

O-289-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3154420
BY TICTRAC LIMITED**

TO REGISTER:



AS A TRADE MARK IN CLASSES 9, 16, 35, 36, 38, 41 & 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 407042 BY UDG UNITED DIGITAL GROUP GMBH**

BACKGROUND & PLEADINGS

1. On 11 March 2016 (claiming an International Convention priority date of 23 February 2016 from an earlier filing in the United States of America), Tictrac Limited applied to register the trade mark shown on the cover page of this decision for the goods and services shown in paragraph 9 below. The application was published for opposition purposes on 27 May 2016.

2. On 22 July 2016, the application was opposed in full by UDG United Digital Group GmbH (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the owner of the following European Union Trade Mark (“EUTM”) No. 12591038:



The EUTM was filed on 12 February 2014 and entered in the register on 21 August 2014. It is registered for, and the opponent relies upon, the goods and services shown in paragraph 9 below.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by HGF Limited and the applicant by Kilburn & Strode LLP. Although neither party filed evidence or elected to attend a hearing, both filed written submissions in lieu of attendance at a hearing.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the

Act. As a consequence, the opponent is entitled to rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

8. The following principles are gleaned from the decisions of the courts of the European Union 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 greater degree of similarity between the marks, and vice versa;

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

(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

9. The competing goods and services are as follows:

The opponent's goods and services	The applicant's goods and services
<p>Class 9 - Analogue and digital data carriers for sound, Images or data; Computer software, recorded; Computer search engine software; Computer programs and Machine readable data carriers of all types with programs installed; Magnetic data carries; CDs, CD-ROMs and DVDs.</p> <p>Class 35 - Computerised file management; Updating of advertising material; Business management and organization consultancy; Business consulting services; Computerised file management; Dialogue marketing; Advertising agencies; Auctioneering services; Transcription of communications [office functions]; Business investigation; Business efficiency expert services; Television commercials; Business management; Publication of publicity texts; Business information; Searches for customers and promotion of customer loyalty via mail advertising; Layout services for advertising purposes; Marketing for third parties in digital networks; Market research; Data search in computer files for others; Public relations services; On-line advertising on a computer network; Arranging and conducting of advertising events; Planning services for</p>	<p>Class 9 - Computer software platforms comprised of computer software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting of data; communication software for the transmission of data, images, audio, and video; computer software designed to collect and process market information; software for the collection, analysis, and presentation of commercial, business and personal information and data; data compilations, namely, downloadable databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; data compilations, namely, databases of information recorded on CDs and DVDs and like digital media in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; consumer lifestyle databases, namely, downloadable databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; consumer lifestyle databases, namely, databases of information recorded on CDs and DVDs and like digital media in the</p>

<p>advertising; Presentation of companies on the Internet and other media; Presentation of goods on communications media for retail purposes; Publication of printed matter (including in electronic form), for advertising purposes; News clipping services; Word processing; Sponsoring in the form of advertising; Systemization of information into computer databases; Business consultancy and advisory services; Dissemination of advertisements; Writing of publicity texts; Sales promotion for others; Rental of advertising space on the internet; Providing of addresses for advertising purposes; Arranging advertising contracts, for others; Advertising by mail order; Direct mail advertising; Goods and services presentations; Advertising; Compilation of information into computer databases; Managing consortiums with regard to professional business and organisational matters; Creating product presentations and Internet presentations, namely presentations of goods and services on communications media for retailing, wholesaling and mail order.</p> <p>Class 36 - Managing consortiums with regard to financial matters; Financial affairs; Monetary affairs; Real estate affairs.</p> <p>Class 38 - Telecommunications, Including telecommunications by means of portals; Internet, online and data services, namely providing access to messages, information and data in data networks; Information about</p>	<p>fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; software for collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting of company data; customer targeting software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for customer targeting; customer profiling software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for customer profiling; local market planning software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for local market planning; direct marketing software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for direct marketing; advertising software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for advertising, competitor information software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data of competitors; market analysis software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for market analysis; business research software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for business research;</p>
--	--

<p>telecommunication; Providing user access to global computer networks; Electronic transmission of information on the Internet; News agencies; Electronic mail; Electronic bulletin board services [telecommunications services]; Electronic mail; Computer aided transmission of messages and images; Telecommunications by means of platforms and portals on the Internet; Providing access to databases; Providing of access to data and information on the Internet regarding the development, creation, programming, production, implementation, dissemination, sale, distribution, application, use, function, handling, modification, maintenance, rental, updating, design and outsourcing of computer programs and software.</p> <p>Class 41 - Education; Providing of training; Entertainment; Sporting and cultural activities, Publishing of electronic publications; Arranging professional workshop and training courses; Publication of printed matter; Organisation of seminars; Editorial support for Internet websites for brand and/or product representation; Editorial support for Internet websites concerning the Internet and Internet applications; Training and further training consultancy; Education using digital media for the presentation and distribution of learning materials and/or for supporting interpersonal communication and e-learning, in particular for use on the Internet; Computer-assisted and/or network-based collaboration (educating)</p>	<p>computer software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting of marketing, advertising and personal consumer data; downloadable electronic publications in the nature of reports, articles, magazines, newsletters, weblogs and blogs, books, journals, brochures, catalogues, forms, manuals, directories and guides in electronic form in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development supplied online from databases or facilities provided on the Internet including websites; computer software and telecommunications apparatus in the nature of portable telecommunication instant messaging devices, pagers, mobile phones, and personal digital assistants enabling connection to databases and the Internet; telecommunications apparatus in the nature of portable electronic devices for monitoring and analyzing consumer research and information, advertising, marketing, consumer lifestyles and personal development and enabling connection to databases and the Internet; computer software to enable the searching of data.</p> <p>Class 16 - Paper and paper articles, namely, note cards, note pads, envelopes, cardboard and cardboard articles, namely, signs, boxes, packaging, cartons, containers, and tubes, books, magazines, printed matter in the nature of journals, brochures and catalogues, and</p>
---	---

<p>and/or education and/or training; Correspondence courses; Publication of texts, other than publicity texts; Publication of electronic books and journals on-line; Instruction, in particular in sales support, marketing support, and product advertising and product description, also sales training, in particular based on and using digital media, in particular on the Internet; Creation of computer animations; Computer animation, namely digital visualisation, representation and presentation of products, processes, procedures and content, included in class 41.</p> <p>Class 42 - Computer hardware and software consultancy; Internet agencies, namely conception, optimisation, creation and updating of websites; Servicing and maintenance of Internet content; Inquiries, research in databases and on the Internet, for scientific and research purposes; Design and development of computer software; Computer software (updating of-); Updating of Internet pages; User management and authorisation on computer networks; Consultancy with regard to the design of homepages and Internet pages; Installing webpages on the Internet, for others; Provision of search engines for the Internet; Consultancy in the field of computers; Computer system analysis; Designing and creating homepages and Internet pages; Software design services; Computer programming; Digital image processing (graphic design); Electronic data</p>	<p>printed publications, namely, newspapers, all in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; stationery; decorative articles, namely, photographs, stickers, graphic prints, gift wrap of paper or plastic, calendars and diaries; writing materials, namely, pens, pencils, crayons, markers, writing paper; printed forms for the compilation of information; manuals in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.</p> <p>Class 35 - Compilation of data in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; compilation of commercial, business and personal information, for the purpose of preparing mailing lists in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; computerised compilation of customer indexes, namely, collection and compilation of customer information into computer databases; online data processing for the review of goods or services of companies or individuals, enabling customers to conveniently review, comment on and compare the goods or services of those companies or individuals; business research and advisory services; business consultation services; market analysis bureau services;</p>
---	--

<p>processing consultancy, namely in the field of information technology and relating to computer networks with different software environments, and relating to computers and software; Electronic data security; Creating and programming optimisation of websites; Preparation of data processing programmes; Creating and maintaining web sites for others; Installation and maintenance of Internet access software; Configuring computer networks by means of software; Data conversion of computer programs and data [not physical conversion]; Duplication of computer programs; Technical consultation services [all fields]; Rental and maintenance of memory space for use as websites for others (hosting); Rental of computers and software; Rental of web servers; Maintenance of software; Recovery of computer data; Providing or rental of electronic memory space on the Internet (webspace); Editing, Formatting and transferring of data onto blank data carriers (premastering); Technical and data processing consultancy in the field of marketing communications and data communications; Design, creation and development of digital media, namely brochure design, commercial design, consultancy regarding the design of advertising material, design relating to corporate image, design and development of multimedia products, design of advertising materials, design of audiovisual creative works, design of printed matter, design relating to the publishing and</p>	<p>data processing services; direct marketing and advertising services, customer loyalty services for commercial, promotion and advertising purposes, advertising analysis services, market and consumer information and research services, namely, providing information and conducting research on market penetration, competitors, customer profiling, consumer lifestyles, and consumer values; provision of online information regarding commercial, business and personal consumer data; market research; collection and interpretation of market research information; market research data collection services; commercial information agencies, namely, the provision of commercial information; market research and surveys; data compilations, namely, online databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; consumer lifestyle databases, namely, online databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; brokerage of name and address based lists, namely, brokerage of mailing lists.</p> <p>Class 36 - Financial information relating to personal development and education, provided online from a computer database or the internet.</p>
---	---

<p>reproduction of documents, visual design; Maintenance, rental and servicing of computer programs and software; Installing webpages on the Internet, for others.</p>	<p>Class 38 - Electronic web and video conferencing, and providing online discussion groups and focus groups in the nature of electronic bulletin boards and chat rooms all being in relation to self-help and self-improvement and in connection with the compilation and dispersal of commercial, business and personal data; transmission of news.</p> <p>Class 41 - Providing online electronic publications in the nature of magazines, journals and blogs, books, journals relating to consumer lifestyle information; news agencies, namely, gathering and dissemination of news and publishing services; education information relating to personal development and educational offerings, provided online from a computer database of the internet; publication of books, directories, guides, manuals and printed matter; information, advice and assistance relating to all the aforementioned services; training and education services, namely, classes, lectures, workshops, and instruction relating to computer software and hardware, business information systems, business research, data processing, direct marketing and advertising; lifestyle counseling in the nature of life coaching and training in the field of self-help, self-improvement, personal development, consumer research, and advertising and marketing; news reporting services in the field of financial news.</p>
--	--

	Class 42 - Providing a website featuring technology in the nature of user interfaces for setting and tracking challenges, projects and goals, offering online support for the setting and tracking of challenges, projects and goals, by which users can interact for recreational, leisure or entertainment purposes.
--	---

10. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

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

11. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This enquiry 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.

12. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

13. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“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”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-O-255-13:

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

Whilst on the other hand:

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

15. In *Separode Trade Mark* (BL-O-399-10), the Appointed Person, Mr Geoffrey Hobbs Q.C. stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

The comments of the CJEU in *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs (30) to (38) are also relevant.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

18. In their submissions, the parties devote a good deal of time to the comparison of the goods and services at issue in these proceedings. I have read them all and will refer to them to the extent I consider it necessary below. In its submissions, the applicant states:

“28...the opponent operates in the field of digital marketing...To summarise, the opponent’s focus is the development of digitalisation strategies for brands and

the implementation of “unique” brand experiences and the bringing of these to “measurable success” for businesses.

29. The applicant, on the other hand, operates a digital health platform aimed at large health and life insurers and health systems...The applicant collects personal data to set and track health and fitness goals. The platform also identifies and closes gaps in health care for individuals subscribed to the service through a company or organisation of which it is an employee...

30. Whilst we accept that there may be some overlap between some individual goods and/or services of the parties to the opposition, where there is considered to be a similarity between the respective goods and/or services, given that the respective target markets are entirely dissimilar, we submit that the uses (provision of digital marketing services and related goods v provision of health related goods and services), end users (companies at large v individuals working within a company or organisation) and nature (marketing v health related) of the respective goods and services are dissimilar. Further, we submit that the respective goods, and/or services are not in direct competition since they cover different fields, are aimed at a different market and would not be used alongside each other.”

19. In its submissions, the applicant accepts that “there may be some overlap between some individual goods and/or services of the parties to the opposition”. Where such an overlap exists, it argues that the goods and/or services are dissimilar because “the respective target markets are entirely different.” It then goes on to identify those goods and services in its application which it considers are “in particular...dissimilar to the goods and/or services of the opponent” (paragraph 31 of its submissions refer). Insofar as the applicant’s arguments regarding the different markets the parties target are concerned, I begin by reminding myself that in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

20. As neither parties' specifications are limited in the manner to which the applicant refers, in approaching the comparison, I must, as the case law dictates, give the words in the competing specifications their natural meanings in the context in which they appear. I must not give them an overly liberal interpretation nor should I strain the words in the competing specifications unnaturally to produce an overly narrow meaning.

21. Before I begin the comparison, I note that both parties' specifications include the word “namely.” The Trade Marks Registry's Classification Guide provides the following guidance in this relation to this word:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

Although the words “including” and “in particular” also appear in the competing specifications, these words have no such limiting effect.

22. For the sake of convenience I will deal with the matter on a class-by-class basis grouping the goods and services together whenever I consider it is appropriate to do so.

Class 9

23. In its submissions, the applicant submits the following goods are “dissimilar to the goods and/or services of the opponent.”

“Data compilations, namely, downloadable databases of information in the fields of consumer research and Information, advertising, marketing, consumer lifestyles and personal development; data compilations, namely, databases of information recorded on CDs and DVDs and like digital media in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; consumer lifestyle databases, namely downloadable databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; consumer lifestyle databases, namely, databases of information recorded on CDs and DVDs and like digital media in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.”

24. The opponent’s specification in this class includes, inter alia, the term “computer software, recorded”; as this term is unlimited, it will include software for any purpose. Applying the principle outlined in *Meric*, it will include the applicant’s software shown below, which is, as a consequence, to be regarded as identical.

Computer software platforms comprised of computer software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting of data; communication software for the transmission of data, images, audio, and video; computer software designed to collect and process market information; software for the collection, analysis, and presentation of commercial, business and personal information and data; software for collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting of company data; customer targeting software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for customer targeting;

customer profiling software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for customer profiling; local market planning software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for local market planning; direct marketing software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for direct marketing; advertising software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for advertising, competitor information software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data of competitors; market analysis software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for market analysis; business research software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting data for business research; computer software for the collection, compiling, storing, processing, tracking, analyzing, presenting and transmitting of marketing, advertising and personal consumer data; computer software to enable the searching of data.

25. The opponent's specification includes "CDs, CD-ROMs and DVDs". As such goods may be either blank or recorded, they would include the following goods in the applicant's specification which are, as a consequence, to be regarded as identical:

Data compilations, namely, databases of information recorded on CDs and DVDs and like digital media in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.

And:

Consumer lifestyle databases, namely, databases of information recorded on CDs and DVDs and like digital media in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.

26. The applicant's specification also includes:

Data compilations, namely, downloadable databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.

And:

Consumer lifestyle databases, namely, downloadable databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.

27. The goods shown in paragraph 26 are simply the downloadable version of the applicant's databases provided on CD and DVD. Although the nature and method of use of the downloadable versions of the databases may differ, as (at the very least), the users, intended purpose and trade channels are likely to be the same, the applicant's downloadable databases are, in my view, to be regarded as highly similar to their counterparts provided on disc.

28. The application also contains the following:

Downloadable electronic publications in the nature of reports, articles, magazines, newsletters, weblogs and blogs, books, journals, brochures, catalogues, forms, manuals, directories and guides in electronic form in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development supplied online from databases or facilities provided on the Internet including websites.

29. In its submissions, the opponent states:

"13...The applicant's "downloadable publications" in class 9 are highly similar to the opponent's publishing services in class 35. In particular, these goods and

services target the same end user, serve the same purpose and may be in competition/complementary.”

30. The opponent’s specifications includes “Publication of publicity texts” and “Publication of printed matter (including in electronic form), for advertising purposes” in class 35 and, inter alia, “Publishing of electronic publications” in class 41. Given the likely similarity in (at least) the users, intended purpose, trade channels and the complementary nature of the goods and services I have identified, leads me to conclude the applicant’s goods are similar to (at least) the opponent’s services I have identified to, at the very least, a fairly high degree.

31. That leaves the following goods in the applicant’s specification to consider:

Computer software and telecommunications apparatus in the nature of portable telecommunication instant messaging devices, pagers, mobile phones, and personal digital assistants enabling connection to databases and the Internet.

And:

Telecommunications apparatus in the nature of portable electronic devices for monitoring and analyzing consumer research and information, advertising, marketing, consumer lifestyles and personal development and enabling connection to databases and the Internet.

32. In its submissions, the opponent states:

“13...The applicant’s “telecommunications apparatus and devices” are similar to the telecommunication services covered by the opponent’s earlier mark in class 35 (sic). Specifically, these goods and services target the same end user and are of a complementary nature.”

33. To the extent that the applicant's specification includes "computer software" for use in portable telecommunication devices, this would be encompassed by the opponent's "computer software, recorded" and is, as a consequence, identical on the *Meric* principle. Insofar as the applicant's telecommunications apparatus in the nature of portable telecommunication/electronic devices is concerned, the average consumer will, in my experience, be very familiar with the symbiotic relationship between telecommunication services and apparatus (such as handsets) to access those services and a pattern of trade in which undertakings provide both the goods and services mentioned under the same trade mark. The applicant's goods are complementary to the opponent's services and, as a consequence, similar to a fairly high degree.

Class 16

34. In its submissions, the opponent states:

"14. The goods in class 16 of the [application] are similar to the publication services covered in class 41 of the earlier mark. The service of publishing and the published matter are inextricably linked. These goods and services serve the same purpose, target the same end user and are highly complementary."

35. In its submissions, the applicant submits the following goods are "dissimilar to the goods and/or services of the opponent."

"Paper and paper articles, namely, note cards, note pads, envelopes, cardboard and cardboard articles, namely, signs, boxes, packaging, cartons, containers, and tubes; stationery; decorative articles, namely, photographs, stickers graphic prints, gift wrap of paper or plastic, calendars and diaries: writing materials, namely, pens, pencils, crayons, markers, writing paper."

36. Firstly, the opponent only directs its comments at those goods in the application which it refers to as "published matter". This could not on any reading include "writing

materials, namely, pens, pencils, crayons, markers” in the application. Such goods are not similar to the services the opponent has identified nor are they, in my view, similar to any of the other goods and services upon which the opponent relies.

37. The opponent’s specification in class 41 includes “Publishing of electronic publications”, “Publication of printed matter”, “Publication of texts, other than publicity texts” and “publication of electronic books and journals on-line.” Collinsdictionary.com defines “printed matter” as: “material that has been printed or published, such as newspapers, magazines, or books.” In my view, the average consumer will be aware of the well-established link/complementary relationship between publishing services and the following goods in the application, such that there is, in my view, a fairly high degree of similarity between them:

Books, magazines, printed matter in the nature of journals, brochures and catalogues, and printed publications, namely, newspapers, all in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; photographs, graphic prints, calendars and diaries; printed forms for the compilation of information; manuals in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development.

38. However, the same is not, in my view, true of:

Paper and paper articles, namely, note cards, note pads, envelopes, cardboard and cardboard articles, namely, signs, boxes, packaging, cartons, containers, and tubes, decorative articles, namely, stickers, gift wrap of paper or plastic, writing paper.

39. Even if the above goods have something printed upon them (which many of them may not), that does not, in my view, make them, to use the opponent’s words, “published matter”. While the users of such goods and the opponent’s publishing

services may be the same, that level of generality tells one little. The nature, intended purpose and method of use of the competing goods and services clearly differs. The competing goods and services are neither complementary nor competitive. The above goods are, in my view, not similar to the opponent's publishing services nor to any of the opponent's goods and services.

40. Finally, the application also includes the term "stationery". Collinsdictionary.com defines stationery as: "paper, envelopes, and other materials or equipment used for writing". . Approached on that basis bearing my comments above in mind, I find that stationery is not similar to any of the goods or services in the opponent's specifications.

Class 35

41. In its submissions, the applicant submits the following services are "dissimilar to the goods and/or services of the opponent."

"Online data processing for the review of goods or services of companies or individuals, enabling customers to conveniently review, comment on and compare the goods or services of those companies or individuals; market analysis bureau services; data processing services; provision of online information regarding commercial, business and personal consumer data; commercial information agencies, namely, the provision of commercial information; consumer lifestyle databases, namely, online databases of Information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; brokerage of name and address based lists, namely, brokerage of mailing lists."

42. The opponent's specification includes the terms "compilation of information into computer databases" and "systemization of information into computer databases", which are, in my view, broad enough to include all of the services in the application

shown below and which are, as a consequence, to be regarded as identical on the *Meric* principle:

Compilation of data in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; compilation of commercial, business and personal information, for the purpose of preparing mailing lists in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; computerised compilation of customer indexes, namely, collection and compilation of customer information into computer databases; data compilations, namely, online databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; consumer lifestyle databases, namely, online databases of information in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development;

43. The opponent's specification also includes the term "data search in computer files for others". This is, self-evidently, a data processing service which would encompass all of the applicant's data processing services shown below and which are, once again, to be considered as identical on the *Meric* principle. The applicant's data processing services would also, in my view, be encompassed by the opponent's "compilation of information into computer databases" and "systemization of information into computer databases" mentioned above.

Online data processing for the review of goods or services of companies or individuals, enabling customers to conveniently review, comment on and compare the goods or services of those companies or individuals; data processing services.

44. The application includes the following services:

Business consultation services; business research and advisory services.

45. The first term is simply an alternative way of describing “business consulting services” which appears in the opponent’s specification; the services are identical. The opponent’s “business consulting services are also, in my view, broad enough to include the applicant’s “business research and advisory services”. However, even if that is not the case, the opponent’s specification also includes, for example, “business information”, “business investigations” and “business consultancy and advisory services” which if not identical, are clearly similar to a high degree.

46. The application includes a range of services relating to marketing and advertising i.e.

Market analysis bureau services; direct marketing and advertising services, customer loyalty services for commercial, promotion and advertising purposes, advertising analysis services, market and consumer information and research services, namely, providing information and conducting research on market penetration, competitors, customer profiling, consumer lifestyles, and consumer values; provision of online information regarding commercial, business and personal consumer data; market research; collection and interpretation of market research information; market research data collection services; commercial information agencies, namely, the provision of commercial information; market research and surveys.

47. The opponent specification includes, for example, “advertising”, “dialogue marketing”, “searches for customers and promotion of customer loyalty via mail advertising”, “advertising agencies”, “marketing for third parties in digital networks”, “market research” and “sales promotion for others”. Once again, the services are either

identical, or if not identical, are clearly similar to the applicant's services to a high degree.

48. The opponent's specification includes "providing of addresses for advertising purposes" which includes "brokerage of name and address based lists, namely, brokerage of mailing lists" which appears in the application; the services are identical.

Class 36

49. In its submissions, the applicant argues that all of its services in this class are dissimilar to the opponent's goods and services. As the applicant's "financial information relating to..." would be encompassed by both "financial affairs" and "monetary affairs" in the opponent's specification in this class, the competing services are to be regarded as identical on the *Merit* principle.

Class 38

50. In its submissions, the applicant submits the following services are "dissimilar to the goods and/or services of the opponent."

"Electronic web and video conferencing in relation to self-help and self-improvement and in connection with the compilation and dispersal of commercial, business and personal data; transmission of news."

51. The opponent's specification in this class includes the term "telecommunications, including telecommunications by means of portals". As I mentioned earlier, the word "including" has no limiting effect. As a consequence, the opponent's "telecommunications" is broad enough to include both the applicant's "electronic web and video conferencing" and "providing online discussion groups and focus groups in the nature of electronic bulletin boards and chat rooms...; these services are identical on the *Merit* principle. In addition, as the applicant's "electronic bulletin boards and chat

rooms...” would be encompassed by the term “electronic bulletin board services” in the opponent’s specification, the services are, once again, identical on the *Meric* principle. As the final term in the applicant’s specification i.e. “transmission of news” would be included within (at least) the term “electronic transmission of information on the Internet”, in the opponent’s specification, these services are also to be regarded as identical on the *Meric* principle.

Class 41

52. In its submissions, the applicant submits the following services are “dissimilar to the goods and/or services of the opponent.”

“Lifestyle counselling in the nature of life coaching in the field of self-help, self improvement personal development, consumer research, and advertising and marketing; news reporting services in the field of financial news.”

53. Although the opponent’s specification includes a range of services relating to education and training, it specifically includes the terms “education” and “providing of training”. As these terms are unlimited they will encompass education/training in all fields and would include the services in the application shown below which are to be regarded as identical.

Training and education services, namely, classes, lectures, workshops, and instruction relating to computer software and hardware, business information systems, business research, data processing, direct marketing and advertising; lifestyle counseling in the nature of life coaching and training in the field of self-help, self-improvement, personal development, consumer research, and advertising and marketing.

54. The applicant’s specification includes “education information relating to personal development and educational offerings, provided online from a computer database or

the internet". When one considers, for example, the users, intended purpose, trade channels and complementary nature of these services to the opponent's education/training services, the competing services are, if not identical, similar to a high degree.

55. The opponent's specification includes the phrases "publishing of electronic publications" and "publication of electronic books and journals on-line" which are broad enough to include "providing online electronic publications in the nature of magazines, journals and blogs, books, journals relating to consumer lifestyle information" in the application which is, once again, to be regarded as identical on the *Merit* principle.

56. "Publication of books, directories, guides, manuals and printed matter" in the application is encompassed by the term "publication of printed matter" in the opponent's specification and identical on the *Merit* principle.

57. The applicant's specification also includes the terms "news agencies, namely, gathering and dissemination of news and publishing services" and "news reporting services in the field of financial news"; I have commented upon the use of the word "namely" above. The use of the word "namely" means that the first phrase is to be interpreted as "gathering and dissemination of news and publishing services". The fact that the applicant uses the word "publishing" in the term mentioned indicates, in my view, that it considers (at the very least) the "dissemination of news" to be a publishing service. Approached on that basis and as news has to be gathered before it can be disseminated, both these services and the applicant's "news reporting services in the field of financial news" (the latter being included in the former), if not identical, are similar to a high degree to the opponent's various publishing services.

58. Finally, the applicant's specification includes the term "information, advice and assistance relating to all the aforementioned services." This term does not, however, relate to all the services in its specification in this class, but only to those services from the start of its specification in this class i.e. "Providing online electronic publications..."

to the term ending "...publication of books, directories, guides, manuals and printed matter." Given the obvious complementary nature of these services to the services to which they relate, they are, in my view, either identical or similar to the same extent as the services to which they relate.

Class 42

59. In its submissions, the opponent states:

"19. In class 42, the applicant's website provision services are identical and highly similar to the class 42 services covered by the earlier mark."

60. In its submissions, the applicant argues that all of its services in this class are dissimilar to the opponent's goods and services. The applicant's service in this class is, in effect, provision of a website featuring a user interface, whereas the opponent's specification in this class includes, inter alia, a wide range of website related services. In my view, the most obvious example of a term appearing in the opponent's specification which includes the applicant's service and which is, as a consequence, to be regarded as identical on the *Meric* principle, is: "conception, optimisation, creating and updating of websites". However, even if that conclusion is considered to be in error, the opponent's specification in this class includes a range of services such as "servicing and maintenance of internet content", "updating of Internet pages" and "consultancy with regard to the design of homepages and Internet pages". Given the likely overlap in the users, intended purpose, trade channels and complementary nature of (at least) the opponent's services I have identified and those of the applicant, results, in my view, in at least, a medium degree_of similarity between them.

The average consumer and the nature of the purchasing act

61. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then

determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

62. In its submissions, the applicant states:

“17. The opponent operates a digital marketing agency and the applicant operates a digital health platform. The average consumer of the respective goods and services will be a member of either the marketing professional public or healthcare profession or the general public. The selection process for the goods and services in question would have a strong visual element, although there would also be a significant aural and conceptual element as the goods and services in question may be selected or recommended aurally. The respective goods and services of the applicant and the opponent may be purchased directly or online. The level of attention paid will be reasonable for the respective goods and services, as the average consumer will pay attention to the type of service being selected, the quality, features and price thereof.”

63. As I mentioned earlier, the parties’ specifications are not limited in the manner the applicant suggests. In the same way as those submissions were not relevant to my approach to the comparison of goods and services, they are also not relevant to the

assessment of the identification of the average consumer. That does not, however, mean that all of the applicant's submissions are without merit.

64. I agree with the applicant that the average consumer of the disparate range of goods and services at issue in these proceedings will be both members of the general public and business users buying on behalf of a commercial undertaking (which would include, but is not limited to, the professional groups the applicant identifies). I also agree that both visual and aural considerations will feature in the selection process. As both the goods and services at issue are more likely than not to be obtained by self-selection from (where appropriate) a bricks-and-mortar retail outlet or from the equivalent pages of a catalogue or website, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations (in the form of word-of-mouth recommendations and oral request to sales assistants both in person and by telephone) can be discounted.



65. As to the degree of care the average consumer will display when selecting the goods and services at issue, the applicant pitches this as "reasonable". Whilst that may be true of some of the goods and services at issue, I note that the cost and importance of many of the goods and services at issue will vary considerably. Contrast, for example, a member of the general public selecting an inexpensive notepad (and paying a low degree of attention during that process) with a business user wishing to engage a company to promote its goods and services. As the latter services are likely to be of considerable importance to the well-being of a commercial undertaking and as any purchasing decisions made in relation to such services is likely to involve not insignificant financial outlay (and may also involve, for example, meetings with potential suppliers), I would expect the average business user to pay a high degree of attention to the selection of many of the goods and services at issue. I will return to this point later in this decision when I consider the likelihood of confusion.

Comparison of trade marks

66. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, 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.”

67. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

The opponent's trade mark	The applicant's trade mark
	

68. In its submissions, the opponent states:

5. The contested mark consists of a figurative depiction of a fingerprint placed above a word element TICTRAC. The earlier mark comprises a figurative depiction of a fingerprint only.

6. Visually, the marks differ by the presence of the word element TICTRAC in the contested mark which has no counterpart in the earlier mark. The marks are visually similar insofar as the fingerprint depictions contained in both marks are of a highly similar composition. In particular, both depictions are in the style of black and white drawings (as opposed to photographic or scientific depictions). In both marks, the fingerprint depictions comprise a number of lines curving around a central point. The lines do not connect at this point in either of the depictions. The angles of the curved lines in both depictions are highly similar and the outermost lines cease at near identical locations in both marks. The depictions convey a highly similar visual overall impression.

7. As the earlier mark is purely figurative, it is not possible to phonetically compare the marks.

8. Marks are conceptually identical or similar when they are perceived as having the same or a similar semantic content. The marks at issue are conceptually identical as they share the common fingerprint element. The conceptual impression has a very high impact in a comparison of the above marks and has a significant contribution to the overall impression produced by the marks, The TICTRAC element does not have any conceptual meaning and thus does not detract from the identical semantic content of both marks.

9. The effect of the visual and phonetic similarities is increased by the fact that the average consumer normally perceives a sign as a whole and does not

proceed to analyse its various details. Consumers rarely have the chance to make a direct comparison between different marks but instead must rely on their imperfect recollection of them...A reliance on such an imperfect recollection for the marks at issue means that there is a heightened risk of confusion between the earlier mark and the contested mark.

10. The trade marks are visually and conceptually highly similar, and cannot be phonetically compared.”

69. In its submissions, the applicant states:

“20. We submit that the respective marks are visually dissimilar. The Opponent’s mark consists of a simple device in the form of a fingerprint, whereas the Applicant’s mark consists of the distinctive word element TICTRAC, together with a device resembling a racing track. Within the Applicant’s device the letters T, I and C can clearly be perceived, drawing a link between the TIC element of the applicant’s word mark and the device element. There are fewer lines in the Opponent’s mark than appear in the Applicant’s device element and the lines in the Opponent’s mark are bolder than those in the Applicant’s mark. Further, the lines appearing in the respective devices flow in opposite directions.

21. The Opponent’s mark does not contain a verbal element and it is therefore not possible to make a direct phonetic comparison of the respective marks. This principle has been confirmed in the [GC’s] decisions in Cases T-5/08 to T-7/08 *Golden Eagle and Golden Eagle Deluxe*, in which it stated:

“...as the earlier marks contain no word element, a phonetic comparison between the marks at issue is not relevant. It cannot be argued that there is a phonetic similarity between the marks at issue because the consumer, when describing the marks at issue, would use expressions like ‘red mug’ and coffee beans’, When referring to the marks applied for the public will

cite their word element but not describe their figurative element.”

(Emphasis added)

22. Further, as is established case law (T-312/03 *Selenium Ace*) when signs consist of both verbal and figurative elements, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements.

23. It follows that, when describing the Opponent’s figurative mark, the relevant public are likely to use the expression ‘fingerprint logo’, whereas they would describe the Applicant’s mark using the word element “TICTRAC” rather than describing the figurative element.

24. Following on from our comments above, from a conceptual point of view, we submit that the Opponent’s earlier mark will evoke the idea of a fingerprint in the mind of the relevant consumer. In contrast, the combination of the racing track device and the ‘word TICTRAC in the Applicant’s mark will call to mind the concept of a racing track.

25. Taking into account the visual, aural and conceptual differences between the respective marks, we submit that the overall impression given by the marks, bearing in mind their distinctive and dominant components, is one of dissimilarity.”

70. The opponent’s trade mark consists exclusively of a device; it is this device which conveys the overall impression and in which the distinctiveness lies. In its submissions, the opponent argues that this device is “a figurative device of a fingerprint” and in its submissions, the applicant agrees stating “the opponent’s mark consists of a simple device in the form of a fingerprint.”

71. The applicant's trade mark consists of two readily identifiable components. The first and largest component is what the applicant describes as a "device resembling a racing track" and which the opponent describes as "a figurative depiction of a fingerprint". Below this device appears the word "TICTRAC" presented in upper case letters in a fine font. This word is significantly smaller than the device component which appears above it. As far as I am aware (and there are no submissions to the contrary), both components are distinctive and both will, in my view, contribute to the overall impression the trade mark conveys. The device component appears first and is much larger than the word which appears below it. In *L&D SA v OHIM* [2008] E.T.M.R. 62, the CJEU stated:

"55. Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant."

72. Given its size and positioning, the device component will, in my view, make a greater contribution to the overall impression the applicant's trade mark conveys than the word which accompanies it. Having reached that conclusion, I turn to consider the letters which the applicant argues can "clearly be perceived" within the device component of its trade mark. If one looks very closely at the device component, it is possible to discern a stylised upper case letter "T" with an extended tale that curves to the right and rises vertically; within the bowl that is formed by the extended tale of the letter "T" there appears a line which the applicant states will be seen as a letter "I". The applicant further states that a letter "C" can also be seen within the device component. The letters "T", "I" and "C" within the device component are, states the applicant, a link to the "TIC" element of the word component appearing in its trade mark

and the device resembling a race track, a link to the “TRAC” element of the word component.

73. In my view, the so called letters which are said to appear within the applicant's device component are likely to go largely unnoticed by the average consumer. However, even if they are noticed, I think it most unlikely they will be discerned in the manner the applicant suggests. Given their size in the context of the trade mark as a whole they will, in my view, make little or no contribution to the overall impression conveyed or its distinctiveness.

74. Bearing those conclusions in mind, I will now compare the competing trade marks from the visual, aural and conceptual standpoints.

The visual comparison

75. The competing trade marks either consist of or contain a device component consisting of a combination of what both parties refer to as “lines” and which the opponent refers to as “curving around a central point”; descriptions I am happy to adopt. As the applicant points out, the lines in the opponent's trade mark are “bolder than those in the applicant's mark” and “flow in different directions”. Notwithstanding those differences, I agree with the opponent that “the angles of the curved lines in both depictions are highly similar and the outermost lines cease at near identical locations in both marks.” Having already concluded that the so called letters which appear within the applicant's device component will make little or no contribution to the overall impression conveyed, the competing device components are, in my view, similar to a fairly high degree. That is not of course the end of the matter, because the applicant's trade mark also contains the word “TICTRAC”. Considered overall, bearing in mind the size and positioning of this component in the context of the applicant's trade mark as a whole, the competing trade marks are, in my view, visually similar to an above average degree.

The aural comparison

76. Both parties appear to agree (as do I), that as the opponent's trade mark does not contain a word element a direct phonetic comparison of the competing trade marks is not possible. It is, however, well-established that when trade marks consist of a combination of word(s) and figurative element(s), the trade mark is most likely to be referred to by the word element. Despite the fact that the device component in the applicant's trade mark will make a greater contribution to the overall impression conveyed, I still think it is more likely than not that the applicant's trade mark will be referred to by the word "TICTRAC" which appears in it.

The conceptual comparison

77. In its submissions, the applicant states that the opponent's trade mark "will evoke the idea of a fingerprint in the mind of the relevant consumer"; I agree. As to its trade mark, the applicant states that "the combination of the racing track device and the word "TICTRAC"...will call to mind the concept of a racing track." Were the device (including the so called letters) the only component of the applicant's trade mark, the average consumer would, in my view, spontaneously interpret it as a fingerprint (possibly even more quickly than they might the fingerprint device forming the opponent's trade mark). Having concluded that the so called letters in the applicant's device component will go largely unnoticed, the average consumer will not, in my view, link them to the same letters appearing in the word "TICTRAC". Even if the average consumer was to notice that the word component of the trade mark contained letters which were phonetically equivalent to the word "TRACK" (and I see absolutely no reason why they would), given the obvious similarity of the applicant's device component to a fingerprint, I see no reason why the average consumer would make any link between the meaning that word conveys and the applicant's device component. In its submissions, the applicant further states that: "the TICTRAC element does not have any conceptual meaning and thus does not detract from the identical semantic content of both marks." I agree with that submission. In my view, the competing trade marks are conceptually identical.

Distinctive character of the earlier trade mark

78. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

79. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its submissions, the opponent states:

“20. The only element in the earlier mark is the figurative fingerprint depiction...The earlier mark enjoys a high level of distinctiveness, particularly because a fingerprint depiction is meaningless in respect of the goods and services for which the earlier mark is registered.”

80. The applicant has not commented upon the distinctiveness of the opponent's earlier trade mark. Whilst it could be reasonably argued that a device of a fingerprint may not be distinctive for some of the goods and services for which the opponent's trade mark is registered (computer software for searching for fingerprints in class 9 and electronic data security employing fingerprint technology in class 42 for example), the opponent's trade mark is a fairly stylised representation of a fingerprint. Considered on that basis, I find that absent use, it is possessed of an average degree of inherent distinctive character (as opposed to high as the opponent suggests).

Goods not considered to be similar

81. 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.”

82. Where there is no similarity in the competing goods and services there can be no likelihood of confusion. Having concluded that the goods in the application shown below are not similar to any of the goods and services in the opponent’s earlier trade mark, the opposition against them fails and is dismissed accordingly:

Paper and paper articles, namely, note cards, note pads, envelopes, cardboard and cardboard articles, namely, signs, boxes, packaging, cartons, containers, and tubes, stationery, decorative articles, namely, stickers, gift wrap of paper or plastic, writing materials, namely, pens, pencils, crayons, markers, writing paper.

Likelihood of confusion

83. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the

opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the applicant's goods in class 9 are either identical or similar to at least a fairly high degree to the opponent's goods/services;
- there is a fairly high degree of similarity between the opponent's publication/publishing services and the following goods in class 16 of the application: Books, magazines, printed matter in the nature of journals, brochures and catalogues, and printed publications, namely, newspapers, all in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development; photographs, graphic prints, calendars and diaries; printed forms for the compilation of information; manuals in the fields of consumer research and information, advertising, marketing, consumer lifestyles and personal development;
- the applicant's services in class 35 are either identical or similar to a high degree to the opponent's services;
- the competing services in class 36 are identical;
- the competing services in class 38 are identical;
- the applicant's services in class 41 are either identical or similar to a high degree to the opponent's services;
- the applicant's services in class 42 are at least similar to a medium degree to the opponent's services;

- the average consumers of the goods and services will include both members of the general public and business users;
- while the goods and services at issue will be selected by both visual and aural means, visual considerations are likely to dominate the selection process;
- the degree of attention paid to the selection of the disparate goods and services will vary from low to high;
- the overall impression conveyed by the opponent's trade mark and its distinctiveness lies in the device of which it is composed;
- although both components in the applicant's trade mark will contribute to the overall impression it conveys and its distinctiveness, the device component will, given its size and positioning, make a greater contribution to the overall impression conveyed than the word component which accompanies it;
- the competing trade marks are visually similar to an above average degree, aurally neutral and conceptually identical;
- the opponent's earlier trade mark is, absent use, possessed of an average degree of inherent distinctive character.

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

85. In reaching a conclusion, I begin by reminding myself that the goods and services which remain in the application are either identical or similar to the opponent's goods and services to at least a medium degree and that the opponent's trade mark is inherently distinctive to an average degree. Having also concluded that, inter alia, the

competing trade marks are visually similar to an above average degree and conceptually identical, I am satisfied that even in relation to those goods and services to which the average consumer will pay a high degree of attention during the selection process (thus making them less prone to the effects of imperfect recollection), there will be a likelihood of confusion. This is likely to be in the form of direct confusion i.e. from a visual perspective the competing trade marks will be mistaken for one another. However, even if that is not the case, the degree of visual similarity between the competing trade marks and, in particular, the identical conceptual messages the competing trade marks are likely to trigger in the mind of the average consumer (which will act as a hook to aid the average consumer's recall), will, in my view, lead to indirect confusion. The average consumer is, in my view, likely to assume that the applicant's trade mark is, for example, a variant form of the opponent's trade mark which is being used with a sub-brand i.e. "TICTRAC".

Overall conclusion

86. The opposition succeeds in relation to all of the goods and services in the application with the exception of the following goods in class 16:

Paper and paper articles, namely, note cards, note pads, envelopes, cardboard and cardboard articles, namely, signs, boxes, packaging, cartons, containers, and tubes, stationery; decorative articles, namely, stickers, gift wrap of paper or plastic, writing materials, namely, pens, pencils, crayons, markers, writing paper.

Costs

87. As the opponent has been overwhelmingly successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using that TPN as a guide, and making a "rough and ready" reduction to reflect the very limited nature of the applicant's success, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement: £200

Written submissions: £375

Official fee: £100

Total: £675

88. I order Tictrac Limited to pay to UDG United digital Group GmbH the sum of £675. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of June 2017

C J BOWEN

For the Registrar

The Comptroller-General