

O-463-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NOS. 3044297 AND 3071266
FOR THE TRADE MARKS**

The logo for 'pinmydeal' features a stylized 'P' icon on the left, which is a circle with a vertical line through it, resembling a pin. To the right of the icon, the word 'inmydeal' is written in a lowercase, sans-serif font.

AND

The logo for 'pinmydeal' features a stylized 'P' icon on the left, which is a circle with a vertical line through it, resembling a pin. To the right of the icon, the word 'inmydeal' is written in a lowercase, sans-serif font. The 'P' icon and the letters 'in' and 'deal' are in red, while 'my' is in black.

**BOTH IN CLASSES 9, 35, 38 AND 41
BY ANDREW TERENCE SMITH**

AND

**THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 402595 AND 403527
BY PINTEREST, INC**

Background and pleadings

1. Andrew Terence Smith applied for the two trade marks shown below on 5 September 2014 for a range of goods and services in classes 9, 35, 38 and 41:

No. 3044297



No. 3071266



2. The specifications applied for are identical for both marks:

Class 9 *CD ROMs; compact discs (CDs); electronic publications; CD ROMs, compact discs (CDs) and electronic publications containing names, addresses, telephone and facsimile numbers of businesses and private individuals; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; pre-recorded discs, tapes and cassettes; computer software; computer products; computer software and publications in electronic form supplied on-line via databases or via facilities provided on the Internet including web sites; parts and fittings for the aforesaid goods.*

Class 35 *Provision of information relating to business; business, information, advertising, marketing and promotional services provided on-line via a computer database or by means of web pages on the Internet; compilation, provision and retrieval of business and commercial information; marketing, promotional and advertising services; data processing and database services; directory services; direct mail advertising services and compilation of direct mailing lists and business and residential directories; provision of names, addresses, telephone and facsimile numbers of businesses and private individuals; compilation and transcription of data; collection and storage of messages and data.*

Class 38 *Telecommunications; digital telecommunications; transmission of messages and data; transmission and processing of messages and data; display of information for business or domestic purposes provided on-line via a computer database, website or the Internet.*

Class 41 *Publishing services; electronic publishing services; provision of publications and of information relating to publications via a computer database or via the Internet; provision of websites relating to publications; publication of directories; publication of directories containing names, addresses, telephone and facsimile numbers of businesses and private individuals.*

3. Pinterest, Inc (“the opponent”) opposes the two applications. It bases its oppositions under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) on the earlier marks shown below. In relation to application 3044297, the opposition under section 5(4)(a) of the Act is based on the use of a sign corresponding exactly to the first of the earlier trade marks shown below (“Pinterest”), for the many of the same goods and services, in the UK from January 2011. For the other application, the sign relied upon under section 5(4)(a) is the plain word PINTEREST. Under section 5(2)(b), the opponent claims that the similarities between the marks and the identical and similar goods and services will lead to a likelihood of confusion. Under section 5(3), the claim is that Mr Smith’s use of the marks will benefit from the earlier marks’ reputation, or be detrimental to their distinctive character and repute. The opponent also claims, under section 5(4)(a) of the Act, that the use of the applications is liable to be prevented under the law of passing off, as the opponent’s significant goodwill would be damaged by misrepresentation.

4. The earlier marks are as follows:

i) International Registration (“IR”) 1187515 (UK designation)

The image shows the word "Pinterest" in its characteristic black, cursive script font.

Date protection requested: 1 February 2013; priority date: 2 August 2012 (USA)

Date protection conferred: 15 April 2014

Class 9 *Computer software, namely, software that allows users to interact online with information and media content that other users share, and software that allows users to discover, access and share information about, and media content concerning, goods, services, and experiences; computer software and software applications that enable electronic communications network users to create, upload, bookmark, view, annotate, and share data, information and media content; software, downloadable or prerecorded, in the nature of a mobile application that enables electronic communications network users to create, upload, bookmark, view, annotate, share and discover data, information and media content; software downloadable via electronic communications networks and wireless devices that enables electronic communications network users to create, upload, bookmark, view, annotate, share and discover data, information and media content; software to facilitate business promotion, connecting social network users with businesses; downloadable electronic publications in the nature of blogs, photographs, and graphic art in the field of general human interest; computer e-commerce software to allow users to perform electronic business transactions via a global computer network.*

Class 35 *Advertising and promotional services; advertising and marketing services, namely, promoting the products and services of others; business data analysis; business monitoring and consulting services, namely, data and behavior analysis to provide strategy, insight, and*

marketing guidance, and for analyzing, understanding and predicting behavior and motivations, and market trends; promoting the goods and services of others by means of operating an online platform with hyperlinks to the resources of others; providing an online searchable database featuring a wide variety of consumer, business, and industrial goods of others; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes.

Class 38 *Electronic bulletin board services.*

Class 42 *Providing a platform featuring technology that enables internet users to create, upload, bookmark, view, annotate, share and discover data, information and multimedia content; computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of general interest; providing a website featuring non-downloadable software that enables electronic communications network users to create, upload, bookmark, view, annotate, share and discover data, information and media content; providing a platform featuring non-downloadable software that enables electronic communications network users to create, upload, bookmark, view, annotate, share and discover data, information and media content; hosting an interactive platform and online non-downloadable software for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and other user-generated content; developing and hosting a server on a global computer network for the purpose of facilitating e-commerce via such a server; platform and facility for mobile device communication, namely, providing non-downloadable software that facilitates sharing and discovering information and media content via mobile devices; platform and facility for networked communications, namely, providing non-downloadable software that facilitates sharing and discovering information and media content via local and global computer, mobile, cellular, electronic, wireless, and data communications networks.*

Class 45 *Providing online social networking services for purposes of commentary, comparison, collaboration, consultation, evaluation, advice, discussion, research, notification, reporting, identification, information sharing, indexing, information location, entertainment, pleasure, or general interest.*

(ii) IR 1159400 (UK designation)



Date protection requested: 23 January 2013; Date protection conferred: 1 August 2013

Class 9 *Computer software; computer software and software applications that enable electronic communications network users to create, upload, bookmark, view, annotate, and share data, information and media content; software, downloadable or prerecorded, in the nature of a mobile application; software downloadable via electronic communications networks and wireless devices; software to facilitate business promotion, connecting social*

network users with businesses; electronic publications; computer e-commerce software to allow users to perform electronic business transactions via a global computer network.

Class 35 *Advertising and promotional services; advertising and marketing services, namely promoting the products and services of others; business data analysis; business monitoring and consulting services, namely, data and behavior analysis to provide strategy, insight, and marketing guidance, and for analyzing, understanding and predicting behavior and motivations, and market trends; promoting the goods and services of others by means of operating an online platform with links to the resources of others; providing an online searchable database featuring goods of others; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes.*

Class 38 *Electronic bulletin board services.*

Class 42 *Providing a platform featuring technology that enables internet users to create, upload, bookmark, view, annotate, and share data, information and multimedia content; computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of general interest; providing a website featuring non-downloadable software; providing a platform featuring non-downloadable software; hosting an interactive platform and online non-downloadable software for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and other user-generated content; developing and hosting a server on a global computer network for the purpose of facilitating e-commerce via such a server; platform and facility for mobile device communication; platform and facility for networked communications.*

Class 45 *Online social networking services; providing social networking services for purposes of commentary, comparison, collaboration, consultation, evaluation, advice, discussion, research, notification, reporting, identification, information sharing, indexing, information location, entertainment, pleasure, or general interest.*

This earlier mark is pleaded only against application 3044297 (under both sections 5(2)(b) and 5(3) of the Act).

(iii) Community Trade Marks (“CTM”) 10634021



Filing date: 10 February 2012; priority date: 7 February 2012 (Australia); date of completion of registration procedure: 23 August 2012

Class 9 *Computer hardware and software; Computer software and software applications that enable internet users to create, bookmark, annotate, and publicly share data, information and multimedia content; Downloadable software in the nature of a mobile application; Downloadable software via the internet and wireless devices; Downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy, insight, marketing, and predicting consumer behavior; downloadable electronic publications; Laptops; Tablets; Mobile phones; handheld computing devices; Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Fire-extinguishing apparatus.*

Class 35 *Advertising and promotional services; Advertising and marketing services, namely promoting the products and services of others; Business data analysis; business monitoring and consulting services, namely, tracking users to provide strategy, insight, marketing guidance, and for analyzing, understanding and predicting consumer behavior and motivations, and market trends; Business management; Business administration; Office functions.*

Class 38 *Electronic bulletin board services; Telecommunications.*

Class 42 *Providing a web site featuring technology that enables internet users to create, bookmark, annotate, and publicly share data, information and multimedia content; Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of general interest; Providing a website featuring non-downloadable software; hosting an interactive website and online non-downloadable software for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and other user-generated content; Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.*

Class 45 *Internet-based social networking services; Online social networking services; Providing a social networking website for entertainment purposes and general interest purposes; Legal services; Security services for the protection of property and individuals; Personal and social services rendered by others to meet the needs of individuals.*

(iv) CTM 10634046



Filing date: 10 February 2012; priority date: 7 February 2012 (Australia); date of completion of registration procedure: 23 August 2012

Class 9 *Computer hardware and software; Computer software and software applications that enable internet users to create, bookmark, annotate, and publicly share data, information and multimedia content; Downloadable software in the nature of a mobile application; Downloadable software via the internet and wireless devices; Downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy, insight, marketing, and predicting consumer behavior; Electronic publications; Laptops; Tablets; Mobile phones; Handheld computing devices; Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Fire-extinguishing apparatus.*

Class 35 *Advertising and promotional services; Advertising and marketing services, namely promoting the products and services of others; Business data analysis; business monitoring and consulting services, namely, tracking users to provide strategy, insight, marketing guidance, and for analyzing, understanding and predicting consumer behavior and motivations, and market trends; Business management; Business administration; Office functions.*

Class 38 *Electronic bulletin board services; Telecommunications.*

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Class 45 *Internet-based social networking services; Online social networking services; Providing a social networking website for entertainment purposes and general interest purposes; Legal services; Security services for the protection of property and individuals; Personal and social services rendered by others to meet the needs of individuals.*

5. Mr Smith denies the claims.

6. The proceedings were consolidated. Both sides filed evidence and submissions. The matter came to be heard before me by video conference on 21 September 2015. Ms Rachel Wilkinson-Duffy, of Baker McKenzie LLP, represented the opponent. Mr Smith did not attend, but his trade mark attorney, Mr Kevin Parnham, of Parnham IP Services, filed written submissions in lieu of attendance.

Evidence

7. The opponent has filed evidence from its Deputy General Counsel, Anthony Falzone, and from Ms Wilkinson-Duffy. Mr Smith has filed evidence given by himself and by Mr Parnham.

The opponent's evidence

8. Mr Falzone's evidence is accompanied by exhibits numbering 368 pages. It was filed before Tribunal Practice Notice 1/2015 came into effect, which limits the amount of evidence in chief to 300 pages. I note that some of the evidence appears to have been filed in proceedings before the Office for Harmonisation of the Internal Market ("OHIM").

9. Mr Falzone describes the services offered by the opponent under its PINTEREST mark in the following way:

"Pinterest allows users, which comprise of businesses, organizations as well as private individuals, to gather images and other content and organize that content into themed collections that it calls "boards." Pinterest users typically build their boards using images from their own collections or other websites."

Mr Falzone states that the service offered at the pinterest.com website and via mobile applications has always been branded PINTEREST since it was launched in March 2010. The mark is derived from 'pin' and 'interest'. The website was ranked 19th in the UK in May 2014, UK visitors accounting for just under 4% of global visitors¹, which had passed the 26 million mark by October 2012². In 2012, Experian Marketing ranked it (globally, presumably) the third most popular social networking site behind Facebook and Twitter. Exhibit AF3 shows that Experian estimated that the year between July 2011 and 2012 would see a 1489% increase in growth in use of the Pinterest website in the UK.

10. Prior to the filing of the applications, the estimated visitor figures to the Pinterest website from the UK and the EU showed an exponential increase:

Region	Estimated Visitors from March 2010 through January 2012	Estimated Visitors from February 2012 to mid-November 2012	Estimated Visitors from February 2012 to May 2014
United Kingdom	396,000	3.2 million	14,420,315
European Union	1.22 million	10.9 million	"

¹ Exhibit AF1.

² Exhibit AF4.

11. The number of people who registered an account to create their own Pinterest board(s) is shown below:

Region	Estimated Account Signups from March 2010 through January 2012	Estimated Account Signups from February 2012 to mid-November 2012	Estimated Visitors from February 2012 to May 2014
United Kingdom	30,000	805,981	4,120,090
European Union	92,500	2.7 million	-

12. The number of unique mobile devices on which the Pinterest application (“app”) was activated is as follows:

Region	UK app activations from March 2010 through January 2012	UK app activations from February 2012 through May 2014
United Kingdom	91,700	2.73 million (iOS) 954,356 (Android)

13. Mr Falzone also exhibits witness statements³ from two auditors from Price Waterhouse Cooper and Fitzgerald and Law to verify the accuracy of the figures which were gleaned from a combination of the opponent’s database and Google Analytics. Their estimates came in at more than the opponent’s figures quoted above, but it is unnecessary for the purposes of this decision to go into any more detail.

14. Examples of UK businesses and organisations which maintain a presence on Pinterest include the English National Opera, the University of Liverpool, Selfridges, Harrods, the London Symphony Orchestra, the Tate Gallery, the Royal Shakespeare Company, The Royal Navy, Barclays Football, Fulham football club, Tesco, Sainsbury’s, M&S and John Lewis; although it is not stated when these entities signed up to Pinterest. Screen shots are shown of these and other organisations in Exhibit AF6: the mark shown is the Pinterest mark in cursive script. An explanation is given on the pages “Pinterest is an online pinboard. Organise and share the things you love”. The number of ‘pins’ is given on each entity’s page. The pages were printed on January 2015.

15. Pinterest won the Best Social Media App and People’s Voice Awards categories in the 2012 Webby Awards, run by the International Academy of Digital Arts and Sciences for excellence on the internet. Mr Falzone states that it is one of the most

³ The witness statements were filed in the OHIM proceedings.

prestigious awards a website can win and that the 2012 awards attracted 10,000 entrants from 60 countries. Exhibit AF8 comprises over 250 pages of press coverage of Pinterest from the UK, many referring to its rapid expansion in popularity. The pages are not very legibly reproduced. The exhibit includes:

- An article in The Telegraph newspaper, dated 27 November 2012, is entitled “The rise of the Pinterest Christmas List.”
- An article in The Guardian, dated 7 February 2013, refers to “Pinterest seeks new financing which could value scrapbook site at \$2.5bn.”
- An article on house renovation in The Telegraph, dated 26 April 2013, refers to Pinterest as “A brilliant way to save images of favourite pieces of furniture or roomsets to inspire your home makeover.”
- A Telegraph article on 14 May 2014 is headed “Chanel is Pinterest’s most popular fashion brand.”

16. Mr Falzone states that the opponent introduced its PIN IT button in May 2011. By February 2013, more than 1.2 million domains included the button which, from looking at an example of use in Exhibit AF11 (which is just about legible), corresponds to the PIN IT earlier mark (CTM10634046). There are no details about the nature or locations of the domains. The example is from M&S’s website, dated 27 May 2014. The pages from ASOS and John Lewis are so poorly reproduced that I cannot discern the PIN IT button.

17. Mr Falzone states that the opponent also uses a P logo which corresponds to earlier mark CTM10634021. He states that this is positioned prominently at the top of the Pinterest website and is used as a ‘favicon’. Mr Falzone states that Exhibit AF12 contains web printouts showing current use of the logo and use dating back to March 2013. The two pages in this exhibit are largely illegible, and I cannot make out the P logo to which he refers.

18. Ms Wilkinson-Duffy is in reply to the applicant’s evidence (detailed below). She has filed copies of an OHIM decision relating to the application for PINGAY (and device) and a WIPO decision regarding the opponent’s complaint about the domain names pingay.com and pin.sex.com. This is an entirely different mark to the applications and is not relevant to these proceedings. She has also filed copies of some correspondence between the present parties.

The applicant’s evidence

19. Mr Smith has filed a witness statement which is a mixture of submission and fact. I will bear in mind the submissions, but will summarise only those facts which appear relevant to the issues in this case. Some of the evidence deals with Mr Smith’s business plans and his actual use over the year prior to making his witness statement. The specifications applied for go wider than this, and have not been limited to the area in which he operates, which is providing an advertisement, at a pinned location, for a deal. The parties’ specifications must be considered for what

they notionally cover; as per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁴, in which the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

20. The thrust of Mr Smith’s evidence is that the opponent cannot claim rights in ‘Pin marks’. He exhibits a large number of ‘pin’ icons (Exhibit A) which are used in digital devices, search engines and apps to define location on digital maps. Mr Smith states:

“Simplicity is important in the digital environment so I coined a combination figurative and invented mark as PIN (taken from the common noun for a map pin and verb to define location), MY (to define ownership by the trader) and DEAL (a colloquialism for an offer such as a discount, fixed price etc.) with figuration further achieve [sic] by use of a classical balloon logo styles to allude towards a p in the common word pin and used by search engines/operating systems.”

21. Mr Smith refers to a large number of third party trade marks which incorporate PIN, but no details are given as to whether these marks are present on the UK market, and for what goods or services.

22. Mr Parnham has filed two witness statements. The second replies to Ms Wilkinson-Duffy; not all of it is strictly in reply. For this reason, I informed the parties that I would only take into account paragraphs 3 and 4 and part of paragraph 7 of Mr Parnham’s second statement. As I have not found it necessary to summarise Ms Wilkinson-Duffy’s evidence, there is no need to summarise Mr Parnham’s reply.

23. Mr Parnham’s first witness statement consists of submissions as to the differences between the marks; comments about the status of the opponent’s rights (not all of which are pleaded in this opposition); and comments about the opponent’s extension of time request. Whilst I have borne it in mind, it is unnecessary to summarise Mr Parnham’s evidence.

Decision

24. Section 5(2)(b) of the Act states that:

“(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,

⁴ Case C-533/06.

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

The principles

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

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

(c) the average consumer normally perceives 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

26. None of the earlier marks are subject to proof of their use, which means that they must be considered across the notional breadth of the specifications. The specifications of the two applications are identical. There is little difference in the wording of the specifications of the earlier marks. Some of the contested goods and services are identical to the goods and services on which the opposition is based. For procedural economy, I will not undertake a full comparison of the goods and services listed above, but will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

Average consumer

27. 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*.

28. The parties' specifications cover a wide variety of goods and services, at varying degrees of cost. Some are highly specialist (e.g. industrial research), others less so (e.g. social networking), which means that there will be a variety of levels of attention paid. However, none of the goods and services are so cheap or fleetingly used that a low level of attention will be paid; at the very least, the level of attention will be normal. All the goods and services are far more likely to be purchased or selected as a result of visual inspection, rather than aural perception; particularly so in relation to the opponent's services for which it has provided evidence of use.

Comparison of marks

29. 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 Court of Justice of the European Union 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.”

30. 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.

31. The respective marks are:

Earlier marks	Applications
  <p>(pleaded against the first of the applications only)</p>  	 

32. The stylisation of the letter P in the first application will not go unnoticed, but it is the conjoined words which form the dominant part of the mark. Although stylised, the P device will still be seen as a P and so will be read through as part of the words. The overall impression of this mark is of the conjoined words ‘pin my deal’. In

contrast, the device at the start of the second application does not look like a P. I do not think the average consumer, unless engaged in an artificially high level of analysis, will see it as a P. The words are longer than the device and form the dominant part of the mark, the overall impression of which is of the conjoined words 'in my deal'.

33. The overall impression of the opponent's word marks is a) of an invented word Pinterest and b) of the words Pin it. The letter P is stylised, but not excessively so. It is clearly a P. It carries less weight in the overall impression than the words. The border around the Pin it mark carries very little, if any, weight in the overall impression: it will just be seen as a border.

34. The overall impression of the other two of the earlier marks is of the stylised letter P. The black circle upon which the white P is superimposed will be seen as a necessary background so that the white representation of the letter can be seen.

35. There is no overall similarity between the opponent's Pinterest mark and either of the applications. The second application is even less similar to the opponent's mark than the first application in which at least the first letter will be seen as a P. Any visual similarity between the P in the first application and the P in the Pinterest mark is lost in the overall comparison of the marks. Although Pinterest and the first application contain the letters Pin at the start, Pinterest is an invented word which evokes the word interest, whilst the first application refers to the locating of a deal. The second application, 'in my deal', is impenetrable in meaning.

36. There is no overall similarity between the opponent's Pin it mark and the second application, the only common point being the letters 'in'. This very low level of visual and aural similarity, in the absence of any conceptual similarity, is insufficient to create any level of overall similarity.

37. There is a low level of similarity between the opponent's Pin it mark and the first application. This is because both marks begin with the word Pin and convey an impression of pinning something; albeit, an undefined something in Pin it, and a defined something (a deal) in Pinmydeal. That said, there are conceptual, visual and aural differences, which offset the similarities, so that the comparison reveals no more than a low level of similarity overall.

38. There is a very low level of visual similarity between the black P device and the first application, no aural similarity and no conceptual similarity. There is no overall similarity. This mark is not pleaded against the second application (but if this is a mistake and it should have been, there is no similarity).

39. There is a very low level of similarity between the white P device and the first application. This is probably the high point of the opponent's case as the white p on a black background creates a point of visual similarity. However, viewed against the whole of the mark, for which there is no aural or conceptual similarity, the overall similarity is very low. There is no similarity at all between the white P device and the second application.

Distinctive character of the earlier marks

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. The opponent’s evidence reveals a substantial reputation but only in respect of the earlier Pinterest mark (IR 1187515) (and its word-only equivalent). There is very little in the way of evidence of any of the other marks by themselves. I have considered whether the use of the Pinterest mark entitles the opponent to rely upon the P logo, the black form of which appears as the first letter in the Pinterest mark. In *Société des Produits Nestlé SA v Cadbury UK Ltd*, Case C-215/14, the CJEU held:

“63 So far as, specifically, the acquisition of distinctive character in accordance with Article 3(3) of Directive 2008/95 is concerned, the expression ‘use of the mark as a trade mark’ must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the goods or services as originating from a given undertaking (judgment in *Nestlé*, C-353/03, EU:C:2005:432, paragraph 29).

64 Admittedly, the Court has acknowledged that such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, it has added that in both cases it is important that, in consequence of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (judgment in *Nestlé*, C-353/03, EU:C:2005:432, paragraph 30, and, in

⁵ Case C-342/97.

connection with Regulation No 40/94, Article 7(3) of which corresponds, in essence, to Article 3(3) of Directive 2008/95, the judgment in *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 27).

65 Therefore, regardless of whether the sign is used as part of a registered trade mark or in conjunction with the registered trade mark, the fundamental condition is that, as a consequence of that use, the sign for which registration as a trade mark is sought may serve to identify, in the minds of the relevant class of persons, the goods to which it relates as originating from a particular undertaking (see, to that effect, judgment in *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 28).

66 It must therefore be concluded, as indicated in points 48 to 52 of the Advocate General's Opinion, that although the trade mark for which registration is sought may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of the registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate.

67 Having regard to those considerations, the answer to the first question is that, in order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95, regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company”.

42. The opponent's evidence does not establish that the average UK consumer, at the date of application, perceived the P device as designating the services for which the Pinterest mark has been used, separately from the presence of the Pinterest mark. The Pinterest mark has a high level of inherent distinctive character as it is an invented word which does not describe or allude to the goods and services for which it is protected. The use shown is only in relation to the protected class 38 services and some of its protected class 42 services:

Class 38 *Electronic bulletin board services.*

Class 42 *Providing a platform featuring technology that enables internet users to create, upload, bookmark, view, annotate, share and discover data, information and multimedia content; computer services, namely, creating an online community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of general interest; providing a website featuring non-downloadable software that enables electronic communications network users to create, upload, bookmark, view, annotate, share and discover data, information and media content; providing a platform featuring non-downloadable software that enables electronic communications network users to create, upload, bookmark, view, annotate, share and discover data, information and media content; hosting an interactive platform and online*

non-downloadable software for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and other user-generated content.

43. If it is possible to enhance the already high level of inherent distinctive character of the earlier Pinterest mark for these services, the level of use of the Pinterest mark in the UK entitles the opponent to an enhanced level of distinctive character. In relation to the other marks, Pin it has a low degree of inherent distinctive character for goods and services which allow one to pin something to a virtual notice board; for other goods and services it is of average inherent distinctive character. The P devices are of average inherent distinctive character.

Likelihood of confusion

44. In *Ravensburger AG v OHIM*, Case T-243/08, the General Court (“GC”) held that:

“27. It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

On further appeal the CJEU held in *Gateway v OHIM*, Case C58/08 P, that it was not necessary for the GC to make apparent the degree of renown of the earlier mark because it was not relevant in circumstances where the marks as a whole were not similar. In these proceedings, I have found that the Pinterest mark is not similar to any of the earlier marks. Its reputation cannot assist the opponent in the assessment as to whether there is similarity between marks. Further, there is no overall similarity between Pin it and the second application; no overall similarity in relation to the black P device (pleaded only against the first application); and no similarity between the white P device and the second application. The Court of Appeal held in *J.W. Spear & Sons Ltd & others v. Zynga Inc* [2015] EWCA Civ 290 (Floyd LJ giving judgment) that where there is no overall similarity between the competing marks, there is justification for not going any further in assessing whether there is a likelihood of confusion:

“58. Thus I do not consider that any of these cases provides direct authority which suggests that there is a minimum threshold of similarity. The cases suggest instead that overall similarity is a binary question. Where there is some overall similarity, even faint, then it is necessary to carry out the global assessment, taking account of all relevant circumstances. Moreover, in such cases, the enhanced distinctive character of the mark may play a role in increasing the likelihood of confusion.

59. On the other hand the cases do show that the General Court has said that where there is (a) average visual and phonetic similarity, but no

conceptual similarity (*Wesergold*), or (b) a number of visual and phonetic features which precluded the signs from being perceived as similar (*Ferrero*), or (c) no visual or phonetic similarity but a low degree of conceptual similarity (*Lufthansa*), or (d) a common suffix (*Kaul*), there may yet be no similarity overall between mark and sign. I have no difficulty with these conclusions: it is only overall similarity which counts.

60. Thus I would summarise the position in the following way:

i) The court should assess the phonetic, visual and conceptual similarity of mark and sign and decide whether, overall, mark and sign would be perceived as having any similarity by the average consumer.

ii) If no overall similarity at all would be perceived, the court would be justified in declining to go on and consider the likelihood of confusion applying the global appreciation test, as Article 9(1)(b) is conditional on the existence of some similarity. Such situations are not likely to occur often in contested litigation, but where they do occur, it is not legitimate to take account of any enhanced reputation or recognition of the mark.

iii) Where the average consumer would perceive some overall similarity, however faint, the court must go on to conduct the global appreciation test for the likelihood of confusion, taking account where appropriate of any enhanced reputation or recognition of the mark.

iv) In conducting the global appreciation test the court must take forward its assessment of the degree of similarity perceived by the average consumer between mark and sign.”

45. This means that the Pinterest marks do not need to be considered further in relation to the section 5(2)(b) ground (or to the 5(3) ground, as I shall go on to explain). Neither does the Pin it mark need to be considered further in relation to the second application, nor the black P device, nor the white P device in relation to the second application. The outcome is that there is no likelihood of confusion in relation to the second application because none of the earlier marks are similar to the second application. The opposition against the second application under section 5(2)(b) of the Act fails.

46. The remaining marks for which I must go on to conduct the global appreciation test are the white P device and the Pin it mark, both in relation to the first application. Deciding whether there is a likelihood of confusion is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*).

47. There is no likelihood of confusion. This is because, even assuming that all the goods and services are identical, the levels of similarity between the earlier marks and the application are very low; the distinctive character of the earlier marks is, at best, average; and, even if a relatively low level of attention was paid to the

purchase, the visual differences in what is a visual purchasing process will be enough to avoid confusion. The imperfect picture kept in mind will be wholly different. The opponent's claim relies too much on dissection of the marks, whereas marks are perceived by the average consumer as wholes. The marks will not be mistaken for one another and there is nothing about them, inherently, which would cause the average consumer to consider that they belong to the same or economically connected undertakings.

48. The ground under section 5(2)(b) fails in relation to both applications.

49. Section 5(3) of the Act states:

“A trade mark which—

is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

50. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the

future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

51. Similarity of signs under section 5(3) of the Act is assessed in the same way as for section 5(2)(b), as per *Adidas-Salomon*:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

52. There is no threshold of similarity but there must be similarity when the marks are compared overall. In Case C-254/09P, the CJEU rejected an appeal against a judgement of the General Court rejecting an opposition against a Community trade mark application under article 8(5) of the Community Trade Mark Regulation, which is analogous to s.5(3) of the Act. The court held that:

“68. It should be noted that, in order for Article 8(5) of Regulation No 40/94 to be applicable, the marks at issue must be identical or similar. Consequently, that provision is manifestly inapplicable where, as in the present case, the General Court ruled out any similarity between the marks at issue.”

53. There must also be a sufficient level of reputation, in combination with similarity of marks, for a link to be made. Where there is neither sufficient reputation, nor similarity of marks, the ground will fail. Accordingly, although the Pinterest mark has a reputation, it cannot succeed under section 5(3) because it is not similar to either of the applications. None of the other marks have a reputation (and some of them are not similar, as discussed above).

54. The ground under section 5(3) of the Act fails.

55. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

56. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

- i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant’s goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant’s misrepresentation.

57. The signs relied upon under section 5(4)(a) are the stylised version of Pinterest (which corresponds to the earlier IR), pleaded against the first application, and the word-only sign Pinterest (pleaded against the second application). Although the

signs are possessed of a significant level of goodwill in relation to the services I have set out at paragraph 42, it follows from my earlier findings that the lack of any overall similarity between the opponent's signs and the applications means that there will be no misrepresentation. The section 5(4)(a) ground fails against both applications.

Outcome

58. The oppositions fail against both applications under all three grounds.

Costs

59. The opponent has been unsuccessful. The applicant is entitled to a contribution towards its costs. In its written submissions of 17 September 2015, the applicant submitted that a costs award should be made on the usual scale, taking into account the consolidation of the two applications. I will not make a full award for the applicant's evidence as it was irrelevant to the issues to be decided, but I will make a small award for replying to the opponent's evidence about the PINGAY decisions. I will also make an award for considering the opponent's sizeable evidence.

60. The award breakdown is:

Considering the two oppositions and preparing and filing two counterstatements	£300
Preparing evidence and considering the opponent's evidence	£700
Written submissions	£300
Total	£1300

61. I order Pinterest, Inc to pay Andrew Terence Smith the sum of £1300 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 6th day of October 2015

**Judi Pike
For the Registrar,
the Comptroller-General**