

o/620/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATIONS 3579982, 3579963 & 3579959

BY

LA Fed Management Company Limited

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 9, 35 & 42



11ONZE

AND THE OPPOSITIONS UNDER NO.s 424800, 424816 & 424817 THERETO

BY

ORGANIZACION NACIONAL DE CIEGOS ESPANOLES

Background and pleadings

1. LA Fed Management Company Limited (“the applicant”) applied to register the trade marks shown on the front page on 15 January 2021. All three were accepted and published in the Trade Marks Journal on 5 March 2021. The goods and services for all three of the marks are as follows:

Class 9: Credit card encoding machines [computer peripherals]; Credit card terminals; Secure terminals for electronic transactions; ATMs; Electronic cash registers; Automatic machines for counting and classifying money; Email security software.

Class 35: Providing information about digital products and services available for purchase or download; Information about the sale of products; Intermediary and advisory services relating to the sale of goods and the provision of services; Product sampling; Marketing via the Internet; Sale promotion; Promotion [publicity] of concerts; Promotion [advertising] of travel.

Class 42: Creation and maintenance of websites; Computer rental; Website design.

2. ORGANIZACION NACIONAL DE CIEGOS ESPANOLES (“the opponent”) opposes the three trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The following marks are relied upon for the opposition:

UK3630045



Filing date: 21 April 2021

Registration date: 1 October 2021

Priority date: 11 November 2020

Relying on the following services:

Class 36: Insurance services; financial services; financial analysis services; monetary services; banking services; home banking services; brokerage services and stock exchange listings; capital management and investment services; real estate management, brokerage and valuation services; real estate services; securities deposit services; issuing of credit and debit cards; trust services; fund formation and investment; mortgage services; on-line banking, financial, monetary, insurance, insurance and real estate services provided through telecommunications networks (including home banking); trust services; mortgage procurement, broking, issuing and financing services; on-line banking, financial, monetary, insurance and real estate services provided through telecommunication networks (including mobile telephones), telematic networks and global computer communications networks; financial consultancy services for lottery winners.

Class 42: Game design services; video game software design services; computer game software programming services; scientific and technological services and related research and design services; industrial or scientific research and analysis services; computer hardware and software design and development services; computer design services; computer development services; maintenance, repair and upgrading of software systems; creation, development, and hosting of an internet platform for electronic commerce; engineering services (engineering work); technical control and inspection services; commercial design services and packaging design services; design and development of new technologies for third parties; expert consultancy services in relation to the design of video and computer games, packaging, computers and software.

UK3629969



Filing date: 21 April 2021

Registration date: 1 October 2021

Priority date: 11 November 2020

Relying on the following goods and services:

Class 9: Computer hardware for games and gaming; downloadable information relating to games and gaming; electronic publications, downloadable, relating to games and gaming; computer application software featuring games and gaming.

Class 35: Sales promotion for others; advertising through all public communication means; business management; business administration; office functions services; assistance services for business management or commercial functions for an industrial or commercial company; business representative services; marketing studies and analysis; advice relating to the conducting of studies in relation to business organisation, inventory control and business surveys; data processing verification; business accounts management; personnel management and employment consultancy; employment counselling; business management of retail outlets; prize draws (organising of -) for promotional purposes; prize draws (organising of -) for promotional purposes; wholesale services and retail services in shops and via computer networks, connected with the sale of lottery tickets, betting slips and betting tickets.

3. The opponent argues that the respective goods and services are identical or similar. It claims that the dominant and distinctive element of the marks have the same meanings and that the marks are similar.

4. The applicant filed a counterstatement. It states that they strongly deny that the marks are similar. It further claims that the marks are not conceptually identical and that the additional elements of the earlier marks would not be ignored by the average consumer, as suggested by the opponent. The applicant further submits that the marks are visually highly different and that there is no risk of confusion when the marks are pronounced. The applicant also denies the similarities between the goods and services.

5. Only the opponent filed evidence and written submissions dated 14 January 2022. No hearing was requested and so this decision is taken following a careful perusal of the papers.

6. The applicant is represented by Lincoln IP and the opponent is represented by Page, White & Farrer Limited.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Preliminary Issues

8. The applicant marks were subject to separate opposition proceedings filed on 9 June 2021. These opposition proceedings were against all three of the applicant's marks but were against only some of the goods and services. The applicant did not file Form TM8 defences and counterstatements within the relevant time frame and therefore the Registry informed the applicant on 16 May 2022 that it was minded to consider the matter undefended.

9. No response was received and therefore, on 4 July 2022, the applicant's specifications were reduced accordingly. The remaining specification is shown above in paragraph 1.

Evidence

10. The opponent's evidence consists of a witness statement dated 14 January 2022 by Lyndsey Hall, who is a paralegal for the legal representative of the opponent. The main purpose of the evidence is to show the use of foreign languages, in particular Spanish, German and French, within the UK.

11. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

Decision

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. 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 IR 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

14. The trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the contested marks pursuant to section 6 of the Act. The earlier marks are not subject to the proof of use requirements pursuant to section 6A of the Act. This is because they had not completed their registration processes more than 5 years before the filing date of the application in issue. The opponent can, therefore, rely upon all of the goods and services for which its marks are registered.

Section 5(2)(b) case law

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation 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

16. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

17. 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:

“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”.

18. 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.

19. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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".

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade*

Mark (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v 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”.

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

23. The goods and services to be compared are shown in the table below:

Applicant’s goods and services	Opponent’s goods and services
Class 9: Credit card encoding machines [computer peripherals]; Credit card terminals; Secure terminals for electronic transactions; ATMs; Electronic cash registers; Automatic machines for counting and classifying money; Email security software.	Class 9: Computer hardware for games and gaming; downloadable information relating to games and gaming; electronic publications, downloadable, relating to games and gaming; computer application software featuring games and gaming.

<p>Class 35: Providing information about digital products and services available for purchase or download; Information about the sale of products; Intermediary and advisory services relating to the sale of goods and the provision of services; Product sampling; Marketing via the Internet; Sale promotion; Promotion [publicity] of concerts; Promotion [advertising] of travel.</p> <p>Class 42: Creation and maintenance of websites; Computer rental; Website design.</p>	<p>Class 35: Sales promotion for others; advertising through all public communication means; business management; business administration; office functions services; assistance services for business management or commercial functions for an industrial or commercial company; business representative services; marketing studies and analysis; advice relating to the conducting of studies in relation to business organisation, inventory control and business surveys; data processing verification; business accounts management; personnel management and employment consultancy; employment counselling; business management of retail outlets; prize draws (organising of -) for promotional purposes; prize draws (organising of -) for promotional purposes; wholesale services and retail services in shops and via computer networks, connected with the sale of lottery tickets, betting slips and betting tickets.</p> <p>Class 36: Insurance services; financial services; financial analysis services ; monetary services; banking services; home banking services; brokerage services and stock exchange listings; capital management and investment services; real estate management,</p>
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	<p>brokerage and valuation services; real estate services; securities deposit services ; issuing of credit and debit cards; trust services; fund formation and investment; mortgage services; on-line banking, financial, monetary, insurance, insurance and real estate services provided through telecommunications networks (including home banking); trust services; mortgage procurement, broking, issuing and financing services; on-line banking, financial, monetary, insurance and real estate services provided through telecommunication networks (including mobile telephones), telematic networks and global computer communications networks; financial consultancy services for lottery winners.</p> <p>Class 42: Game design services; video game software design services; computer game software programming services; scientific and technological services and related research and design services; industrial or scientific research and analysis services; computer hardware and software design and development services; computer design services; computer development services; maintenance, repair and upgrading of software systems; creation, development, and hosting of an internet platform for electronic commerce;</p>
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	<p>engineering services (engineering work); technical control and inspection services; commercial design services and packaging design services; design and development of new technologies for third parties; expert consultancy services in relation to the design of video and computer games, packaging, computers and software.</p>
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24. Firstly, I consider that the applicant's 'Credit card encoding machines [computer peripherals]; Credit card terminals; Secure terminals for electronic transactions; ATMs; Electronic cash registers; Automatic machines for counting and classifying money' will have a slight overlap of use and end-user with the opponent's 'monetary services; banking services; issuing of credit and debit cards' as the applicant's goods could be used within the opponent's services. I believe the trade channels will differ due to the goods being purchased from a specialist. Their nature will also be different. The applicant's goods are likely to be purchased by retailers and other businesses; however, the opponent's services are aimed at both businesses and the general public. Further, I think that it is possible that some of the goods and services could be seen as complementary. I find that the average consumer of credit card encoding machines, credit card terminals, secure terminals for electronic transactions and ATMs might reasonably think that an undertaking that provides monetary and banking services might have these goods as part of their infrastructure in order to carry out some of these services, especially given some of them will be of a fairly specialist nature. I therefore find these goods and services to be similar to no more than a medium degree. I do not believe there to be complementarity for the electronic cash registers and automatic machines for counting and classifying money and the opponent's goods and therefore I find them to be similar to a low degree.

25. I find that the applicant's 'Creation and maintenance of websites; Website design' fall within the wider category of the opponent's 'Scientific and technological services and related research and design services' as the creation and design of websites

would indeed be a type of technological service. I therefore find these to be identical under the *Meric* principles.

26. In relation to the applicant's 'computer rental' and the opponent's 'Computer hardware for games and gaming' I consider there to be an overlap in user, and in trade channels as a retailer could possibly also offer rental contracts. To my mind, there could also be an element of competition between the goods as a consumer would have the choice between buying the computer hardware or renting it. Further, there could be an element of complementarity between the goods and services as computer hardware is essential for the delivery of the applicant's service; however, I note that the opponent's goods are limited to those related to gaming. The average consumer may assume that the same entity is responsible for both the rental and the goods themselves. I do recognise that the method of use, purpose and the nature of the services will differ slightly. I therefore find the applicant's services to be similar to a low degree to the opponent's goods.

27. I find that the opponent's 'computer hardware and software design and development services' will have some overlap of end user and purpose with the applicant's 'email security software'. In my view, the average consumer would expect the goods and services to be supplied by the same undertaking and therefore they would be considered complementary to a degree – it is reasonable to believe that the undertaking that designs and develops computer software would also then sell the software to others. The opponent's services also cover hardware which do not feature in the applicant's goods and I find that these goods and services will obviously differ in nature as one is a good and the other is a service. I consider the goods and services to be similar to no more than a medium degree.

28. I consider that the applicant's 'Sale promotion; Promotion [publicity] of concerts; Promotion [advertising] of travel' is the wider category in which the opponent's 'sales promotion for others' falls and therefore, these services are identical under the *Meric* principles.

29. Finally, I find that the applicant's 'Providing information about digital products and services available for purchase or download; Information about the sale of products;

Intermediary and advisory services relating to the sale of goods and the provision of services; Product sampling; Marketing via the Internet' overlaps in user, use, nature and purpose to the opponent's 'Sales promotion for others' as they all relate to promoting/advertising/information in relation to other goods. For example, product sampling is often used in marketing strategies, as are services involving the provision of information. All of the services are intended to assist in making sales of other goods and services. They will therefore also be an overlap in trade channels. I therefore find these services to be similar to a high degree.

Average consumer and the purchasing act

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

31. 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. (as he then was) 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."

32. I consider that the average consumer of the Class 9 goods save for 'email security software' and 'computer hardware for games and gaming' will be a business or a professional. The costs of these goods are likely to vary and I believe could range between medium and high cost. I would consider that these goods will be purchased relatively infrequently. The average consumer will need to take into consideration the

cost and suitability of these goods in accordance with their needs. I therefore consider that the average consumer would pay a higher than average level of attention during the purchasing process.

33. 'Email security software' would be purchased by the public or businesses. It ranges in cost and overall I consider the average consumer would pay at least a medium degree of attention in its purchase. The average consumer will see the mark used on any packaging or descriptions on websites. They may also use reviews in the media or online, and so I consider that the visual element will be most important. However, I do not discount the aural element, as word-of-mouth recommendations may also be influential.

34. Regarding 'computer hardware for games and gaming' I believe that these would more likely be purchased by the general public and potentially some businesses such as amusement arcades and would vary in price from low for the smaller accessories to much more expensive for more specialist items. I think that the average consumer for these goods will pay at least a medium degree of attention to the purchase. The average consumer will likely see the mark on packaging or on websites and catalogues and therefore I consider the visual element to be the most important but I do not discount the aural element as information from sales assistants or word of mouth recommendations may play a part.

35. The services at issue in Class 35 comprise a range of advertising, promotional and marketing services. I find that the average consumer for these services would most likely be a professional or business. The selection of such services is most likely to be a visual process, either online, via websites or printed marketing material, with the possibility of aural conversations with salespersons and other advisors and word of mouth recommendations.

36. All of the class 35 services at issue are likely to be a fairly regular consideration for a professional consumer or business, but I feel such selections will generally invite a higher level of attention than casual purchases, due to the higher cost of such services and their impact on the health and profitability of the business. I therefore

consider the average consumer will pay a higher than average level of attention in the selection and purchase of these services.

37. In relation to rental of computers, I believe that the majority of consumers will be businesses. This will offer an alternative solution for getting IT equipment for the business without the need for a large initial costs outlay. It also might provide ongoing maintenance/upgrade provisions. It would probably involve ongoing contracts and would be more than a casual inexpensive purchase which is not likely to be frequent. I consider the likelihood of the services being offered by selection from websites and marketing materials. Again, the aural element will come into consideration by advice being given from sales people. I therefore find that a higher than average level degree of attention will be paid.

38. Turning now to the remaining services (scientific and technological services and related research and design services; creation and maintenance of websites; website design; computer hardware and software design and development services), I consider that there could be individuals that would be using these services; however, the majority would be purchased by businesses for the progression of their own brands. The purchase process will likely require more attention than casual inexpensive purchases as this is more likely to be a less frequent and more expensive purchase with ongoing use. I find that in relation to design services, there will be a large influence from the visual aspect - from websites online or from portfolios of previous work done within an office or store. I do not discount the possibility of the marks being expressed aurally in conversation with salespersons or designers. Once again, I find the level of attention to be a higher than average.

Comparison of the marks


39. 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.”

40. 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.

41. The respective trade marks are shown below:

Contested marks	Earlier marks
<p data-bbox="204 1189 336 1220">3579982</p>  <p data-bbox="204 1518 336 1550">3579963</p>  <p data-bbox="204 1848 336 1879">3579959</p> <p data-bbox="368 1962 596 2016">11ONZE</p>	<p data-bbox="778 1189 1070 1220">3629969 & 3630045</p> 

42. The earlier marks consist of three words and a device. The word 'ONCE' is displayed in large capital letters in a simple typeface and is placed underneath the second element which is 'grupo social' in smaller lower case letters. On the left hand side of the mark is a device which appears to be a stylised stick person walking and holding a stick in front of them. The stick person is made up of a yellow head, blue arm and red and green legs whilst the stick element is white with a black edge.

43. In considering the mark I find that 'ONCE' is the more dominant element of the mark due to its size and placement. The words 'grupo social' will make some contribution to the overall impression of the mark as they do not appear to be descriptive or allusive to the services. However, as discussed further later in this decision, the average consumer may not be able to assign an obvious specific meaning to 'grupo' and this could cause them to look more to the parts of the mark they can assign meaning to. I consider that the design of the device element is relatively simple although the colour arrangement is fairly striking. I therefore find that it will make a lesser contribution than the word 'ONCE'.

44. The applicant's 3579982 mark comprises of the letters ONZE presented as ON above ZE. They are presented in black in a simple font with all letters the same size. I consider that the dominant element of the mark will be the letters ONZE and I find that they will be read in such an order as the majority of people in the UK will read from left to right, top to bottom. To the left hand side of the mark are two yellow vertical lines with slanted tops. The applicant submits that the device is the number '11'. However, I find that in this mark they are not presented as a recognisable '1' and that the average consumer would likely rather view them as two lines. Given the simple nature and placement of the device element, I consider the role it plays to be small.

45. Similarly, the applicant's 3579963 mark also contains the 'ONZE' in the same font but this time presented in a linear fashion. I find that this will be the dominant element of the mark. Once again, the same yellow lines as the 3579982 mark are present on the left hand side of the mark and as such I find the role they play within the mark to be small for the reasons given in paragraph 42.

46. Applicant mark 3579959 is a word mark of 11ONZE. I find the overall impression lies in the mark as a whole and as the numbers and word are placed all together the average consumer will likely read them together in that order.

47. Visually, the earlier mark features three words with 'grupo social' placed on top of 'ONCE' which is presented in a much larger size, whereas the earlier marks feature one word 'ONZE', which is either split over two lines or on a single line. The earlier marks contain 15 letters in total compared to the applicant marks which contains 4 letters (and two numbers in the case of the 3579959 mark). All marks share the three letters O, N and E together in one word and arranged in that order, with a different third letter. There are also the device elements, both are relatively simple and made up of lines. However, there are multiple colours in the earlier marks compared to one colour in the two applicant marks which feature it. There are also just two vertical lines compared to three lines on a more diagonal angle and a dot at the top arranged in the form of a stick person. Taking all of this into account and given the various elements of the marks compared to each other, I find the applicant's marks 3579982 and 3579963 to be visually similar to only a low degree to the earlier marks. The applicant's 3579959 mark is a word mark and therefore I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person, in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* case BL O/281/14:

“21. It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark.”

48. I therefore acknowledge that the word mark may be presented in any font, sizing or combination of upper and lower-case fonts. In any event, there are still two numbers and four letters to the three words/15 letters in the earlier marks and there is no device element. I therefore find that these marks are also visually similar to a low degree.

49. I will next consider the aural comparison between the marks. I agree with the opponent's submissions that the aural comparison for the applicant marks will differ. I do not think that the average consumer will see the device element in the 3579982 and 3579963 marks as being the number 11 and therefore they will not articulate it as such. For these, I believe that although there is no obvious word in the English dictionary, the average consumer would likely articulate this as one syllable 'on/zuh'. In my mind, for the word mark, the average consumer would articulate the '11' and therefore the mark would be pronounced 'eleven onze', this is four syllables.

50. For the opponent's marks, I consider that even though the words 'grupo social' are presented in a smaller font, they are presented above the 'once' and do not appear to be descriptive of the goods and services provided. I believe they will therefore likely still be articulated. For 'grupo' I find that the average consumer will likely pronounce this as grew/poh. 'Social' and 'once' will be given their ordinary dictionary pronunciations. I find that the 'once' will be pronounced somewhat differently to the 'onze' in the applicant marks. It will be pronounced won/suh compared to on/zuh. I therefore find for all marks, the level of aural similarity will be low as the only slight overlap is with the words once/onze and these are pronounced slightly differently also.

51. The opponent submitted that 'onze' means eleven in French and 'once' means eleven in Spanish. I have considered the evidence put to me by the opponent which focuses on the teaching of foreign languages in UK schools and the number of French and Spanish nationals that now live in the UK and which they argue would mean that the average consumer would be aware of the meanings of 'onze' and 'once'. I acknowledge there would be some members of the UK general public that would understand these words but I must consider what the average UK consumer would know. There will be some people with no foreign language knowledge whatsoever or who know different foreign languages. There will be people who have previously learnt foreign languages but due to not using it, will not remember. I consider therefore that the average UK consumer might know or recognise that 'onze' is a foreign language word but might not necessarily be able to assign to it its proper meaning.

52. For the opponent's marks, the average UK consumer will assign 'social' and 'once' their ordinary UK dictionary meanings even if they do have alternative meanings in

another language. I also consider that the concept of the mark needs to be easily understandable by the average consumer and as there is a common meaning in the English language for the word 'once' I find that it would be unlikely that a consumer would see this word, understand its meaning in English but then assign it a different meaning from a foreign language. Social means relating to society or to the way society is organized.¹ Once means something that happens one time only.² For 'grupo' I find that the average UK consumer would probably recognise that this is a foreign word and might believe it to mean 'group' given its similar spelling. Finally, in my mind, the average consumer will believe the device element of the mark to be a stick person, possibly side facing and holding a stick- given the stick is white and held in front of the stick person, some consumers might believe this represents a blind or partially sighted person. The device element does not appear to have a specific meaning connected to the words within the mark.

53. Conceptually for the applicant's marks, the average consumer might recognise that 'onze' is from a different language or even recognise it means a number. For the word mark they might view the '11' to reference a numeric value towards the name. I therefore find the marks to be conceptually dissimilar.

Distinctive Character of the Earlier Mark

54. 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-

¹ <https://www.collinsdictionary.com/dictionary/english/social>

² <https://www.collinsdictionary.com/dictionary/english/once>

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).”

55. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier marks. I will therefore consider the position based solely on the inherent distinctiveness of the marks.

56. The mark is made up of two ordinary dictionary words together with a foreign language word as well as the ‘stick person’ device. The mark does not appear to be descriptive or allusive of the goods and services registered. Therefore, I find that the opponent’s earlier marks can be said to be inherently distinctive to a higher than average degree.

Likelihood of Confusion

57. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

58. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.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.

59. I have come to the conclusions above that the marks at issue are visually and aurally similar to a low degree; they are conceptually dissimilar and the average consumer would be paying a higher than average degree of attention, although not the very highest level. The goods and services at issue have been found to be between identical or similar to a low degree. The earlier marks are inherently distinctive to a higher than average degree.

60. Although I have found that the dominant components of the marks would be ‘once’/‘onze’ (except for the word mark which I found the distinctiveness lies in the mark as a whole), I believe that there are enough differences (extra words and differences in the devices) between the marks that the average consumer would not overlook and therefore there would be no direct confusion between any of the marks. I do not believe the average consumer would mistake one mark for the other.

61. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“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”).

62. These examples are not exhaustive but provide helpful focus.

63. Turning to the above categories; firstly, the shared elements between the marks are the letters ‘ON-E’ which are common letters and cannot be said to be strikingly distinctive.

64. Secondly, there is a difference in spelling between the marks, which also affects the meaning/concept of each mark when considering the terms ONCE and ONZE. Once has an ordinary dictionary meaning in the UK and the other does not. There is also the different devices and the additional words in the earlier marks which serve to distinguish these marks from each other. These additional words are not allusive or descriptive of the goods and services registered. I therefore do not believe that the contested marks will be considered a sub brand of the earlier brand, or vice-versa

65. The change of spelling in the marks and additional/differing elements would not be an obvious or logical brand extension in my opinion. I do not consider this to be a step that the average consumer of the goods or services at issue would reasonably expect a business to take.

66. Whilst the categories set out above by Mr Purvis are not exhaustive, I can find no other reason why the average consumer of the 'Grupo social once' brand would, when exposed to the contested marks, assume that the goods and services at issue came from the same or an economically linked undertaking, or vice-versa. Even if I had agreed with the opponent that the average consumer would understand both marks to contain the word 'eleven' in two different languages, I do not see why the average consumer would assume that the marks come from the same or connected entities, given the additional differences between them.

67. I therefore find that there would be no indirect confusion between the marks.

Conclusion

68. The consolidated oppositions have failed in their entirety and so the contested marks will proceed to registration.

Costs

69. The applicant has been successful and is entitled to a contribution towards its costs. Award of costs are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs in this matter has been calculated as follows:

Considering the Notice of Opposition and preparing Counter Statement	£300
Considering the Opponent's evidence	£500
Considering the Opponent's written submissions in lieu	£300
Total	£1100

70. I therefore order Organizacion Nacional De Ciegos Espanoles to pay LA Fed Management Company Limited the sum of £1100. 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 20th day of July 2022

**L Nicholas
For the Registrar**