

O/200/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3330355 BY  
FRANK LONDON LIMITED  
TO REGISTER:

**FRANK**  
L O N D O N

AS A TRADE MARK IN CLASSES 9, 39 & 42

AND

IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 415558 BY  
THE SECRETARY OF STATE FOR HEALTH AND SOCIAL CARE

## **BACKGROUND AND PLEADINGS**

1. Frank London Limited (“the applicant”) applied to register the trade mark on the front cover of this decision in the United Kingdom on 8 August 2018. It was accepted and published in the Trade Marks Journal on 23 November 2018 in respect of the goods and services in Classes 9, 39 and 42 and which are shown in paragraph 36 of this decision.

2. The application was opposed by The Secretary of State for Health and Social Care (“the opponent”) on 22 February 2019. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all goods and services of the application.

3. With regards to its claims based upon sections 5(2)(b) and 5(3) of the Act, the opponent is relying upon the following earlier marks:

a) UK Trade Mark No. 3146979 (“the 979 mark”):

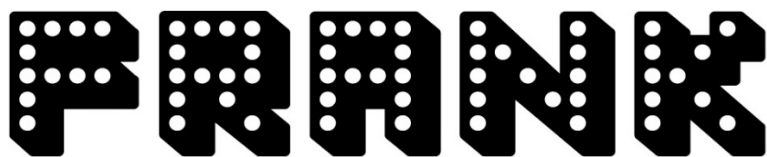
TALK TO FRANK

Filing date: 29 January 2016

Registration date: 22 April 2016

Registered for goods and services in Classes 9, 16, 35 and 41 shown in paragraph 36 of this decision. The opponent is relying on all these goods and services.

b) UK Trade Mark No. 3146981 (“the 981 mark”):



Filing date: 29 January 2016

Registration date: 29 July 2016

Registered for the goods and services in Classes 9, 16 and 41 shown in paragraph 36 of this decision. The opponent is relying on all these goods and services.

4. Under section 5(2)(b), the opponent claims that the contested mark is closely similar to the earlier marks and that the applicant's goods and services are identical or similar to the opponent's goods and services, and that, as a result of this similarity, there is a likelihood of confusion, including a likelihood of association.

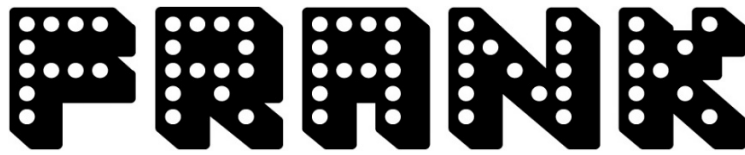
5. With regards to its claim based upon section 5(3), the opponent claims that its earlier marks enjoy an enhanced reputation in the UK on account of the use made of them in relation to the goods and services for which they are registered and that use by the applicant of the contested mark without due cause is likely to take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier marks. In particular, it claims that:

- if the contested mark is used in relation to goods or services that are inferior in nature and quality to those provided by the opponent, this is likely to lead to damage to the opponent's reputation;
- the contested mark takes advantage of the earlier marks by free-riding on the coat-tails of the opponent's registrations in an attempt to trade upon the opponent's reputation; and/or
- the contested mark may cause detriment to the distinctive character of the earlier marks because it is likely to weaken the ability of the opponent's registrations to identify the goods and services for which they are registered and used as being produced by or on behalf of the opponent.

6. Under section 5(4)(a) of the Act, the opponent claims that use of the contested mark is liable to be prevented under the law of passing off, owing to its goodwill attached to the following signs, which it claims to have used throughout the UK since 2003:

**FRANK**

## TALK TO FRANK



7. The goods and services in relation to which the opponent claims to have used the above signs are as follows:

### Goods

*Downloadable news, information and publications supplied over a global communication network; films bearing recorded educational material; audiovisual teaching materials; printed matter relating to health education; paper, cardboard, stationery, instructional and teaching material, printed publications, educational materials in printed form; booklets; books; leaflets; printed publications; exercise books; pens; handbooks; letters; magazines; manuals; newsletters; pamphlets; promotional pamphlets and publications; plastic covered cards bearing printed matter; printed matter for advertising purposes; printed matter for educational purposes; printed matter for instructional purposes.*

### Services

*Education; arrangement of conferences for educational purposes; arrangement of seminars, workshops and exhibitions for educational purposes; publication of books; writing of texts other than publicity texts; educational information and services; instructional services; provision of on-line electronic publications (not downloadable from the Internet); production of video-tapes for corporate use in corporate educational training; publication of educational material; providing of training; entertainment; arranging, organising and conducting conferences, exhibitions, seminars, symposia and classes; production of films, videos, radio and television programmes; publishing services, including publishing educational material such as books and texts; electronic publishing; instruction courses relating to physical fitness; information, advisory and consultancy services relating to all the aforesaid.*

8. The applicant filed a defence and counterstatement, denying all the grounds and putting the opponent to proof of use of its earlier mark.

9. The opponent filed evidence in these proceedings. This will be summarised to the extent I consider necessary.

10. Neither party requested a hearing. The opponent filed written submissions in lieu of a hearing on 20 November 2019. These will not be summarised but will be referred to as and where appropriate during this decision, which I have taken following a careful consideration of the papers.

11. In these proceedings, the opponent is represented by Mathys & Squire LLP and the applicant by The Brooke Consultancy LLP.

## **PRELIMINARY ISSUE**

12. In its counterstatement, the applicant denies that the contested mark is similar to either of the earlier marks. It then states:

“6. Further, and or in the alternative, the Applicant’s Mark would not be declared invalid and therefore the use of the Applicant’s Mark does not amount to an infringement of the Opponent’s Marks by virtue of Section 11 of the Trade Marks Act 1994.

7. Furthermore, and or in the alternative, the alleged infringement is denied on the basis that the Applicant is using its own name (Section 11(2)(a) Trade Marks Act 1994). The Applicant is incorporated in England & Wales as a private limited company under the trade name of Frank London Limited after having changed its name from Frank Car Hire Limited.”

13. These proceedings purely concern the opposition to the application for registration. No infringement has been claimed here; and even if it had been, this Tribunal has no jurisdiction to deal with alleged infringements.

## EVIDENCE

14. The opponent's evidence comes from Mr David Townsend, Senior Campaign Manager of Public Health England, an executive agency of the Department of Health and Social Care. It is dated 22 July 2019.

15. Mr Townsend explains that the opponent's marks are used in relation to a national drug education service. He continues:

"The associated campaign 'Talk to Frank' is the longest running anti-drugs campaign the UK has had. The Opponent's Drug Advisory Service was launched in 2003 with a series of TV adverts. It aimed to support young people with access to accurate and accessible information about drug use and where to obtain help. The Opponent's Drug Advisory Service is used by over six million people each year and includes a 24-hour telephone helpline, email and text services, website and webchat. It remains a key means of providing accurate factual advice on the risks and effects of a range of drugs, as well as broader advice around substance abuse, including signposting to relevant services provided by third parties."<sup>1</sup>

16. The table below shows the number of visits to the website:

<b>Year</b>	<b>Number of hits on talktofrank.com</b>
2018	6,692,143
2017	10,260,749
2016	6,035,397
2015	9,958,312
2014	6,237,749

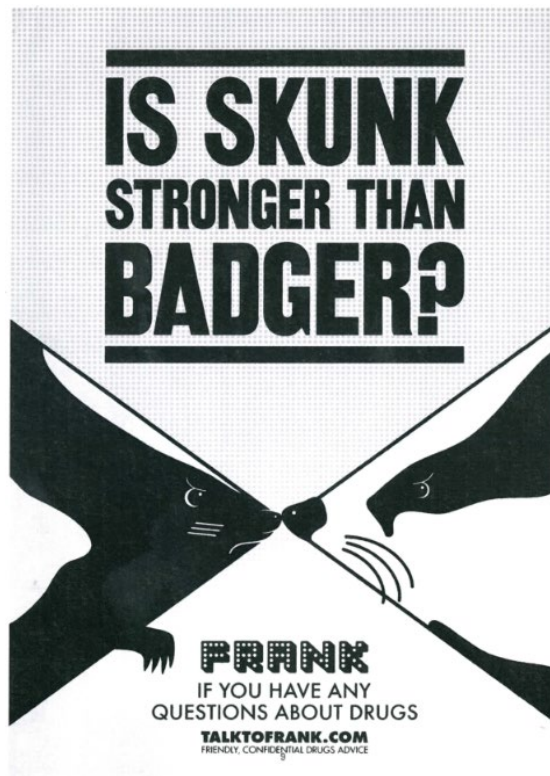
17. Exhibit DT2 consists of a series of screenshots from the website retrieved via the Wayback Machine. The earliest is dated 19 March 2004 and the latest 14 June 2018. An example is shown below:

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<sup>1</sup> Paragraph 5.



18. The marks are also used on posters and leaflets. A selection can be found in Exhibit DT4. All of these were available either from 6 October 2011 or 8 April 2013. I have reproduced an example which shows how the opponent uses its marks:



19. Mr Townsend states that the opponent’s drug advisory service is so well-known that organisations such as mental health charity Mind, Barnet Council, Dewis Cymru and Parenting Across Scotland, refer to it when providing details of drug information services.<sup>2</sup>

20. The table below shows the approximate marketing expenditure on the drugs advisory service:

<b>Year</b>	<b>Expenditure (£)</b>
2018	170,000
2017	250,000
2016	56,493
2015	50,934
2014	62,472
2013	75,306

21. These figures represent a drop from previous expenditure. According to a freedom of information release from 2011, £3.77 million was spent on advertising in the 2008/09 financial year and £5.07 million was the total budget for marketing and advertising in 2010.<sup>3</sup> A study commissioned into the effectiveness and awareness of the service, and dated 27 November 2017, noted that:

“While the site is well-used, there has been no recent marketing and the service has not been significantly altered since its inception.”<sup>4</sup>

22. Mr Townsend states that the opponent uses various types of media campaigns to advertise the service and refers to screenshots from YouTube contained in Exhibit DT6. Of the five videos shown here, four were first published in 2011 and the fifth in 2013.

23. I shall refer to the evidence in more detail where appropriate during my decision.

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<sup>2</sup> See Exhibit DT5 for screenshots from their websites. These all bear the date of printing: 2 July 2019.

<sup>3</sup> Exhibit DT9.

<sup>4</sup> Exhibit DT7, page 2.



## **DECISION**

### **Section 5(2)(b)**

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

“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.”

25. Section 5A of the Act states that:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

26. An “earlier trade mark” is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

(a) a registered trade mark, international trade mark (UK) or European Union 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.”

27. The earlier marks qualify as earlier trade marks under the above provision. As both the marks were registered within the five years before the date of the application for the contested mark, they are not subject to the proof of use requirement under section 6A of the Act and the opponent is therefore entitled to rely on all the goods and services for which the marks stand registered.

28. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (CJEU) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-529/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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***

29. When comparing the goods and services, all relevant factors should be taken into account, per *Canon*:

“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 complementary.”<sup>5</sup>

30. Guidance was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

31. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court (GC) clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06:

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<sup>5</sup> Paragraph 23.

“... 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.”<sup>6</sup>

32. While making my comparison, I bear in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... 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.”<sup>7</sup>

33. In *FIL Limited & Anor v Fidelis Underwriting Limited & Ors* [2018] EWHC 1097 (Pat), Arnold J (as he then was) considered how this principle should be applied in the case of services:

“... terms in specifications of goods and services should be given their ordinary and natural meaning, but this is subject to two overlapping qualifications: first, specifications of services are inherently less precise than specifications of goods, and therefore should be interpreted in a manner which confines them to the core of the ordinary and natural meaning rather

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<sup>6</sup> Paragraph 82.

<sup>7</sup> Paragraph 12.

than more broadly; and secondly, terms should not be interpreted so liberally that they become unclear and imprecise.”<sup>8</sup>

34. I bear in mind the judgment of the GC in *Gérard Meric v OHIM*, Case T-133/05, where it stated that:

“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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”<sup>9</sup>

35. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“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.”<sup>10</sup>

36. The goods and services to be compared are shown in the table below:

Opponent’s goods and services	Applicant’s goods and services
<p><u>Class 9 (Both marks)</u></p> <p><i>Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; computer software and computer hardware; downloadable news, information and publications supplied over a</i></p>	<p><u>Class 9</u></p> <p><i>Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; computer software for obtaining, arranging and booking transportation services;</i></p>

<sup>8</sup> Paragraph 86.

<sup>9</sup> Paragraph 29.

<sup>10</sup> Paragraph 5.

Opponent's goods and services	Applicant's goods and services
<p><i>global communication network; CDs, DVDs, CD-ROMs; films bearing recorded educational material; audiovisual teaching materials.</i></p>	<p><i>computer software for use by others to provide transportation services; computer software for navigation; computer software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; computer software for coordinating and obtaining delivery services; mobile application software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; mobile application software for navigation; mobile application software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; mobile application software for coordinating and obtaining delivery services; computer software; computer hardware; electronic publications (downloadable); downloadable software; mobile applications; telephones; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; cash registers, calculating machines, data processing equipment and computers; digital recording media; CDs; DVDs, CD-Roms; sunglasses; eyewear; computer peripherals.</i></p>
<p><u><i>Class 16 (Both marks)</i></u></p> <p><i>Adhesive printed matter; advertisements [printed matter], advertising material being printed matter; computer software in the form of printed matter; computer programmes in the form of printed matter; printed matter relating to health education; paper, cardboard, stationery, instructional and teaching material, printed publications, educational materials in printed form; booklets; books; leaflets; directories; charts, drawing instruments and materials; drawings and printed publications; exercise books; pens; handbooks; letters; magazines; manuals; newsletters; pamphlets; promotional pamphlets and publications; pictures; posters, memo books, year planners; personal organisers [printed matter]; plastic covered cards bearing printed matter; printed matter for advertising purposes; printed matter for educational purposes; printed matter for record keeping; photographs.</i></p>	<p><i>computer software for use by others to provide transportation services; computer software for navigation; computer software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; computer software for coordinating and obtaining delivery services; mobile application software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; mobile application software for navigation; mobile application software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; mobile application software for coordinating and obtaining delivery services; computer software; computer hardware; electronic publications (downloadable); downloadable software; mobile applications; telephones; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; cash registers, calculating machines, data processing equipment and computers; digital recording media; CDs; DVDs, CD-Roms; sunglasses; eyewear; computer peripherals.</i></p>
<p><u><i>Class 35 (979 mark only)</i></u></p> <p><i>Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of therapeutic, diagnostic and medical devices, software and medical equipment; market campaigns.</i></p>	<p><u><i>Class 39</i></u></p> <p><i>Car Hire; Car hire services; Arranging of car hire; Chauffeur driven car hire services; Hire of cars; Hired car transport; Rental of chauffeur driven cars; Transportation of passengers in chauffeur driven vehicles; Provision of hired vehicles; Provision of hired vehicles for the transport of passengers; Escorting of passengers; Escorting of travellers; Transportation of passengers;</i></p>

Opponent's goods and services	Applicant's goods and services
<p><u>Class 41 (Both marks)</u></p> <p>Education; arrangement of conferences for educational purposes; arrangement of seminars, workshops and exhibitions for educational purposes; publication of books; writing of texts other than publicity texts; educational information and services; instructional services; provision of on-line electronic publications (not downloadable from the Internet); production of video-tapes for corporate use in corporate educational training; publication of educational material; providing of training; entertainment; sporting and cultural activities; arranging, organising and conducting conferences, exhibitions, seminars, symposia and classes; production of films, videos, radio and television programmes; publishing services, including publishing educational material such as books and texts; electronic publishing; organisation of fitness activities at a gym or fitness suite; instruction courses relating to physical fitness; information, advisory and consultancy services relating to all the aforesaid.</p>	<p>Transportation of passengers and passengers' luggage; Transportation of passengers by road; Transportation of passengers in chauffeur driven vehicles; Transportation of passengers' baggage; Transportation of passengers' luggage; Transportation of people; Transportation of persons; Transportation services; Travel and transport reservation services; Arranging of transport and travel; Arranging transport for travelers; Planning and booking of travel and transport, via electronic means; Services for arranging the transportation of travellers; Transport of travelers; Travel agency services, namely arranging transportation for travelers; Travel and passenger transportation.</p> <p><u>Class 42</u></p> <p>Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers, and for coordinating and obtaining delivery services; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; Providing temporary use of online non-downloadable software for planning, scheduling, controlling, monitoring, and providing information on the transport of passengers, assets and goods; Providing temporary use of online non-downloadable software for providing information concerning pick-up and delivery of passengers, assets and goods in transit; Providing a web site featuring software that enables customers to manage and track pickup and delivery of passengers, assets, and goods; Providing</p>



Opponent's goods and services	Applicant's goods and services
	<i>temporary use of online non-downloadable software for coordinating and matching drivers and passengers for potential ridesharing; information, advisory and consultancy services relating to all of the aforesaid.</i>

*Class 9 goods*

37. The applicant's *Computer software; computer hardware; electronic publications (downloadable); apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; CDs; DVDs and CD-Roms* are self-evidently identical to goods in the opponent's specification.

38. The applicant's *Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; computer software for obtaining, arranging and booking transportation services; computer software for navigation; computer software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; computer software for coordinating and obtaining delivery services and downloadable software* are identical to the opponent's *computer software* under the *Meric* principle.

39. I agree with the opponent's submission that the applicant's *computers and computer peripherals* are identical to the opponent's *computer hardware* per *Meric*. In my view, the applicant's *data processing equipment* would also include *computer hardware*, and so they are identical. I also find that the applicant's *digital recording media* is identical to the opponent's *recording discs*, and the applicant's *Photographic and cinematographic apparatus and instruments* are identical to the opponent's *apparatus for recording, transmission or reproduction of sound or images* on the same principle.

40. The opponent submits that the following goods are also identical to its *Computer software*:

*mobile application software for coordinating transportation services, namely software for the automated scheduling and dispatch of motorized vehicles; mobile application software for obtaining, arranging and booking transportation services; mobile application software for navigation; mobile application software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; mobile application software for coordinating and obtaining delivery services; mobile applications.*

41. These goods are all computer software designed to run on a mobile device, so I agree with the opponent that under *Meric* they are identical.

42. The applicant's *telephones* are devices that are used to allow a person in one location to speak to someone elsewhere via a telecommunications network. In *Apple Inc v Swatch AG* [2017] EWHC 713 (Ch), Mr John Baldwin QC, sitting as a Deputy Judge of the High Court, stressed the importance of assessing the essential, rather than the incidental, features of the goods at issue. While it is the case that some telephones share a range of functions with computers or equipment for playing recordings, the essential function of a telephone (as a broad term) is to enable individuals to talk to each other. The users and the trade channels are the same and there is a fairly low degree of competition and complementarity between *telephones* and the opponent's *computer hardware or apparatus for recording, transmission or reproduction of sound and images*. I find there to be a low degree of similarity.

43. I turn now to the applicant's *scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments*. I have already dealt with *photographic and cinematographic apparatus and instruments* in paragraph 38 above.

44. The applicant's *teaching apparatus and instruments* share a purpose and users with the opponent's *instructional and teaching material* in Class 16 and *audiovisual teaching materials* in Class 9. Their nature is different, as the opponent's goods are printed or audiovisual material, but there will be an overlap in trade channels. There may also be some degree of complementarity, as *instructional and teaching material* could require the use of *teaching apparatus and instruments* and the average

consumer would assume that the goods were the responsibility of the same undertaking. I find there to be a medium degree of similarity between *teaching apparatus and instruments* and the opponent's *instructional and teaching material* and *audiovisual teaching materials*.

45. *Optical apparatus and instruments* are instruments that are intended to enhance the user's vision or analyse light waves. The opponent submits that all of the applicant's *apparatus and instruments* are similar to its goods relating to computer software as they are likely to be used together and therefore share a similar method of use and end users, while being complementary. While the end users may be the same, the purpose and nature of the goods are different. They will not share trade channels, nor are they in competition. The applicant's goods are specialist items which the average consumer will not expect to be the responsibility of the same undertaking that produces *computer software*.

46. However, it seems to me that there is a degree of similarity between *optical apparatus and instruments* and *apparatus for recording, transmission or reproduction of sound or images*. The nature of some of the apparatus in both categories will be similar, involving lenses which may, for example, be used to magnify or clarify an image. The purposes and trade channels will, however, be different, although there will be some overlap in the producers of the goods. Overall, I find that they are similar, but to a relatively low degree.

47. The opponent submits that the applicant's *life-saving apparatus and instruments* may be used in a medical setting and are therefore similar to its *Retail services connected with the sale of therapeutic, diagnostic and medical devices, software and medical equipment*. The opponent is correct to say that the classification system for goods and services is for administrative purposes. However, it is permissible to take the class number into account, where the meaning of the term is not otherwise sufficiently clear and precise: see *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)* [2018] EWHC 3608 (Ch). *Life-saving apparatus and instruments* is not a precise term. I therefore turn for assistance to the class number and note that Class 9 specifically excludes medical equipment and devices, which are included in Class 10. The types of life-saving

equipment covered by Class 9 include clothing to protect from bullets, radiation or chemicals, protective headguards for sport, smoke detectors and fire-fighting equipment. The distribution channels, users and purpose of these goods are different from those of the opponent's retail services. They are not in competition, and neither do I find them to be complementary. Consequently, I find the applicant's goods to be dissimilar to the opponent's services.

48. I find that *scientific, nautical, surveying, weighing, measuring, signalling and checking (supervision) apparatus and instruments* are also dissimilar to the opponent's goods, as they have different purposes, natures and trade channels. They are not in competition or complementary.

49. The applicant's *cash registers* are mechanical or electronic devices for registering and calculating monetary transactions. They are used by staff in a shop or other outlet, such as a bar, café or restaurant, when a customer purchases goods or services. There will be some overlap with the users of computer software and hardware, and electronic cash registers may be linked to computer systems. The average consumer would expect a supplier of cash management systems to supply both cash registers and associated software. Consequently, I find there is a degree of complementarity and a low degree of similarity between *cash registers* and *computer software and computer hardware*.

50. The opponent submits that the applicant's *Calculating machines* are similar to its Class 9 goods as they "all relate to, or can be used in conjunction with, computer, or smart, devices". *Calculating machines* are devices whose main function is to perform arithmetical calculations, while computers have a much broader range of uses. The users will be the same, as will the distribution channels. The goods are not strictly in competition, given the difference in functions. I find that *calculating machines* are similar to a medium degree to the opponent's *computer hardware*.

51. The opponent submits that the applicant's *eyewear and sunglasses* are similar to its *Retail services connected with the sale of therapeutic, diagnostic and medical devices, software and medical equipment* for the following reasons:

“Eyewear and sunglasses are frequently sold to consumers in order to manage health complaints such as glaucoma. The channels of trade and end users may therefore be the same as the Applicant’s goods, whilst the respective goods and services are likely also to be complementary.”

52. The purpose of the applicant’s goods is to correct deficiencies in vision and protect the eyes from bright sunlight, in the case of sunglasses. The users are members of the general public, and the goods are sold through specialist eyewear retailers and, in the case of non-prescription eyewear like sunglasses or reading glasses, general retailers. The goods consist of lenses, generally made from plastic, set in plastic or metal frames that enable the lenses to be placed in front of the eyes.

53. The opponent’s services therefore consist of selecting an assortment of therapeutic, diagnostic and medical devices, software and medical equipment and offering retail services to induce customers to buy them. The users will either be members of the general public or medical professionals, and the services are likely to be supplied by specialist retailers of medical goods. In my view, there is little real overlap between the suppliers of eyewear and sunglasses and the providers of the opponent’s retail services, neither do I find there to be competition. I find the goods to be dissimilar to the opponent’s services.

#### *Class 39 services*

54. The opponent submits that all the applicant’s Class 39 services are similar to the opponent’s *computer software and computer hardware* as

“the Opponent’s goods are commonly used to arrange and book the Applicant’s services. These respective goods and services are therefore likely to have the same end user, whilst being complementary.”

55. I agree that the end users are likely to be the same, but the purposes of the goods and services are dissimilar, as are the nature, methods of use and trade channels. They are not in competition and complementarity requires the average consumer to be likely to think that they are the responsibility of the same undertaking. It may well

be the case that *computer software and computer hardware* are indispensable for the delivery of at least some of the applicant's Class 39 services, but I do not believe that the average consumer will think that the same business supplies computer software or hardware and travel or transportation services. I find the goods and services to be dissimilar.

56. For a section 5(2)(b) claim to be successful, there must be some degree of similarity between the goods and/or services: see *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, paragraph 49. The section 5(2)(b) ground therefore fails in respect of the Class 39 services.

#### *Class 42*

57. I shall consider the following services as a group:

*Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers, and for coordinating and obtaining delivery services; providing temporary use of online non-downloadable software for planning, scheduling, controlling, monitoring, and providing information on transportation of passengers, assets and goods; providing temporary use of online non-downloadable software for providing information concerning pick-up and delivery of passengers, assets and goods in transit; providing temporary use of online non-downloadable software for coordinating and matching drivers and passengers for potential ridesharing.*

58. All these services involve providing temporary use of online non-downloadable software for arranging or providing information on a range of transportation services. There will be a degree of complementarity with the opponent's *computer software* as the average consumer may think that the goods and services are the responsibility of the same undertaking. They are also in competition: users could choose to purchase downloadable software or use non-downloadable software services as and when they need to do so. The end-users are the same, as is the purpose. I find the goods and services to be similar to a high degree.

59. I consider that the same reasoning applies in the comparison between the opponent's *computer software* and the applicant's *Providing a web site featuring software that enables customers to manage and track pick-up and delivery of passengers, assets and goods*.

60. The applicant's mark covers *design and development of computer hardware and software*. This service has some of the same users as the opponent's *computer software and computer hardware*. The nature of the goods and services differ, but there may be some overlap in trade channels. There is also a degree of complementarity, as the producers of hardware and software may also supply design and development services. I find the goods and services to be similar to a medium degree.

61. The applicant's *scientific and technological services and research and design* include services relating to the provision of information technology services. There will therefore be some overlap in nature with the opponent's *computer software and computer hardware* as these will be used for delivery of those services. There may be some overlap in trade channels, but there will be a degree of competition as software in particular may be supplied either as a good or as a service. Rental of computer software or hardware would, in my view, also be considered as a technological service. I find that there is a medium degree of similarity.

62. The applicant's *industrial analysis and research services* refer to activities performed in the field of science and technology involving research, examination and development of technological or scientific information. The services are usually undertaken by scientists or engineers. While these personnel conduct their research and experiments on computers, or sometimes provide education services, the goods and services have different end-users and purposes. They are not in competition, nor are they complementary. In my view, the applicant's services are dissimilar from the goods and services of the opponent. The opposition under section 5(2)(b) therefore fails in respect of these services.

## Summary

63. For convenience, I summarise my findings on the goods and services comparison below:

Applicant's Goods and Services	Comparison
<p><i>Computer software; computer hardware; electronic publications (downloadable); apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; CDs; DVDs; CD-Roms</i></p>	<p><b>Identical:</b> terms appear in both parties' specifications</p>
<p><i>Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; computer software for obtaining, arranging and booking transportation services; computer software for navigation; computer software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; computer software for coordinating and obtaining delivery services; Mobile application software for coordinating transportation services, namely software for the automated scheduling and dispatch of motorized vehicles; mobile application software for obtaining, arranging and booking transportation services; mobile application software for navigation; mobile application software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; mobile application software for coordinating and obtaining delivery services; downloadable software; mobile applications.</i></p>	<p><b>Identical</b> to computer software</p>
<p><i>Photographic and cinematographic apparatus and instruments</i></p>	<p><b>Identical</b> to apparatus for recording, transmission or reproduction of sound or images</p>



<b>Applicant's Goods and Services</b>	<b>Comparison</b>
<i>Data processing equipment and computers; computer peripherals</i>	<b>Identical</b> to computer hardware
<i>Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers, and for coordinating and obtaining delivery services; providing temporary use of online non-downloadable software for planning, scheduling, controlling, monitoring, and providing information on transportation of passengers, assets and goods; providing temporary use of online non-downloadable software for providing information concerning pick-up and delivery of passengers, assets and goods in transit; providing temporary use of online non-downloadable software for coordinating and matching drivers and passengers for potential ridesharing.</i>	<b>Highly similar</b> to computer software
<i>Teaching apparatus and instruments</i>	<b>Medium similarity</b> to instructional and teaching material and audiovisual teaching materials.
<i>Calculating machines</i>	<b>Medium similarity</b> to computer hardware
<i>Design and development of computer hardware and software; Scientific and technological services and research and design relating thereto.</i>	<b>Medium similarity</b> to computer software and computer hardware
<i>Telephones</i>	<b>Low similarity</b> to computer hardware or apparatus for recording, transmission or reproduction of sound and images
<i>Optical apparatus and instruments</i>	<b>Low similarity</b> to apparatus for recording, transmission and reproduction of sound or images.
<i>Cash registers</i>	<b>Low similarity</b> to computer software and computer hardware
<i>Sunglasses; eyewear</i>	<b>Dissimilar</b>

<b>Applicant's Goods and Services</b>	<b>Comparison</b>
<i>Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments</i>	<b>Dissimilar</b>
<i>Car Hire; Car hire services; Arranging of car hire; Chauffeur driven car hire services; Hire of cars; Hired car transport; Rental of chauffeur driven cars; Transportation of passengers in chauffeur driven vehicles; Provision of hired vehicles; Provision for hire vehicles for the transport of passengers; Escorting of passengers; Escorting of travellers; Transportation of passengers; Transportation of passengers and passengers' luggage; Transportation of passengers by road; Transportation of passengers in chauffeur driven vehicles; Transportation of passengers' baggage; Transportation of passengers' luggage; Transportation of people; Transportation of persons; Transportation services; Travel and transport reservation services; Arranging of transport and travel; Arranging transport for travelers; Planning and booking of travel and transport, via electronic means; Services for arranging the transportation of travellers; Transport of travelers; Travel agency services, namely arranging transportation for travelers; Travel and passenger transportation.</i>	<b>Dissimilar</b>
<i>Industrial analysis and research services</i>	<b>Dissimilar</b>

### ***The average consumer and the purchasing process***

64. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>11</sup>

65. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

66. The average consumer for most of the goods and services will either be a member of the general public or a business/professional. These goods and services are targeted at both. However, the goods and services highlighted in the table above will mainly be bought by businesses or professionals. They will tend to be relatively high in price and purchased infrequently (apart, perhaps, from *teaching apparatus and instruments*). These factors suggest that the average consumer will be paying a higher than average level of attention, although not the highest. The consumer will make their choice by looking through brochures and websites so the visual element will be important. However, I do not discount the aural element as word-of-mouth recommendations may also influence the consumer’s decision.

67. The remaining goods and services are targeted at both the general and business/professional public. Most of the goods and services are relatively low cost, or (as with eyewear and sunglasses) can range in price from fairly cheap to expensive. They will be bought online or in physical shops, and the consumer will see the marks on packaging, and also in advertising, brochures and websites. As above, the visual element will be most significant, but the aural element will also play a role, with word-of-mouth recommendations and advice from sales staff. The average consumer will be paying an average degree of attention.

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<sup>11</sup>Paragraph 60.

68. I make an exception to this analysis in the case of *computer hardware* and *computers*. These goods are not everyday purchases and are relatively expensive. The average consumer, even if they are a member of the general public, will want to ensure that the goods possess the features they require and it would not be unusual for the consumer to undertake some research before buying, given the cost of the items. The goods will be bought online or in shops, and assistance may be sought from sales staff. The visual and aural elements will be important, with perhaps the visual carrying a little more weight. In my view, the average consumer will pay a higher than average degree of attention, although not the highest.

### ***Comparison of marks***

69. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>12</sup>

70. It would be wrong, therefore, artificially to dissect the 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 created by the marks.

71. The respective marks are shown below:

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<sup>12</sup> Paragraph 34.

Earlier marks	Contested mark
<p>The 979 mark:</p> <p>TALK TO FRANK</p> <p>The 981 mark:</p> 	

72. The contested mark consists of the word “FRANK” in bold block capital letters, with the word “LONDON” in fine capitals below it. A standard font is used throughout. The opponent submits that “LONDON” merely describes the location in which the goods and services are provided, and so the word “FRANK” dominates the overall impression of the contested mark. I agree.

73. The opponent submits that the dominant and distinctive element of both of its marks is the word “FRANK”. With regards to the 979 mark, it submits that the words “TALK TO” are subordinate to “FRANK”, as “FRANK” “is the subject”. I am not persuaded that it is necessarily the case that a noun is dominant over a verb in a trade mark. Rather, it seems to me that the words will be read as a phrase and that the overall impression of the mark rests in that phrase.

74. The 981 mark consists of the word “FRANK” in stylised black block capitals, with a 3D effect. Within the black letters, the shape of each letter is presented again, this time in white dots. The stylisation serves to emphasise the word “FRANK”, which is dominant in the overall impression of the 981 mark.

*Visual comparison*

75. The opponent submits that the marks share a very high degree of visual similarity. The 981 mark is presented in black and white and in a stylised font, but the word “FRANK” is clear to the viewer. This is, as I have noted above, the word that is

dominant and distinctive in the applicant's mark. I find that these marks have a high degree of visual similarity.

76. The dominant and distinctive element in the applicant's mark appears at the end of the 979 mark, and comprises just under half of the letters in that mark (five out of eleven). The contested mark also has eleven letters, spread over two lines. I find the marks to have a medium degree of visual similarity.

#### *Aural comparison*

77. The opponent's marks will be articulated as written, with the 979 mark having three syllables and the 981 mark having one. In my view, given the presentation of the contested mark, the average consumer will not pronounce the word "LONDON". Consequently, I find that the contested mark is aurally identical to the 981 mark, while it has a medium degree of aural similarity to the 979 mark. If the average consumer were to pronounce both words, I would find that the contested mark is aurally similar to a medium degree to the 981 mark and to a lower degree to the 979 mark.

#### *Conceptual comparison*

78. The opponent submits that the average consumer will understand "FRANK" to signify a male name or to mean "open" or "honest". The word will have the same interpretation in both the contested and the 981 mark. The contested mark will additionally be seen to be a business operating in London, which will be well known to the average UK consumer as the capital city. I find the contested mark and the 981 mark to have a high degree of conceptual similarity, and the dominant and distinctive element of the contested mark is identical to the 981 mark. In the case of the 979 mark, the average consumer will interpret the mark as inviting a conversation with somebody called Frank. If the average consumer sees "FRANK" in the contested mark as a name, I find there to be a medium degree of conceptual similarity between the marks. If the average consumer sees it as meaning "open" or "honest", the marks are conceptually dissimilar.

### ***Distinctiveness of the earlier marks***

79. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

“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).”

80. The opponent submits that the earlier marks are inherently distinctive and that the distinctiveness of the name “FRANK” has been enhanced through use made of the earlier marks in the UK for over 15 years.

81. The word “FRANK” is, as I have already found, either a name or a dictionary word. The word does not describe any of the goods or services which are supplied under the 981 mark. If the average consumer understands it to be a word meaning “open” or “honest”, it could be seen to allude to a quality the consumer would expect to find in

*Downloadable news, information and publications supplied over a global communication network, instructional and teaching material and audiovisual teaching materials.* For these goods and services, the mark has a lower than medium level of inherent distinctiveness; for the remaining goods and services the inherent distinctiveness is medium. However, if the average consumer thinks “FRANK” is a name, given that it is fairly common in the UK, the inherent distinctiveness will be medium for all the goods and services. The phrase “TALK TO FRANK” does not describe, or allude to, the opponent’s goods or services either. The mark has a medium degree of inherent distinctiveness.

82. The evidence adduced by the opponent shows the level of use of the earlier marks in the UK since their launch in 2003. Mr Townsend states that the service has 6 million users a year, and between 2014 and 2018 the website received between 6 million and 10 million visits. It appears that marketing spend dropped in recent years, but was £250,000 and £170,000 in 2017 and 2018 respectively.

83. The 2017 study to which I referred in paragraph 21 found that 10% of 14-50 year olds in the UK had used the FRANK website to find information about illegal drugs (out of 52% of that population who had sought information from any source), and that the service was perceived as being authoritative, but friendly:

“If FRANK is your honest Mum, NHS is your annoying Dad telling you what you’re doing wrong.”<sup>13</sup>

84. The evidence shows that the 979 mark is used in the URL of the website and in the name of the YouTube channel.<sup>14</sup> However, elsewhere on the website, in news articles and in the study it is apparent that it is the 981 mark (“FRANK”) by which the service is distinguished. The goods and services shown in the evidence are information and advice on drugs. I find that the distinctiveness of the 981 mark has been enhanced through use in relation to the following goods and services:

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<sup>13</sup> Exhibit DT7, page 8.

<sup>14</sup> Exhibits DT2 and DT6 respectively.



Class 9

*Downloadable news, information and publications supplied over a global communication network; films bearing recorded educational material; audiovisual teaching materials; **all the aforesaid being related to drug advisory services.***

Class 41

*Educational information and services; instructional services; provision of on-line electronic publications (not downloadable from the Internet) **all the aforesaid being related to drug advisory services.***

**Conclusions on likelihood of confusion**

85. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 28. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>15</sup> The distinctiveness of the earlier mark must also be taken into account.

86. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods and services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind.<sup>16</sup>

87. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, gave helpful guidance on making the global assessment:

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<sup>15</sup> *Canon*, paragraph 17.

<sup>16</sup> *Lloyd Schuhfabrik Meyer*, paragraph 27.

“81.2 ... in my view it is important to keep in mind the purpose of the whole exercise of a global assessment of a likelihood of confusion, whether direct or indirect. The CJEU has provided a structured approach which can be applied by tribunals across the EU, in order to promote a consistent and uniform approach. Yet the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3 Third, when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set

out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.”

88. The goods and services that I found to be identical or similar to the applicant’s goods and services are all covered by the 981 mark, which I found to be the more similar of the opponent’s marks to the contested mark. For these goods and services, I found that the visual element would be most significant during the purchasing process, although the aural element would also play a role. The high degree of visual similarity between the 981 and the contested mark leads me to find that the average consumer is likely to be confused between the marks. In the contested mark, it is the word “FRANK” that is the dominant and distinctive element. I find that the average consumer will be directly confused. Even if I am wrong in this and the average consumer notices the word “LONDON”, they will, in my view, see this as a sub-brand, highlighting a geographical connection, or a variant mark used by the same undertaking, and be indirectly confused.

89. The section 5(2)(b) opposition succeeds in respect of the following goods and services:

Class 9

*Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; computer software for obtaining, arranging and booking transportation services; computer software for use by others to provide transportation services; computer software for navigation; computer software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; computer software for coordinating and obtaining delivery services; mobile application software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; mobile application software for navigation; mobile application software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; mobile application software for coordinating and obtaining delivery services; computer software; computer hardware; electronic publications (downloadable); downloadable software; mobile applications; telephones; Photographic, cinematographic,*

*optical and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; cash registers, calculating machines, data processing equipment and computers; digital recording media; CDs; DVDs, CD-Roms; computer peripherals.*

*Class 42*

*Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers, and for coordinating and obtaining delivery services; Scientific and technological services and research and design relating thereto; design and development of computer hardware and software; Providing temporary use of online non-downloadable software for planning, scheduling, controlling, monitoring, and providing information on the transport of passengers, assets and goods; Providing temporary use of online non-downloadable software for providing information concerning pick-up and delivery of passengers, assets and goods in transit; Providing a web site featuring software that enables customers to manage and track pickup and delivery of passengers, assets and goods; Providing temporary use of online non-downloadable software for coordinating and matching drivers and passengers for potential ridesharing; information, advisory and consultancy services relating to all of the aforesaid.*

90. The opposition under section 5(2)(b) fails in respect of the following goods and services:

*Class 9*

*Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; sunglasses; eyewear.*

*Class 39*

*Car Hire; Car hire services; Arranging of car hire; Chauffeur driven car hire services; Hire of cars; Hired car transport; Rental of chauffeur driven cars; Transportation of passengers in chauffeur driven vehicles; Provision of hired vehicles; Provision of hired vehicles for the transport of passengers; Escorting of*

*passengers; Escorting of travellers; Transportation of passengers; Transportation of passengers and passengers' luggage; Transportation of passengers by road; Transportation of passengers in chauffeur driven vehicles; Transportation of passengers' baggage; Transportation of passengers' luggage; Transportation of people; Transportation of persons; Transportation services; Travel and transport reservation services; Arranging of transport and travel; Arranging transport for travelers; Planning and booking of travel and transport via electronic means; Services for arranging the transportation of travellers; Transport of travelers; Travel agency services, namely arranging transportation for travelers; Travel and passenger transportation.*

*Class 42*

*Industrial analysis and research services; information, advisory and consultancy services relating to all of the aforesaid.*

**Section 5(3)**

91. Section 5(3) of the Act states that 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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

92. Section 5(3A) of the Act states that:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

93. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-487/07), *L'Oréal SA & Ors v Bellure NV & Ors* (Case C-487/07) and *Marks and Spencer v Interflora* (Case C-323/09). 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 Salomon*, 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 or services, the extent of the overlap between the relevant consumers for those goods or 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 or 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 or services for which

the earlier mark is registered, or a serious risk that this will happen in the 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'Oréal*, 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 project 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*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

## **Reputation**

94. The CJEU gave guidance on the assessment of reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by the trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

95. The opponent submits that its earlier marks have a reputation for anti-drugs advisory services, anti-drugs campaigns and associated goods and services. I must, however, consider the goods and services for which the earlier marks are registered and what the evidence shows about the reputation of the marks.

96. The relevant public for the opponent’s goods and services in Classes 9, 16 and 41 is the general public. The relevant public for the Class 35 services covered by the 979 mark is business. The opponent has not adduced any evidence that shows use of the 979 mark for these services or that businesses have any knowledge of the mark.

97. The earlier marks have been used since 2003 in the United Kingdom for information and advice on the use and effects of (mostly illegal) drugs. The 2017 study to which I have already referred several times in this decision indicates that the relevant public is aware of the website as a trusted source of information on drugs. The four 2011 videos in Exhibit DT6 had, at the time of printing, the following views:

<b>Subject</b>	<b>Number of Views</b>
Cocaine	262,139
Ecstasy	308,334



Subject	Number of Views
LSD	215,778
Cannabis	310,463

A proportion of these figures will represent views after the relevant date of 8 August 2018.

98. The graphics used on the website, posters and leaflets are eye-catching and designed to appeal to a younger audience. The study found that awareness was highest among the 19-24 age group “suggesting that a lot of FRANK’s awareness is from previous marketing and use in schools”.<sup>17</sup> As shown in the table in paragraph 20, marketing expenditure increased in 2017 and 2018, following significant falls from the figure of £5.07 million in 2010.

99. The evidence as a whole shows that the opponent’s marks have a strong reputation for drug information and advisory services and related goods, all delivered in a friendly and approachable manner. To my mind, it is the content – the information, the videos, and so on – that is the primary source of this reputation. I consider that this reputation covers the 979 and the 981 marks as they are both prominent in the promotional material. I have set out below the goods and services for which the evidence shows the opponent is known by the relevant public. The evidence relating to online goods and services far outweighs any evidence of reputation for the Class 16 printed goods. The goods and services are set out below:

Class 9

*Downloadable news, information and publications supplied over a global communications network; films bearing recorded educational material; audiovisual teaching materials; all the aforesaid being in relation to drug advisory services.*

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<sup>17</sup> Exhibit DT7, page 13.

Class 41

*Educational information and services; instructional services; provision of on-line electronic publications (not downloadable from the Internet); all the aforesaid being in relation to drug advisory services.*

**Link**

100. My assessment of whether the public will make the required mental link between the marks must take account of all relevant factors. The factors identified by the CJEU in *Intel* are as follows:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks are registered or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and
- the existence of the likelihood of confusion on the part of the public.

101. Earlier in my decision, I found that there was a high degree of visual similarity, a medium degree of aural similarity or aural identity (depending on whether "LONDON" in the contested mark is spoken) and a medium to high degree of conceptual identity between the 981 mark and the contested mark. In the comparison between the 979 mark and the contested mark, I found a medium degree of visual similarity, no more than a medium degree of aural similarity, and either a medium degree of conceptual similarity or dissimilarity, depending on what the average consumer understood by the word "FRANK".

102. The majority of the goods and services in the application are dissimilar to the goods and services for which the opponent has a reputation. In my view, the exceptions are as follows, all in Class 9:

*Electronic publications (downloadable); teaching apparatus and instruments; CDs; DVDs; CD-Roms.*

103. There is a lower degree of similarity between the opponent's goods and services and *computer software and apparatus for recording, transmission and reproduction of sound and images, magnetic data carriers, recording discs and digital recording media*. These goods may all be used for delivering the information and advisory services for which the opponent has a reputation.

104. I found that both earlier marks had a medium degree of inherent distinctiveness and that the distinctiveness of the 981 mark had been enhanced through use for the goods and services for which it has a reputation, which I found to be strong.

105. Considering all these factors, I find that the relevant public would make a link between the opponent's mark and the goods set out in paragraph 102. It also seems to me that the public would find it plausible that an undertaking with a reputation connected to a drugs advisory service might also supply *scientific and technological services and research and design relating thereto and industrial analysis and research services*, despite their dissimilarity, and so make the required link. However, I struggle to see why the relevant public would make the link between the opponent's mark and the contested mark when used for the remaining goods and services. The distance between those goods and services, and the goods and services for which the opponent has a reputation, is, in my view, too great.

### **Damage**

106. First, I shall consider the claim that use of the applicant's mark will constitute unfair advantage of the distinctive character or repute of the earlier marks. In *L'Oréal*, the CJEU stated that:

"In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's

reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods and services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, *Intel Corporation*, paragraphs 67 to 69)."<sup>18</sup>

107. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later mark was required to establish unfair advantage. The Court of Appeal had earlier decided in *Whirlpool Corp v Kenwood Ltd* [2009] EWCA Civ 753 that mere commercial advantage was not sufficient to render the taking of advantage unfair. Lloyd LJ (with whom Wilson and Rix LJJ agreed) stated that:

“There must be an added factor of some kind for that advantage to be categorised as unfair.”<sup>19</sup>

108. The opponent submits that:

“The Opponent's Registered Marks have been developed and heavily invested in by the Opponent over a number of years, as discussed in the Witness Statement. To exploit the reputation, fame, popularity and customer base which the Opponent has built in relation to the Opponent's Registered Marks, and for the Applicant to ride on the coat tails of the Opponent, will be to give the Applicant a clear unfair advantage.”

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<sup>18</sup> Paragraph 44.

<sup>19</sup> Paragraph 136.

109. The consumers of the applicant's *scientific and technological services and research and design relating thereto* and *industrial analysis and research services* are businesses, government and the public sector and third-sector organisations, such as charities. Exhibit DT5 shows that a selection of local government and third-sector organisations signposting users to the opponent's services, thus indicating knowledge among this particular public. There is a degree of overlap between the subject matter of the opponent's goods and services and that of the applicant's services. It seems to me that the applicant would be able to benefit from the marketing effort and awareness of the opponent's goods and services in promoting its own scientific and research services – particularly where they might relate to health or chemistry. The relevant public for the goods listed in paragraph 102 is the general public and the levels of awareness of the opponent's goods and services shown in the evidence would also provide a marketing "leg-up" for these goods. Consequently, I find that this head of damage is made out, and the section 5(3) claim succeeds, with respect to the following goods and services:

Class 9

*Electronic publications (downloadable); teaching apparatus and instruments; CDs; DVDs; CD-Roms.*

Class 42

*Scientific and technological services and research and design relating thereto and industrial analysis and research services.*

110. I shall briefly consider the other heads of damage.

111. The opponent submits that "Use by the Applicant of a similar mark will inevitably lead to dispersion of the identity and hold upon the public mind of the Opponent's Registered Marks". For this head of damage to be made out, the opponent must provide evidence that there will be a change in the economic behaviour of the average consumer of the goods of services for which the earlier mark was registered: see *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, paragraphs 34-43. It is not necessary to adduce evidence of actual detriment, as the serious or risk detriment may be inferred, through the use of logical deductions. However, these deductions

must not be the result of suppositions but be founded on an analysis of the probabilities of the situation. In my view, the opponent has adduced no evidence that would enable me to make such an inference and so the claim that there would be detriment to the distinctive character of the earlier marks is not made out.

112. The opponent submits that it “will not be able to control the manner in which the Applicant uses its mark which may be adverse to the image created by the Opponent and which will inevitably tarnish the Opponent’s reputation”. The opponent’s submissions are essentially hypothetical arguments and so insufficient for me to find detriment to repute: see *Unite The Union v The Unite Group Plc*, BL O/291/13.

### **Section 5(4)(a)**

113. Section 5(4)(a) of the Act states that:

“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 or 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’.”

114. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited trading as The Discount Outlet v Clarke-Coles Limited trading as Feel Good UK* [2017] EWHC 1400 IPEC:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all these limbs.

56. In relation to deception, the court must assess whether ‘*a substantial number*’ of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

115. *Halsbury’s Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

116. The first task is to identify the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted approvingly the following summary of the law by Mr Allan James, acting for the Registrar, in *SWORDERS TM*, BL O-212-06:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour



complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

117. The applicant has not claimed to have used the mark before the date of application (8 August 2018), and so this is the relevant date.

### **Goodwill**

118. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

119. It will be seen that long-established case law refers to “the goodwill of a business”. However, the courts have recognised that public bodies have goodwill capable of being protected: see *Wadlow on The Law of Passing-Off*, 5<sup>th</sup> edition, sections 3-24–3-27. The goods and services in respect of which the opponent claims to have goodwill, and which are listed in paragraph 7, are all goods and services in which there is a competitive market and where customers can choose from a range of providers. If goodwill is “the attractive force that brings in custom”, it follows that the opponent is capable of having protectable goodwill in relation to these goods and services.

120. Earlier in my decision, I found that the opponent had enhanced distinctiveness and a reputation in relation to *Downloadable news, information and publications supplied over a global communication network; films bearing recorded educational*

*material; audiovisual teaching materials; all the aforesaid being related to drug advisory services and Educational information and services; instructional services; provision of on-line electronic publications (not downloadable from the Internet) all the aforesaid being related to drug advisory services.*

121. One of the signs on which the opponent is relying under section 5(4)(a) is identical to the 981 mark, and another is the plain word **FRANK**. In my view the evidence shows that the opponent had protectable goodwill in the goods and services listed above, but also in the following: *printed publications, educational materials in printed form, booklets, leaflets, pamphlets and printed matter for instructional purposes*, all related to drug advisory services, and that both these signs are distinctive of the opponent's business.

122. There is some evidence that the sign **TALK TO FRANK** is also used in connection with these goods and services. It is the URL of the website and shown prominently on the opponent's homepage and on posters and leaflets. In my view, the use is more than trivial, given the number of website visits, and so I find that the opponent had protectable goodwill in connection with this sign also.

### ***Misrepresentation***

123. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the

defendants' [product] in the belief that it is the respondents'[product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

124. The applicant's goods and services that have survived the previous two grounds of opposition are as follows *Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; sunglasses; eyewear* and the Class 39 transportation services. The Court of Appeal stated in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) that a common field of activity is not essential for a passing-off claim to succeed, but Millet LJ also said:

"Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd* [1984] RPC 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that

the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

125. I have difficulty in seeing how the public would be deceived, or misled into purchasing the goods and services listed in the previous paragraph in the belief that they are the goods and services of the opponent. The opponent has not, in my view, adduced the evidence that would support this claim. The section 5(4)(a) opposition fails with respect to these goods and services.

126. I would have found that, given the similarity between the goods and services and the signs, the section 5(4)(a) claim succeeds in relation to a number of the applicant’s Class 9 goods, namely *Electronic publications (downloadable); Teaching apparatus and instruments; CDs; DVDs; CD-Roms*, and Class 42 services, namely *Scientific and technological services and research and design relating thereto and industrial analysis and research services*. However, the opposition has succeeded in respect of these goods and services on other grounds.

## **Conclusion**

127. The opposition has been partially successful. The application by Frank London Limited may proceed to registration in respect of the following goods and services:

### Class 9

*Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; sunglasses; eyewear.*

Class 39

*Car Hire; Car hire services; Arranging of car hire; Chauffeur driven car hire services; Hire of cars; Hired car transport; Rental of chauffeur driven cars; Transportation of passengers in chauffeur driven vehicles; Provision of hired vehicles; Provision of hired vehicles for the transport of passengers; Escorting of passengers; Escorting of travellers; Transportation of passengers; Transportation of passengers and passengers' luggage; Transportation of passengers by road; Transportation of passengers in chauffeur driven vehicles; Transportation of passengers' baggage; Transportation of passengers' luggage; Transportation of people; Transportation of persons; Transportation services; Travel and transport reservation services; Arranging of transport and travel; Arranging transport for travelers; Planning and booking of travel and transport via electronic means; Services for arranging the transportation of travellers; Transport of travelers; Travel agency services, namely arranging transportation for travelers; Travel and passenger transportation.*

**COSTS**

128. Both parties have enjoyed a share of success, with that share being roughly even. In the circumstances, I therefore order each party to bear their own costs.

**Dated this 30<sup>th</sup> day of March 2020**

**Clare Boucher  
For the Registrar,  
Comptroller-General**