

O-0074-23

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3550671
BY NOWYOYO LIMITED
TO REGISTER**

NowYoYo

**AS A TRADE MARK
IN CLASSES 38 & 42
AND OPPOSITION THERETO (UNDER NO. 424710)
BY
SKY UK LIMITED**

Background & pleadings

1. NowYoYo Limited (“the applicant”) applied to register the trade mark **NowYoYo** on 1 November 2020. The mark was published in the Trade Marks Journal on 26 February 2021 in classes 38 and 42 for the following services:

Class 38: Telecommunications; Internet telephony services; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; information, advice and consultancy in relation to all the aforesaid services.

Class 42: Providing temporary use of non-downloadable computer software and application software for use in relation to for use in relation to telecommunications, electronic and digital communications, commercial orchestration and fulfillment and information technology systems and processes; application service provider (ASP) featuring software to enable or facilitate telecommunications, electronic and digital communications, commercial orchestration and fulfillment and information technology systems and processes; information, advice and consultancy relating to all the aforesaid services.

2. Sky UK Limited (“the opponent”) initially opposed the application on 26 May 2021 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Mark Act 1994 (“the Act”). The pleadings under section 5(3) and 5(4)(a) were subsequently withdrawn by the opponent leaving the opposition to continue under section 5(2)(b) only. The opposition is based on some of the goods and services in the following four UK earlier registrations, the details of which are set out below. The goods and services the earlier registrations rely on will be set out later in this decision.

<p>UK TM No. 3127306</p> <p>NOW</p> <p>In classes: 9, 41 & 42</p> <p>Filing date: 19 August 2015</p> <p>Registration date: 21 June 2019</p>	<p>UK TM No. 3126405</p> <p>NOW TV</p> <p>In classes: 9, 38, 41 & 42</p> <p>Filing date: 9 September 2015</p> <p>Registration date: 28 October 2016</p>
<p>UK TM No. 3123271</p>  <p>In classes: 9, 38, 41 & 42</p> <p>Filing date: 19 August 2015</p> <p>Registration date: 4 November 2016</p>	<p>UK TM No. 3243763</p>  <p>In classes: 9, 38, 41 & 42</p> <p>Filing date: 14 July 2017</p> <p>Registration date: 15 December 2017</p>

3. The opponent's registrations are earlier marks, in accordance with section 6 of the Act, but as none have been registered for five years or more before the filing date of the application, they are not subject to the proof of use requirements, as per section 6A of the Act.

4. The applicant filed a counterstatement in which it denied the remaining ground of opposition.

5. The parties have been represented throughout these proceedings. The applicant is represented by Griffin Law and the opponent by Mishcon de Reya LLP. Both sides filed evidence and a hearing was held before me on 28 October 2022. Both sides filed skeleton arguments in advance of the hearing, which I refer to in more detail below. The opponent was content to present its case in writing only. Michael Smith of Counsel appeared for the applicant, instructed by Griffin Law. The opponent did not participate in the hearing but attended in an observational capacity.

6. I make this decision following consideration of all the material before me and taking into account the submissions made at the hearing. I shall refer to the evidence as and when necessary.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the 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.

Preliminary issues arising from the hearing

8. As per the usual tribunal guidelines on the filing of skeleton argument in advance of the hearing, the parties were required to file all material by 14:00 on 26 October 2022.

9. At 9:14 on 26 October the applicant filed its skeleton argument and list of authorities. Then at 13:14 on 26 October the opponent filed its skeleton argument and an annex containing details of four previous decisions, two from the UK IPO and two from the EUIPO, in which the opponent was successful and concerning the same earlier registrations as in the instant case. Within the same email the opponent observed that the applicant was seeking to introduce new evidence into the case and referenced in particular paragraph 17 of the applicant's skeleton, viz

17. The word "NOW" and the prefix "NOW" are inherently undistinctive:

(a) "NOW" is an ordinary English word. The average consumer of all the goods and services relied upon is used to seeing multiple brand names that share the same ordinary English word as one component without there being any connection or link between brands.

(b) As at 4 April 2022, a "Starts-With" search for "NOW" at the IPO website³ returned 574 live trade marks, of which 175 were in classes 38 and 42. [Delo ¶34, 35].

(c) There appear to be active hundreds of active UK companies with a name beginning "NOW".

10. The applicant responded at 14:38 on 26 October with additional authorities, in particular with reference to an Appointed Person decision O/285/21, aimed at opponent's annex containing the previous decisions.

11. Finally the opponent responded again at 9:52 on 27 October objecting to the additional and, in their view, mostly irrelevant material sent by the applicant the previous day. In addition, the opponent pointed out that it did not seek to rely on facts in its previous decisions but instead felt it was "instructive" to bring these cases to my attention as the hearing officer but accepted that I was not bound by these decisions.

12. For convenience I will address these issues separately. Taking first the issue that the applicant sought to introduce new evidence in its skeleton argument. In paragraph 17 of its skeleton as set out above, point (a) references the "ordinariness" of the word NOW, point (b) sets out the number of live UK trade marks beginning with "NOW" as of 6 October 2022 and point (c) is an assertion that there are many UK companies with "NOW" in their company name. In relation to points (a), (b) and (c), the applicant made virtually identical points in its counterstatement¹ dated 6 October 2021 and point (b) regarding live marks containing "NOW" was repeated in the opponent's witness statement dated 4 April 2022². The only difference I can see between the evidence and the skeleton was there were 574 live UK trade marks starting "NOW" with 152 of those cases being in the contested classes 39 and 42 on 4 April 2022 and 574 live UK marks starting "NOW" with 175 of those cases being in 39 and 42 on 6 October 2022. Although the figures have changed slightly, the point that the applicant was highlighting in what appears to be state of the register evidence or at least the commonness of the word "NOW" in both trade mark and company names is not new evidence as I see it. The same points, but not the exact number of live trade marks, were raised in the counterstatement and in the evidence so the opponent has been previously aware of the applicant's direction of travel on this point.

¹ Paragraph 9 (a), (b) & (c)

² Paragraphs 34 & 35

13. The commonness or otherwise of “NOW” in other trade marks or in company names is not relevant to the decision I must make in relation to the marks and the respective goods and services before me in these proceedings. This point was established in *Zero Industry Srl v OHIM*³, where the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

14. With regard to the issue of the opponent seeking to rely on the outcomes of previous decisions in its favour, the opponent said in its skeleton⁴ that,

“The Opponent acknowledges that earlier decisions turn on their own facts and that the UKIPO is not bound to follow findings of a likelihood of confusion in such cases. However, the Opponent respectfully submits that it is instructive to bring to the UKIPO's attention the following cases (copies are provided hereunder) especially given that the first two concern actions brought by the Opponent in reliance upon the mark "NOW" (or NOW-formative marks).”

³ Case T-400/06

⁴ Paragraph 8.1

15. The applicant criticised this approach and references *Hollington v Hewthorn*⁵ which was cited in an AP decision namely O/285/21. The principle in *Hollington* states that “earlier judgements cannot be used as evidence to support the findings of fact”. I note the point the applicant makes but I do not consider the opponent was seeking to rely on the earlier judgments in the way suggested. The opponent made clear it was bringing the decisions to my attention as they believed the cases contained similar circumstances as the instant case but they rightly point that I am not bound by the outcomes of previous decisions and indeed I must make the decision in this case based on its own facts. In terms of the earlier decisions I do not consider them to be on all fours with the instant case. One of the contested marks in the earlier decisions consisted of one word, namely a stylised “NOW”, with no additional words. The remainder of the contested marks in the earlier decisions did comprise “Now” plus an additional word. However the additional words, namely SERIES, BOX and WIRELESS can be considered as descriptive words in relation some of the services and which I believe are not on a par with the contested mark here. Therefore I am not taking those earlier decisions into account.

Opponent’s evidence

16. The opponent filed evidence in reply in the form of a witness statement and four exhibits. The witness statement was filed in the name of Felicia Oduntan, a Chartered Trade Mark Attorney and Associate of Mishcon de Reya LLP, the opponent’s representative in these proceedings. Ms Oduntan’s evidence comprises information regarding the applicant’s current and historic lack of website presence obtained from the WaybackMachine internet archive service as well, as a lack of activity on social media. In addition, information as provided on the applicant’s status as a micro company.

Applicant’s evidence

17. The applicant filed a witness statement in the name of Mark Delo, who is a Director and the Chief information officer of the applicant. Mr Delo appended one exhibit. The applicant’s evidence sets out the company’s commercial origins and

⁵ [1943] KB 587

history with regard to domain name purchase, logo development, social media exposure and the services it has provided for customers. The evidence also contains an assertion that Mr Delo and his fellow director are not aware of any customer confusion between the applicant and the opponent during the course of business. In addition, information was provided on the number of other live trade marks on the UK register containing the word “Now”.

18. Before proceeding further I think it is worthwhile pointing out that it is settled case law⁶ that absence of confusion in the marketplace is not relevant to the decision I must make. In *Roger Maier*, Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

My approach

NOW

⁶ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

Section 5(2)(b)

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

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

(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

21. 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.”

22. The following principles are gleaned from the judgments 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 C3/03, *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.

The principles:

(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 the 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 greater 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;

(l) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

23. In the judgment of the CJEU in *Canon*⁷, 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”.

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁸, 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;

⁷ Case C-39/97

⁸ [1996] R.P.C. 281

(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.

25. I also note the following comments of the GC in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*⁹:

“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”.

26. In *Kurt Hesse v OHIM*¹⁰, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*¹¹, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

⁹ Case T- 133/05

¹⁰ Case C-50/15 P

¹¹ Case T-325/06

27. In *Sanco SA v OHIM*¹², the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*¹³:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

28. The applicant’s services are set out above in paragraph 1 and in its skeleton arguments the opponent set out specific goods and services from its specifications where it believed there was particular overlap with the applicant’s services. These goods and services are set out in Annex 1 to this decision. Given that both of the earlier registrations and the application have directly comparable services in classes 38 and 42, I intend to begin with those classes and will return to the other classes if required.

29. For the purpose of a comparison, it is appropriate to group related goods and services together, where they are sufficiently comparable to do so¹⁴.

Class 38

¹² Case T-249/11

¹³ BL-0-255-13

¹⁴ *Separate Trade Mark* decision, BL O-399-10 (AP)

30. Both the opponent's '271 registration and the application contain the identical term *telecommunications* in the respective class 38 specification. I also find that the term *telecommunications* is sufficiently broad to encompass the remaining services in the applicant's specification on the basis of *Meric* identity. Consequently, all of the applicant's services are identical to the services covered by the opponent's '271 registration.

31. The opponent's '306 registration does not have class 38 but has the following goods in class 9 namely *transmitters [telecommunications]; transmitting sets [telecommunications]; encoded programs for telecommunications; apparatus for recording, transmission or reproduction of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing musical or musical performances; mobile telephones*. I find these goods to have a close connection to the applicant's services namely *Telecommunications; Internet telephony services; communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks*. The class 9 goods are the means by which the services can be received, enabled and accessed and consumers may conclude that the same undertaking will provide both the goods and services. As such the goods and services are complementary and therefore similar to a low degree.

Class 42

32. I find the applicant's terms *Providing temporary use of non-downloadable computer software and application software for use in relation to for use in relation to telecommunications, electronic and digital communications, commercial orchestration and fulfillment and information technology systems and processes; application software for use in relation to for use in relation to telecommunications, electronic and digital communications, commercial orchestration and fulfillment and information technology systems and processes information, advice and consultancy relating to all the aforesaid services* are sufficiently broad enough to cover the opponent's terms in its '271 mark namely *provision of non-downloadable computer software for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely*

accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network; consultancy, information and advisory services relating to all the aforesaid services on the basis of Meric and are, therefore, identical.

33. I find the opponent's terms *application service provider services; consultancy, information and advisory services relating to all the aforesaid services* in its '271 mark are broad enough to cover the terms *application service provider (ASP) featuring software to enable or facilitate telecommunications, electronic and digital communications, commercial orchestration and fulfillment and information technology systems and processes; information, advice and consultancy relating to all the aforesaid services* in the applicant's specification on the basis of *Meric* identity.

Average consumer and the purchasing process

34. I next consider who the average consumer is for the contested services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.¹⁵ 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 question¹⁶.

35. The average consumer for the services at issue will be the general public, businesses and IT professionals. The services are likely to be selected from a primarily visual means, for example by way of examining technical or more general information on technical specifications and functionality from an online or printed source, although I do not discount an aural element if advice is sought by consumers from technical sales advisors. In addition, I find that as the contested services cover quite a breadth of telecommunications and software services, they are likely to vary

¹⁵ *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)

¹⁶ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

in price depending on the services. However clearly consumers will need to establish that the telecommunications or software services they are choosing will meet their needs, for example in terms of operating systems, compatibility and functionality for purpose. Therefore they will be paying at least a medium degree of attention during the purchasing process.

Mark comparisons

36. 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 CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹⁷, 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.”

37. 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.

38. The respective trade marks to be compared are:

Opponent's earlier registrations	Applicant's mark
UK TM No.3127306	NowYoYo

¹⁷ Case C-591/12P

NOW

UK TM No.3123271



39. The opponent's '306 mark consists of the word **NOW** with no other aspect such as stylisation or a device to it. The overall impression derives solely from the word itself.

40. The opponent's stylised '271 mark consists of the letters N and W in a curved font with a circle placed between them, such that the whole presents as the word NOW. The whole word is depicted as white lettering on a black rectangular background. The overall impression resides in a combination of the word "NOW" and the visual get-up.

41. The applicant's mark consists of a word **NowYoYo** with a capital letter for the N and for the two letters Y. There is no other aspect to the mark such as stylisation or a device but given this presentation some consumers may see the word Now conjoined with the word YoYo. So the overall impression is derived from this presentation.

42. In a visual comparison the respective marks share the word element **NOW**. It is the entirety of the opponent's '306 mark and the verbal element of its '271 mark. As a point of difference, the stylisation for the '271 mark is not replicated elsewhere and the applicant has the additional **YoYo** element ending its mark. It is settled case law¹⁸ that the beginnings of words tend to have greater visual and aural impact on consumers but I note that the applicant's mark is longer by four additional letters

¹⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

than the opponent's marks which will make a visual impact. Taking all these factors in account I find there is a medium level of visual similarity between the respective marks.

43. In an aural comparison the respective marks will share the identical pronunciation for the shared element **NOW**. The point of difference will be the applicant's additional two syllables "**YoYo**" which lengthens that mark when spoken in full. Overall I find there will be a medium level of aural similarity.

44. In a conceptual comparison, the opponent's marks consist of **NOW**, a dictionary word which consumers will understand as meaning "immediately"¹⁹. the applicant's mark will have no immediately graspable concept²⁰ for a significant proportion of consumers, but consumers may look for words that they recognise and might see the element **Now** meaning immediately and **YoYo** being the toy or a swing from one position to another²¹, but the whole does not form a meaningful unit and whilst there is a low degree of conceptual similarity for the shared element **NOW**, I do not find there is any conceptual similarity for the applicant's mark as a whole.

Distinctive character of the earlier mark

45. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*²² 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

¹⁹ [Now definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](#) – accessed 6/1/23

²⁰ *The Picasso Estate v OHIM*, Case C-361/04 P

²¹ [Yo-yo definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](#) – accessed 6/1/23

²² *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

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)."

46. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

47. No evidence of enhanced distinctiveness was provided so I have only the inherent position to consider.

48. The earlier mark ending '306 consists of an ordinary dictionary word and the mark ending '271 is the same word in a stylised font. The word **NOW** is not descriptive in relation to the goods and services for which it is registered but neither is it particularly distinctive as a dictionary word. I would pitch the distinctiveness for the word only mark as between a low and medium degree and the stylised word mark at a medium degree.

Likelihood of confusion

49. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they

have kept in mind.²³ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

50. 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.

51. In *L.A. Sugar Limited*²⁴, Mr Iain Purvis Q.C. (as he then was), sitting 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

52. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark²⁵. This is considered mere association not indirect confusion.

²³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

²⁴ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

²⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

53. So far in this decision I have found that,

- The services are identical and the goods similar to a low degree
- The average consumer will pay a medium level of attention during the primarily visual purchasing process, but I do not ignore that aural considerations may play a part
- There is a medium degree of visual and aural similarity
- There is no conceptual similarity for the marks as a whole although there is some low degree of similarity for the shared element
- The earlier '306 mark is distinctive to a low to medium degree
- The earlier '271 mark is distinctive to a medium degree

54. The respective marks clearly share the same word, namely **NOW**. However even taking into account the case law relating to the beginnings of words and the distinctiveness levels of the earlier marks, I find any such similarity is outweighed by the difference in the applicant's mark, namely the additional element **YoYo** which has a visual and aural impact and does not have the conceptual hook of the earlier marks, on which a consumer can hang a meaning. The addition of "YoYo" to the word "Now" in the applicant's mark is not likely to go unnoticed and overall I find there is no direct confusion between the marks.

55. Having found no likelihood of direct confusion, I will go on to assess the likelihood of indirect confusion. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to the same or an economically connected undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark. However I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because two marks share a common element.

56. In this instant case consumers may note the fact that the respective mark share the element **NOW** but I have found that this is not a highly distinctive word whereas **YoYo** is much more so and in my view alters the distinctive character of the whole. It has impactful visual and aural differences from the opponent's mark, and it has no

immediately graspable concept, for consumers to be confused into thinking the services come from the same or connected undertakings. If one mark is brought to mind by the other on the basis of the shared element, **NOW**, then I put this down to mere association not indirect confusion as per *Duebros*.

57. I do not need to consider the remaining earlier marks or the additional classes as these do not put the opponent in any stronger a position.

Conclusion

58. The opposition fails in its entirety and subject to any appeal against this decision, the application can proceed to registration.

Costs

59. The applicant has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£300	Consideration of statement of opposition & preparation of counterstatement
£500	Consideration of evidence
£800	Preparation for & attending the hearing
£1600	Total

60. I order Sky UK Limited to pay NowYoYo Limited the sum of £1600. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of January 2023

June Ralph
For the Registrar
The Comptroller-General

Annex 1

Goods & services relied on for the opponent's earlier NOW UK TM No. 3127306 ("the '306 mark")

9: transmitters [telecommunication]; transmitting sets [telecommunication]; encoded programs for computers and for data processing and telecommunications; apparatus for recording, transmission or reproduction of sound or images but not including any such apparatus with the sole function of recording, transmitting or reproducing music or musical performances; computer software but not including computer software with the primary function of composing, recording, reproducing or transmitting music or musical performances; digital set top boxes; computer software to enable searching of data; encoded programs for computers and for data processing and telecommunications; telephones; mobile telephones; telephone and radio modems; parts and fittings for all of the above.

42: Hosting computer sites [web sites]; Rental of computer software; Rental of web servers; online technical storage facilities, online storage of files, data, photographs, graphics, documents, videos, images, audio files, audio-visual files, visual files, computer files, computer applications and information for others, electronic data storage services for personal and business use, and services for the electronic storage and organization of files, images, audio, video, photos, drawings, audio-visual, text, documents and data, but excluding business relocation services; hosting websites; analysis and monitoring of Telecommunication services; computer programming services; rental or leasing of computer hardware or software; none of the aforesaid services listed in this class being provided in connection with musical sound recordings, downloadable music, musical performances.

Goods & services relied on for the opponent's earlier NOW UK TM No. 3123271 ("the '271 mark")

38: Telecommunications; Cellular telephone communication; Telephone services; telecommunications services over the Internet including but not limited to services provided using voice over Internet protocol (VOIP); provision of access and/or connectivity to broadband networks whether fixed, portable or wireless; communications services; satellite, cellular and radio communication services; transmission and communication services; broadcasting and transmission of content including television programmes, films, sport, documentaries and entertainment to platforms including television, personal computers, mobile devices and tablet computers; broadcasting and communications by means of or aided by computer; transmission of audio, video and/or audio visual programming by any means; consultancy, synchronization, transfer and transmission of programs, data, files, e-mails, contacts, calendars, task lists, text messages, photos, audio, visual, audio visual, video, text, graphics, programs and other information via telecommunications and global communications networks; information relating to all the aforementioned services provided on-line from a computer database or via a helpline or the Internet; none of the aforesaid services listed in this class being provided in connection with musical sound recordings, downloadable music.

42: Design and development of computer hardware and software; online storage of files, data, photographs, graphics, documents, videos, images, audio files, audio-visual files, visual files, computer files, computer applications and information for others, electronic data storage services for personal and business use, and services for the electronic storage and organization of files, images, audio, video, photos, drawings, audio-visual, text, documents and data, but excluding business relocation services; Computer programming; Computer rental; Computer software consultancy; Computer software design; Computer software (Updating of -); Computer system design; Consultancy in the design and development of computer hardware; Hosting computer sites [web sites]; Installation of computer software; Maintenance of computer software; Rental of computer software; Rental of web servers; Including online technical storage facilities, online technical back-up services and online technical back-up facilities, software as a service [saas] services, and electronic

hosting of files, data, photographs, graphics, documents, videos, images, audio files, audio-visual files, visual files, computer files, computer applications, information for others and video-conferencing services; hosting websites; creating and maintaining websites; computer services for interactive communications and broadcasting; installation, rental and maintenance of computer software; computer services relating to entertainment, education, retrieval of information and data via telephone line, cable, wire or fibre, database or computer network; computer services for retrieving information, messages, text, sound, images and data via a computer network; computer services relating to radio and television programmes; computer services; home computer services namely computer consultancy, installation, repair and maintenance of computer software, updating software and computer support services; computer services, namely the organisation of an infrastructure to enable television subscribers to access internet services via the television; advisory services relating to computer hardware or software; design, installation, maintenance or updating of computer software; design of computer hardware; designing electrical or electronic systems; design services for artwork for animated films; computer programming services; rental or leasing of computer hardware or software; provision of non-downloadable computer software for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network; application service provider services; technical advisory services including these services provided by a helpline; provision of software updates electronically; provision of customised webpages containing user defined information, search engines and links to other websites; online managing and filtering of electronic communications; consultancy, information and advisory services relating to all the aforesaid services; information relating to all the aforementioned services provided on-line from a computer database or via a helpline or the Internet; none of the aforesaid services listed in this class being provided in connection with musical sound recordings, downloadable music, musical performances.