

O/641/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003323791

BY VYNAMIC LLC

TO REGISTER THE TRADE MARK:

VYNAMIC

IN CLASSES 35 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 414289

BY DIEBOLD NIXDORF INCORPORATED

BACKGROUND AND PLEADINGS

1. On 11 July 2018, Vynamic LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 3 August 2018. The applicant seeks registration for the following services:

Class 35 Business management consultancy; business management consultancy in the field of healthcare; business consultancy; business assistance, management and administrative services; business information and research; business intelligence services; business advisory services; business organization, management, analysis, planning and appraisal services; business and market analysis services; business evaluations; economic research and analysis; collection, compilation, and analysis of supplier information; commercial information services; collection, compilation and analysis of business data; compilation of business and supplier information into computer databases; data management and processing; preparation of business statistical data; market research data analysis; provision of business data; composition and recording of statistical data; marketing services; development and implementation of marketing and sales strategies for others; management services, consulting, planning, project management, and information related thereto; business consulting regarding new ventures and mergers and acquisitions; administrative management of projects in the field of developing, specifying, installing and implementing business solutions; business consultation and private consultation in the field of executive coaching; business consulting in the area of trade in technological products.

Class 42 IT services; IT consultancy, advisory and information services; software development, programming and implementation; IT security, protection and restoration; data duplication and conversion services; data coding services; computer analysis and diagnostics; research, development and implementation of computers and systems; computer project

management services; data mining; digital watermarking; computer services; technological services relating to computers; computer network services; data migration services; updating websites for others; monitoring of computer systems by remote access; testing, authentication and quality control services; website design; website hosting; website development; website maintenance.

2. The application was opposed by Diebold Nixdorf, Incorporated (“the opponent”) on 5 November 2018. The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

Vynamic

International trade mark no. 1446612

International registration date 19 April 2018

Date of designation date 19 April 2018

Date of protection granted in the EU 2 March 2021¹

Priority dates claimed 20 October 2017 and 23 October 2017

Relying upon all goods and services for which the earlier mark is registered, namely:

Class 9 Software for: self-service terminals, automated teller machines (ATMs), automatic cash dispensers, automated cash deposit machines, electrically operated machines for the dispensing of coupons, tickets, vouchers, coins, postage stamps, credit and debit card terminals, automatic price scanning systems, biometric devices for identification, verification and detection, image processing equipment, encryption; software for on-line financial transactions and online commercial payment transactions, forecasting cash replenishment requirements of automated teller machines, branch banks and other cash dispensing equipment, mobile devices for performing financial transactions and

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

obtaining commercial information; software for electronic cash registers, automatic scanner cash registers and cash registers, terminals for banking and automated payment services; software for computers, handheld computers, tablet computers, namely for banking and payment transactions; software that enables financial institutions and commercial companies to integrate the delivery of services to customers by mobile devices, branch financial institutions, worldwide web portals, call centers, tellers, kiosks, automated teller machines cash register systems and self-service point of sale systems; software for monitoring cash transactions and noncash transactions; software for monitoring transactions against fraud for banks and commercial companies; software to enable secure payment processing; computer software platforms (recorded or downloadable) for banking and payment transactions; authentication software for self-service terminals, self-service point of sale systems, cash register systems and automated teller machines (ATMs); interactive computer programs relating to financial matters and banking and payment transactions; software for facilitating secure credit card transactions; computer software for analysing market information; cloud network monitoring software; cloud computing software; software for diagnostics and troubleshooting; software for the analysis of business data; software for the processing of business transactions; recorded or downloadable computer software platforms, namely for banking and payment transactions; computer software to automate data warehousing; computer e-commerce software; software development kit [SDK] for software for banking and payment transactions; software for network and device security.

Class 42 Development, installation, maintenance, repair and rental of software for banking and commercial financial transactions; development, installation, maintenance, repair and rental of software for platforms for electronic commerce, internet platforms, commercial analysis, commercial reporting, secure network operations, and financial transactions; Software as a service (SaaS); hosting software for use by others for electronic commerce, internet platforms, commercial analysis,

commercial reporting, secure network operations; hosting computer sites [web sites]; electronic monitoring services for security purposes of transmitted data via telecommunication; custom design of software packages for banks and commercial companies; programming, development, installation, maintenance, repair and rental of software for accessing and using a cloud computing network; computer software technical support services; software customisation services.

3. The opponent claims that there is a likelihood of confusion because the marks are identical, and the goods and services are highly similar. The opponent is opposing all the services for which the applicant seeks protection.

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

5. The opponent is represented by Hogan Lovells International LLP and the applicant is represented by JP Mitchell Solicitors. Neither party filed evidence nor requested a hearing. However, the opponent filed written submissions in lieu regarding the previous opposition and cancellation proceedings at the EUIPO between the parties. This decision is taken following a careful perusal of the papers.

6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(1) and 5(2)(a)

7. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are

identical with the goods or services for which the earlier trade mark is protected.”

8. Section 5(2)(a) of the Act reads as follows:

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

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

(b) [...]

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

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

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

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

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

10. The trade mark upon which the opponent relies qualifies as earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process

more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Identity of the marks

11. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

12. As highlighted by the opponent, Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14 found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

13. The opponent’s mark is the word “Vynamic”. The applicant’s mark is the word “VYNAMIC”. Taking the above into account, I consider that these marks are clearly identical.

Comparison of goods and services

14. The applicant’s services are set out in paragraph 1 of this decision. The opponent’s goods and services are set out in paragraph 2 of this decision.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for 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.”

16. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

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

“... 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.”

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

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

19. 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. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

20. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in

circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, *in Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

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

Class 35

Collection, compilation and analysis of business data; Collection, compilation, and analysis of supplier information; Compilation of business and supplier information into computer databases

21. “Software for the analysis of business data” in the opponent’s class 9 specification overlaps with the applicant’s above class 35 services. There is an overlap in purpose and user because both the goods and services are being used to analyse different types of business data. However, the nature and method of use differ. I consider that there is an overlap in trade channels because both the goods and services could be provided by the same undertakings. The goods and services are complementary. They are also in competition because the user could choose either the goods or the services

in order to obtain the same information and achieve the same result. Overall, I consider the goods and services to be similar to between a medium and high degree.

Business and market analysis services; market research data analysis

22. “Computer software for analysing market information” in the opponent’s class 9 specification overlaps with the applicant’s above class 35 services. I consider there to be an overlap in purpose and user because both the goods and services are being used to analyse market information. There may be an overlap in trade channels, however, the nature and method of use differ. I consider the goods and services to be complementary. They may also be in competition because you could choose either the goods or the services in order to attain the same information. I consider the goods and services to be similar to between a medium and high degree.

Preparation of business statistical data; Provision of business data

23. “Software for the analysis of business data” in the opponent’s class 9 specification overlaps with the applicant’s above class 35 services. I consider that there is an overlap in trade channels because both the goods and services would be provided by the same undertakings which specialise in business data. I also consider there to be an overlap in user. However, they differ in nature and method of use. I consider that they also differ in purpose because the opponent’s software is used to analyse the data, whereas the applicant’s services are used to provide and prepare the business data. I do not consider that they are in competition nor complementary. Taking the above into account, I consider the goods and services to be similar to between a low and medium degree.

Data management and processing; Composition and recording of statistical data

24. I also consider that “software for the analysis of business data” in the opponent’s class 9 specification overlaps with the above applicant’s class 35 services. I consider that the applicant’s *preparation of business statistical data* and *provision of business data* would be encompassed by the above applicant’s class 35 services. Consequently, I consider that there is an overlap in trade channels and user for the

same reasons as set out above. However, they differ in nature, method of use and purpose. I do not consider that they are in competition nor complementary. Taking the above into account, I consider the goods and services to be similar to between a low and medium degree.

Business information and research; Economic research and analysis

25. I also consider that “software for the analysis of business data” in the opponent’s class 9 specification overlaps with the above applicant’s class 35 services. I consider that there is an overlap in trade channels because the same undertaking would normally provide analysis, research and information based goods and services all in relation to business. Both the goods and services are likely to be used by businesses so there will be an overlap in user. However, they differ in nature, method of use and purpose. I do not consider them to be in competition, nor complementary. Therefore, I consider the goods and services to be similar to between a low and medium degree.

Business management consultancy; Business management consultancy in the field of healthcare; Business consultancy; Business assistance, management and administrative services; Business intelligence services; Business advisory services; Business organization, management, analysis, planning and appraisal services; Business evaluations; Commercial information services; Management services, consulting, planning, project management, and information related thereto; Business consulting regarding new ventures and mergers and acquisitions; Administrative management of projects in the field of developing, specifying, installing and implementing business solutions; Business consultation and private consultation in the field of executive coaching; Business consulting in the area of trade in technological products

26. The applicant’s above class 35 services are in relation to business management, organisation, administration and consultancy. These services are intended to help companies manage their business and therefore will be involved in activities associated with the running of a business. The opponents class 9 goods and class 42 services are all in relation to computer software and related services. Therefore, they are all fundamentally different in nature, purpose and method of use. In the absence

of any evidence to assist me, I can see no obvious overlap in trade channels. They are neither in competition nor complementary. I consider that they would overlap in users, such as businesses, however, this alone is not enough to establish similarity. Taking the above into account, I consider the applicant's services to be dissimilar to the opponent's goods and services.

Marketing services; Development and implementation of marketing and sales strategies for others

27. The applicant's above class 35 services are in relation to marketing which is a type of advertising service which is used to promote businesses goods and services and reinforce the client's position in the market. Consequently, they do not overlap in trade channels because the opponent's goods and services focus on software and related services. I also consider that these services are fundamentally different in nature, purpose and method of use. They are neither in competition nor complementary. I consider that they will overlap in users, however, this is not enough to establish similarity. I consider the applicant's services to be dissimilar to the opponent's goods and services.

Class 42

Website hosting

28. I consider that "hosting computer sites [web sites]" in the opponent's specification is self-evidently identical to "website hosting" in the applicant's specification.

IT services; Computer services; Technological services relating to computers

29. I note that information technology is defined as "the theory and practice of using computers to store and analyse information".² Therefore, I consider that the applicant's above services would encompass a broad range of services in relation to computers. Consequently, I consider that "programming, development, installation, maintenance,

² <https://www.collinsdictionary.com/dictionary/english/information-technology>

repair and rental of software for accessing and using a cloud computing network” in the opponent’s specification is self-evidently a type of IT/computer service which will fall within all of the above applicant’s services. I consider them identical on the principle outlined in *Meric*.

IT consultancy, advisory and information services

30. I consider that the applicant’s above class 42 service falls within the broader category of “computer software technical support services” in the opponent’s specification. Consultancy, advice and information would need to be carried out as part of the opponent’s service in order to provide technical support. Consequently, I consider them identical on the principle outlined in *Meric*. Even if I am wrong in this finding, the services will overlap in trade channels, users, purpose, method of use and nature. I consider that they will be highly similar.

Software development, programming and implementation; Research, development and implementation of computers and systems

31. I consider that “development, installation, maintenance, repair and rental of software for banking and commercial financial transactions” and “development, installation, maintenance, repair and rental of software for platforms for electronic commerce, internet platforms, commercial analysis, commercial reporting, secure network operations, and financial transactions” in the opponent’s specification fall within both of the above broader categories. I consider them identical on the principle outlined in *Meric*.

Computer analysis and diagnostics

32. I consider that the applicant’s above class 42 service falls within the broader category of “computer software technical support services” in the opponent’s specification. Computer analysis and diagnostics would be carried out as part of the opponent’s service in order to detect the technical problem which needs assistance. Consequently, I consider them identical on the principle outlined in *Meric*.

IT security, protection and restoration

33. I consider that “software for network and device security” in the opponent’s class 9 specification overlaps with “IT security, protection and restoration” in the applicant’s specification. I consider that there is an overlap in purpose because both of the goods and services are being used for security and protection purposes. However, the nature and method of use differ. Both the goods and services could be provided by the same undertakings. I consider that there is an overlap in trade channels and user. The goods and services may be complementary, and they also may be in competition because you could use either to achieve the same result. Consequently, I consider the goods and services to be similar to between a medium and high degree.

Computer network services

34. The parties did not submit what the intended scope for the above term in the applicant’s specification would cover. However, I consider that it would be a service where a provider will set up and run a large secure network for a business. I consider this term will overlap with “hosting software for use by others for [...] secure network operations” in the opponent’s specification which would host internal intranets, email services and other security/network features. There is an overlap in user, nature and trade channels. However, they do not overlap in method of use and purpose. They are not in competition, nor complementary. I consider the services to be similar to a medium degree.

Website design; Website development; Website maintenance; Updating websites for others

35. I consider that the above terms in the applicant’s specification may overlap with “hosting computer sites [web sites]” in the opponent’s class 42 specification. Web hosting is a service which allows the user to post a website which can be viewed and accessed on the internet. Website development, design, maintenance and updating can be provided via a separate service. However, there are some providers that offer all the above services. Therefore, I consider that there can be an overlap in trade channels, nature and user. However, they do not overlap in purpose and method of

use. They will not be in competition; however, they may be complementary. Taking the above into account, I consider the services to be similar to a medium degree.

Monitoring of computer systems by remote access

36. I consider that “electronic monitoring services for security purposes of transmitted data via telecommunication” in the opponent’s specification overlaps with “monitoring of computer systems by remote access” in the applicant’s specification. I consider that they overlap in nature, trade channels and user. To the extent that they are both used to monitor, there will be an overlap in purpose. However, the purpose differs to the extent that the opponent’s only monitors transmitted data, and the applicant’s monitors computer systems. They also may not overlap in method of use. They are not complementary nor in competition. Taking the above into account, I consider the services to be similar to a medium degree.

Computer project management services

37. The parties did not submit what the intended scope for the term “computer project management services” in the applicant’s specification would cover. However, I consider that it would include overseeing projects for anything that could be included on a computer from hardware to software development and installations. Consequently, I consider this term overlaps with “programming, development, installation, maintenance, repair and rental of software for accessing and using a cloud computing network” in the opponent’s specification. There will be an overlap in user and trade channels. However, they do not overlap in nature, method of use and purpose because the applicant’s service is specifically managing and overseeing the computer project, whereas the opponent’s service is the computer project itself. Consequently, I consider that the services are complementary. Taking the above into account, I consider the services to be similar to be similar to a medium degree.

Testing, authentication and quality control services

38. “Testing, authentication and quality control services” in the applicant’s specification are services aimed to control and confirm the fulfilment of standards and quality

requirements, which would be approved by certification. I, therefore, do not consider that this service overlaps with any of the opponent's goods or services. They are fundamentally different in purpose, method of use, user, nature and trade channels. They are not complementary or in competition. I consider the applicant's services to be dissimilar to the opponent's goods and services.

Digital watermarking

39. Digital watermarking is the process of marking a video or image in order to identify the owner and holder of the copyright in those goods. I consider that as such a specialist service, this does not overlap in nature, user, method of use, purpose or trade channels with any of the opponent's goods or services. They are not complementary or in competition. I consider the applicant's services to be dissimilar to the opponent's goods and services.

Data duplication and conversion services; Data coding services; Data mining; Data migration services

40. In the absence of any evidence to assist me, I consider that the applicant's above class 42 services do not overlap with any of the opponent's goods and services. The applicant's above services are so specialist that I do not consider that they would be provided by the same undertakings. Consequently, I do not consider that there is any overlap in trade channels, nature, method of use and purpose. I do not consider that they are in competition nor complementary. I recognise that there may be some overlap in user, but that is not enough on its own for a finding of similarity. Therefore, I consider the goods and services to be dissimilar.

41. It is a prerequisite of section 5(1) that the goods and services be identical. The opposition will, therefore, fail in respect of those goods and services that I have found to be only similar (and not identical).

42. The opposition under section 5(1) succeeds in respect of the following services only:

Class 42 IT services; IT consultancy, advisory and information services; Software development, programming and implementation; Computer analysis and diagnostics; Research, development and implementation of computers and systems; Computer services; Technological services relating to computers; Website hosting.

The average consumer and the nature of the purchasing act

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

44. The average consumer for the goods and services will be both members of the general public and business users. The cost of purchase is likely to vary, but it is not likely to be at the very highest end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of the purchase is low, various factors will be taken into consideration such as suitability for the user's particular needs, ease of use and reliability. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process.

45. The goods are likely to be purchased from the shelves of a retail outlet or their online equivalent or following inspection of a specialist catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I

recognise that word-of-mouth recommendations and verbal advice means that aural considerations cannot be discounted.

46. The services are likely to be purchased from specialist retail outlets or their online equivalents. Alternatively, the services may be purchased following perusal of advertisements. The purchasing process is, therefore, likely to be predominantly visual. However, I do not discount that there may be an aural component to the purchase of the services given that advice may be sought from a sales assistant or a recommendation may have been given through word-of-mouth.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

48. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

49. As the opponent has not filed any evidence to show that the distinctiveness of its earlier mark has been enhanced through use, I only have the inherent position to consider.

50. The word Vynamic is an invented word which is neither allusive nor descriptive in relation to the goods and services for which the mark is registered. Therefore, I consider the earlier mark to be inherently distinctive to a high degree.

Likelihood of confusion

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

52. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the opponent's mark to be identical to the applicant's mark.
- I have found the opponent's mark to be inherently distinctive to a high degree.
- I have identified the average consumer as members of the general public and business users who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process.
- I have found the parties goods and services to vary from being identical to dissimilar.

53. As noted above, where I have found the services to be identical, the application has already succeeded under the section 5(1) ground. In respect of those services that I have found only to be similar, taking all of the factors listed in paragraph 52 into account, I am satisfied that the average consumer would likely mistake one mark for the other. This is particularly the case given the identity of the marks. I also consider that the identity of the marks offsets the differences between the goods and services that I have found to be similar to only between a low and medium degree. Consequently, a likelihood of direct confusion will arise.

54. However, for those goods and services that I have found to be dissimilar, there can be no likelihood of confusion.³

CONCLUSION

55. The opposition is partially successful in respect of the following services, for which the application is refused:

Class 35 Business information and research; Business and market analysis services; Economic research and analysis; Collection, compilation, and analysis of supplier information; Collection, compilation and analysis of business data; Compilation of business and supplier information into computer databases; Data management and processing; Preparation of

³ eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

business statistical data; Market research data analysis; Provision of business data; Composition and recording of statistical data.

Class 42 IT services; IT consultancy, advisory and information services; Software development, programming and implementation; IT security, protection and restoration; computer analysis and diagnostics; Research, development and implementation of computers and systems; Computer project management services; Computer services; Technological services relating to computers; Computer network services; Updating websites for others; Monitoring of computer systems by remote access; Website design; Website hosting; Website development; Website maintenance.

56. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 35 Business management consultancy; Business management consultancy in the field of healthcare; Business consultancy; Business assistance, management and administrative services; Business intelligence services; Business advisory services; Business organization, management, analysis, planning and appraisal services; Business evaluations; commercial information services; Marketing services; Development and implementation of marketing and sales strategies for others; Management services, consulting, planning, project management, and information related thereto; Business consulting regarding new ventures and mergers and acquisitions; Administrative management of projects in the field of developing, specifying, installing and implementing business solutions; Business consultation and private consultation in the field of executive coaching; Business consulting in the area of trade in technological products.

Class 42 Data duplication and conversion services; Data coding services; Data mining; Digital watermarking; Data migration services; Testing, authentication and quality control services.

COSTS

57. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 27th day of August 2021

L FAYTER

For the Registrar