

BL O/0253/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. WO1637848
BY SHENZHEN FUTU NETWORK TECHNOLOGY CO., LTD
TO REGISTER THE TRADE MARK:**

FUTU I&E

IN CLASSES 9, 35, 36, 38, 41 & 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433002
BY FUTURICE OY**

1. International trade mark no. 1637848 ('the contested mark') shown on the cover page of this decision was registered by Shenzhen Futu Network Technology Co., Ltd (the holder) with effect from 11 November 2021. From the same date, the holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement. The holder seeks protection in relation to the following goods and services:

Class 9: Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; biometric identity cards; security surveillance robots; computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; cases for smartphones; network communication devices; headsets; cameras; downloadable emoticons for mobile phones; spectacles; batteries, electric; refrigerator magnets.

Class 35: Business consultancy and advisory services; on-line promotion of computer networks and websites; marketing; organization of exhibitions for commercial or advertising purposes; business auditing; commercial administration of the licensing of the goods and services of others; business data analysis; personnel recruitment; rental of sales stands; updating and maintenance of data in computer databases.

Class 36: Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange transactions; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.

Class 38: Cable television broadcasting; communications by computer terminals; video-on-demand transmission; providing internet chatrooms; videoconferencing services; providing access to databases; communications by fibre optic networks; telephone services; communications by cellular phones; providing online forums.

Class 41: Teaching; arranging and conducting of conferences; games equipment rental; entertainment services; conducting fitness classes; educational services; providing online electronic publications, not downloadable; organization of lotteries; providing online videos, not downloadable; game services provided online from a computer network.

Class 42: Cloud computing; technological research; monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet; user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; electronic data storage; data encryption services; software development in the framework of software publishing; development of computer platforms; design and development of multimedia products; surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; graphic design.

2. The request to protect the contested mark was published on 28 January 2022. On 28 April 2022 Futurice Oy (the opponent) opposed the protection of the contested mark in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade marks:

UK3429209 ('the first earlier registration')

FUTURICE

futurice

Futurice

Filing date: 17 September 2019

Registration date: 6 December 2019

UK917097487 ('the second earlier registration')

FUTURICE

Filing date: 15 August 2017

Registration date: 1 December 2017

Both relying on the following goods and services:

Class 9: Data processing apparatus; Computers and computer hardware; Software; Computer software development tools; Data storage devices; Cloud servers.

Class 35: Advertising; Business management; Business management consultancy; Business management consulting services in the field of information technology; Business administration; Clerical services; Business intelligence services; Data management services; Business data analysis services.

Class 41: Teaching; Coaching; Organisation of training; Entertainment services; Sporting and cultural activities; On-line publication of electronic books and journals.

Class 42: Analytical services relating to computers; Software development; Software design and development; Cloud computing; Consulting in the field of cloud computing networks and applications; Development and testing of computing methods, algorithms and software; Database design and development; Research and development of computer software; Software engineering; Computer software consultancy; Consultancy and information services relating to software maintenance; Providing technical advice relating to computer hardware and software; Software as a service [SaaS]; Advisory and consultancy services relating to computer hardware; Advisory services relating to computer based information systems; Advisory services relating to computer systems analysis; Computer and information technology consultancy

services; Consultancy services for designing information systems; Technical consultancy relating to the installation and maintenance of computer software; Technical consultancy relating to the application and use of computer software; Technical consultancy services relating to information technology; Computer programming; Design and development of computer software architecture; Research relating to the development of computer programs and software.

UK917901316 ('the third earlier registration')

FUTUCARE

Filing date: 16 May 2018

Registration date: 5 September 2018

Relying upon the following goods and services:

Class 9: Data processing apparatus; Computers and computer hardware; Software; Computer software development tools; Data storage devices; Cloud servers.

Class 42: Analytical services relating to computers; Software design and development; Software development; Cloud computing; Consulting in the field of cloud computing networks and applications; Development and testing of computing methods, algorithms and software; Database design and development; Research and development of computer software; Software engineering; Computer software consultancy; Consultancy and information services relating to software maintenance; Providing technical advice relating to computer hardware and software; Software as a service [SaaS]; Advisory and consultancy services relating to computer hardware; Advisory services relating to computer based information systems; Advisory services relating to computer systems analysis; Computer and information technology consultancy services; Consultancy services for designing information systems; Technical consultancy relating to the installation and maintenance of computer software; Technical consultancy relating to the application and use of computer software;

Technical consultancy services relating to information technology; Computer programming; Design and development of computer software architecture; Research relating to the development of computer programs and software.

3. The opponent claims that the marks are similar to each other and that the goods and services in question are identical or similar.

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

5. The holder is represented by RMW&C Mietzel Wohlneck & Calheiros Partnerschaft mbB and the opponent is represented by Kilburn & Strode LLP.

6. Neither party filed evidence nor requested a hearing. The opponent provided submissions in lieu. The holder provided weblink printouts but no further submissions. This decision is therefore taken following careful perusal of the papers.

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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Decision

Section 5(2)(b)

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

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

(a)...

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

public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

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

...”

10. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2, above, which qualify as earlier trade marks under the above provisions. As the earlier trade marks had not completed their registration processes more than 5 years before the filing date of the application in suit, the earlier marks are not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Case law

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of Goods and Services

12. Within the Form TM8 and counterstatement, the holder admits that the following some goods and services within their specification are similar to the opponent's goods and services:

Class 9: Computer software platforms. Recorded or downloadable; computer screen saver software, recorded or downloadable; security surveillance robots; computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; network communication devices; batteries, electric.

Class 35: On-line promotion of computer networks and websites; business consultancy and advisory services; marketing; organization of exhibitions for commercial or advertising purposes; business auditing; business data analysis; updating and maintenance of data in computer databases.

Class 41: Teaching; arranging and conducting of conferences; games equipment rental; entertainment services; conducting fitness classes; educational services; providing online electronic publications, not downloadable; organization of lotteries; providing online videos, not downloadable; game services provided online from a computer network.

Class 42: Cloud computing; technological research; software development in the framework of software publishing; development of computer platforms; design and development of multimedia products.

13. In CX02 BL O/393/19, Professor Phillip Johnson as Appointed Person stated as follows:

“Once such an admission is made it is deemed to be conclusively proved (a formal admission is sometimes called a “waiver of proof”: Phipson on Evidence (19th Ed), paragraph 4-03). This means neither party can lead evidence contrary to the admitted fact and, accordingly, a Hearing Officer cannot find a fact contrary to the admission (as doing so is the same as finding facts contrary to the evidence).”¹

14. As the holder did not specify what degree of similarity it considers exists between the parties’ respective goods and services, I must still undertake a comparison in order to identify the degree of similarity between them.

15. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International

¹ Paragraph 33

Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

16. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

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

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

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

19. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

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

21. I bear in mind 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.

(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.”²

22. Geoffrey Hobbs KC, sitting as an Appointed Person in the case of *Raleigh International Trade Mark* [2001] RPC 11:

“20. If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22”

23. The goods and services specifications for the first and second earlier registrations are identical and the goods and services for the third earlier registration is identical to classes 9 and 42 in the first and second earlier registrations’ specifications. Consequently, for ease, I will only list the specification once in the table below:

Contested Goods and Services	Earlier Goods and Services
Class 9: Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; biometric identity cards; security surveillance robots; computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; cases for smartphones; network communication devices; headsets;	Class 9: Data processing apparatus; Computers and computer hardware; Software; Computer software development tools; Data storage devices; Cloud servers.

² 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).

cameras; downloadable emoticons for mobile phones; spectacles; batteries, electric; refrigerator magnets.	
Class 35: Business consultancy and advisory services; on-line promotion of computer networks and websites; marketing; organization of exhibitions for commercial or advertising purposes; business auditing; commercial administration of the licensing of the goods and services of others; business data analysis; personnel recruitment; rental of sales stands; updating and maintenance of data in computer databases.	Class 35: Advertising; Business management; Business management consultancy; Business management consulting services in the field of information technology; Business administration; Clerical services; Business intelligence services; Data management services; Business data analysis services.
Class 36: Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange transactions; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.	
Class 38: Cable television broadcasting; communications by computer terminals; video-on-demand transmission; providing internet chatrooms; videoconferencing services; providing access to databases; communications by fibre optic networks; telephone	

<p>services; communications by cellular phones; providing online forums.</p>	
<p>Class 41: Teaching; arranging and conducting of conferences; games equipment rental; entertainment services; conducting fitness classes; educational services; providing online electronic publications, not downloadable; organization of lotteries; providing online videos, not downloadable; game services provided online from a computer network.</p>	<p>Class 41: Teaching; Coaching; Organisation of training; Entertainment services; Sporting and cultural activities; On-line publication of electronic books and journals.</p>
<p>Class 42: Cloud computing; technological research; monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet; user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; electronic data storage; data encryption services; software development in the framework of software publishing; development of computer platforms; design and development of multimedia products; surveying; chemistry services; medical research; meteorological information;</p>	<p>Class 42: Analytical services relating to computers; Software development; Software design and development; Cloud computing; Consulting in the field of cloud computing networks and applications; Development and testing of computing methods, algorithms and software; Database design and development; Research and development of computer software; Software engineering; Computer software consultancy; Consultancy and information services relating to software maintenance; Providing technical advice relating to computer hardware and software; Software as a service [SaaS]; Advisory and consultancy services relating to computer hardware; Advisory services relating to computer based</p>

<p>vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; graphic design.</p>	<p>information systems; Advisory services relating to computer systems analysis; Computer and information technology consultancy services; Consultancy services for designing information systems; Technical consultancy relating to the installation and maintenance of computer software; Technical consultancy relating to the application and use of computer software; Technical consultancy services relating to information technology; Computer programming; Design and development of computer software architecture; Research relating to the development of computer programs and software.</p>
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24. The following goods and services are found identically in both specifications: Teaching; Entertainment services; Cloud computing.

Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; computer software, recorded; computer programs, downloadable; computer software applications, downloadable

25. I consider that the above goods from the holder's specification will fall into the wider category of 'software' within the opponent's specification and therefore find them to be identical under the *Meric* principles.

Security surveillance robots

26. On the basis that 'computer hardware' from the opponent's specification will include items such as webcams, I shall consider the similarity between those and the above goods from the holder's specification. I believe there will be an overlap in nature

as both devices will involve cameras. However, the method of use will be different as will their purpose and users. The surveillance robots will likely be used as security and monitoring by businesses whereas webcams will be used by the general public whilst plugged in to a laptop or computer for video calls or recording at home. I do not believe the providers will overlap and nor do I believe the trade channels will be the same- the holder's goods are likely to be purchased from specialist providers whereas the opponent's goods will be available in more general retail. I do not believe the goods to be in competition nor are they complementary. Ordinarily, a slight overlap in nature would not be enough to find similarity between the goods however, as the holder has not disputed the similarity of them in this case, I must find them similar to a very low degree.

Monitors

27. I consider that monitors are a type of computer hardware and they fall within the wider category of the opponent's 'computers and computer software'. Therefore, they are identical under the *Meric* principles.

Security tokens

28. As far as I'm aware, a security token, can be a physical device that provides the information for the user to prove their identity in a log in process. As a physical device I consider that it would be a device that can have data stored on it- in this instance for security purposes and it would fall within the opponent's wider category of "data storage devices" and I therefore find them to be identical under the *Meric* principles.

Wearable computers

29. I consider that wearable computers from the holder's specification would fall within the wider category of 'computers and computer software'. Therefore, they are identical under the *Meric* principles.

Network communication devices

30. I believe that 'network communication devices' in the holder's specification are items such as routers and hubs which allow hardware on computer networks to interact with each other. Therefore, I find that there will be an overlap of user with the opponent's 'computers and computer hardware' as anyone using a computer or hardware that is part of a network will likely be using the network communication device in order to access the network. I also believe that the goods could have a level of complementarity as one is used as part of the other and it would be reasonable to assume that the hardware and communication device was produced by the same undertaking. There could also be an overlap in trade channels and the goods might be found together in computer stores. I believe the nature differs and they are not in competition. I also believe the actual use of the goods differs. I therefore find the goods to be similar to a medium degree.

Batteries, electric

31. It is my understanding that electric batteries can be found within laptop computers and other similar devices. I find that they will fall within the wider category of the opponent's 'computer hardware' and therefore, they are identical under the *Meric* principles.

Headsets

32. I have considered the holder's arguments that headsets are an equipment which can be deemed similar to a very low degree at best and their reference to *Shenzhen Jiuyi Keji Youxian Gongsi v Swiss Aviation Software IG*, BL O/054/21. The case finds headphones to be dissimilar to computer hardware however, that is not exactly what is being compared here. I consider that the holder's 'headsets' are a set of headphones with a microphone attached that can be used connected to a computer allowing the user to take calls/videocalls and speak whilst keeping both hands free. I believe that there could be some overlap in user between 'headsets' and the opponent's 'computers and computer hardware' as the consumer would be using the headset to make a call from their computer. This would also mean there is a slight degree of

complementarity as the same undertaking could make headsets that are compatible with their own hardware and the headsets would need to be used with hardware in order for them to operate. The nature will not likely overlap. There would be an overlap in trade channels businesses selling computers will also sell things like a mouse, keyboards, and headsets to be used with the computer. I do not believe them to be in competition nor do they share a purpose. I therefore find them to be similar to a medium degree.

Cameras

33. As above, I stated that 'computer hardware' from the opponent's specification will include items such as webcams, and I will once again use that for this comparison with the holder's 'cameras'. I believe there will be an overlap in nature as both devices will involve cameras. However, the method of use will be different, one is used to take still shots whereas the other is more for videos. I do not believe the providers will overlap. The users could overlap slightly and they could be found in the same trade channels as technology shops could indeed sell both. I do not believe the goods to be in competition nor are they complementary. I therefore find these goods to be similar to a low degree.

Biometric identity cards; downloadable emoticons for mobile phones; cases for smartphones; spectacles; refrigerator magnets.

34. On application of the *Treat* guidance, I cannot see any overlap between the above goods and the opponent's goods and services. I therefore find the goods and services to be dissimilar.

Business consultancy and advisory services

35. I consider that the above services will fall within the wider category of the opponent's 'business management consultancy' and therefore I find them to be identical under the *Meric* principles.

On-line promotion of computer networks and websites

36. I find that 'advertising' as found in the opponent's specification means the promotion of goods or services for sale.³ I therefore believe the above service from the holder's specification falls within the wider category of the opponent's 'advertising' and they are identical under the *Meric* principles.

Marketing

37. It is my understanding that advertising is a specific step of marketing in that advertising uses the data and research collected by marketing to make the produce known to consumers. It follows that I find the holder's 'marketing' identical in accordance with *Meric* to the opponent's 'advertising'.

Organization of exhibitions for commercial or advertising purposes

38. I believe that the above service in the holder's specification is a type of advertisement and therefore falls within the wider category of 'advertising' found within the opponent's specification and I therefore find them to be identical under the *Meric* principles.

Business auditing

39. For the above service in the holder's specification, I find that there is likely an overlap of user with the opponent's 'business administration' as both services will be used by businesses. The purpose of business auditing is to undertake checks of the business to ensure a level of work/quality is being adhered to. It could be used within the process of administration of a business in order to improve and therefore the trade channels and purpose overlap slightly as well as being slightly complementary. I believe the nature will not overlap and they are not in competition. I therefore find these services to be similar to a medium degree.

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

Commercial administration of the licensing of the goods and services of others

40. I agree with the holder's argument that the above services do not relate to the organisation, efficiency or performance of a business and therefore I cannot see any overlap in purpose or use with the opponent's specification. Although the user of these services will be a business, as will the opponent's class 35 services, this in itself is not enough for a finding of similarity. I can see no overlap of trade channels as 'commercial administration of the licensing of the goods and services of others' will not be carried out by the same companies who undertake business management or business administration generally. I do not believe the goods to be complimentary or in competition and I therefore find these services to be dissimilar.

Business data analysis

41. I find that the above services from the holder's specification fall within the wider category of the opponent's 'business data analysis services' and therefore I find them to be identical under the *Meric* principles.

Personnel recruitment

42. I note the arguments put forward by the holder that personnel recruitment cannot be considered identical or even similar to the services covered by the earlier marks and the reference to decision BL O/142/13 where no similarity is found between "employment services or recruitment services or advice and assistance in relation to employment, employing others and finding others for employment and either business administration or business management".⁴ I am not bound by previous decisions of the tribunal and I note that there is a later decision which does find similarity between personnel recruitment and business management and business administration.⁵ A business management service will indeed involve the day to day running of a business and that includes recruitment which means there is an overlap in purpose. There will

⁴ Para 23

⁵ BL O-466-19, Para 34

evidently be an overlap in user as both can be used by businesses and will be offered through the same trade channels. I therefore find them similar to a medium degree.

Rental of sales stands

43. Once again, I note the caselaw from the EUIPO provided by the holder, *NOZ v NÓS* B2 395 237 where the rental of sales stands is found to be dissimilar to business management, business administration and advertising. I am not bound by the decisions of the EUIPO. I also note there are later decisions that differ from the findings in the case provided. I believe that rental of sales stands refers to the loaning of stands which are used to display goods for sale on or in. I believe that there might be an overlap in use with the above service in the holder's specification with the opponent's 'advertising' as the sales stands could be used within an advertising campaign. The users will likely be businesses for both. The nature may differ as may the trade channels. They could be in competition as the stands might be provided within an advertising company's campaign or they could be rented separately by companies wishing to undertake their own advertising. I therefore find them to be similar to no more than a medium degree.

Updating and maintenance of data in computer databases

44. I believe 'updating and maintenance of data in computer databases' will fall within the wider category of the opponent's 'data management services' and therefore I find them to be identical under the *Meric* principles.

Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange transactions; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.

45. I note that the opponent has compared the above services with their 'analytical services relating to computers; software design and development; software development; cloud computing; technical consultancy relating to the installation and maintenance of computer software; providing technical advice relating to computer

hardware and software; software as a service [SaaS] in class 42 and 'data processing apparatus; computers and computer hardware; software; computer software development tools; data storage devices; cloud servers' in class 9 as they state that all the above services from the holder's specification are provided by computer software, an app or online. Having regard to the principles set out in *Sky v Skykick* mentioned in paragraph 20 above, I believe that such a finding would be interpreting the opponent's goods and services too widely. I cannot see that the holder's class 36 services share purpose, trade channels or use with any of the opponent's goods and services. Any general overlap of user is not enough for a finding of similarity and I do not believe there to be any complementarity or competition. I therefore find these services dissimilar.

Cable television broadcasting; video-on-demand transmission

46. I believe that the above services will fall within the wider category of the opponent's 'entertainment services' and therefore I find them to be identical under the *Meric* principles.

Communications by computer terminals; communications by fibre optic networks; videoconferencing services; providing internet chatrooms; providing online forums

47. The above services from the holder's specification are all related to communications and messages online and through fibre optics (which I understand can be used to transmit the internet). I consider that the opponent's goods and services such as software, software as a service, software development will share a similarity because of the close relationship between software and the ability to provide the communication services. The holder's services may be delivered using bespoke software for the purpose and as part of the delivery of its services. The consumer may have an expectation that the software they require to access the communication will be designed, installed and, where necessary, repaired by the communications deliverer. Consequently, they may share trade channels and be complementary and I therefore conclude that these goods and services share a medium degree of similarity.

Providing access to databases

48. I consider that the above service in the holder's specification might overlap in trade channels as both are related to databases. I do not believe there to be an overlap in use as database design services are used to produce databases whereas providing access to databases are used to provide users with access to information. It could be that these services are also in competition- a consumer might choose to access an already available database or choose to have one designed. The nature of the services does differ and I do not believe them to be complementary. I therefore find them to be similar to a low degree.

Telephone services; communications by cellular phones

49. I cannot see that the holder's 'telephone services; communications by cellular phones' share purpose, trade channels or use with any of the opponent's services. Any general overlap of user is not enough for a finding of similarity and I do not believe there to be any complementarity or competition. I therefore find these services dissimilar.

Arranging and conducting of conferences

50. I believe that the above service from the holder's specification will fall within the wider category of the opponent's 'organisation of training' and therefore I find them to be identical under the *Meric* principles.

Games equipment rental; providing online videos, not downloadable; game services provided online from a computer network; organization of lotteries

51. To my mind, the above holder's services fall within the wider category of 'entertainment services' found within the opponent's specification. Therefore, I find them to be identical using the *Meric* principles.

Conducting fitness classes

52. I believe these services will fall within the wider category of 'sporting and cultural activities' from the opponent's specification. Therefore, using the *Meric* principles I find these services to be identical.

Educational services

53. The above 'educational services' from the holder's specification form a wider category of services which encompasses the opponent's 'teaching' and therefore, I find them to be identical using the *Meric* principles.

Providing online electronic publications, not downloadable

54. I consider that the above services are identical although the wording of the terms is slightly different.

Technological research

55. I consider that the above service from the holder's specification will encompass the opponent's 'research relating to the development of computer programs and software' and therefore, I find them to be identical under the *Meric* principles.

Monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet

56. I believe that the above services relate to looking after data i.e. establishing ways to watch the data to make sure it remains safe. I note that the opponent's specifications include 'data management services'. I consider there might be an overlap in user however, I do not believe there are any other overlaps in the *Treat* criteria. I therefore find these services to be similar to be dissimilar.

Electronic data storage; data encryption services

57. I consider that the above services would overlap users with the opponent's 'Data management services' as if a business wishes to use a company to manage their data, it would be reasonable to expect that they will also expect that data to be stored and secured. I therefore believe that also means the services are complementary. The use might go together with one another but are not necessarily the same. The trade channels might overlap. I therefore find these services to be similar to at least a medium (although not the highest) degree.

Software development in the framework of software publishing

58. I consider the above service falls within the wider category of the opponent's 'software development' and therefore I find them to be identical under the *Meric* principles.

Development of computer platforms

59. Computer platforms are a type of software and therefore the above services from the holder's specification will fall within the wider category of the opponent's 'software development' and therefore I find them to be identical under the *Meric* principles.

User authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; design and development of multimedia products; surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; graphic design

60. I find no evident similarity between these services and the opponent's goods and services. The goods and services are dissimilar.

61. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

62. I have found no similarity in respect of the following goods and services from the holder's specification:

Class 9: Biometric identity cards; downloadable emoticons for mobile phones; cases for smartphones; spectacles; refrigerator magnets.

Class 35: Commercial administration of the licensing of the goods and services of others

Class 36: Insurance underwriting; art appraisal; surety services; lending against security; foreign exchange transactions; real estate management; financial customs brokerage services; charitable fund raising; online real-time currency trading; securities brokerage.

Class 38: Telephone services; communications by cellular phones

Class 42: Monitoring of computer systems for detecting unauthorized access or data breach; electronic monitoring of personally identifying information to detect identity theft via the internet; user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; design and development of multimedia products; surveying; chemistry services; medical research; meteorological information; vehicle roadworthiness testing; toy design; interior design; dress designing; numismatic authenticating services; graphic design

63. The opposition therefore fails in relation to those applied-for goods and services for lack of similarity.

64. I will continue to consider the opposition in respect of the following goods and services:

Class 9: Cameras; Computer software platforms, recorded or downloadable; computer screen saver software, recorded or downloadable; security surveillance robots; computer software, recorded; monitors; computer programs, downloadable; computer software applications, downloadable; security tokens; wearable computers; cases for smartphones; network communication devices; headsets.

Class 35: Business consultancy and advisory services; on-line promotion of computer networks and websites; marketing; organization of exhibitions for commercial or advertising purposes; business auditing; business data analysis; personnel recruitment; rental of sales stands; updating and maintenance of data in computer databases.

Class 38: Cable television broadcasting; communications by computer terminals; video-on-demand transmission; providing internet chatrooms; videoconferencing services; providing access to databases; communications by fibre optic networks; providing online forums.

Class 41: Teaching; arranging and conducting of conferences; games equipment rental; entertainment services; conducting fitness classes; educational services; providing online electronic publications, not downloadable; organization of lotteries; providing online videos, not downloadable; game services provided online from a computer network.

Class 42: Cloud computing; technological research; electronic data storage; data encryption services; software development in the framework of software publishing; development of computer platforms.

Average consumer and the purchasing act

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

66. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

67. I consider that the average consumer of the class 9 goods and class 35 and 42 services could be members of the public or professionals/business. The costs of these goods and services are likely to vary greatly between low and high cost. I would consider that these goods and services will be purchased relatively infrequently although there is potential for the class 9 goods to be more frequent. The average consumer will need to take into consideration the cost and suitability of these goods and services in accordance with their needs. I therefore consider that the average consumer would pay an above medium (but not the highest) level of attention during the purchasing process. The above goods and services are likely to be selected from various retailers, websites, advertisements and signs on a physical property. I therefore believe that visual considerations will dominate the selection process. However, I do not discount the possibility that there could be aural considerations from word of mouth recommendations or advice from a sales assistant.

68. The relevant average consumer of services in class 38 is likely to be an individual, in particular for the video-on-demand services and telephone services. It could also be a business using the services. In either case, I see no reason to believe that average consumers will pay an unusually high, or low, level of attention when selecting the services in question. I therefore find that average consumers will pay a medium level of attention when selecting the services at issue. The services are likely to be selected primarily by eye, e.g. from advertisements on the internet. However, word-of-mouth recommendations may also play a part in the selection process, so the sound of the marks must also be considered.

69. In relation to the class 41 services, I consider that these terms could cover a very wide range of services. These services could be purchased by the general public or by professionals. The services could be for a one-off event, such as a wedding, or one off training conference or for regular occurrences, such as weekly fitness classes also. Again, I feel that the selection of these services would generally be a visual process, although there could be aural considerations. I once again conclude that the average consumer will likely pay a medium degree of attention to ensure the entertainment or teaching fits their requirements or perhaps a higher degree of attention for one-off more expensive or bespoke entertainment/teaching services.

Comparison of the marks


70. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural, and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

71. 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.

72. The parties respective marks are shown below:

Earlier Marks	Contested Mark
<p><i>The first earlier registration</i></p> <p>FUTURICE</p> <p>futureice</p> <p>Futurice</p>	
<p><i>The second earlier registration</i></p> <p>FUTURICE</p>	
<p><i>The third earlier registration</i></p> <p>FUTUCARE</p>	

73. The earlier marks are all word marks, all containing just one word and therefore the overall impression lies in the word itself.

74. The contested mark is a very lightly stylised mark which is made up of one word followed by what appears to be an abbreviation made up of two letters with an ampersand in-between them. In my opinion, the overall impression lies in the combination of these elements, with neither dominating.

75. The first and second earlier registrations all contain eight letters. The contested mark contains a word with four letters followed by one letter, an ampersand and another letter. The first four letters are identical to the first four letters in the first earlier registration. They also contain the letters 'I' and 'E' as does the contested mark and in both instances, they are separated by another character. The first and second earlier registrations do not contain any symbols whereas the contested mark contains a space and an ampersand. I therefore find the first and second earlier registrations to be visually similar to the contested mark to at least a medium (but not the highest) degree.

76. For the third earlier registration, this is also eight letters with the first four letters being identical to the contested mark and the last letter also being identical. It has the additional letters 'CAR' which are not found at all within the contested mark. Therefore, I find the marks to be visually similar to a medium degree.

77. Next, I turn to the aural comparison. I consider that the contested mark could be pronounced in five syllables as '*FOO/TOO EYE/AND/EE*'. For the first and second earlier registrations, I consider that there are two possible pronunciations. Firstly, there would be some consumers who would pronounce it as *FOO/TOO/RICE* which is three syllables. The first two syllables would be identical and there would be some similarity between the third syllables, however, there are a further two syllables at the end of the contested mark which have no commonality with these earlier marks. Therefore, I find them to be similar to a medium degree. The second pronunciation I consider is *FEW/CHUR/RICE* which is again three syllables. This is due to the first five letters of the marks almost spelling the word 'future'. For this pronunciation, I consider that there is overlap with the very first 'F' sound and the beginning of the third syllable. Obviously,

this pronunciation is further away than the first and I find the aural similarity with the contested mark to only be of a low degree.

78. Regarding the third earlier registration, 'FUTUCARE' I believe this will likely be pronounced *FOO/TOO/CARE* and therefore it will share the first two syllables only. 'CARE' clearly differs in sound from 'I&E' and therefore I find the marks to be aurally similar to a medium degree.

79. Conceptually, the contested mark, as suggested by the holder will likely be viewed as an invented word followed by an abbreviation. It does not have a clear dictionary meaning nor does it appear to allude to any potential meaning. For the opponent's first and second earlier registrations, 'FUTURICE', it is possible that the average consumer might find it allusive to future due to sharing the first five letters or to see the word 'ICE' at the end but I do not believe that viewing the mark as a whole will lead them to assign a particular meaning or concept and therefore, they will view it as an invented term.

80. For the third earlier registration, I believe that the average consumer will also see this as an invented term. I do not believe that this mark is allusive to 'future' as it does not contain the letter 'R' where the first and second registrations do.

81. As I believe the average consumer will believe the terms to be made up and therefore, as there is no immediate clear meaning for any of the marks, the conceptual comparison is neutral.

Distinctive Character of the Earlier Marks

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).”

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

84. Although the earlier marks as a whole are invented, the average consumer will be able to identify the normal dictionary terms ‘ICE’ and ‘CARE’ in them. I do not believe ‘ICE’ to have any particular meaning in relation to the opponent’s goods and services. ‘CARE’ however, could allude to the ongoing maintenance and looking after of the goods in class 9 and the designing and development services in class 42. Therefore, I find the third earlier registration to be inherently distinctive to a medium degree. I find the first and second earlier registrations to be inherently distinctive to at least a medium (but not the highest degree).

Likelihood of Confusion

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

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

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

87. I have reached the following conclusions above regarding the marks:

- For the earlier marks the overall impression lies in the words themselves. For the contested mark I consider the Overall impression of the mark lies in the combination of the invented word and abbreviation.
- The first and second earlier registrations are visually similar to the contested mark to at least a medium (but not the highest) degree. The third earlier registration is visually similar to the contested mark to a medium degree.
- The first and second earlier registrations are aurally similar to the opponent’s mark to a medium or low degree. The third earlier registration is aurally similar to a medium degree.
- I have found the concepts to be neutral.
- The first and second earlier registration are inherently distinctive to at least a medium (if not the highest) degree and the third registration is inherently distinctive to a medium degree.
- The remaining goods and services are between identical and similar to a very low degree
- The average consumer will be paying between a medium and an above medium (but not the highest) degree of attention.

88. I bear in mind the differences between the earlier marks and the contested mark, in particular that the contested mark is presented as a word and abbreviation and contains a symbol compared to the earlier marks which are all one word without any symbols. Also, there are additional letters within the earlier marks which are not contained within the contested mark. Together with the aural differences and given that there is nothing to connect the marks conceptually, I do not believe that the

average consumer will mistake one mark for the other and therefore there is no likelihood of direct confusion.

89. Moving on to indirect confusion, I do not find that there is any “proper basis” why the average consumer would consider the contested mark to be another brand of the owner of the earlier mark, so no indirect confusion arises either.⁶ A finding of indirect confusion should not be made merely because the two marks share a common element.⁷ The common element between the marks are the first four letters. I am not convinced that there is enough between the marks to call one to mind when encountering the other nor is FUTU so strikingly distinctive that no other could use it. The overall impressions differ and there is nothing conceptually to link the marks. I do not consider ‘I&E’ to be an obvious brand extension nor a non-distinctive element. If they did call the marks to mind it would be mere association and not indirect confusion.

Conclusion

90. The opposition fails in its entirety.

Costs

91. The holder has been successful and is entitled to a contribution towards its costs.

92. Award of costs are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs in this matter has been calculated as follows:

Considering the Notice of Opposition and preparing Counter Statement	£450
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93. I therefore order Futurice Oy to pay Shenzhen Futu Network Technology Co., Ltd the sum of £450. The above sum should be paid within twenty-one days of the expiry

⁶ See Arnold LJ at [13] of the judgement in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

⁷ As noted, for instance, by James Mellor Q.C. (as he then was), as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 7th day of March 2023

L Nicholas

For the Registrar