

**BL O/839/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3571702**

**BY**

**PIXSIGHT**

**TO REGISTER THE FOLLOWING TRADE MARK:**



**AND**

**OPPOSITION NO. 426779 THERETO**

**BY**

**X-ION GMBH**

## **Background and pleadings**

1. On 23 December 2020, Pixsight (the “Applicant”) applied to register the trade mark as shown on the cover of this decision. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 11 June 2021. Registration of the mark is sought in respect of the following goods and services:

Class 9        *Software, namely electronic platforms adapted to administrative management in the field of employment; software for connecting companies, temporary employment agencies or personnel recruitment and employees, job seekers or temporary employment assignments; software for evaluating temporary employment assignments; software for the management of employment contracts and provision of personnel.*

Class 35       *Management services in the field of employment; data processing services in the field of temporary employment agencies and personnel recruitment; supplying an online computer data base in the field of personnel recruitment; compilation of data in computer data bases for commercial purposes; providing information in terms of personnel recruitment from an online computer data base; consultancy for questions of recruitment and work in companies.*

Class 42       *Providing temporary access to non-downloadable software in the field of temporary employment agencies or personnel recruitment; software as a service ( SaaS) proposing software for connecting companies, temporary employment agencies or personnel recruitment, and employees, job seekers or temporary employment assignments; software as a service (SaaS) proposing software for the management of personnel recruitment or temporary employment assignments; software as a service (SaaS) proposing software for the management of employment contracts or temporary employment assignments.*

2. On 7 October 2021, x-ion GmbH (the “Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of one earlier European Union Trade Mark (EUTM):

EUTM No. 018204782



Filing date: 2 March 2020

Receiving date: 17 October 2020

Registration date: 9 July 2020

3. For the purposes of this opposition, the Opponent relied upon only some of the goods and services for which the earlier mark is registered, namely:

Class 9 *Mail server software; Server-side software; Communication, networking and social networking software; Computer-aided design (CAD) software; Digital dashboard software; Data engines; Cloud servers; Databases (electronic); Software for network and device security; Computer databases; CAE software; Application software for cloud computing services; Cloud computing software; Electronic mail servers; Computer software for database management; Cloud server software; Cloud network monitoring software; Wireless local area network devices.*

Class 35 *Computerised inventory preparation; Compilation and input of information into computer databases; Computerized file management;*

*Data processing, systematisation and management; Computerised compilation of customer indexes; Computerized on-line ordering services; Electronic data processing; Computerised stock management; Administrative support and data processing services; Computerised accounting; Computerized file management; Computerised data verification; Computerized word processing; Computerized file management; Administration of employee benefit plans; Computerised accounting.*

Class 42 *Hosting of digital content on the Internet; Computerised business information storage; Maintenance of software; Design and development of software for database management; Hosting websites on the Internet; Providing virtual computer systems through cloud computing; Design and development of data retrieval software; updating and maintenance of software and database systems; Software as a service [SaaS]; Programming of software for database management; Software development, programming and implementation; Information technology [IT] consultancy; Rental of operating software for accessing and using a cloud computing network; Development of software for communication systems; Development of software solutions for internet providers and internet users; Computer software consultancy; Providing virtual computer environments through cloud computing; Hosting of computerized data, files, applications and information.*

4. Since the filing date of the earlier mark predates that of the contested application, the Opponent's mark is considered to be an "earlier mark" in accordance with section 6 of the Act.<sup>1</sup> However, as the mark has not been registered for a period of five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

any or all of the goods and services for which the earlier mark is registered without having to show that it has used the mark at all.

The listed goods and services show a high degree of identity, as both are mainly in the field of IT and software development (Software as a Service, SaaS), respectively, resulting in a high likelihood of confusion between the trademarks.

6. On 11 February 2022, the Applicant filed a counterstatement denying the grounds of opposition. The Applicant submitted that the intended purpose and end-users of the contested goods and services differ from those of the goods and services of the earlier mark. The Applicant argued that contrary to the Opponent's submission that the contested goods are in the field of IT and software development, the contested goods in Class 9 actually relate specifically to computer software in the field of employment. The Applicant referred to the fact that the Opponent had not particularised any claims as to the similarity of the marks at issue, and explained that it was therefore unable to make any submissions in this regard. The Applicant argued that the marks are distinguishable from each other, with the contested mark being displayed in purple and white block colouring, whilst the earlier mark "...features different shades of blue with tonal contrasts".

7. On the 13 May 2022, the Opponent filed further submissions. In its submissions, the Opponent described the earlier mark as consisting of four graphic elements: "Two arrows of different sizes, directed towards each other, and two strokes which, at a certain distance from the larger of the two arrows, visually extend that arrow. The ingenious composition creates an overall impression from which the letter X can be seen in two variations." The Opponent argued that the contested mark adopted "all four features identically", with only minimal differences that are hardly visible and have no influence on the overall impression.

8. The Opponent referred to the CJEU judgment *Specsavers International Healthcare Limited & Others v. Asda Stores Limited*, C-252/12, which discusses the registration of a black and white trade mark being considered to also cover use of the mark in

colour. The Opponent argued that it is therefore not relevant in which colour the trade mark is used, "...since any use of colour leaves the degree of similarity unchanged". The Opponent argued that the marks at issue are therefore visually similar to a very high degree. The Opponent submitted that an aural comparison of the marks is not possible due to the fact that both marks are classified as a "Trade Mark without text". The Opponent stipulated that if an aural assessment were to be made then it is most likely that the average consumer would perceive each mark as the depiction of the letter 'X' or 'XX', and as such the marks would be aurally identical. The Opponent also submitted that there can be no conceptual comparison between the marks, although the Opponent again stipulated that if the consumer were to consider the marks as the letter 'X' or 'XX' then they would also be conceptually identical. The Opponent provided submissions as to the identity/similarity of the goods and services at issue, which shall not be reproduced here, but shall be called upon if and when necessary.

9. No Hearing was requested. Only the Applicant filed submissions in lieu of a Hearing.

10. In their submissions of 22 August 2022, the Applicant reiterated that the goods and services at issue differ overall as to their intended purpose, method and end user, and that they are not in competition. The Applicant specified that the contested goods and services relate to the fields of recruitment and temporary employment, whereas the goods and services of the earlier mark focus on software, data management and cloud computing, which are not designed to facilitate staffing or recruitment activities. The Applicant submitted that the average consumer of the goods and services at issue is likely to be a professional, purchasing items on a business-to-business level. As a result, any purchase would be thoroughly considered and involve a high degree of attention.

11. In comparing the marks, the Applicant submitted that they differ as to their colouring and use of contrasts (the contested mark having none). The Applicant argued that this difference "...is particularly striking given the simple shape of the Opponent's mark". The Applicant argued that due to the simplicity of its shape, the consumer's attention will be drawn to the colouring of the earlier mark, which is its dominant and distinctive element. The Applicant referred to the judgment *Specsavers*

as cited by the Opponent, and submitted that it relates to the registration of a black and white trade mark, which is not the case in the current proceedings.

12. The Applicant referred to the curved edges of the earlier mark contrasting with the pointed edges of the contested mark, which it argued created recognisable stylisation differences. The Applicant reasoned that due to the significant visual differences, and lack of aural and conceptual comparisons, any similarity between the marks is "...to a low degree only".

13. Both parties are professionally represented. The Applicant is represented by Boulton Wade Tennant LLP, and the Opponent is represented by Adamson Jones.

### **Decision**

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

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

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

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

(a) ...

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

### **Section 5A**

16. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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



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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

18. Both parties provided submissions in relation to the respective goods and services at issue. Whilst the parties' comments are noted, the degree of similarity or identity of the specifications, as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods and services at issue. I shall refer to the submissions of each party if and when I consider them to provide assistance and clarity.

| Earlier mark  | Application   |
|---|---|
| <i>Class 9: Mail server software; Server-side software; Communication, networking and social networking software; Computer-aided design (CAD)</i> | <i>Class 9: Software, namely electronic platforms adapted to administrative management in the field of employment; software for connecting companies,</i> |

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| <p><i>software; Digital dashboard software; Data engines; Cloud servers; Databases (electronic); Software for network and device security; Computer databases; CAE software; Application software for cloud computing services; Cloud computing software; Electronic mail servers; Computer software for database management; Cloud server software; Cloud network monitoring software; Wireless local area network devices.</i></p>   | <p><i>temporary employment agencies or personnel recruitment and employees, job seekers or temporary employment assignments; software for evaluating temporary employment assignments; software for the management of employment contracts and provision of personnel.</i></p>   |
| <p><i>Class 35: Computerised inventory preparation; Compilation and input of information into computer databases; Computerized file management; Data processing, systematisation and management; Computerised compilation of customer indexes; Computerized on-line ordering services; Electronic data processing; Computerised stock management; Administrative support and data processing services; Computerised accounting; Computerized file management; Computerised data verification; Computerized word processing; Computerized file management; Administration of employee benefit plans; Computerised accounting.</i></p> | <p><i>Class 35: Management services in the field of employment; data processing services in the field of temporary employment agencies and personnel recruitment; supplying an online computer data base in the field of personnel recruitment; compilation of data in computer data bases for commercial purposes; providing information in terms of personnel recruitment from an online computer data base; consultancy for questions of recruitment and work in companies.</i></p> |
| <p><i>Class 42: Hosting of digital content on the Internet; Computerised business information storage; Maintenance of</i></p>  | <p><i>Class 42: Providing temporary access to non-downloadable software in the field of temporary employment agencies or</i></p>   |

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|--|--|
| <p><i>software; Design and development of software for database management; Hosting websites on the Internet; Providing virtual computer systems through cloud computing; Design and development of data retrieval software; updating and maintenance of software and database systems; Software as a service [SaaS]; Programming of software for database management; Software development, programming and implementation; Information technology [IT] consultancy; Rental of operating software for accessing and using a cloud computing network; Development of software for communication systems; Development of software solutions for internet providers and internet users; Computer software consultancy; Providing virtual computer environments through cloud computing; Hosting of computerized data, files, applications and information.</i></p> | <p><i>personnel recruitment; software as a service ( SaaS) proposing software for connecting companies, temporary employment agencies or personnel recruitment, and employees, job seekers or temporary employment assignments; software as a service (SaaS) proposing software for the management of personnel recruitment or temporary employment assignments; software as a service (SaaS) proposing software for the management of employment contracts or temporary employment assignments.</i></p> |
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19. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

## Class 9

22. The Opponent submitted that all of the contested Class 9 goods are included in the terms of the earlier mark, in particular *Server-side software; Communication,*

*networking and social networking software; Computer-aided design (CAD) software; Digital dashboard software; CAE software; Cloud computing software; Electronic mail servers; Computer software for database management; Cloud network monitoring software.* Other than making the statement, no specific reasoning has been provided by the Opponent as to why the contested goods are identical or similar to these particular goods of the earlier mark. Nevertheless, I tend to agree that the identified goods of the earlier mark are of a general category that would include the contested goods. Whilst the contested goods are clearly specified as relating to the field of recruitment and employment, the goods of the earlier mark would encompass within their broad spectrum these more specific fields. The majority of the contested software goods are adapted to enable the administration, management and connection (networking) between employers and employees. The goods of the earlier mark, most specifically *Communication, networking and social networking software; digital dashboard software; and Computer software for database management* would facilitate the intended purpose of such contested goods. The contested *Software, namely electronic platforms adapted to administrative management in the field of employment; software for connecting companies, temporary employment agencies or personnel recruitment and employees, job seekers or temporary employment assignments; and software for the management of employment contracts and provision of personnel* are therefore found to be identical under the *Meric* principle.

23. The contested *software for evaluating temporary employment assignments* does not appear to fall as simply within the general category of the goods of the earlier mark. However, I consider 'evaluating' to be part of a management and communication process, and so it therefore has a highly similar intended purpose, user and trade channel to the *Computer software for database management* and *Communication, networking and social networking software* of the earlier mark.

#### Class 35

24. The contested *Management services in the field of employment* is a general category that would include the *Administration of employee benefit plans* in the earlier mark. Management as a service would include several aspects of responsibility and control, including administration. The contested *Management services in the field of employment* is therefore identical under the *Meric* principle.

25. The contested *data processing services in the field of temporary employment agencies and personnel recruitment* will fall within the general category of the *Data processing, systematisation and management* of the earlier mark, and is therefore identical under the *Meric* principle.

26. The contested *supplying an online computer data base in the field of personnel recruitment; compilation of data in computer data bases for commercial purposes; and providing information in terms of personnel recruitment from an online computer data base* are all forms of data bases. They are therefore identical under the *Meric* principle to the *Compilation and input of information into computer databases; electronic data processing; administrative support and data processing services; and computerized data verification* of the earlier mark.

27. The earlier mark is registered for *Administrative support (and data processing services)*. Administrative support is a general term that would encompass several aspects, including processing and organising. It would also likely cover consultancy, as by its nature a 'support' service facilitates advice and information. The contested *consultancy for questions of recruitments and work in companies* would likely fall within the general category of *Administrative support and (data processing services)* of the earlier mark, and is therefore considered to be identical under the *Meric* principle. In the alternative, the contested *consultancy for questions of recruitments and work in companies* is at least highly similar to the identified services of the earlier mark, as they have the same/similar intended purpose, user and trade channels. They may also be in competition.

#### Class 42

28. The earlier mark is registered for the general category of *Software as a service [SaaS]*. The contested services include forms of Software as a services [SaaS]. Under the *Meric* principle, the following contested services are found to be identical: *software as a service ( SaaS) proposing software for connecting companies, temporary employment agencies or personnel recruitment, and employees, job seekers or temporary employment assignments; software as a service (SaaS) proposing software for the management of personnel recruitment or temporary employment assignments;*

*software as a service (SaaS) proposing software for the management of employment contracts or temporary employment assignments.*

29. *Software as a service [SaaS]* is the provision of software via means of subscription. SaaS is a form of cloud computing, whereby software is hosted on a central server and access to users is provided remotely.<sup>2</sup> By being provided on a hosted system, SaaS is a type of software that is non-downloadable and normally usable only whilst accessing the service. For all intents and purposes, the SaaS of the earlier mark and the contested *Providing temporary access to non-downloadable software in the field of temporary employment agencies or personnel recruitment* are identical, as they both provide access to non-downloadable software. Although the contested *Providing temporary access to non-downloadable software in the field of temporary employment agencies or personnel recruitment* is more specific than the SaaS of the earlier mark, it would fall within the general category and is therefore identical under the *Meric* principle.

30. Following a comparison of the respective goods and services at issue, I have found each of the contested goods and services to be either identical or highly similar to the goods and services of the earlier mark.

### **Comparison of the marks**

31. 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



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<sup>2</sup> <https://www.collinsdictionary.com/submission/7719/SaaS>

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

32. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

33. The respective trade marks are shown below:

| Earlier mark   | Application   |
|--|---|
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34. The earlier mark is a figurative trade mark consisting of a graphical design. Describing the design from left to right, the graphical element contains a navy-blue chevron facing right towards a larger inverted chevron. The top half of the inverted chevron is navy-blue whilst the bottom half is a lighter shade of blue, which I shall refer to as sky-blue. In the central longitudinal line of the design is a sky-blue half chevron above, and a navy-blue half chevron below, a clear white space. The edges of the chevrons are curved. The chevroned graphic elements are placed in such a way as to create within their void a white letter 'X'. The white letter 'X' also functions as the forward-facing surface of a 3-D letter 'X', whereby the blue chevrons occupy the vertexes. In my opinion, the overall impression is that of a 3-D letter 'X', created by the use of dynamic blue chevrons.

35. The contested mark also consists of a graphical design. Describing the design from left to right, the graphical element contains a purple chevron facing right towards



a larger inverted purple chevron. In the central longitudinal line of the design is a purple half chevron in each hemisphere, with a clear white space between the chevrons. The edges of the chevrons are sharp. The chevroned graphic elements are placed in such a way as to create within their void a white letter 'X'. The white letter 'X' also functions as the forward-facing surface of a 3-D letter 'X', whereby the purple chevrons occupy the vertexes. In my opinion, the overall impression is that of a 3-D letter 'X', created by the use of dynamic purple chevrons.

### **Visual similarity**

36. Visually, the marks are similar insofar as they each contain identically positioned full and half chevrons. The identical positioning of the chevrons in each mark results in the identical creation of a 3-D letter 'X', with a white forward-facing surface.

37. The marks visually differ as to the choice of colour and shading of the chevrons. An additional but minor difference is that the edges of the chevrons are rounded in the earlier mark and sharper in the contested mark.

38. The marks are considered to be visually highly similar.

### **Aural similarity**

39. I do not discount the possibility that for a certain number of consumers the marks will be perceived to be an abstract graphical design that does not contain a word element. A figurative mark without word elements cannot be pronounced. Further, it is not necessary to examine the aural perception of a figurative mark that does not have word elements. In this regard I refer to *DosenbachOchsner AG Schuhe und Sport v OHIM*, Case T- 424/10, whereby the GC stated:

“45 The fact none the less remains that, contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 Nestlé v OHMI — Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe) [2010] ECR II-1177, paragraph 67).

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46 A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.

47 In those circumstances, and given that the contested mark is a figurative mark lacking word elements, it cannot be concluded there is either a phonetic similarity or a phonetic dissimilarity between that mark and the earlier marks.”

40. Consequently, and in relation to those consumers who perceive the marks to consist exclusively of an abstract graphical design, there is no aural comparison to be made.

41. However, and in the alternative, I am of the opinion that a significant number of the relevant public will perceive the combination of graphic elements in each mark to create the outline of a 3-D letter ‘X’, with a white forward-facing surface. The 3-D letter ‘X’ will be perceived and pronounced equally in each mark. Consequently, and in relation to those consumers who perceive the sign as a stylised 3-D letter ‘X’, the marks are aurally identical.

### **Conceptual similarity**

42. For a conceptual message to be relevant, it must be capable of being immediately grasped by the average consumer.<sup>3</sup> For those consumers who perceive the marks to consist of an abstract graphical design, the marks cannot be considered to possess any concept, and so no conceptual comparison can be made.

43. For a significant number of consumers, however, the marks will be perceived as consisting of a stylized 3-D letter ‘X’ with a white forward-facing surface, and either

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<sup>3</sup> See *T-185/02 Ruiz-Picasso and Others v OHIM – DaimlerChrysler (PICARO)* [2004] ECR II-0000; confirmed in *C-361/04 P*.

blue (earlier mark) or purple (contested mark) vertexes. For that part of the relevant public, the marks are considered to be conceptually highly similar.

### **Average consumer and the purchasing act**

44. 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.<sup>4</sup> 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.”

45. The goods and services at issue range between those which are generic and used on a daily basis by the majority of average consumers in their personal or professional lives, such as *Electronic mail servers; Computerised business information storage; and Software as a service [SaaS]*, to those which have more specific functions, such as *Software for evaluating temporary employment assignments; Management services in the field of employment; and Providing temporary access to non-downloadable software in the field of temporary employment agencies or personnel recruitment*. Although I have deemed certain goods and services to be more specific, I nevertheless do not consider them to be particularly specialist or dealing in an especially niche field. Accordingly, while the price paid for the goods and services can vary, I believe that overall they will fall within a generally affordable price range. As a result, the level of attention of the respective consumer will be no more than medium.

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<sup>4</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

46. Based on the nature of the goods and services at issue, I consider it most likely that the purchase process will be visually dominated. Whether the consumer is buying social networking software, accessing systems via cloud computing, conducting computerized word processing, or searching for job vacancies, etc., the consumer would predominantly be using their eyes, and would therefore most likely be making a purchase decision based on the visual appearance of the product or service provider. I do not entirely discount the possibility that the marks may be spoken, over the telephone for instance, especially when *consulting for questions of recruitment and work in companies*, and as such I accept that there may be an aural element to the purchasing process. However, I believe any aural aspect to be secondary to a visual one in a purchasing process.

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

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

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

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

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

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

51. The earlier mark is a figurative trade mark, consisting of a graphical design. The trade mark contains full and half chevrons of different shades of blue, placed at deliberately chosen and specific positions in order to create a vacuum where a white

3-D letter 'X' becomes visible. The distinctiveness of the earlier mark rests in the intricate positioning of chevrons used to create a 3-D letter 'X', with a white forward-facing surface and blue vertexes. Overall, I consider the earlier mark to be inherently distinctive to a high degree.

### **Likelihood of confusion**

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

53. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

"49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed.

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

And

“50... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

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

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)*

[2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

56. Having conducted a full analysis and thorough comparison of both the marks and their respective goods and services at issue, I have determined that it is the visual considerations which are of a greater importance in the assessment of a likelihood of confusion, due to the purchasing process of the respective goods and services being visually dominated. With this in mind, it is important to reaffirm that I have found the marks to be visually similar to a high degree. It is also important to reaffirm that I did not rule out a part of the relevant public paying attention to the aural aspect of the marks during the purchasing process, in which case I consider the finding of aural identity for the consumers who perceive the marks to be a figurative letter ‘X’ to be of significance. The high degrees of similarities in these two aspects would not be lost on the average consumer, who is considered to be reasonably well informed and reasonably observant and circumspect,<sup>5</sup> but who must nevertheless rely upon an imperfect picture of the trade marks they kept in their mind.

57. The earlier mark consists of a graphical design that, in my opinion, uses deliberately and precisely placed blue chevrons to create a 3-D letter ‘X’, with a white forward-facing surface. The contested mark also consists of a graphical design that, again in my opinion, uses deliberately and precisely placed purple chevrons to create a 3-D letter ‘X’, with a white forward-facing surface. The choice of when to use full or half chevrons is identical in each mark, as is the exact positioning of the chevrons. The

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<sup>5</sup> See paragraph 60 of *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*.



subsequent creation of a 3-D letter 'X' with a white forward-facing surface is identical in each mark.

58. I do not dismiss the Applicant's contention that the chevrons in each respective mark have differing rounded or sharp edges. However, I do not consider these extremely subtle differences to likely to be perceived by the reasonably observant and circumspect consumer (who is neither highly attentive nor casually dismissive), nor do I consider it likely that such minor details would likely be retained in a consumer's mind when imperfectly recalling the earlier mark.

59. As I have previously identified whilst analysing the respective marks, I consider the only notable difference between the two marks at issue to be the use of colour. In my opinion, the marks will be pronounced identically by a significant number of the relevant public, and will be perceived by a significant number of the relevant public as possessing the identical concept of a stylized letter 'X'. In the alternative, and for the consumer who does not perceive the marks at issue to be a stylized letter 'X', the aural and conceptual aspects of the marks do not exist and therefore have no impact on the overall impression. As a consequence, for such a consumer the only difference between the marks is entirely and exclusively limited to the visual aspect of colour.

60. I note that each party has made references to the judgment *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12. In that judgment, the CJEU held that:

“2. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

3. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly

infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.”

61. This judgment is not entirely relevant to the marks at issue, as neither mark has been registered in black and white, meaning that any subsequent use of a mark in colour does not need to be considered. Whilst neither mark has specifically claimed colour by way of a description or limitation or by citing a Pantone reference, for example, it is nevertheless clear that the respective marks at issue each use a particular colour scheme, being either different shades of blue or purple. It is these specific colours that must, therefore, be held in mind whilst conducting a global assessment of the marks at issue.

62. Blue is clearly different to purple. However, as far as a colour spectrum would suggest, the colours are relatively close. Blue bleeds into purple and the colours are not at polar opposite ends of the spectrum in the same way as blue and yellow or black and white would be, for instance. With this in mind, I consider it a distinct possibility that when an average consumer (who is not paying a particularly high degree of attention) is faced with the contested mark consisting of a 3-D letter ‘X’ with a white forward-facing surface, they may mistake it for a previously seen trade mark consisting of a 3-D letter ‘X’ with a white forward-facing surface mark being used in relation to identical or highly similar goods and services. It is important to appreciate that a consumer retains in its mind only an imperfect picture of an earlier mark, in which case I would argue that the difference between blue and purple (in my opinion the *only* perceptible difference between the marks at issue) could be misremembered. Further, the only perceptible difference between the marks (being their colour) would have zero impact on those occasions where the marks at issue are referred to aurally, in which case during such instances the marks at issue would be considered to be identical.

63. As I have previously made reference to, a global assessment includes keeping in mind a number of factors, one of which is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice

versa.<sup>6</sup> The goods and services at issue have been found to be either identical or highly similar. Such a degree of similarity could offset a lower degree of similarity between marks. When the marks at issue are in fact highly similar in regards to the most pertinent visual aspect, the degree of similarity between the goods and services only serves to reinforce a finding of a likelihood of confusion. In my opinion, I find it a distinct possibility that an average consumer who is buying for example *Electronic mail servers* or *Management services in the field of employment* sold under a 3-D white letter 'X' created by the use of purple chevrons, could misremember having previously bought identical goods and services sold under a 3-D white letter 'X' created by the use of blue chevrons. In light of the above, I consider there to be a likelihood of direct confusion.

64. In the event that I am considered to be wrong in this regard, due to the possibility that the average consumer would not directly confuse the marks owing to the impact of the difference in colour from blue to purple, I shall consider the possibility of a likelihood of indirect conclusion.

65. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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<sup>6</sup> *Canon*, C-39/97, para 17

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).”

66. I remind myself of the fact that I have found the marks at issue to be visually highly similar, whilst also being aurally and conceptually identical for the significant number of relevant consumers for whom the marks represent a stylised letter ‘X’ (for those consumers who do not perceive a stylised letter ‘X’, the aural and conceptual aspects are not relevant).

67. In order to find a likelihood of indirect confusion, I must consider it to be realistic that the average consumer would recognise the contested mark is different from the earlier mark, but would nevertheless consciously or subconsciously carry out the mental process whereby they distinguish a common element in the marks, and conclude that it is part of another brand from the same owner. I have made clear that I consider the use and positioning of graphical elements to be identical in each mark, with the result being an identically produced 3-D letter ‘X’. It is the identically replicated and precise positioning of the graphical elements which create the subsequent white letter ‘X’ that is, in my opinion, the “common element” in each mark. So unique is the formation of the letter ‘X’ in the earlier mark that I find it likely the average consumer would believe that whether the chevrons are blue or purple the undertaking using the

specific formation is one and the same. I consider it likely that an average consumer would assume no-one else but the brand owner of such a particular construction would use it in a trade mark. I also consider it likely that the average consumer would put the change in colour from blue to purple down to an entirely logical brand extension. Essentially, the structure of the letter 'X' is so strikingly distinctive that the consumer would believe all subsequent representations of the identical structure resulting in the identical letter 'X' belong to the portfolio of brands owned by the same or an economically linked undertaking.

68. Considering again the notion of interdependency, I am of the opinion that the identity or high similarity of the goods and services at issue reinforces in the mind of the average consumer the assumption that the marks at issue belong to the same undertaking, to the extent that if this were not to be the case, and the consumer purchased the goods and services believing them to be part of a brand extension of a trade origin with whom they are already familiar, then they would have been indirectly confused. It is therefore my opinion that there is a likelihood of indirect confusion.

## **Conclusion**

69. The opposition is successful. Subject to an appeal, the contested application will be refused in its entirety.

## **Costs**

70. The Opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

|   |      |
|---|------|
| Fee for opposition  | £100 |
| Preparing a statement and considering the<br>counterstatement of the other side | £200 |

|   |      |
|---|------|
| Preparing submissions and considering the<br>submissions in lieu of a hearing of the other side | £400 |
| Total   | £700 |

71. I therefore order Pixsight to pay x-ion GmbH the sum of £700. 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 29<sup>th</sup> day of September 2022**

**Dafydd Collins**

**For the Registrar**