

BL O/0198/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3654430

BY

ISAC GmbH

TO REGISTER THE TRADE MARK:



IN CLASSES 35, 38 AND 41

-AND-

THE OPPOSITION THERETO UNDER No. 430197

BY

FREELANCE.COM

Background and pleadings

1. ISAC GmbH (“**the Applicant**”) applied to register the following trade mark (“**the Contested Mark**”) in the UK on 11 June 2021, in respect of services in Classes 35, 38 and 41:¹



The application was published for opposition purposes in the Trade Marks Journal on 15 October 2021.

2. On 14 January 2022, FREELANCE.COM (“**the Opponent**”) opposed the Contested mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”).² The opposition is directed at all the services applied for.
3. For the purposes of its opposition, the Opponent relies on two trade marks, one being an international trade mark registration designating the UK, and the other a UK trade mark registration. Details of these marks are set out below. Given the respective filing dates, the Opponent’s marks are earlier trade marks in accordance with section 6 of the Act.

International Registration (UK) – “the Earlier IR Mark”

Representation of the Earlier IR Mark:	
Registration No.:	WO0000001583956
Date protection conferred in UK:	11 November 2021

¹ The applied-for services are set out in their entirety at my paragraph 34.

² I note that in its Form TM7 ‘Notice of Opposition’ the date the Opponent has inserted as the ‘opposition notification date’ is 17 December 2022. Clearly this is an error and after having reviewed the papers, I can see that this date was in actual fact the 15 December 2021.

International Registration Date:	10 December 2020
Designation Date:	10 December 2020
Priority Date:	15 June 2020

UK Trade Mark Registration – “the Earlier UK Mark”

Representation of the Earlier UK Mark:	
Registration No.:	UK00003608750
Registration Date:	22 October 2021
Priority date (earliest date): ³	31 January 2017

4. Both of the Opponent’s marks are registered in respect of services in Classes 35, 36, 38, 41, 42 and 45. For the purposes of this opposition, the Opponent relies solely on services contained in its Classes 35, 38 and 41, which are set out in their entirety at **Annexes 1 and 2** to this decision.
5. As these marks had not been registered for five years or more at the filing date of the application, they are not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent does not need to show any use at all of the services upon which it relies.
6. The Opponent did not file submissions or evidence during the evidence rounds, and it did not elect to file submissions in lieu of a hearing. As the only comments I have before me from the Opponent are contained in its Form TM7 – ‘Notice of

³ The application to register the Earlier UK Mark was filed pursuant to Article 59 of the ‘Withdrawal Agreement’ (‘Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)’, also known as the ‘Withdrawal Agreement’). As a consequence, it is deemed to have the same filing date as the trade mark application filed in the EU (i.e. 15 May 2017). The Opponent’s EUTM application claimed priority from the Opponent’s earlier French mark, being 31 January 2017, therefore in turn, the Earlier UK Mark also claims the same priority.

opposition and statement of grounds', I have reproduced them in full below:

"It is submitted and evidence will be adduced that the Opponent's earlier trade mark[s] [are] similar to the Opposed mark Freelance & star device. The services of the Opponent's earlier trade mark[s] relied upon in this opposition are identical or similar to the services at which this opposition is directed.

In light of the similarity of the respective marks and the identical or similar nature of the services at issue, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the Opponent's earlier mark[s].

It is therefore submitted that the Opposed Application should be refused under Section 5(2)(b) of the Trade Marks Act 1994."

7. The Applicant filed a counterstatement and later filed evidence and submissions in lieu of a hearing. The Applicant has admitted that the respective services are (for the most part) *"identical or similar"* – there are some services which it deems to be dissimilar. However, it has denied that there is a likelihood of confusion between the respective marks on the basis that the word 'freelance' is descriptive (and therefore non-distinctive) of the respective services and *"should remain free for others to use"*, and as a consequence, the comparison should be made between the other elements making up the respective marks – which the Applicant submits are different from each other and therefore *"the average consumer would readily distinguish the marks from one another visually"* and would not be confused.
8. This decision has been taken following a careful perusal of the papers.
9. In these proceedings the Opponent is represented by Keltie LLP and the Applicant is represented by Lewis Silkin LLP.
10. 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.

Evidence

11. Below is a list of the evidence filed by the Applicant in these proceedings:

- (1) Witness Statement of Simon Gravel, the CEO of ISAC GmbH (i.e. the Applicant), dated 14 September 2022.
- (2) Exhibits FL1 – FL5

Summary of the Applicant's evidence

12. In its submissions,⁴ the Applicant states that it *“has filed evidence showing how its trade mark is used and the services on which the trade mark has been used. Whilst the use only commenced in 2021, there have been no known instances of confusion with the opponent's services (paragraph 16 of the witness statement of Simon Gravel) despite the fact that the applicant's website has been frequently visited since it went live in July 2021.”*

13. Paragraph 16 of the Witness Statement of Simon Gravel states:

“Since my Company began to operate in the UK under the trade mark, to the best of my knowledge, we have not encountered any instances of confusion with the trade marks of FREELANCE.COM.”

I note this statement only makes reference to the Earlier IR mark and does not make any reference to the Opponent's other mark, i.e. the Earlier UK Mark.

14. The Applicant has submitted that the word ‘freelance’ in the respective marks is descriptive and as a result it should be disregarded when comparing the marks. With specific reference to the Opponent's Earlier UK Mark, the Applicant has submitted that the comparison between these two marks should therefore rest solely in relation to their device elements. The Applicant essentially claims that

⁴ Dated 5 December 2022, paragraph 34.

the 'star device' in its mark is the distinctive element on which the consumer will rely to determine trade origin, and that as a consequence of it differing from the device in the Earlier UK Mark, there is no confusion between the respective marks.⁵ Yet, I note that the Applicant's 'star device' does not appear anywhere in the 'use' evidence presented to me.

15. Indeed, the 'use' evidence on which the Applicant bases its claim that "*there have been no known instances of confusion*" in the marketplace, is 'use' in relation to a different sign and not the mark subject of this opposition.
16. Having reviewed the Applicant's evidence, the only 'use' presented to me is in relation to the following sign as opposed to the mark as applied for:



and

freelance.co.uk

17. Some evidence is undated (namely Exhibit FL3), however, the earliest date of the evidence is 19 November 2021,⁶ and the latest date is 22 July 2022,⁷ (the July 2022 evidence still shows deployment of the above signs and not use of the mark as applied for).
18. The witness states that the Applicant spends on average €2000 - €3000 per month on marketing the services provided under the Contested Mark.⁸ However, I note that the undated marketing materials presented to me in Exhibit FL3 only make reference to the above 'freelance.co.uk' signs, not to the mark as applied for.
19. Even if the evidence related to use of the mark as applied for, absence of evidence of actual confusion is not necessarily detrimental to an opposition under section 5(2)(b) and it would depend on the evidence.
20. I understand from the evidence that the Applicant renders its services via its 'UK' website and that such website was launched in July 2021 (being the month

⁵ See the Applicant's submissions set out in my paragraph 52.

⁶ Being approximately one month after the Contested Mark was published for opposition purposes.

⁷ Being approximately more than one year after the filing date of the Contested Mark.

⁸ See paragraph 15 of the Witness Statement of Simon Gravel.

following the date of application). Even if the evidence related to the mark applied for it is anyway insubstantial, covering only a short period of time, which might account for the absence of confusion at the time the evidence was collated.

21. I bear in mind the following comment of Kitchin L.J. in *Roger Maier and Another v ASOS*,⁹ in relation to absence of confusion in the marketplace (my emphasis):

“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 [...] 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.”

I also bear in mind that marketing considerations are not relevant when considering the likelihood of confusion.¹⁰

22. Finally, although the likelihood of confusion must be assessed at the relevant date (i.e. in this case, the date of application of the Contested Mark), it is also a forward looking enquiry. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹¹ Lord Justice Arnold confirmed that:

“The judge was not precluded, in assessing the likelihood of confusion at [the relevant] date, from taking into account probable future developments. On the contrary, he would have been in error had he not done so, since it is of the essence of the test of likelihood of confusion that it is forward-looking.”

23. In light of all of the factors detailed above, the Applicant’s evidence will not have any bearing on my assessment of whether a likelihood of confusion exists between the respective marks and I shall make no further reference to it.

⁹ [2015] EWCA Civ 220, paragraph 80.

¹⁰ See the decision of the Court of Justice of the European Union (CJEU) in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, paragraph 59

¹¹ [2021] EWCA Civ 1207, paragraph 33

DECISION

Legislation and Case Law

24. Sections 5(2)(b) and 5(A) of the Act are 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.”

“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.”

25. I am guided by the following principles which 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.

Approach

26. The Opponent is relying on two earlier marks, both of which are registered for the services on which the Opponent relies i.e. its services in Classes 35, 38 and 41. Having reviewed the specification for both earlier marks I note that they are fundamentally identical to each other. This is because they either use identical wording, for example, they both contain the exact term '*advertising*' in Class 35, or they contain terms that are identical albeit worded differently, such as '*newspaper subscription services (for third parties)*' in Class 35 for the one and '*arranging newspaper subscriptions (for others)*' for the other.
27. The Applicant's submissions with regard to its services comparison are essentially the same for each of the Opponent's marks.¹² In the circumstances, I need only carry out the services comparison once.
28. I shall firstly carry out my assessment between the Earlier UK Mark and the Contested Mark, on the basis that the Earlier UK Mark does not contain any additional wording/letters that are not contained in the Contested Mark.¹³ If the opposition is successful based on the Earlier UK Mark, then it follows (given the identity between the two specifications) that there will be no need to move on to carry out a comparison between the Earlier IR Mark and the Contested Mark as it would not materially improve the Opponent's position.

Comparison of services

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*,¹⁴ ("**Mer**ic"), the General Court held to the effect that goods can be considered as identical when

¹² Save for the disparities detailed in my paragraphs 36 and 37.

¹³ i.e. it does not contain the letters 'COM'.

¹⁴ Case T- 133/05

the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

30. Section 60A of the Act provides:

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

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

31. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:¹⁵

- (1) the physical nature of the goods or acts of service;
- (2) their intended purpose;
- (3) their method of use / uses;
- (4) who the users of the goods and services are;
- (5) the trade channels through which the goods or services reach the market;
- (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (7) whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)

¹⁵ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

or

- (8) whether they are complementary to each other. 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”*.¹⁶ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.¹⁷

32. When interpreting the terms in a specification I bear in mind:

- (1) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods [and services] in question”*;¹⁸
- (2) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”*;¹⁹
- (3) the following applicable principles of interpretation:

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

¹⁶ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

¹⁷ *Kurt Hesse v OHIM*, Case C-50/15 P

¹⁸ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

¹⁹ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”²⁰

33. For the purposes of making a comparison, the services can be grouped together where the same reasoning applies.²¹

34. The services to be compared are set out below:

Earlier UK Mark	Contested Mark
<p><u>Class 35</u></p> <p>Advertising;</p> <p>Business management;</p> <p>Business administration;</p> <p>Office functions;</p> <p>Direct mail advertising;</p> <p>Arranging newspaper subscriptions (for others);</p> <p>Arranging subscriptions to telecommunication services for others;</p> <p>Presentation of goods on communication media, for retail purposes;</p> <p>Business management and organization consultancy;</p> <p>Accounting;</p> <p>Document reproduction;</p> <p>Employment agencies;</p>	<p><u>Class 35</u></p> <p>Provision of an on-line marketplace for buyers and sellers of goods and services;</p> <p>Preparing and placing of advertisements, for others, on the internet;</p> <p>Providing and rental of advertising space on the internet;</p> <p>Presentation of goods and services;</p> <p>Initiation and arranging of commercial and business contacts, Also via the Internet;</p> <p>Advertisement for others on the Internet;</p> <p>Recruitment information services;</p> <p>Compilation and bringing together of commercial information on electronic communications media, in particular via internet platforms, e-mail newsletters or mobile communications messages;</p>

²⁰ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

²¹ *Separode Trade Mark* BL O/399/10, paragraph 5

<p>Business management for freelance service providers;</p> <p>Computerised file management;</p> <p>Web site traffic optimisation;</p> <p>Exhibitions for commercial or advertising purposes;</p> <p>On-line advertising on a computer network;</p> <p>Rental of advertising time on communication media;</p> <p>Publication of publicity texts;</p> <p>Rental of advertising space;</p> <p>Dissemination of advertising matter;</p> <p>Consultancy regarding advertising communications strategy;</p> <p>Public relations services;</p> <p>Communication consultancy (public relations);</p> <p>Company auditing (business analysis);</p> <p>Business brokerage services.</p>	<p>Gathering and collating of product, address and classified directories and information contained therein;</p> <p>Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, for the arranging of contracts for the providing of services for others, via electronic market places on the internet;</p> <p>Providing information in the field of career development and information in the fields of employment, recruitment, job resources, and job listings via the internet;</p> <p>Providing of information about and in relation to goods and services;</p> <p>Compilation of data for providing and updating of a business and recruitment database;</p> <p>Presentation of goods and services for sales purposes (for others);</p> <p>Presentation of individuals and companies on the Internet and other media;</p> <p>Computerised data processing;</p> <p>Computerised file management;</p> <p>Pricing for goods and services;</p> <p>Comparison services (Price -);</p> <p>Providing of product, address and classified directories and information contained therein;</p> <p>Publication of information with editorial content, namely of commercial information, on electronic communications media, in particular via internet platforms, e-mail</p>
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	<p>newsletters or mobile communications messages;</p> <p>Arranging of contracts for information technology in the fields of business networks and for establishing and arranging of business contacts;</p> <p>Updating and maintenance of data in computer databases.</p>
<p><u>Class 38</u></p> <p>Telecommunications;</p> <p>Information about telecommunication;</p> <p>Communications by computer terminals;</p> <p>Communications by fiber optic networks;</p> <p>Radio communications;</p> <p>Communications by telephone;</p> <p>Communications by cellular phones;</p> <p>Providing user access to global computer networks;</p> <p>Provision of on-line forums;</p> <p>Providing access to databases;</p> <p>Electronic bulletin board services [telecommunications services];</p> <p>Providing telecommunications connections to a global computer network;</p> <p>News agencies;</p> <p>News agencies;</p> <p>Rental of telecommunication equipment;</p> <p>Radio broadcasting;</p>	<p><u>Class 38</u></p> <p>Online messaging services;</p> <p>Transmission of messages via computer networks, in particular via the Internet;</p> <p>Transmission of information with editorial content and commercial information, including advertisements and contract tenders, on electronic communications media, in particular via internet platforms, e-mail newsletters or mobile communications messages;</p> <p>Provision of portals on the Internet;</p> <p>Transmission of product, address and classified directories and information contained therein via the Internet;</p> <p>Telecommunications services provided via platforms and portals on the internet for exchange of contact information of all kinds;</p> <p>Internet based telecommunication services;</p> <p>Providing of telecommunication facilities that enable the creation and updating of personal web pages featuring user-provided content;</p>

<p>Television broadcasting;</p> <p>Teleconferencing services;</p> <p>Videoconferencing;</p> <p>Electronic messaging;</p> <p>Rental of access time to global computer networks.</p>	<p>Telecommunication services provided via Internet platforms and portals;</p> <p>Providing access to portals, platforms, electronic marketplaces, forums, on the internet;</p> <p>Providing access to information on the Internet;</p> <p>Providing access to databases;</p> <p>Providing online access to databanks, lists of goods, address directories and trade directories;</p> <p>E-mail services;</p> <p>Web messaging;</p> <p>Providing shared access to business information and professional information via an internet site.</p>
<p><u>Class 41</u></p> <p>Education;</p> <p>Providing of training;</p> <p>Entertainment;</p> <p>Sporting and cultural activities;</p> <p>Entertainment information;</p> <p>Education information;</p> <p>Vocational retraining;</p> <p>Recreation facilities (Providing -);</p> <p>Publication of books;</p> <p>Library services;</p> <p>Providing films, not downloadable, via video-on-demand transmission services;</p>	<p><u>Class 41</u></p> <p>Publication of information relating to editorial content on electronic communications media, in particular via internet platforms, e-mail newsletters or mobile communications messages;</p> <p>Electronic and online publishing services.</p>

Production of cinematographic films; Hire of televisions; Rental of show scenery; Photography; Organisation of competition (education or entertainment); Arranging and conducting of colloquiums; Arranging and conducting of conferences; Arranging and conducting of congresses; Arranging of exhibitions for cultural or educational purposes; Booking of seats for shows; Game services provided on-line from a computer network; Gambling; Publication of electronic books and journals on-line.	
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Class 35

35. The Applicant’s submissions accept that most of its Class 35 services are “*identical or similar*” to the Opponent’s Class 35 services, save for certain terms (that I have detailed in my paragraph 38 below).
36. For ease of reference, I have included the Applicant’s submissions in relation to identity and similarity at **Annex 3** to this decision. I note that there is a transcription error contained in these submissions in relation to one of the Opponent’s Class 35 services, namely, that the Applicant has included the Opponent’s Class 35 term as being “*presentation of goods and services for sales*”

purposes (for others)” whereas it is “presentation of goods on communication media, for retail purposes.”²²

37. There is some contradiction with regard to the Applicant’s submissions in relation to the following applied-for term:

“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, for the arranging of contracts for the providing of services for others, via electronic market places on the internet.”

The contradiction is that:

- (1) in relation to the comparison with the Class 35 services for which the Earlier IR Mark is registered,²³ the Applicant submits that (my emphasis):

- (a) the following term:

“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, ~~for the arranging of contracts for the providing of services for others~~, via electronic market places on the internet.”

is “*identical or similar*” to the Opponent’s:

“presentation of goods on all communication media, for retail purposes”

- (b) whereas the following term is “*dissimilar*” to any of the Opponent’s services:

“Arranging of commercial transactions for others, for arranging of contracts for others, in particular ~~for the buying and selling of goods~~

²² The correct term is used in the Applicant’s submissions in relation to the Earlier IR Mark.

²³ See paragraph 9 of the Applicant’s submissions dated 5 December 2022.

~~for others, for the arranging of contracts for the providing of services for others, via electronic market places on the internet.~~

(2) Conversely, in relation to comparison to the Class 35 services for which the Earlier UK Mark is registered,²⁴ it submits that (my emphasis):

(a) the following term:

“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, ~~for the arranging of contracts for the providing of services for others~~, via electronic market places on the internet.”

is “*identical or similar*” to the Opponent’s:

“presentation of goods on communication media, for retail purposes”²⁵

(b) and that the entire applied-for term is simultaneously “*dissimilar*” to any of the Opponent’s services:

“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, for the arranging of contracts for the providing of services for others, via electronic market places on the internet.”

Despite the contradiction in the Applicant’s submissions, I shall provide my own assessment of similarity or dissimilarity as the case may be, in relation to this applied-for term (see my paragraph 38(2) below). Therefore, with the exception of the Applicant’s submissions in relation to this term, in essence, I agree with the Applicant’s assessment on identity and similarity of the respective Class 35 services. Indeed, it is my opinion that they are all **identical** on the principle set out in *Meric*. In the **alternative** they are **highly similar**.

²⁴ See paragraph 10 of the Applicant’s submissions dated 5 December 2022.

²⁵ See my paragraph 36 in relation to this term.

38. I now turn to the Applicant's Class 35 services which it submits are dissimilar to the 'Opponent's Class 35 services'. I disagree with the Applicant's assessment for the reasons set out in this paragraph. In reaching this conclusion, I have carried out a comparison between the Applicant's Class 35 services and the Opponent's services (in Classes 35, 38 and 41),²⁶ as follows:

(1) Compilation and provision of commercial information

(a) The following services in the Applicant's specification, namely:

- *"Compilation and bringing together of commercial information on electronic communications media, in particular via internet platforms, e-mail newsletters or mobile communications messages"*
- *"Gathering and collating of product, address and classified directories and information contained therein"*
- *"Providing of product, address and classified directories and information contained therein"*
- *"Presentation of individuals and companies on the Internet and other media"*

are services related to the compiling of information and the dissemination and/or presentation of that information, presumably (when interpreted in the context of Class 35 services),²⁷ for business or advertising purposes.

(b) The information could be gathered for business management and administrative purposes for example, compiling product information to produce a catalogue or produce an online directory to then present or

²⁶ Bearing in mind the provision of section 60A of the Act.

²⁷ Class 35, being inter alia, 'advertising', 'business management' and 'business administration' services which include mainly services rendered by persons or organisations principally with the object of helping in the management of the business affairs or commercial functions of an industrial or commercial enterprise for example, as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

‘advertise’ the products to consumers for retail purposes. Or it could be related to recruitment as another example.²⁸

- (c) The compilation and the bringing together of information would result in the creation of a database that can then be made accessible (for instance, via internet platforms such as on-line forums and electronic bulletin boards).
- (d) A directory (being a collection of information, organised alphabetically, thematically or by category e.g. a telephone directory) can be regarded as a database. This is because databases can be collections of files and structured sets of organised information, often held in a computer and often created with a view to managing that information by storing, retrieving and manipulating the data contained therein. Databases can store information such as files containing customer data, contact information (of individuals and companies), product information, sales transactions as well as other types of commercial information.
- (e) Also, the compilation of commercial information is intrinsic to the services of business management and business administration, for example, the gathering of commercial information in order to carry out analytical tasks such as business forecasting.
- (f) With all the foregoing in mind, the Applicant’s services are similar to the following services in the Opponent’s specification:

Class 35

“business management; business administration; presentation of goods on communication media, for retail purposes; business management and organization consultancy; business

²⁸ Bearing in mind that the Applicant has also applied for the services of *“Providing information in the field of career development and information in the fields of employment, recruitment, job resources, and job listings via the internet; Compilation of data for providing and updating of a business and recruitment database; Recruitment information services”*.

management for freelance service providers; computerised file management”

Class 38

“Provision of on-line forums; Providing access to databases; Electronic bulletin board services [telecommunications services]”

this is because they would overlap in their nature, method of use and their intended purpose.

- (g) They would also overlap in user since for example, the user of *‘business management services for freelance service providers’* is likely to include the same user of the services for the *‘compilation and bringing together of commercial information’*.
- (h) The respective services will also be available through the same trade channels, for example, the undertaking responsible for gathering and collating the information (into a database), is likely to also be the undertaking that provides ‘users’ on-line access to those databases of information.
- (i) The respective services are also complementary to each other. For example, the Opponent’s ‘computerised file management’ services are complementary to the Applicant’s services of gathering and collating information.
- (j) I therefore find **at least a medium degree of similarity** between parties’ the respective services.

(2) ‘Intermediary services’

(a) I interpret the following services in the Applicant’s specification, namely:

- *“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of*

goods for others, for the arranging of contracts for the providing of services for others, via electronic market places on the internet.”²⁹

- *“Arranging of contracts for information technology in the fields of business networks and for establishing and arranging of business contacts.”*

as business services provided by an intermediary (such as a ‘broker’), for the purpose of connecting a seller and a buyer of goods, or a service provider and a service user, to facilitate a transaction between them for the provision of goods or the rendering of services as the case may be.

- (b) With this in mind, I consider the Applicant’s services similar to the following services in the Opponent’s Class 35 specification:

“Business management; Business management for freelance service providers; Business brokerage services”

- (c) This is because they would overlap in nature and intended purpose, they would also overlap in their method of use and user, particularly when taking into account that ‘business management’ encompasses managing the coordination and organisation of business activities (which would include arranging contracts), and that ‘business brokerage’ could encompass the brokerage of commercial transactions for others.
- (d) They are also likely to reach the market through the same trade channels as the same undertaking would provide both and they would be complementary to each other. I therefore find **at least a medium degree of similarity** between parties’ respective services.

²⁹ I have listed this term as applied for, given the disparity in submissions in relation to this term, as set out in my paragraph 37.

(e) In **addition**, I consider the Applicant's following service of:

“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, via electronic market places on the internet”³⁰

to be **similar** to the Opponent's:

“presentation of goods on communication media, for retail purposes.”³¹

(3) 'Publication of information'

(a) The following services in the Applicant's Class 35 specification, namely:

- *“Publication of information with editorial content, namely of commercial information, on electronic communications media, in particular via internet platforms, e-mail newsletters or mobile communications messages”*

are services for the publication of information.

(b) 'An editorial' is an article which expresses an opinion on a topic which can be intended to inform, educate and even entertain. An editorial article or 'editorial content' can be used by a business as a form of marketing by way of sharing expert knowledge (through the means of an article) that a business has in a particular subject, whilst at the same time showcasing that this knowledge comes from that particular business, organically promoting its expertise.

³⁰ The whole term applied for being: *“Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, for the arranging of contracts for the providing of services for others, via electronic market places on the internet.”*

³¹ This is in line with the Applicant's submissions (dated 5 December 2022), contained in paragraph 9 of the submissions in relation to the Earlier IR Mark (referenced in my paragraph 37(1)), which I agree with.

- (c) Within the context of Class 35 services, the publication of such ‘editorial content’ can be interpreted as a form of advertising/publicity service. It can also be interpreted as a form of publishing service.³²
- (d) With the above in mind, I consider the Applicant’s services in Class 35 to be **identical**, on the principle outlined in *Meric*, to the following services contained in the Opponent’s specification:

Class 35

“Publication of publicity texts”

Class 41

“electronic publication of journals online”.

- (e) In the **alternative**, they are **highly similar**, this is because they will overlap in purpose and nature as both are publication services. There would also be overlap in method of use and user and they may overlap in trade channels as the same undertakings would likely provide both. There may be a degree of competition between them as a consumer may select one over the other.

(4) ‘Pricing’

- (a) The Applicant’s specification contains the following services:

- *“Pricing for goods and services”*
- *“Comparison services (Price -)”*

These services fall under the broad category of *“business management”* in the Opponent’s Class 35 specification. This is because I interpret these services as being the kind of services that

³² I note that the Applicant’s Class 35 term is identical, if not highly similar to the following applied-for service in Class 41: *“Publication of information relating to editorial content on electronic communications media, in particular via internet platforms, e-mail newsletters or mobile communications messages”*. The Applicant has submitted its Class 41 term is *“identical or similar”* to the Opponent’s Class 41 ‘publishing’ services which in essence I agree with – see my paragraphs 39 and 40.

have the object of helping in the management of the business affairs or commercial functions of an industrial or commercial enterprise.

- (b) For instance, the services of 'business management' could encompass the management of 'price strategy' for a business which would entail comparing prices with competitors in order to then establish and set the best price for a product or service (which ultimately feeds into the management of the 'commercial function' of a business).
- (c) As such, the respective services are likely to overlap in nature and purpose as well as method of use. They are also likely to overlap in user and are likely to overlap in trade channels as the same undertaking is likely to provide both. They would also be complementary to each other. I therefore consider the respective services to be **similar to at least a medium degree**.

39. The Applicant's submissions accept that the respective Class 38 services are "*identical or similar*"; and likewise that the parties' Class 41 services are "*identical or similar [...] and in particular [the Opponent's services of] 'education information' and 'publication of electronic books and journals on-line'*".

40. Having compared the parties' respective Class 38 and 41 services, I essentially agree with the Applicant's assessment. Indeed, it is my opinion that they are all **identical** to each other either because the terms are identical, or because they are identical on the principle set out in *Meric*. In the **alternative** they are **highly similar**.

Conclusion on the comparison of services

41. I have found instances of identity and similarity (to varying degrees) between the respective services. I have not found any instances of dissimilarity.

The average consumer and the nature of the purchasing act

42. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical.³³ It is therefore necessary to determine who the average consumer of the respective services is, and how the consumer is likely to select those services.
43. The average consumer for the services clearly encompasses businesses (including small traders), but some of the services are also for the general public such as ‘telecommunication’ services and ‘online messaging’ services for personal use; those are not services exclusive to businesses.
44. Bearing in mind the nature of some of the services, they would be made available on the internet via the service provider’s website or mobile app for example, whereas others may also be additionally available at the service provider’s place of business.
45. The respective services will reach the market through varying trade channels (depending on the category of services). Whichever way the services are offered to the relevant average consumer, in each instance, the selection process will be predominantly visual. For example, the average consumer will select the services having viewed an image of the trade marks on promotional materials, brochures, through marketing campaigns etc. (including their online equivalents). That said, I do not discount that aural consideration may play a part by way of word-of-mouth recommendations.
46. The average consumer in this case (whether a member of the general public, a professional, or a business, organisation/undertaking) is, likely to pay at least a medium level of attention when selecting the services at issue. Where the

³³ *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), paragraph 60; also see *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98, as to what “average” means

services are of a specialised nature, then the level of attention paid by the relevant average consumer is only likely to increase.

Comparison of marks

47. It is clear from established case law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.³⁴ The assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole, by reference to the overall impressions created by the marks in the mind of the average consumer, bearing in mind the distinctive and dominant components of the marks.³⁵ Then, in light of the overall impression, and all factors relevant to the circumstances of the case, it is necessary to assess the likelihood of confusion.³⁶
48. The assessment of the similarity between two marks means more than taking into consideration only one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks at issue as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components.³⁷
49. There are situations in which the average consumer, while perceiving a composite mark as a whole, will perceive that it consists of several signs, one (or more) of which has a distinctive character which is independent of the significance of the whole.³⁸ However, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of

³⁴ *Sabel BV v. Puma AG*, Case C-251/95, paragraph 23

³⁵ *Ibid.*

³⁶ *Bimbo SA v OHIM*, Case C-591/12P, paragraph 34

³⁷ *Matratzen Concord AG v OHIM*, Case T-6/01, paragraph 34

³⁸ Although this principle does not apply where the meaning of one of the component parts is qualified by another component.

confusion. It remains necessary to carry out a global assessment taking into account all relevant factors.³⁹

50. It would be wrong 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. It is only where all the other components of a composite mark are negligible that the assessment of the similarity may be carried out solely on the basis of the dominant element. This could be the case, in particular, where that component is capable alone of dominating the image of that mark which members of the relevant public keep in their mind, such that all the other components of the mark are negligible in the overall impression which it creates.

Applicant's submissions

51. Before I proceed with my comparison of the marks I note the Applicant's submissions in relation to the word 'freelance' being descriptive of both parties' services. Essentially the Applicant is inviting me to conclude that the word 'freelance' should be disregarded in my comparison and that it is the device in its mark that is the element on which the average consumer will rely to determine trade origin, and as a consequence of it differing from the device in the Earlier UK Mark, there is no confusion between the respective marks.
52. The Applicant has submitted that (my emphasis):⁴⁰

"14. [...] the device elements are not insubstantial parts of the respective trade marks. The font size of the word FREELANCE in both marks is smaller than the height of the respective devices and, moreover, the word is shown in lower

³⁹ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271, paragraphs 19 to 21. In *Whyte and Mackay* Arnold J. (as he then was) considered the impact of the judgment in *Bimbo*, on the Court's earlier judgment in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04) in relation to composite marks where a composite mark contains an element which is similar to an earlier mark.

⁴⁰ See the Applicant's submissions dated 5 December 2022.

case characters. The latter could be seen as an indication that the word is intended to be the descriptive element.

[...]

18. Whilst the word FREELANCE in the respective trade marks could be seen as an independent component of the marks, the word alone has no distinctive character in relation to the respective services. It will make little or no contribution to the overall distinctive impression in the eyes of the average consumer.

19. [...] Those additional [figurative] components [in the respective marks] are not insignificant and do serve to distinguish the marks from one another.

[...]

22. The word FREELANCE is directly descriptive of the services of the applicant and the opponent [...].

[...]

24. [...] According to the Cambridge Dictionary, the word “freelance” means “doing particular pieces of work for different organizations, rather than working all the time for a single organization” [...].

25. As a result, it is submitted that the word FREELANCE is wholly descriptive in relation to the services of the opponent’s prior rights and no weight should be given to that element in the comparison of the respective trade marks.

26. The distinctiveness in the opponent’s trade mark rests solely in the device element which is wholly different to the device in the applicant’s trade mark.

27. The opponent has chosen not to file any evidence of the use of their trade mark and so cannot claim that the trade mark has an enhanced distinctive character or that they have acquired any rights in the word FREELANCE in relation to their services. The default position remains, therefore, that

FREELANCE is a descriptive word in the context of the services in question and should remain free for others to use.

[...]

36. *Bearing in mind the services of the applicant and the opponent, the average customer is likely to understand the meaning of the word FREELANCE as a description of the respective parties' services or the purpose of those services to the freelance employment sector. On seeing either the opponent's or the applicant's mark, they would view that element of the mark merely as an indication of the nature/purpose of the services and would use other factors, namely the device elements to determine the origin of the services. See for example, the reasoning in INVESTED.TOGETHER v. LA FRANÇAISE INVESTING TOGETHER and device (O/719/18).*

53. I note that the 'La Francaise'⁴¹ case referenced by the Applicant involved the comparison (in opposition proceedings) between the applied-for word only mark 'INVESTED. TOGETHER' and the following earlier mark:



In that case, the services involved were characterised as financial services. The case did not involve the disregard of any word elements in favour of a comparison based on the device elements alone. The applied-for mark was a word-only mark and the words making up the mark were considered at worst, allusive of the services and not descriptive of them.

⁴¹ *Groupe La Francaise v Russell Investments Group, LLC*, BL O/719/18 – a first instance decision in opposition proceedings before this Tribunal.

54. The Applicant has also referenced another first instance opposition decision of this Tribunal in which the common element between two marks was deemed to have a low distinctive character.⁴²
55. I note that each of the considerations with regard to the similarity of the marks in the above cases is unique to the facts in those specific cases and that I am not bound by those previous decisions.
56. Whilst I do not overlook that (as stated in *Whyte and Mackay*⁴³) “if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion”, it is well to recall the specific facts of that case and the marks compared in that case that led the judge to make that statement.
57. In *Whyte and Mackay*, the mark ORIGIN was being relied on in opposition to the trade mark JURA ORIGIN for alcoholic drinks. The Judge held that there was no likelihood of confusion, essentially because when used after the name of the island Jura, the name Origin became entirely descriptive and would simply be taken as indicating that the product in question came from the island, rather than having any independent trade mark significance.⁴⁴
58. What is clear from established case law is that, although the distinctive character of the earlier mark must be taken into account in assessing the likelihood of confusion – because it affects the greater or lesser capacity of the mark to act as an indicator of trade origin (which includes taking into account, inter alia, whether the mark does or does not contain an element descriptive of the goods or services for which it has been registered)⁴⁵ – it is only one of the considerations involved in the global assessment of the likelihood of confusion and it cannot be the only assessment the Tribunal must carry out.

⁴² *Acrisure, LLC v N4 Partners LLP*, BL O/340/22

⁴³ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*, paragraph 44

⁴⁴ This summary was provided by the Appointed Person in *Dominique Tillen v Design Go Limited and DG Capital Limited*, BL O/331/19, paragraph 16

⁴⁵ See *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraphs 22 – 23.

59. It should be noted that the characterisation of a sign being descriptive or generic is equivalent to denying its distinctive character, which is an absolute ground for refusal. Whilst in these current opposition proceedings I am required to assess the distinctive character of the earlier mark, this consideration has limits, and it cannot culminate in a finding that the earlier sign lacks distinctive character and is therefore invalid. Thus, a registered trade mark must be assumed to have at least some distinctive character.⁴⁶ (That said, I recognise that the Applicant's submission is in relation only to the word component of the applied-for mark; there is no submission that the applied-for mark as a whole is without distinctive character.)
60. I note that even where an earlier trade mark is deemed to have a weak distinctive character, that does not preclude a finding of a likelihood of confusion per se. Indeed, in *L'Oréal SA v OHIM*,⁴⁷ the CJEU stated (my emphasis):

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.”

[...]

“45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of

⁴⁶ See *Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 - 44. Also see *Sona Nutrition Ltd v EUIPO*, Case T-152/18 – wherein the General Court (following the principle in *Formula One*) held that assessing distinctive character could not culminate in the finding that an element that is identical to an earlier registered mark is devoid of distinctive character when it is included in a later composite mark. In *Sona Nutrition*, the General Court, referencing its earlier decision in '*TPG POST*' (Case T-102/14) also stated that even though in '*TPG POST*' the court had accepted that a term which was part of a composite mark could be perceived differently when it is used on its own or in a different context, it did not, however state that the term, which was identical to the earlier mark, was devoid of any distinctive character.

⁴⁷ Case C-235/05 P

similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

Definition of the word ‘freelance’

61. The Applicant has provided me with the definition of the word ‘freelance’ taken from the Cambridge Dictionary. According to this dictionary, it means “*doing particular pieces of work for different organizations, rather than working all the time for a single organization.*” That is indeed my understanding of the word.
62. I have also consulted the definitions contained in the Oxford English Dictionary and the Collins English Dictionary (British English entries).
 - (1) The Oxford English Dictionary defines the word:
 - (a) ‘freelance’ as:
 - A person who works as a freelancer.
 - Of a person: working as a freelancer. Also: characteristic of a freelance; individualistic, independent.
 - To act as a freelance; to do freelance work; to earn one’s living as a freelance.
 - (b) ‘freelancer’ as:
 - A person who makes himself or herself available to be engaged for work on particular assignments or projects, rather than being engaged on a long-term or permanent basis by a single employer.

(2) The Collins English Dictionary defines the word:

(a) 'freelance' as:

- *Also called:* freelancer. A self-employed person, esp a writer or artist, who is not employed continuously but hired to do specific assignments.
- a person, esp a politician, who supports several causes or parties without total commitment to any one.
- to work as a freelance on (an assignment, etc)

(b) 'freelancer' as:

- A freelancer is someone who does freelance work.

63. The word 'freelance' clearly relates to an employment status of a person i.e. that they are self-employed and render their services on an ad hoc basis, presumably on a fee or commission basis and to a number of clients. As such, the word 'freelance', contrary to the Applicant's submissions, does not describe the services for which the earlier marks are registered and it does not describe the services applied-for. 'Freelance', in relation to the services at hand is odd and is not the apt term to describe them. At most, the term could be deemed to be allusive – that the service provider is a 'freelance' worker (even then it would be an odd way to refer to the services), or it could allude to who the intended consumer of the services is (again, this would be an odd way of referring to a service i.e. by the term for the intended consumer of that service).
64. I note that the Opponent's marks are registered for the service of "*business management for freelance service providers*", even so, I do not think that 'freelance' exclusively describes this service, since 'freelance' is a status of employment of an individual, it does not describe a '*business management*' service, at most it alludes that the service is tailored for 'freelance service providers'.
65. The services registered and applied for are broad and far reaching and are not limited to any specific market sector (save for the Opponent's service detailed in my paragraph 64 above), and for that matter, 'freelance' is a term that is also not

limited to any particular market sector since a freelance worker could work in any number of professions.

66. It is necessary for me to consider all the circumstances in which the registered marks and the mark applied for might be used, since this may vary in time. My comparison shall not be made between the devices only (as the Applicant submits should be the case). I shall compare the marks in the ordinary way as I am required to do. I will not disregard the word 'freelance' since it is an integral part of the marks that is not negligible.
67. However, my finding that the word 'freelance' does not describe the services is not a finding that the word is therefore highly distinctive for those services. I shall address the distinctiveness of the word when I address the distinctiveness of the Earlier UK Mark. In any event, the distinctive character of an earlier mark is not a factor which influences the perception which the consumer has of the similarity of the signs.⁴⁸
68. The trade marks being compared are shown below:

Earlier UK Mark	Contested Mark
	

Overall Impression

69. Earlier UK Mark

- (1) The Earlier UK Mark is a figurative mark which consists of the word 'freelance' written in black, lowercase letters. Due to its sizing and placement, the word has a dominant position in the mark since it forms the widest part of the mark and it draws the eye's attention. It certainly is not a

⁴⁸ Ibid., paragraph 42

negligible part of the mark neither is it subservient to the device element – the average consumer would not overlook its presence.

- (2) The Applicant has submitted that the lowercase lettering “*could be seen as an indication that the word is intended to be the descriptive element*”. I reject this argument – the lowercase lettering is clearly a stylistic choice. Notwithstanding my conclusion that the word ‘freelance’ does not describe the services at hand, I note that, whether a word is in lowercase or uppercase letters, or a combination of both, it would not affect the perception of whether it is descriptive or not. If a word is descriptive then lowercase or uppercase lettering would not affect that. For example, the word ‘soap’ used on soap products is descriptive irrespective of whether it is written as: soap; SOAP; or Soap.
- (3) To the left of the word ‘freelance’ is a blue stylised device, which is taller in height than the word ‘freelance’. The Applicant refers to the device as a letter ‘F’. Some may perceive it as a letter ‘F’, however, the stylisation of the device is such that they may not perceive it as a letter at all, and perhaps just as a decorative swirl device, either way it is somewhat banal.
- (4) Although the device is taller in height than the word ‘freelance’, the size and prominence of the word ‘freelance’ contributes greatly to the overall impression of the mark and it is the word that penetrates the concept of the mark, such that the device performs a more decorative role within the mark. The presence of that device does not alter nor qualify the meaning of the word ‘freelance’.
- (5) As this is a figurative mark (that has not been applied for in black and white), the blue and black colour combination plays a role in the overall impression created by the mark, which not only forms part of the protection conferred on the earlier mark, but is also relevant to the global assessment of the likelihood of confusion.⁴⁹

⁴⁹ See *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12, paragraph 3.

- (6) In the case of a mark consisting of both a word and figurative element, generally speaking, the mind of the average consumer ‘latches on’ to the word elements of such marks, and it is the word elements that the average consumer will use to identify the mark.
- (7) In that regard, it should be noted that, *“according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements”*.⁵⁰
- (8) Whilst I consider the average consumer would latch onto the word ‘freelance’ to identify the mark, I do not discount that the presentation of the mark also contributes to its overall impression i.e. the black, lowercase, plain font used for the word ‘freelance’; the stylised blue device to the left of that word; and the size and placement of that word relative to the device element.

70. Contested Mark

- (1) The Contested Mark is a figurative mark which consists of the word ‘freelance’ written in black, lowercase letters. Due to its sizing and placement, the word has a dominant position in the mark since it forms the widest part of the mark and it draws the eye’s attention. It certainly is not a negligible part of the mark neither is it subservient to the device element – the average consumer would not overlook its presence.
- (2) To the left of the word ‘freelance’ is a blue star device, which, though stylised, remains somewhat banal. Although the device is taller in height than the word ‘freelance’, the size and prominence of the word ‘freelance’ contributes greatly to the overall impression of the mark and it is the word that penetrates the concept of the mark, such that the device performs a

⁵⁰ *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

more decorative role within the mark. The presence of that device does not alter nor qualify the meaning of the word 'freelance'.

- (3) As this is a figurative mark (that has not been applied for in black and white), the blue and black colour combination plays a role in the overall impression created by the mark, which not only forms part of the protection conferred on the earlier mark, but is also relevant to the global assessment of the likelihood of confusion.
- (4) As with the Earlier UK Mark, whilst I consider the average consumer would latch onto the word 'freelance' to identify the Contested Mark, I do not discount that the presentation of the mark also contributes to its overall impression i.e. the black, lowercase, plain font used for the word 'freelance'; the stylised blue star device to the left of that word; and the size and placement of that word relative to the device element.

Visual comparison

71. The competing marks share the same word 'freelance', which visually dominates the marks overall. The word is presented in a highly similar, lowercase typeface in both marks. The font is more emboldened in the Contested Mark but it is an element that would likely be overlooked by the average consumer.⁵¹
72. Both marks contain somewhat banal blue devices to the left of the word 'freelance'. The placement of the word 'freelance' is the same in both marks and overall, the dimensions of the marks are visually highly similar given the height and size of the devices relative to the height and size of the word 'freelance'.
73. Whilst the devices are different to each other in their design, and therefore they represent a point of visual difference between the two marks, they are nonetheless roughly the same dimensions being very similar in size, width and height relative to the word 'freelance', and they both have the same placement in the marks i.e. they both appear left of the word and they are both blue.

⁵¹ Especially when taking into account the principle of imperfect recollection i.e. that the consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon their imperfect recollection. See *Lloyd Schuhfabrik Meyer*, paragraph 27

74. Whilst the devices are in different shades of blue, this is something that is likely to be overlooked by the average consumer (especially when factoring in the principle of imperfect recollection). Indeed, what is more likely to be recalled in the mind of the average consumer is that the devices are blue, rather than the specific shade of blue – therefore the fact that the shades of blue differ is not a notable point of visual dissimilarity.
75. It is the specific colour combination of black and blue that is a point of visual similarity more worthy of note.
76. Considering the above factors and the overall impressions, I find that the respective marks are visually similar to a medium degree.

Aural comparison

77. Aurally, the marks are identical insofar as they both contain the word ‘freelance’. Even in the event that the average consumer perceives the device in the Earlier UK Mark as the letter ‘F’, I do not consider that they will articulate it, therefore my assessment remains that the marks are aurally identical.

Conceptual comparison

78. The marks are conceptually identical in relation to the word ‘freelance’. The devices have a different concept insofar as the device in the Contested Mark has a clear concept, being a star and the device in the Earlier UK Mark has no definitive clear concept, and therefore its concept is neutral. In the event that it is perceived as the letter ‘F’ then its concept would differ from that of a star. However, the overriding concept of the two marks lies in the word ‘freelance’ therefore, overall, the marks are at least highly similar (taking into account the conceptual differences between the devices).

Distinctive character of the earlier trade mark

79. In *Kurt Geiger v A-List Corporate Limited*,⁵² as the Appointed Person pointed out, the level of ‘distinctive character’ is only likely to increase the likelihood of

⁵² BL O-075-13

confusion to the extent that it resides in the element(s) of the marks that are identical or similar. 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.

80. The Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier UK Mark, therefore I only have the inherent distinctiveness of the mark to consider.
81. The word 'freelance' dominates the visual, aural and conceptual identity of the mark and whilst there are other factors making up the mark, it is the word 'freelance' that penetrates its overall impression and it is that word, that the average consumer would use to refer to the mark.
82. 'Freelance' is an ordinary, English word. Whilst I acknowledge that the word 'freelance' could be perceived differently when it is used in its ordinary context (to refer to a person's state of employment, rather than a term used for a specific profession), contrary to the claims made by the Applicant, the word 'freelance' does not describe the Opponent's services. I recognise that it has the potential to be allusive and accordingly, the inherent distinctiveness of the word element of the mark would be on the lower side as a result of this allusive nature.
83. That said, the whole is greater than the sum of its parts – the distinctive character of the mark is elevated because of the way it is presented as a figurative mark. The font used is quite plain, although there is some stylisation to it; and the device, whilst it is quite banal, does have some prominence within the mark. All these in combination render the mark distinctive to a medium degree overall.

Conclusions on Likelihood of Confusion

84. 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.⁵³ I must also keep in mind the average consumer of the services, 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 services and vice versa.⁵⁴

85. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.⁵⁵ The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.⁵⁶
86. I have found that the services applied for are mostly identical to the Opponent's and that where they are similar, they are for the most part highly similar. I have determined that the selection of the services will be predominantly visual and that the average consumer will be paying at least a medium degree of attention when selecting those services.
87. The marks are visually similar to a medium degree and they are aurally identical and arguably conceptually identical.
88. The overall impression of the respective marks is dominated by the word 'freelance', which I have found, in respect of the Opponent's mark, has a relatively low distinctive character on an inherent basis due to its potentially allusive nature. However, the question of the likelihood of confusion must be assessed globally and notwithstanding the word 'freelance' may be perceived as having a lower degree of distinctive character, when comparing the marks as a

⁵³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

⁵⁴ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

⁵⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

⁵⁶ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

whole, it is the overall impressions that are relevant and that the marks look similar, they sound the same and they are conceptually identical or very similar.

89. The likelihood of confusion is not just to be assessed by comparing 'freelance' with the word 'freelance', it involves comparing the marks overall and then deciding whether the average consumer of predominantly identical and highly similar services, is likely to be confused as to their origin, even when paying at least a medium degree of attention when selecting those services. In my opinion, the answer to this is that they would be confused.
90. The visual differences are not enough to outweigh the overall impression of the mark that the average consumer is likely to keep in mind i.e. the average consumer is more likely to recall that the marks are both 'freelance' marks, and, having seen an image of the one, is likely to retain that overall impression in mind when viewing the other and, given their similarity in appearance (and that the Earlier UK Mark is distinctive overall to a medium degree) is likely to confuse them by mistaking one for the other.
91. Given the banal nature of the devices in both marks, the average consumer, even paying a medium degree of attention, is not likely to consider that the devices, when used in blue, with the word 'freelance', on predominantly identical services, denotes services from different undertakings. On the contrary, those devices have no distinctive conceptual hook that is relevant in the overall impression of the marks. It is likely that the average consumer may misremember the device, because the overall impression of the marks that they have retained in their mind would be dominated by the word 'freelance' (which they are likely to easily retain, given that it is an ordinary word). Moreover, they are likely to imperfectly recollect the devices.
92. Even in the event that they notice the difference between the devices, they may attribute those differences to a brand evolution or brand revamp and would therefore nonetheless be confused as to the trade origin of the services, believing them to come from the same undertaking. This is particularly likely when

considering the two marks essentially use the same 'corporate colours' of black and blue such that the average consumer may assume that the device has merely been updated rather than it denotes services from two unrelated undertakings. Indeed, one only needs to look at the evidence presented by the



Applicant (with particular reference to the device i.e. its use of this as



opposed to this) to see that updating and evolving a brand is a customary practice of brand owners.

OUTCOME

93. The opposition succeeds under section 5(2)(b) of the Act.

Final Remarks

94. As the Earlier UK Mark leads to the opposition being successful in its entirety, there is no need to consider the other mark i.e. the Earlier IR Mark upon which the opposition is based.

COSTS

95. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
TOTAL	£300

96. I therefore order ISAC GmbH to pay the sum of £300 to FREELANCE.COM. This 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 27th day of February 2023

Daniela Ferrari

For the Registrar

Annex 1

Services for the Earlier IR Mark

Class 35	Advertising; commercial business management; commercial administration; office functions; dissemination of advertising material (leaflets, prospectuses, printed matter, samples); newspaper subscription services (for third parties); arranging subscriptions to telecommunication services for others; presentation of goods on all communication media, for retail purposes; business management and organization consultancy; accounting; document reproduction; employment agency services; business management for freelance service providers; computerized file management service; website traffic optimization; organization of exhibitions for commercial or advertising purposes; online advertising on a computer network; rental of advertising time on all means for communication; publication of advertising texts; rental of advertising space; dissemination of advertisements; advice regarding communication (advertising); public relations; advice regarding communication (public relations); company audits (commercial analyses); commercial intermediation services.
Class 38	Telecommunications; information relating to telecommunications; communications by computer terminals; communications by fiber-optic networks; radio communications; telephone communications; cellular telephone communication; provision of user access to global computer networks; provision of online forums; provision of access to databases; electronic bulletin board services (telecommunication services); connection by telecommunications to a global computer network; news agencies; news (information) agencies; rental of telecommunication apparatus; transmission (or broadcasting) of radio and television programs; teleconferencing services; videoconferencing services; electronic messaging services; rental of access time to global computer networks.

Class 41	Education; training; entertainment; sporting and cultural activities; information regarding entertainment; information regarding education; vocational retraining; provision of recreational facilities; publication of books; book lending; provision of non-downloadable films via video-on-demand services; motion picture production; rental of television sets; rental of show scenery; photography services; organization of competitions (education or entertainment); organization and conducting of colloquiums; organization and conducting of conferences; organization and conducting of congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; game services provided online from a computer network; gambling services; electronic publication of books and journals online.
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Annex 2

Services for the Earlier UK Mark

Class 35	Advertising; Business management; Business administration; Office functions; Direct mail advertising; Arranging newspaper subscriptions (for others); Arranging subscriptions to telecommunication services for others; Presentation of goods on communication media, for retail purposes; Business management and organization consultancy; Accounting; Document reproduction; Employment agencies; Business management for freelance service providers; Computerised file management; Web site traffic optimisation; Exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of publicity texts; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Communication consultancy (public relations); Company auditing (business analysis); Business brokerage services.
Class 38	Telecommunications; Information about telecommunication; Communications by computer terminals; Communications by fiber optic networks; Radio communications; Communications by telephone; Communications by cellular phones; Providing user access to global computer networks; Provision of on-line forums; Providing access to databases; Electronic bulletin board services [telecommunications services]; Providing telecommunications connections to a global computer network; News agencies; News agencies; Rental of telecommunication equipment; Radio broadcasting; Television broadcasting; Teleconferencing services; Videoconferencing; Electronic messaging; Rental of access time to global computer networks.
Class 41	Education; Providing of training; Entertainment; Sporting and cultural activities; Entertainment information; Education information;

	<p>Vocational retraining; Recreation facilities (Providing -); Publication of books; Library services; Providing films, not downloadable, via video-on-demand transmission services; Production of cinematographic films; Hire of televisions; Rental of show scenery; Photography; Organisation of competition (education or entertainment); Arranging and conducting of colloquiums; Arranging and conducting of conferences; Arranging and conducting of congresses; Arranging of exhibitions for cultural or educational purposes; Booking of seats for shows; Game services provided on-line from a computer network; Gambling; Publication of electronic books and journals on-line.</p>
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Annex 3

Applicant's Submissions, dated 5 December 2022, paragraph 10

10. The opposition based on UK Registration No. 3608750 F freelance and device is limited to the class 35, 38 and 41 services of that earlier registration. Comparing the respective services in those classes, we would submit the following:

UK Registration No. 3608750 F freelance and device	No. 3654430 FREELANCE and device
<p>Class 35 Advertising; Business management; Business administration; Office functions; Direct mail advertising; Arranging newspaper subscriptions (for others); Arranging subscriptions to telecommunication services for others; Presentation of goods on communication media, for retail purposes; Business management and organization consultancy; Accounting; Document reproduction; Employment agencies; Business management for freelance service providers; Computerised file management; Web site traffic optimisation; Exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of publicity texts; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Communication consultancy (public relations); Company auditing (business analysis); Business brokerage services.</p>	<p>Class 35 It is accepted that <i>"Provision of an on-line marketplace for buyers and sellers of goods and services;"</i>, <i>"Presentation of goods and services;"</i> and <i>Arranging of commercial transactions for others, for arranging of contracts for others, in particular for the buying and selling of goods for others, , via electronic market places on the internet;"</i>, <i>"Providing of information about and in relation to goods and services;"</i> and <i>"Presentation of goods and services for sales purposes (for others);"</i> are identical or similar to <i>"Presentation of goods and services for sales purposes (for others);"</i> in the opponent's registration.</p> <p>It is accepted that <i>"Preparing and placing of advertisements, for others, on the internet;"</i> and <i>" Providing and rental of advertising space on the internet;"</i>, <i>"Advertisement for others on the Internet;"</i>, are identical or similar to <i>"Exhibitions for commercial or advertising purposes;"</i>, <i>"On-line advertising on a computer network;"</i>, <i>"Rental of advertising time on communication media;"</i>, <i>"Publication of publicity texts;"</i>, <i>"Rental of advertising space;"</i>, <i>"Dissemination of advertising matter;"</i> and <i>"Consultancy regarding advertising communications strategy;"</i> in the opponent's earlier registration.</p> <p>It is accepted that <i>"Initiation and arranging of commercial and business contacts, Also via the Internet;"</i> are identical or similar to <i>"Business management;"</i>, <i>"Business administration;"</i>, <i>"Business management and organization consultancy;"</i> and <i>"Business management for freelance service providers;"</i> in the opponent's registration.</p> <p>It is accepted that <i>"Recruitment information services;"</i>, <i>"Providing information in the field of</i></p>

career development and information in the fields of employment, recruitment, job resources, and job listings via the internet; "Compilation of data for providing and updating of a business and recruitment database;" are identical or similar to "Employment agencies;" in the opponent's registration.

It is accepted that "Computerised data processing;" "Computerised file management;" and "Updating and maintenance of data in computer databases." are identical or similar to "Computerised file management;" in the opponent's earlier registration.