

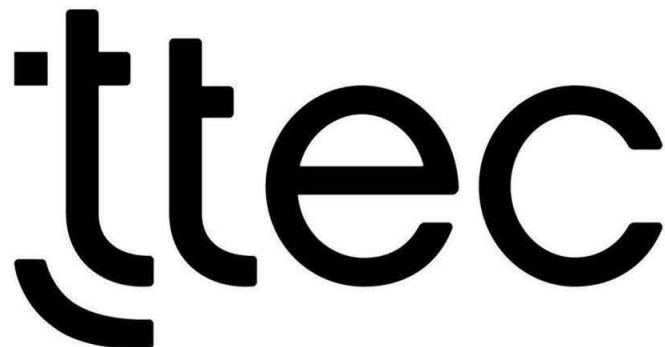
**O/709/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003611069**

**BY TTEC HOLDINGS, INC.**

**TO REGISTER THE TRADE MARK:**



**ttec**

**IN CLASS 38**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 425683**

**BY TYNTEC GROUP LIMITED**

## BACKGROUND AND PLEADINGS

1. On 16 March 2021, claiming a US priority date of 8 January 2018, TTEC Holdings, Inc. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 21 May 2021. The applicant seeks registration for the following services:

Class 38 Telecommunications services, namely, providing telephone and electronic mail services, providing multiple-user access to a global computer information network, that also features routing calls for others to customer service representatives.

2. The application was opposed by TYNTECH GROUP LIMITED (“the opponent”) on 21 July 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

# TYNTEC

UK registration no. UK00904502928

Filing date 22 June 2005; registration date 24 May 2007.

**(“the First Earlier Mark”)**



UK registration no. UK00002578250

Filing date 12 April 2011; registration date 8 July 2011.

**(“the Second Earlier Mark”)**

3. Under section 5(2)(b), the opponent relies upon all of the goods and services for which its First Earlier Mark and Second Earlier Mark is registered, as set out in the Annex to this decision. The opponent claims that the marks are “similar in visual appearance and are pronounced similarly”.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Dr Robert Harrison and the applicant is represented by Marks & Clerk LLP. Neither party requested a hearing, however, the opponent filed evidence in chief. The applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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

## **EVIDENCE**

7. The opponent’s evidence consists of a statement of use by Thorsten Trapp which is dated 29 November 2021. Mr Trapp is the Director of the opponent. Mr Trapp’s statement was accompanied by 31 exhibits (TT1-TT31). I note that the Registry previously granted a Confidentiality Order for exhibit TT3.

8. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to it where necessary below.

## **DECISION**

9. 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.”

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

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]”

11. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed  
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has 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,  
or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

12. As the earlier mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

13. The opponent’s marks qualify as earlier marks in accordance with section 6(1)(a) and 6(1)(ab) as their filing dates are earlier dates than the priority date of the applicant’s mark. As the earlier trade marks had completed their registration process more than five years before the priority date of the mark in issue, they are subject to proof of use pursuant to section 6A(1) and (1A) of the Act.

### **Proof of use**

14. I will begin by assessing whether, and to what extent, the evidence supports the opponent’s statement that it has made genuine use of its mark in relation to the goods and services for which it is registered. The relevant period for this purpose is the five years ending on the priority date, i.e. 9 January 2013 to 8 January 2018.

15. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have set out above. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

[2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37];



*Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### **Form of the mark**

17. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are

analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

18. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

19. Where the opponent’s mark has been used as registered this will, clearly, be use upon which the opponent can rely.

20. I also note that the mark has been used in the following variant:



21. The above variant is the same as the Second Earlier mark, however, the difference lies in the top half of the device being presented in the colour orange. I do not consider

that the orange colour alters the distinctive character and therefore I consider that the above variant is acceptable use of the mark.

### **Sufficient/genuine use**

22. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>1</sup>

23. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

24. As the earlier marks relied upon are UKTMs, I must consider the UK as the market in which the opponent is required to show genuine use.

25. However, I note that as the opponent’s First Earlier Mark is a comparable mark it is possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020.<sup>2</sup>

26. I am also guided by the following case law in assessing evidence. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, **a tribunal**

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<sup>1</sup> New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09

<sup>2</sup> <https://www.gov.uk/government/publications/tribunal-practice-notice-2020-end-of-transition-period-impact-on-tribunal-proceedings/tribunal-practice-notice-2020-end-of-transition-period-impact-on-tribunal-proceedings>

**will be justified in rejecting the evidence as insufficiently solid.** That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

27. Mr Trapp submits that the marks have been used in “the entire European Union which included the United Kingdom in the relevant period between 2013 and 2018”. The use of the marks “sums up to a turnover of about 66.4 milo EUR Euros for the relevant time period”.

28. **Exhibit TT2** is a revenue distribution overview of the applicant, as referred to in the affidavit in **exhibit TT1**. I note that this contains the following:

Audited statement		
	2018	
EU	13.586.404	31,34%
USA	28.323.369	65,32%
Africa	480.270	1,11%
Asia	958.072	2,21%
Oceania	10.264	0,02%
	<b>43.358.379</b>	<b>100%</b>

DHW Revenueu

	Date						
	2013	2014	2015	2016	2017	2018	Total
	22.082.787	29.976.686	32.639.448	32.340.921	39.836.988	55.041.172	
	31,34%	31,34%	31,34%	31,34%	31,34%	31,34%	
EUR customer revenueu	6.919.670	9.393.233	10.227.613	10.134.069	12.482.972	17.247.222	66.404.779

29. From the above, I consider that the audited statement shows the percentage of sales per territory for 2018. I note that the percentage for the EU was 31.34%. This percentage has then been applied to the years of 2013 to 2018 for its DHW Revenueu to show the percentage sales for the EU for those years. Therefore, I consider that this demonstrates an ‘average’ figure based on the 2018 figures. Consequently, this is not an accurate depiction of the “EU customer revenueu” for the years 2013 to 2018. I also note that I have not been provided any explanation as to the difference between the top and bottom figures, more specifically the 2018 figures which differ. I also note that the bottom figures are labelled as “DHW Revenueu”. I consider that “revenueu” is most likely the Italian word for revenue, however, it is not clear what DHW means, nor is it clear what the “audited statement” figures pertain to. Thus, I am unable to determine what the ‘revenue’ figures and “audited statement” figures specifically show, and therefore I consider that this exhibit is insufficiently solid in accordance with *Plymouth City Council* above.

30. **Exhibit TT4** is a screenshot from the opponent’s website dated 23 January 2016. I note that use of the opponent’s mark is displayed in the top left hand corner of the page. I also note the following services are listed on the website:

- Mobile inbound SMS
  - Mobile inbound SMS service – HTTP interface
  - Mobile inbound SMS service – SMPP interface
- Mobile outbound SMS

- Mobile outbound SMS service- REST API
- Mobile outbound SMS service- HTTP interface
- Mobile outbound SMS service- SMPP interface
- OTP SMS
  - OTP SMS service- HTTP interface
  - OTP SMS service- SMPP interface
- Number Information Services
  - Number information services – REST API
  - Number information services – ENUM\_SIP\_H225
  - Number information services – Asynchronous SOAP
  - Number information services – Synchronous SOAP
- Voice
  - Voice inbound service
  - Voice outbound service
- Service
  - REST API – pricing and coverage

31. I note that no explanation of these services are provided in this exhibit.

32. **Exhibit TT5** is a product SMS sheet from 2015. The services that the opponent provides is the delivery of secure SMS messages, with “worldwide coverage connecting 1000+ networks in over 200 countries”. They also provide the following:

- ④ **2-way SMS:** tyntec’s robust infrastructure ensuring a fast, effective way to send and receive texts across continents.
- ④ **Interface & API options:** Pick your preference: REST API, SMPP v3.4, HTTP.
- ④ **Message encoding:** Unicode, GSM7, ASCII, Latin-1, Binary supported.
- ④ **Concatenation:** For SMS messages longer than 160 characters, we’ll automatically split long messages into multiple SMS to ensure delivery.
- ④ **Dynamic sender ID:** Specify the sender ID for each message (numeric, alphanumeric, or short code), and our network does the rest, identifying and adapting sender IDs for delivery.
- ④ **Delivery reports:** Live delivery reports and advanced error codes available in our Customer Lounge.
- ④ **Security:** Access via VPN or SSL—and send your messages via our protected mobile network powered by direct carrier connections.
- ④ **Flexible retry:** You decide when messages expire and pay for just one delivery. If the message can’t be delivered immediately (phones turned off or unreachable), tyntec queues the message for future delivery.
- ④ **Number portability support:** When users change their service providers—or are roaming—you’ll still reach them.



33. I note that at the end of the product sheet is an “about tyntec” section which describes the opponent as a “telecom-web convergence company that connects the immediacy and convenience of telecom with the power of the internet”. “Tyntec enables enterprises and internet brands to power their applications, authentication and mission-critical communications with universal mobile services such as SMS, voice and phone numbers in the cloud”. Lastly the section highlights that the opponent was founded in 2002, employs over 150 in six offices around the globe, “serving more than 500 global businesses, internet brands and telecom operators”.

34. **Exhibit TT6** is a “tt.One” product sheet from 2015. tt.One is “a portfolio of mobile numbers with 2-way SMS and voice. With all of the core mobile communications capabilities enabled, you get complete control of your messaging and voice flow across all communication channels”. I also note that the opponent provides “SMS-capable long codes” as well as a “single virtual number for 2-way SMS and voice calls”. The following information is also provided:

### Key Features

- ② **Temporary, disposable numbers:** Ultimate privacy protection with numbers that can be assigned temporarily to users, ads, and OTT services.
- ② **SMS & voice features:** All the standard features of our SMS and voice services provided.
- ② **Virtualization service:** Get more from your existing pool of phone numbers, including landlines with SMS enablement, without having to buy additional mobile numbers.
- ② **IT governance:** With virtual numbers, the enterprise gets in control of call and message flows, which can be fully administered by your IT department.

35. **Exhibit TT7** is a “Voice” product sheet from 2016 which details tyntec’s inbound and outbound voice services. This helps consumers add “instant global voice connectivity” with the applicant’s “high capacity SIP trunking”. I note that this exhibit does not provide any explanation as to what “SIP” is/stands for. However, the exhibit includes the following “key features” information:

- ② **2-way voice worldwide:** Choose voice inbound and outbound as a package or opt for a standalone service.
- ② **Voice & SMS numbers:** Get one virtual number with SMS and voice capability, and let your customers decide how to contact you. (We provide numbers in US, Canada, UK, Italy, and Poland.)
- ② **Interface:** Default connection by SIP, the standard for most enterprises.
- ② **Wide range of codecs:** Support G.711, G.729, iLBC, among others.
- ② **Caller ID:** Ensured for over 100 destinations with reliable CLI delivery through tyntec's stable connections.
- ② **Number information:** Support for roaming ranges and number portability.

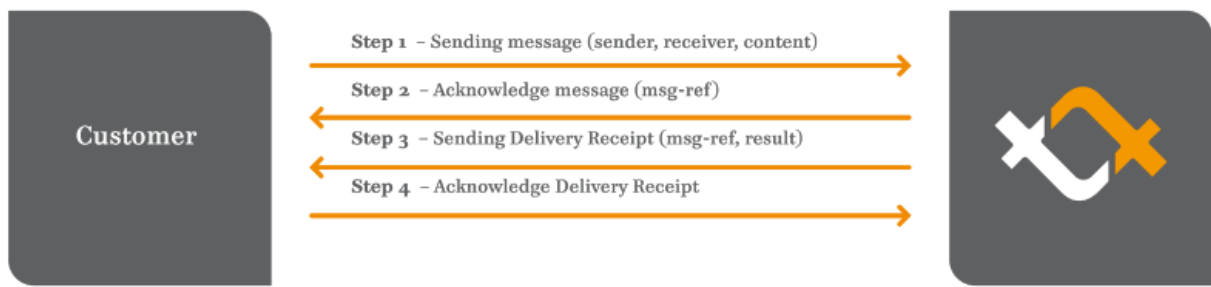
36. **Exhibit TT8 and TT9** are two technical guides for the applicant's voice inbound service and voice outbound service from 2015. I note that the content within these guides are highly technical in nature. Therefore, without any supporting explanation or submissions from the opponent, it is not possible for me to determine what this evidence is demonstrating and what the opponent's services are. I consider that these exhibits are, therefore, insufficiently solid in accordance with *Plymouth City Council* above.

37. I note that **exhibit TT8** does provide the definition of SIP, which is "session initiation protocol". However, this is not explained any further and, therefore, I do not consider that this makes **exhibit TT7** any clearer.

38. **Exhibit TT10** is a product technical guide from 2015 which explains what the opponent's mobile outbound SMS HTTP services are. I note that HTTP is defined in the brochure's glossary of term as "hyper text transfer protocol". Collins Dictionary also defines HTTP as "a way of formatting and transmitting messages on the internet".<sup>3</sup> The opponent's SMS HTTP services "enables you to send high quality SMS to all operators listed on tyntec's network list using the HTTP protocol. This service is appropriate for a mid-level usage (50,000 – 200,000 SMS sent/month)". The brochure also explains that "the customer needs a computer system with a fixed IP address from where the SMS sending is initiated, and where optionally the customer's HTTP Server is running and accepts the Delivery Receipts. This computer system must be reachable from the tyntec IP". I also note the following diagram was provided on the first page of the brochure below:

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<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/http>



**Figure 1: The Mobile Outbound SMS Communication Process with HTTP**

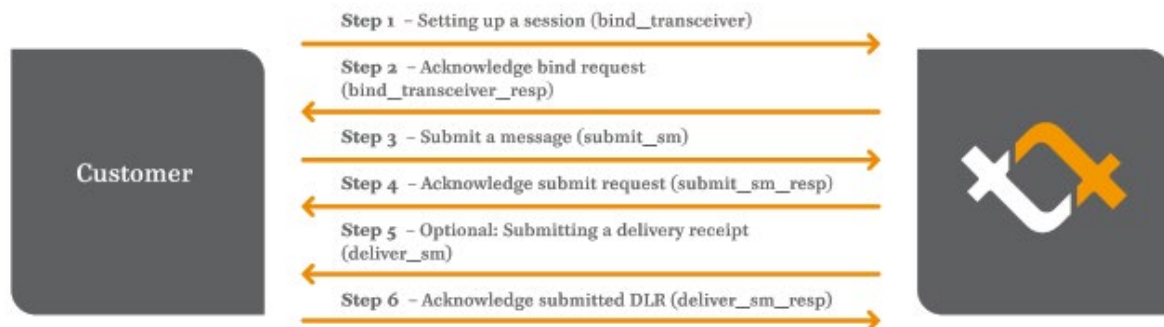
The arrows show the direction of the data flow. Each arrow is labeled with the data type carrying the data. The essential data that is transported appears in brackets following the data type. A detailed overview of the communication process is provided in section 5 of this document.

39. **Exhibit TT11** is a Mobile Outbound SMS Service SMPP Interface product technical guide from 2015. “The Mobile Outbound SMS SMPP is a service which enables you to send high quality SMS to all operators listed on tyntec’s network list using the SMPP protocol”. “SMPP is a session based Peer- to -Peer (P2P) protocol. Session based means a customer has to establish a connection to tyntec and use this connection to send messages. Peer to peer means that both the customer and tyntec (i.e. the peers) may use operations defined by the SMPP protocol, depending on the type of session. Authentication is done during the set-up of this connection. After the initial authentication, the session between the customer’s system and tyntec’s system (i.e. the peers) is kept open and alive”.

40. **Exhibit TT12**, which is a product technical guide from 2016, explains what the opponent’s OTP SMS HTTP services are. “The One-Time Password SMS HTTP is a service which enables you to send high quality SMS to all operators listed on tyntec’s network list using the HTTP protocol”. “This service also allows you to determine in real-time when a message is sent to invalid numbers and to notify your users to correct the number in order to receive the OTP”. I note that the information provided in this booklet highly overlaps with the information in **exhibit TT10**.

41. **Exhibit TT13**, which is a product technical guide from 2015, explains what the opponent’s OTP SMS service SMPP interface services are. The One-Time Password SMS SMPP is a service “which enables you to send high quality SMS to all operators

listed on tyntec's network list using the SMPP protocol". I also note the following diagram was provided on the first page of the brochure below:



42. I consider that the above exhibits, **TT10** to **TT13**, therefore shows that the opponent provides different variations of SMS services which allows users to send SMS using the opponents network.

43. **Exhibit TT14** is a product technical guide on REST API for Number Information Services from 2016. I note that REST API is described as the following:

The REST API (**R**epresentational **S**tate **T**ransfer **A**pplication **P**rogramming **I**nterface) enables quick and easy access to tyntec's **N**umber **I**nformation **S**ervices (**NIS**). The communication is established via **HTTPS** (**H**ypertext **T**ransfer **P**rotocol **S**ecure) connections. The exchanged object type is **JSON** (**J**ava**S**cript **O**bject **N**otation). tyntec's application accepts and replies with "application/json" as "Content-Type" (and "charset=utf-8") in the HTTP header.

All of tyntec's Number Information Services are accessible through the base URL (**U**nique **R**esource **L**ocation) (`{baseURL}`):

44. I note that this exhibit defines number information services as:

The Global Number Portability service returns information on the subscription network (MCC MNC) based on the MSISDN.

The Global Number Verification service returns information on the number range holder, the IMSI (International Mobile Subscriber Identity), the subscription network, and the servicing network.

The number information is provided at best effort. In case a response does not contain all fields listed in this guide, the respective information could not be retrieved.

45. I consider that the information contained in **exhibit TT14** is very technical in nature. I note that the opponent has not provided any supporting explanation or submissions to decipher the technical information provided within this exhibit. Therefore, it is not possible for me to determine what the evidence is demonstrating and what the opponent's REST API for Number Information Services specifically are. Consequently, I consider that this exhibit is insufficiently solid in accordance with *Plymouth City Council* above.

46. **Exhibit TT15** and **TT16** are product technical guides on Number Information Services, the first on Asynchronous SOAP from 2015 and the second on Synchronous SOAP from 2015. I note that "tyntec's Number Information Services enable companies to perform number portability resolution, subscriber database cleaning, compile statistical data, implement anti-fraud procedures and ID verification. These services provide network information from databases, from the mobile network and from other sources". I also note that "SOAP is a protocol used for exchanging messages over a network" and that it is defined in the glossary of terms as Simple Object Access Protocol which is "an XML protocol used for the exchange of information. It consists of three parts: an envelope that defines a framework for describing what is in a message and how to process it, a set of encoding rules for expressing instances of application- defined data types, and a convention for representing remote procedure calls and responses".

47. **Exhibit TT17** is a product technical guide, REST API Coverage and Pricing, from 2015. I note that the same definition for REST API above is also referenced within this exhibit. I also note that although the exhibit is called "coverage and pricing", no pricing is given within this exhibit. Instead, to retrieve the full coverage and pricing list, you have to "make a GET request to the coverage resource".

48. **Exhibit TT18** is a technical guide for REST API for mobile outbound SMS from 2016. The same definition of REST API is used as above. The brochure also highlights that "all of tyntec's SMS services are accessible through based URL". "The mobile outbound SMS service is governed by two operations that allow you to send an SMS and to query the status of a previously sent SMS".

49. **Exhibit TT19** is a product sheet on global number portability from 2016. I consider that number portability, using the information from the product sheet, allows SMS messages and voice calls to be appropriately routed and counted. “Tyntec simplifies number portability by working with data taken directly from local number portability databases and live network information from across the globe”. I also note that the exhibit also includes the following information:

Use Case

### Efficient Delivery

#### Know your customer’s network—no waste

```
graph LR; 01[01 Company wants to send messages to customers in various countries.] --> 02[02 Company sends the phone numbers to tyntec to check which numbers have been ported.]; 02 --> 03[03 Company sends messages to the appropriate networks, avoiding message loss.];
```

Companies that keep large customer databases are sitting on reams of outdated information, wasting time and money trying to contact customers with out-of-date network information. Your customers know they can take their phone numbers to other network operators—and they do.

Stop wasting time and money. tyntec’s Global Number Portability will check if their numbers have been ported so that you can optimize your message and voice routing. Make it right for your customers—reach them where they are.

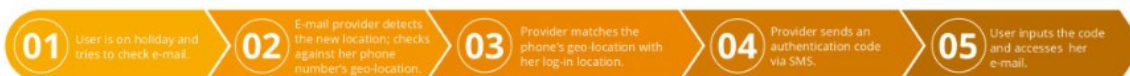
50. **Exhibit TT20** is a product sheet on global number verification from 2015. I note that the following information is provided on the opponent’s number verification services:

Real-time number verification is a critical component of mobile communications deployment. The only way to stop message loss and unsuccessful call attempts is with up-to-the-millisecond portability and network information providing key data on your user’s phone number including subscriber status, roaming, and geographic data.

To optimize message delivery and call routing, cut down on fraud and increase conversions—all while keeping your own data whisper-clean—tyntec’s number verification package provides the best-in-class solution with real-time number information and global coverage.

## User authentication

### Contextual authentication meets best-in-class number information



Ask any company that's been victimized by cybercrime. Flimsy web-based password challenges are no match for phishing attacks. That's why smart companies use phone-based user authentication. When customers know they can easily confirm their identity on their mobiles with one-time passwords and contextual authentication everyone wins. Access is authenticated, identity verified, fraud minimized, convenience maximized and there's less chance of other, unauthorized access of your data. As more user interactions move to the cloud, SMS- and voice-based authentication become an integral part of cyber security measures. tyntec helps you stay ahead of the bad guys.

51. **Exhibit TT21** is a product sheet for Mobile Inbound SMS service HTTP interface, from 2015. "The Mobile Inbound SMS HTTP is a service which enables you to receive SMS from all operators listed on tyntec's network list using the HTTP protocol". "Using the HTTP protocol it is possible to receive SMS from tyntec's messaging platform either via HTTP method, GET or POST. Sender, receiver and content are transmitted via individual and mandatory parameters". "On request, tyntec can connect to an SSL-encrypted HTTP service, thus ensuring secure transmission of sensitive data".

52. **Exhibit TT22** is a product sheet for Mobile Inbound SMS service SMPP interface, from 2015. "The Mobile Inbound SMS SMPP is a service which enables you to receive SMS from all operators listed on tyntec's network using the SMPP protocol". The same definition for SMPP is provided, as above in **exhibits TT11** and **TT13**.

53. I note that all of the technical guides and invoices above use the opponent's mark. I also note that the majority of the above evidence pertains to the transmission of SMS and voice communications.

54. **Exhibit TT23** is the following definition and description sheet for the opponent's services which have been explored above, which again, mainly relates to the transmission of SMS and voice communications:

	<b>Description</b>
<b>SMS Outbound</b>	SMS Outbound means a service which permits Customer to send mobile messages to mobile subscribers within tyntec's scope of coverage.
<b>SMS 2-Way</b>	SMS 2-Way means a service which permits Customer to send and receive mobile messages to and from mobile subscribers within tyntec's scope of coverage.
<b>Mobile Chat API</b>	Mobile Chat API means a service which permits Customer to send and receive messages to partner messaging apps (OTTs) and to send SMS.
<b>Interactive Text</b>	Interactive Text is a service which permits Customer to send and receive mobile messages to and from mobile subscribers using their own Numbers.
<b>Global Number Portability</b>	Global Number Portability is a service which permits Customer to query number portability information relating to a mobile or landline subscriber's phone number within the scope of tyntec's coverage.
<b>Global Number Verification</b>	Global Number Verification means a service which permits Customer to query information relating to a mobile or landline subscriber's phone number within the scope of tyntec's coverage.
<b>Voice Outbound</b>	Voice Outbound means a service which permits Customer to terminate voice traffic with destination to any operator within the tyntec's scope of coverage.
<b>Voice Inbound</b>	Voice Outbound means a service which permits Customer to receive voice traffic from operators within the tyntec's scope of coverage.
<b>Two-Factor Authentication (2FA)</b>	2FA means a service which permits Customer to authenticate its users through validation of mobile phone ownership. This is done by verifying with tyntec a pin code that is created and delivered by tyntec with an SMS or an automated voice call

55. **Exhibit TT24** is a screenshot from the opponent's website dated 25 March 2016. I note that this exhibit highlights that the opponent has served over 500 enterprises and mobile network operations.

56. **Exhibit TT25** is a screenshot from the opponent's website dated 1 May 2016. This is of the opponent's home page, with the 'PRODUCTS' dropdown listing; messaging, voice, numbers, number information services and operator services.

57. I note that at **exhibits TT26** and **TT27** the opponent has provided a number of invoices that display the opponent's mark. I note that the product amount and the invoice amount has been redacted. Furthermore, I note that the following "messaging products" are listed:

- SMS- MO AU LN 01
- SMS-MT
- SMS-MO GBR MNX
- SMS-MO UK LN 01
- tt.One SMS-MO PL LN 01



58. I am unable to determine what the abbreviations MO, MT and PL specifically mean. However, I recognise that SMS stands for short messaging service, that LN and GBR would most likely be referencing the locations London and Great Britain. I also recognise the opponent's "tt.One" services as referenced above. I note that out of the 20 invoices which are exhibited in **TT26**, 18 invoices are for EU clients, but none are for the UK, and out of the 16 invoices which are exhibited in **TT27**, 14 invoices are for EU clients, but none are for the UK.

59. **TT30** is a ROCCO S2P SMS Messaging Vendor Performance Report 2016. I note that in this report the opponent is given a rating out of 5 for the following:

- 4.77 for its technical expertise
- 4.62 for its reputation
- 4.77 for its understanding of interconnect
- 4.54 for its quality of service

60. I note that in general, overall, the opponent is marked very highly in all aspects of its business. In its leader board ranking in 2016, the opponent is ranked as number 3.

61. Lastly, I consider **exhibit TT3**. As established above, this exhibit is confidential because the information is commercially sensitive. I note that the exhibit is 24 pages long, and breaks down the opponent's revenue, for the EU, from 2013 to 2018. I note that just for the UK alone, during the above relevant period, the following figures are provided for all of their services as a whole:

Year	Total
2013	
2014	
2015	
2016	
2017	
2018	

62. Therefore, the revenue made by the opponent from 2013 to 2018, in the UK alone amounts to £ [REDACTED].

63. Cross-referencing the above exhibits, I note that the figures are also broken down by the services that the opponent offers, including those that have been referenced above such as number information services, global number portability, global number verification and tt.One voice. However, I also note that the same abbreviations are used in the example invoices in **exhibits TT26** and **TT27**, such as SMS-MT and SMS-MO GBR MNX. Although I am not provided with any specific information, explanation or supporting evidence as to what these abbreviations specifically mean, I note that as they use the “SMS” abbreviation, it is reasonable for me to conclude that these are messaging services that the opponent provides.

64. Clearly, there are issues with the opponent’s evidence. For example, some of the brochure/product sheet evidence is particularly technical in nature and therefore it is unclear as to what the opponent’s services are. I also haven’t been provided with any evidence as to how many brochures or product sheets were distributed throughout the UK and EU. I also note that I haven’t been provided with any advertising figures. However, the opponent does provide detailed sales figures which are broken down into EU territories and their services in **exhibit TT3**. I also consider that these are significant sales figures for the UK, and the EU (which can be taken into account for the First Earlier Mark), for what is likely to be a significant market.

65. The opponent’s exhibits, in isolation, would be insufficient to make a finding of actual use. However, the opponent, as highlighted above, has provided evidence in the form of significant turnover figures during the relevant period and that use of the marks have been geographically widespread across the EU. The opponent’s evidence, in combination, creates a picture which is sufficient to establish genuine use of the registrations, by the opponent, during the relevant period.

### **Fair Specification**

66. I must now consider whether, or the extent to which, the evidence shows use of the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

67. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

68. The goods and services for which the earlier marks are registered and upon which the opponent relies are a broad range of technical goods in class 9 and telecommunication services in class 38.

69. However, as set out above, it is clear from the opponent’s evidence, including all of the product sheet and brochure evidence, as well as the information and figures provided in **exhibit TT3**, that use of the earlier marks has been limited to SMS and voice telecommunication services in class 38, for users to send and receive SMS and voice communications through the internet. The opponent has not shown any use of its goods in class 9. Consequently, I consider a fair specification for both the First and Second Earlier marks to be:

Class 38 Providing access to telecommunications networks for the transfer and dissemination of voice, information, messages and data; transmission and reception of messages by means of telecommunications networks.

### **Section 5(2)(b) case law**

70. 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 services

71. The competing services are as follows:

<b>Opponent's services</b>	<b>Applicant's services</b>
<p><u>Class 38</u>            Providing access to telecommunications networks for the transfer and dissemination of voice, information, messages and data; transmission and reception of messages by means of telecommunications networks.</p>	<p><u>Class 38</u>            Telecommunications services, namely, providing telephone and electronic mail services, providing multiple-user access to a global computer information network, that also features routing calls for others to customer service representatives.</p>

72. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union (“CJEU”) in Canon, Case C-39/97, the court stated at paragraph 23 that:

“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.”

73. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

74. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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.”

75. I note that at least some of the services covered by the parties’ respective specifications are identical. For example, the term “providing access to telecommunications networks for the transfer and dissemination of voice, information, messages and data” in the opponent’s specification falls within the broader category of “telecommunications services, namely, providing telephone and electronic mail services, providing multiple-user access to a global computer information network, that also features routing calls for others to customer service representatives” in the applicant’s specification. I consider that the services are identical on the principle outlined in *Meric*. For this reason, I will not undertake a full comparison of the services above. The examination of the opposition will proceed on the basis that the contested services are identical to those covered by the opponent’s mark. If the opposition fails, even where the services are identical, it follows that the opposition will also fail where the services are only similar.

### **The average consumer and the nature of the purchasing act**

76. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

77. The average consumer for the services will be members of the general public and business users. The cost of purchase is likely to vary, but is not likely to be at the very highest end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. The average consumer will take various factors into consideration such as the ease of use, reliability, cost and the suitability of the telecommunication services for the user’s particular needs. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

78. The services are likely to be purchased from telecommunication specialist undertakings or their online equivalent. Consequently, visual considerations are likely to dominate the selection process. Alternatively, the services may be purchased following perusal of advertisements or inspection of a business directory. However, I do not discount that there may be an aural component to the purchase of the services given that advice may be sought from technical sales staff, or a recommendation may have been given through word-of-mouth.

### **Comparison of the trade marks**


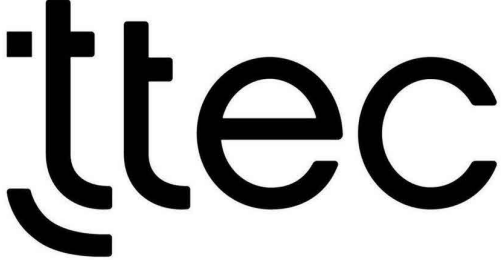
79. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

80. 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.

81. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="312 952 675 1025"><b>TYNTEC</b></p> <p data-bbox="320 1099 667 1133">(The First Earlier Mark)</p> <p data-bbox="480 1368 751 1451">tyntec</p>  <p data-bbox="296 1816 695 1850">(The Second Earlier Mark)</p>	

## Overall impression

82. The First Earlier Mark consists of the word TYNTEC. There are no other elements to contribute to the overall impression which lies in the word itself.

83. The Second Earlier Mark consists of the word 'tyntec' in the top right hand corner, with a device mark comprised of two lower case t's, one slanted to the left, facing upwards in a dark grey, and the other slanted downwards to the right in a light grey. The two t's together creates an asymmetric diamond shape. Although the eye is naturally drawn to the element of the mark that can be read, given the size of the device, and its placement at the beginning of the mark, which would be read from left to right, I consider that it plays a roughly equal role in the overall impression of the mark with the word element.

84. The applicant's mark consists of the word 'ttec', with a cube on the left hand side of the first t's cross and a curved underline under the bottom of the letter t. The applicant submits that these elements "transform the first 't' present in the mark into a smiling human face with eyes, nose and mouth". Albeit this may be recognised after a significant inspection of the mark, I do not consider that this will be recognised by the average consumer. I consider that the average consumer will see the cube incorporated into the letter, making the horizontal line of the "t". I do not consider that the average consumer will put significant weight on the curved underline, and will recognise it as a minimal design element. Consequently, I consider the word 'ttec' to play a greater role, with the cube device, in the overall impression of the mark, with the curved underline device element playing a lesser role.

## Visual Comparison

### *The First Earlier Mark and the Applicant's Mark*

85. Visually, the marks coincide in the presence of the letters T at the beginning of both words. They also coincide in the presence of the letters T, E and C at the end of both marks. These act as visual points of similarity. However, the First Earlier Mark has the letters Y and N in the middle of the mark which lengthens it, and therefore is

more likely to be noticed by the average consumer. The applicant's mark also includes the device elements at the beginning of the mark, which as submitted by the applicant, it is well-established that greater attention is paid to the beginning of the marks. I therefore consider that these act as visual points of difference. Taking all of the above into account, I consider that the marks are visually similar to between a low and medium degree.

#### *The Second Earlier Mark and the Applicant's Mark*

86. The same comparison applies as above to the word element; however, the Second Earlier Mark includes the double t device at the beginning of the mark, which is larger in size than the 'tyntec' wording and makes a significant impact. Consequently, I consider that the marks are visually similar to a low degree.

#### Aural Comparison

#### *The First Earlier Mark and the Applicant's Mark*

87. Aurally, I consider that the First Earlier Mark will be pronounced as TIN-TEC. I consider that the applicant's mark will be pronounced as TEE-TEC. As the marks share the T element of the first syllable, and the whole second syllable, I consider that the marks are aurally similar to at least a medium degree.

#### *The Second Earlier Mark and the Applicant's Mark*

88. The same comparison applies as set out above. The average consumer will not pronounce the double t device. Therefore, I consider that the marks are aurally similar to at least a medium degree.

#### Conceptual Comparison

#### *The First Earlier Mark and the Applicant's Mark*

89. The applicant submits that both marks share the suffix 'TEC' which "corresponds to an abbreviation of the word technology" which can be seen as "referring to technological products and services". However, I consider that the abbreviation for technology that would be known to the average consumer is "TECH" and therefore I do not consider that the meaning of 'technology' would be assigned, or recognised in, either marks. Furthermore, the First Earlier Mark begins with the "TYN" element, which I do not consider would be assigned an ordinary dictionary meaning. The applicant's mark begins with the letter t, which again, wouldn't be assigned a conceptual meaning.

90. As highlighted above, the average consumer would not dissect the marks. Therefore, I consider that the average consumer would view both marks, as a whole, as invented words, which would be attributed no particular meaning. On this basis, I consider that the marks are conceptually neutral.

#### *The Second Earlier Mark and the Applicant's Mark*

91. The same comparison applies as set out above. I do not consider that the double t device adds to the concept of the mark. Consequently, I consider that the marks are conceptually neutral.

#### **Distinctive character of the earlier trade mark**

92. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

93. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

94. I will begin by assessing the inherent distinctive character of the earlier trade marks.

95. As highlighted above, I consider that the word TYNTEC will be viewed as an invented word which is neither allusive nor descriptive in relation to the services for which the mark is registered. Therefore, I consider the First Earlier Mark to be inherently distinctive to a high degree.

96. I consider that the double t device element in the Second Earlier Mark would slightly add to the distinctiveness of the mark. Consequently, I consider that Second Earlier Mark is inherently distinctive to the highest degree.

97. The opponent has not pleaded that its First and Second Earlier Marks have acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

98. The opponent has provided sales figures in **exhibit TT3** to enable to me assess the extent of use made of the marks in the UK. I note that the revenue made by the opponent from 2013 to 2018, in the UK alone amounts to £[REDACTED], and is therefore significant. However, as highlighted above, there are issues with the opponent's evidence. I haven't been provided any advertising figures, and I haven't been provided with any evidence of how many product sheets and brochures were distributed throughout the UK, or seen by UK members of the general public. Furthermore, I have no evidence of geographical spread of the mark within the UK, nor have I been provided with UK market share figures.

99. Consequently, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

### **Likelihood of confusion**

100. 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 services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier 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.

101. The following factors must be considered to determine if a likelihood of confusion can be established:

- The First Earlier Mark is visually similar to the applicant's mark to between low and medium degree.
- The Second Earlier Mark is visually similar to the applicant's mark to a low degree.
- All of the marks are aurally similar to at least a medium degree.
- All of the marks are conceptually neutral.
- I have found the First Earlier Mark to be inherently distinctive to a high degree.
- I have found the Second Earlier Mark to be inherently distinctive to the highest degree.
- I have identified the average consumer for the services to be members of the general public, and business users, who will select the services primarily by visual means.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' services to be identical.

102. I take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

103. Therefore, taking all of the above case law into account, I consider that 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.

104. As established above, I recognise that the word TYNTEC is highly distinctive and therefore a factor in favour of the opponent. The fact that the competing services are identical is also a factor in favour of the opponent.

105. However, as highlighted above, the average consumer does not dissect the mark. The marks will be viewed as a whole. I also note that the distinctiveness of both the opponent's and applicant's marks lies in the marks as a whole, as they are both



invented words. Therefore, the differing letters – Y and N – which are in the middle of the opponent's mark (TYNTEC), which also lengthens the word, have an impact. The result of this is that there is between a low and medium degree, or low degree, of visual similarity between the First and Second Earlier Marks' and the applicant's mark, which will be particularly important given the predominantly visual purchasing process. Consequently, I do not consider that the average consumer would overlook the differing letters in the middle of the marks. I also consider that due to the size and positioning of the double t device in the Second Earlier Mark, that this would not be overlooked either. This will particularly be the case given that the average consumer will be paying a medium degree of attention during the purchasing process. For all of the above reasons, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other, even when used on identical services. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

106. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

107. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he

said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

108. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant’s trade mark was connected with the opponent or vice versa on the basis that they both end with the letter combination T, E and C. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole. Consequently, they are not natural variants or brand extensions of each other. Therefore, taking all of the above into account, I do not consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

109. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

110. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filling written submissions in lieu	£350
<b>Total</b>	<b>£550</b>

111. I therefore order TYNTECH GROUP LIMITED to pay TTEC Holdings the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 22<sup>nd</sup> day of August 2022**

**L FAYTER**

**For the Registrar**

## ANNEX

### **The First Earlier Mark**

#### Class 9

Software for mobile communication devices, but excluding software for use in mobile medical communication devices; software for online and mobile messaging, but excluding software for use in medical communication devices; software for operating a virtual network, including a mobile virtual network, but excluding software for the use in virtual networks for medical applications; communications software for connecting mobile telephone network services to fixed line telecommunications networks, but excluding communication software to connect medical devices; telecommunications equipment, in particular for the fixed network and mobile communications sectors, but excluding communication equipment installed in medical devices and communication technology used within medical devices.

#### Class 38

Voice, information, data and messaging transmission via fixed network and mobile telecommunications networks; providing access to telecommunications networks for the transfer and dissemination of voice, information, messages and data; transmission and reception of messages by means of telecommunications networks; communication by fixed line and mobile telecommunications equipment, including communication of voice, information, data and messages; operation of a telecommunications network or components thereof, including a virtual telecommunications network; operation of a telecommunications network or components thereof for others, including a virtual telecommunications network; consulting services in the field of transmission of voice, messages, data and information via mobile and fixed telecommunications networks.

### **The Second Earlier Mark**

#### Class 9

Software for mobile communication devices, but excluding software for use in mobile medical communication devices; software for online and mobile messaging, but excluding software for use in medical communication devices; software for operating a virtual network, including a mobile virtual network, but excluding software for the use

in virtual networks for medical applications; communications software for connecting mobile telephone network services to fixed line telecommunications networks, but excluding communication software to connect medical devices; telecommunications equipment, in particular for the fixed network and mobile communications sectors, but excluding communication equipment installed in medical devices and communication technology used within medical devices.

### Class 38

Voice, information, data and messaging transmission via fixed network and mobile telecommunications networks; providing access to telecommunications networks for the transfer and dissemination of voice, information, messages and data; transmission and reception of messages by means of telecommunications networks; communication by fixed line and mobile telecommunications equipment, including communication of voice, information, data and messages; operation of a telecommunications network or components thereof, including a virtual telecommunications network; operation of a telecommunications network or components thereof for others, including a virtual telecommunications network; consulting services in the field of transmission of voice, messages, data and information via mobile and fixed telecommunications networks