categories of software. The Applicant has made several arguments that the Opponent cannot have a “monopoly” over an entire class of goods, and that the marks can coexist in the same class as they move in different trade channels. In response, the Opponent argued that it is entirely legitimate and in accordance with good faith practice to apply for specification wordings such as *computer software*. Indeed, it is assumed that when making an application the respective party has a good faith intention to use the mark in relation to each good and service that has been applied for in the future, and actually has five years to do so following the date of completion of the registration procedure before the registered mark is eligible to be revoked if it has not been put to genuine use for certain registered goods and services.² It is therefore assumed that the earlier mark is legitimately registered for all types of *computer software*, including those varieties of downloadable software in the contested mark. The contested Class 9 goods, all of which are varying types of *downloadable software*, therefore fall within the general category of the earlier mark’s *computer software*, and are subsequently considered identical under the *Meric* principle.

Class 35

36. The contested services in Class 35 all provide an online marketplace, specifically for the opportunity to buy and sell crypto, digital assets and non-fungible tokens. The earlier mark is registered for, amongst other things, *promoting the goods and services*

² Trade Marks Act 1994

Section 46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

of others via computer and communication networks; electronic commerce services, namely, providing information about products via telecommunication networks for an on-line community for advertising and marketing; and electronic commerce services, namely, providing an on-line community for advertising and marketing. The differences between these service offerings can be simplified as, on the one hand, online promoting and marketing (earlier mark), and on the other hand, online buying and selling (contested mark). Although they both exist in the online realm, the intended purpose is clearly different: promoting and marketing Vs buying and selling. However, the service offerings are nevertheless linked insofar as that which is promoted and marketed is ultimately bought and sold. The respective users may be the same, and they have the same nature by being online versions of the offerings. They are therefore considered to be similar to between a low and medium degree. In the alternative, they are considered to be complementary, as one (advertising) is important for the other (selling) in such a way that customers may think that the responsibility for those goods lies with the same undertaking.

Class 42

37. The contested *Creation of online retail stores for others in the nature of web-based service that allows users to create hosted crypto collectible and blockchain-based non-fungible token stores and creation of a members-only website in relation to technology which provides members with the ability to access multiple databases for the purpose of purchasing crypto collectible and blockchain-based non-fungible tokens* have the same intended purpose of providing the facility to purchase crypto and NFTs. One service is an open retail store, whilst the other appears closed to members only. Nevertheless, the intended purpose of each is the same: the ability to buy crypto and NFTs. The earlier mark is registered for *hosting virtual communities for registered users to organize groups, events, participate in discussions, and engage in social, business, and community networking and creating and maintaining websites that provide an on-line community for advertising and marketing.* Such services include providing the facility for specific communities to engage in several interactions, including *business networking*. The service of *business networking* is relatively vague, however, it could certainly include a platform for buying and selling goods and services, potentially including crypto and NFTs, for example. It must be remembered

that under the principle of *Meric* a general category would include more specific categories. The contested *Creation of online retail stores for others in the nature of web-based service that allows users to create hosted crypto collectible and blockchain-based non-fungible token stores and creation of a members-only website in relation to technology which provides members with the ability to access multiple databases for the purpose of purchasing crypto collectible and blockchain-based non-fungible tokens* services are therefore considered to be similar to a degree between low and medium with the identified services of the earlier mark.

Comparison of the marks

38. 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.”

39. It would be wrong, therefore, to dissect the trade marks artificially, 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.

40. The respective trade marks are shown below:

Earlier mark	Application
VTAIL	vtail.com

41. The earlier mark is presented in a standard typeface. It consists of the term VTAIL, which is where the overall impression and any distinctiveness must lie. The term as a whole is not an English language word. In fact, neither party has provided submissions as to any potential meaning, and it is therefore assumed to be a seemingly invented term.

42. The contested mark consists of the conjoined terms vtail.com. It is presented in a standard typeface. As a whole, the mark has no apparent meaning in the English language, and neither party has provided submissions as to any potential meaning. Whilst the element 'vtail' is a seemingly invented term, the element '.com' will nevertheless be familiar to all consumers, as the indicator of the top-level domain, which is part of the universal structure of websites. Due to the inclusion of the '.com' top-level domain, the overall impression of the contested mark will be that of a website named 'vtail'. This overall impression is where any distinctiveness must lie.

Visual similarity

43. Visually, the marks are similar insofar as they coincide identically in the first five letters of each respective mark, being 'vtail'. The marks differ to the extent that the contested mark contains the domain indicator '.com'. As the earlier mark is wholly contained within the contested mark, and represents the beginning of the later mark, the marks are considered to be visually similar to a high degree.

Aural similarity

44. The combination of the letter 'v' followed by the consonant 't' is not a natural combination in the English language. In my opinion the most obvious way to pronounce the earlier mark will be to enunciate the letter 'v' first and separately, followed by the standard pronunciation of the combination of letters forming the recognised word 'tail'. The earlier mark constitutes the two syllables 'vee' – 'tail'. The contested mark is aurally similar to the earlier mark insofar as it shares the first two syllables, which will be pronounced identically. The contested mark aurally differs from the earlier mark insofar as it also contains the element '.com', that has no counterpart in the earlier mark. The '.com' element of the contested mark will be pronounced as the word 'dot' followed by the word 'com', as in 'COMputer'. This is the standard practice when enunciating the top-level domain that '.com' will be recognised as being. The contested mark therefore consists of the four syllables 'vee' – 'tail' – 'dot' – 'com'. The marks are aurally similar to between a medium and high degree as they share the identical first two syllables, but differ as to the last two syllables.

Conceptual similarity

45. Neither party has provided submissions as to the concept of the term 'vtail', and it is therefore assumed and accepted by both parties to be a seemingly invented term.

46. The contested mark contains the identical seemingly invented term, with the additional suffix '.com'. In my opinion, the suffix '.com' will be universally understood as representing a top-level domain, which the average consumer will unanimously interpret as indicating a website. The average consumer will therefore consider the contested mark to have the concept of a website called 'vtail'. Such is the familiarity of the suffix '.com', due to its prevalence in all manners of trade to indicate an internet presence, that its conceptual impact is considered to be minimal.

47. Due to the fact that the earlier mark has no obvious conceptual meaning, there can be no conceptual comparison.

Average consumer and the purchasing act

48. 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.³ 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 goods at issue include varying types of software, whilst the services at issue provide varying forms of marketing, advertising, facilitation, access and retail. The predominant subject of the contested goods and services is crypto, digital assets and NFTs. A small number of the goods are aimed at children’s entertainment, so the average consumer will include a child or parent/guardian of a child responsible for making the purchase. In the majority of instances, however, the goods and services will be aimed at a financially minded adult, specifically one with an interest in online networking, as well as the realm of crypto and digital assets. In my experience, the market for crypto, digital assets and NFTs etc is extremely volatile, and in my opinion any financial investment in this market is unlikely to be casual, with the average consumer more likely showing a heightened degree of attention. Even if it were to be determined that the consumer attention in relation crypto, digital assets and NFTs is not necessarily any higher than it is in relation to other types of finance, it is nevertheless accepted that most areas of financial services tend to attract a heightened degree of attention from both the average and professional consumer. The finances surrounding crypto, digital assets and NFTs would certainly fall within this

³ *Lloyd Schuhfabrik Meyer*, Case C-342/97

category. In relation to those goods for which the average consumer is the child or parent/guardian of a child, the level of attention will be relatively low, as involvement will be for the purposes of entertainment rather than financial gain.

50. Based on the nature of the goods and services at issue, I consider it most likely that the purchasing process will be visually dominated. Although some of the goods may be tangible (in which case the purchase process will in any case be dominated by the visual aspect), the majority of the goods and services would be predominantly encountered online or via an app store etc. The purchasing decision will therefore be based on the visual appearance of the product. That having been said, I do not entirely discount the possibility that the marks may often be spoken, for instance whilst engaging with a financial advisor, investor or trader of crypto, NFTs etc., on the telephone. As a consequence, I consider the aural aspect to often be an important aspect in the purchasing process.

Distinctive character of the earlier trade mark

51. The Opponent has not made a direct claim that its earlier mark has acquired an enhanced degree of distinctive character, nor has the Opponent filed any evidence of use that may indicate such a position. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

52. 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).”

53. In *Kurt Geiger v A-List Corporate Limited* BL O-075-13, Mr Iain Purvis K.C., acting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

54. The earlier mark has no obvious meaning in the English language, and therefore it has no apparent link to the goods and services at issue. Neither party has provided

submissions as to any supposed link to the goods or services either. As a seemingly invented word, VTAIL can be said to be inherently distinctive to a high degree.

Honest concurrent use

55. The Applicant referred to the principle of honest concurrent use when arguing that it had made sure it applied for goods that were distinct from those of the earlier mark, and also to refute the Opponent's claim that the contested mark was non-distinctive. The Opponent replied to the Applicant's claims by arguing that it had failed to demonstrate any period of concurrent use, that the existence of the supposed earlier mark was not supported by fact, and that no legal relationship had been established between the two entities which the Applicant had referred to in this matter, namely VFL and Vtail LTD.

56. The UKIPO Manual of Trade Mark Practice includes information pertaining to the defence of honest concurrent use:

21 Honest concurrent use

An order was passed in 2007 which means that Honest Concurrent Use can no longer be filed in support of an application where there is a requirement to notify the owners of earlier marks thought to be confusable with the applicant's mark.

Applicants may wish to place on file evidence of their earlier use of the mark applied for. If so, the application will not be held up in order for them to do so. It is anticipated that any evidence is more likely to be filed in response to any opposition the applicant may face after publication.

57. Relatively recent case law also provides useful information when considering such claims. The cases include *Victoria Plum Ltd v Victorian Plumbing Ltd*,⁴ and *Gnat and Company Ltd and Another v West Lake East Ltd and Another*.⁵ The cases make clear that one of the key principles of honest concurrent use is that two parties have co-existed for a long period using the same or closely similar names. The Opponent's earlier mark was registered on 9 July 2021, less than one month before the date of

⁴ *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch) [2017] FSR 17

⁵ *Gnat and Company Ltd and Another v West Lake East Ltd and Another* [2022] EWHC 319 (IPEC)

application of the contested mark, i.e., 12 August 2021. I therefore do not consider it possible to determine that the marks at issue have co-existed for a long period of time, or the potential impact of such hypothetical concurrent use. The *Gnat and Company* case in particular also makes reference to the notion of the Applicant searching for similar marks before applying, and notifying any potential owners of a similar mark of its intention to apply. There is no indication in its submissions that the Applicant did so.

58. As to the comments of the Applicant, the principle of honest concurrent use does not appear to me to relate to the issue of different goods and services (which in any case have been found to be identical and similar to varying degrees), nor does it relate to the issue of distinctiveness. As to the comments of the Opponent, I agree that the legal relationship between the Applicant and previous company of one of its current directors has not been shown clearly in evidence, and is therefore insufficient for the purposes of establishing honest concurrent use.

59. Essentially, the Opponent has not been required to prove or disprove that the marks have co-existed, as the earlier mark is not eligible to be contested under proof of use requirements specified within section 6A of the Act. As a result, I cannot determine any factual truth in the claim of honest concurrent use, and I shall therefore proceed on the basis that it is not a legitimate claim.

Likelihood of confusion

60. 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.

61. 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 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.

62. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

63. In *Quelle AG v OHIM*, Case T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs

(*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

64. Having conducted a full analysis and thorough comparison of both the marks and their respective goods and services at issue, I have determined that it is the visual considerations which are of a greater importance in the assessment of a likelihood of confusion, due to the purchasing process being visually dominated. In this regard, I refer to the fact that I have found the marks to be visually similar to a high degree. It should not be forgotten that I also considered the aural aspect to be prevalent in many purchasing situations, in which case I refer to the fact that I have found the marks to be aurally similar to between a medium and a high degree.

65. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between

the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

66. Having identified that it is both the visual and aural aspects of the marks that will dominate the purchasing process, and having considered the principle established in the case law above that the beginnings of word tend to have more visual and aural impact than the ends, it is significant that the beginning of each mark is visually and aurally identical. It is also significant that the contested mark contains the entirety of the earlier mark, meaning that there are no elements or aspects of the earlier mark which do not appear in the contested mark. With this in mind, it is pertinent to also remind myself of the principle established in *Kurt Geiger* (cited above in paragraph 53), whereby if the distinctive character of the earlier mark resides in the element of the contested mark that is identical or similar then it will only serve to increase the likelihood of confusion.

67. I acknowledge that the contested mark contains the element '.com', which is an element not contained within the earlier mark. However, as established in paragraph

23 of *Lloyd Schuhfabrik Meyer*, cited in paragraph 52 above, the CJEU found that the assessment of the distinctive character of a mark should include taking account of whether that mark contains, amongst other things, a descriptive element. I consider it clear and obvious that the element '.com' will be perceived to be entirely descriptive, at least in relation to the services at issue, by means of indicating the fact that they are available on/via a website. With this in mind, I consider the element '.com' to be less dominant, less distinctive, and secondary to the element 'Vtail'. There is even a case to suggest that the element '.com' will be dismissed as negligible. Indeed, in T-412/08, *Trubion*, the GC found the following:

35 Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *OHIM v Shaker*, paragraph 41 and the case-law cited).

36 **It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element** (*OHIM v Shaker*, paragraph 42, and judgment of 20 September 2007 in Case C 193/06 P *Nestlé v OHIM*, not published in the ECR, paragraph 42). That could be the case, in particular, where that component is capable alone of dominating the image of that mark which members of the relevant public keep in their minds, so that all the other components are negligible in the overall impression created by that mark. In addition, the fact that an element is not negligible does not mean that it is dominant, and by the same token the fact that an element is not dominant in no way means that it is negligible (*Nestlé v OHIM*, paragraphs 43 and 44) [emphasis added].

Considering this, I believe that it is the element 'Vtail' which dominates the contested mark, and it is the element 'Vtail' which the "relevant public will keep in their minds". The effect of all of this is that the comparison of the marks may be carried out solely on the basis of the earlier mark against the dominant and certainly non-negligible

element of the contested mark, i.e., VTAIL Vs Vtail. With this in mind, I consider there to be a likelihood of direct confusion.

68. Even in those scenarios where the consumer may attribute significance to the element '.com', and therefore do not find it to be a negligible element, it is my opinion that the marks at issue will nevertheless still be directly confused. This is because I consider it a likely and realistic possibility that when accessing an online retail environment to purchase an NFT, for example, the relevant consumer will mistake the contested mark Vtail.com for the trade mark VTAIL they imperfectly recollect having seen previously on a virtual community for business networking. I consider this to be even more certain in instances where the goods and services at issue are either identical or similar to a high degree.

69. One of the factors in the global assessment of comparing trade marks includes the interdependency principle, whereby 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. Having found the marks to be highly similar, this could offset a hypothetical lower degree of similarity between the goods and services at issue. The fact that the goods at issue have been found to be identical, and that several of the services at issue have been found to be highly similar, only serves to reinforce the finding that a likelihood of confusion will inevitably be created. In my opinion this will also apply in relation to those services found to be similar to a degree between low and medium or complementary, such is the high degree of similarity between the marks at issue.

70. In light of the above, I consider there to be a likelihood of direct confusion in relation to all of the contested goods and services.

71. As an alternative and additional finding, it is my opinion that the marks at issue will at least lead to indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

“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).”

72. I have established that the common element ‘Vtail’ is highly distinctive. Neither party has provided submissions to the contrary or attempted to argue that Vtail has some meaning in the fields of the goods and services at issue. In fact, I argue that the element Vtail it is so strikingly distinctive that the average consumer would assume that no-one else but the brand owner is using it in trade. It is my opinion the later contested mark simply adds the non-distinctive element ‘.com’, which one would expect in a sub-brand, insofar as the contested mark will be interpreted to be the online version of the earlier mark. In light of the above, and as an alternative finding, I

consider there to be a likelihood of indirect confusion in relation to all of the contested goods and services, especially when bearing in mind the principle of interdependency.

Conclusion

73. The opposition is successful in its entirety under Section 5(2)(b). Subject to an appeal, the contested application will be refused.

Costs

74. The Opponent has been 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 £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Fee for the opposition	£100
Preparing a statement and considering the counterstatement of the other side	£400
Preparing submissions and considering and commenting on the other side's submissions	£300
Total	£800

75. I therefore order Vtail LTD to pay vTail Healthcare Telecommunications Limited the sum of £800. 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 8th day of December 2022

Dafydd Collins

For the Registrar