

O-267-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2625205
BY TEMASEK HOLDINGS (PRIVATE) LIMITED TO REGISTER THE TRADE
MARK**

TEMASEK TOUCH

IN CLASSES 35, 36, 38 AND 41

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 104241
BY TOUCH FOUNDATION, INC**

BACKGROUND

1) On 20 June 2012, Temasek Holdings (Private) Limited (hereafter “the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark TEMASEK TOUCH in respect of the following services:

Class 35: *Charitable services, namely business management and administration, organising and conducting volunteer programmes and community service projects.*

Class 36: *Charitable collections; Charitable fund raising; Charitable services, namely financial services; Organising of charitable collections.*

Class 38: *Weblog or blog services related to on-line publication of journals or diaries.*

Class 41: *Entertainment; provision of news in relation to education, training, entertainment or sporting and cultural activities; news reporters services; library services provided by means of a computerized database containing information extracted by newspapers; information and advisory services relating to current events; publication of reviews and critiques; publication of electronic books and journals on-line; providing on-line electronic publications (not downloadable); electronic publishing services; web-based publication consisting primarily of periodic articles, news feeds, publication of text, audio, video and graphic works online featuring news, diaries, commentary, photos, poetry, mini-essays, project updates, non-fiction and fiction; preparation of news programmes for broadcasting; on-line publication of journals or diaries; advisory, information and consultancy services relating to all the aforesaid; charitable services, namely academic mentoring; charitable services, namely education and training; educational services; training services; arranging and conducting of conferences, congresses, seminars, symposiums and training workshops.*

2) The application was published in the Trade Marks Journal on 21 September 2012 and on 18 December 2012, Touch Foundation, Inc (hereafter “the opponent”) filed notice of opposition to the application. The original grounds of opposition were amended and the single remaining ground of opposition is based upon Section 5(2)(b) of the Act. The opponent claims that the applicant’s mark is similar to an earlier mark in the name of the opponent and that it covers identical or similar services. It points out that the applicant’s mark contains the whole of the opponent’s mark. The relevant details of the earlier mark relied upon are:

Relevant details	List of services
2398673 TOUCH Priority date: 8 February 2005 Filing date: 5 August 2005 Date of entry in register: 8 August 2008	Class 36: <i>Charitable fund raising services</i>

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Both sides filed written submissions and the applicant also filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard and after a careful consideration of all the papers, I give my decision.

5) I will not summarise the written submissions, but I will refer to them as relevant in my decision.

Applicant's Evidence

6) The applicant's evidence consists of a witness statement by Roberto Calamita, trade mark attorney in the firm Dehns, the applicant's representatives in these proceedings. He states that his company has conducted searches on the websites of the Charity Commission for England and Wales and the Scottish Charity Regulator. The purpose of this search was to identify other charities whose name contains the term TOUCH and was validly registered at the date of application of the contested mark. The results of the search are provided at Exhibit RC1. The following charities are a small proportion of the charities found, all containing the word TOUCH:

CHILDREN IN TOUCH (1978)
 DIVINE TOUCH: CHURCH OF GOD MINISTRIES
 FAMILIES IN TOUCH (BRISTOL)
 FIRST TOUCH
 GENTLE TOUCH HEALING ASSOCIATES LIMITED
 HUMAN TOUCH WORLDWIDE
 IN TOUCH (SOUTH EAST WALES) LIMITED
 IN TOUCH SUPPORT

7) Exhibit RC2 contains the results of searches of the UK, CTM and International (insofar as it covers the UK or EU) registers for marks which contain the word TOUCH and cover "charitable services". Fifteen registrations were identified, including TOUCH TRUST (and device), TOUCHING LIVES, TOUCHING TINY LIVES (and device), FIRST TOUCH, TOUCH OF TARTAN, IN TOUCH, as well as the opponent's earlier mark.

DECISION

Preliminary point

8) The admissibility of the opposition was questioned by the applicant because the recorded proprietor of the earlier mark was recorded as “Touch Foundation” It argues that this is not a legal entity. The opponent subsequently sought to amend the mark’s proprietor’s name to “Touch Foundation Inc.”. The applicant (see Dehns’ submissions dated 19 December 2013, paragraph 5 onwards) claims that the Registry is not correct to permit the opponent to amend its name on the form TM7 Notice of Opposition as a “correction of an error”. It argues that because of the existence of other companies that include the words “Touch Foundation” the name used could not unambiguously be clearly referring to one legal entity.

9) I reject the applicant’s arguments. Firstly, there has been no challenge to the opponent’s earlier mark and in the absence of this, there is a prima facie presumption of validity of the registration (see Section 72 of the Act). Secondly, I am content that the opponent is, in fact, the proprietor of the earlier mark. Meaghan Hetherington, for the opponent, has explained in a witness statement that the mark was applied for erroneously in the name of “Touch Foundation” but that the error did not come to light until the applicant in these proceedings questioned the legal status of the recorded proprietor. There is no suggestion that the name was anything other than a genuine mistake.

10) Taking all of this into account, I see no reason to disturb the preliminary view (issued by the Registry in its letter of 4 July 2013) to permit the register to be amended to record Touch Foundation, Inc as the registered proprietor.

Section 5(2)(b)

11) Section 5(2)(b) reads:

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

(a) ...

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

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

12) The opponent relies upon a single earlier mark that is registered and therefore qualifies as an earlier mark as defined by Section 6 of the Act. Further,

the registration procedure was completed on 8 August 2008, being less than five years prior to the publication of the applicant's mark. The significance of this is that the earlier mark is not subject to the proof of use provisions (Section 6A of the Act). Consequently, the opponent is entitled to rely on the full scope of services listed in its earlier mark.

13) In reaching my decision under this ground I bear in mind that the Court of Justice of the European Union ("the CJEU") has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

Comparison of services

14) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

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

15) Other factors may also be taken into account such as, for example, the distribution channels of the goods (and by analogy, services) concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

16) I also bear in mind the following guidance, of the General Court ("the GC") in *Gérard Meric v OHIM*, T-133/05, that again, by analogy applies equally to services as it does to goods:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM

– France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42.”

17) In terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* where it was stated:

"It is true that goods [*and by analogy, services*] are complementary if 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 (see, to that effect, Case T-169/03 Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos) [2007] ECR I-0000, paragraph 48)."

18) In understanding the considerations I need to undertake, I also keep in mind the following guidance:

Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another [2000] F.S.R. 267 (HC):

"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."

and;

YouView Ltd v Total Ltd [2012] EWHC 3158 (Ch) at [12]:

"...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”.

and;

Avnet Incorporated v Isoact Limited - [1998] F.S.R. 16 (HC):

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

Class 35 specification

Charitable services, namely business management and administration, organising and conducting volunteer programmes and community service projects.

19) The opponent submits that the applicant’s Class 35 services are similar to the opponent’s Class 36 services because the purpose is the same, namely to assist the less fortunate/less able. It also contends that the applicant’s services are associated with *charitable fund raising* and run alongside that of the opponent’s services. The applicant argues that the applicant’s services are “in no way similar”, regardless of whether or not they are provided for charitable purposes. It is not correct to assume that to prefix services with the word “charitable” will result in any similarity with any other services that are also prefixed in the same way. To do so would result in a conclusion that all services are similar to all other services merely because they could be provided for a charitable purpose. This is clearly wrong and would provide charities with an unfairly broad protection. I do accept that some services require the word “charitable” to be used to fully understand the nature of the service. An example of this is the opponent’s services “charitable fund raising services”. The use of “charitable” distinguishes the service from other forms of “fund raising”, for example raising funds to launch a company on the stock market. However, the scope of services covered by the term *business management and administration* remains the same whether it is in the context of a charity or any other organisation. *Business management and administration* differs in its intended purpose and nature when compared to *charitable fund raising services*. They are not in competition with or complementary to the other. It is not normal to procure *business management and administration* services from the same provider as charitable fund raising services. Further, the respective average consumers are different. Taking all of this into account, I conclude that there is no similarity between the opponent’s *charitable fund raising services* and the applicant’s *charitable services, namely business management and administration*.

20) In respect to the applicants *organising and conducting volunteer programmes and community service projects*, both are cornerstone services of many charitable organisations. Consequently, there is likely to be an overlap in trade channels and average consumers. There is also a degree of complementarity with volunteer programmes, for example, being an important part of charitable fund raising. Taking all of this into account, I find that there is a moderately high degree of similarity.

Class 36 specification

Charitable collections; Charitable fund raising; Charitable services, namely financial services; Organising of charitable collections.

21) It is self evident that the applicant's *Charitable fund raising* is identical to the opponent's *charitable fund raising services*.

22) Similarly, the applicant's *Charitable collections* and *Organising of charitable collections* are a subset of the opponent's broader services and applying the guidance set out in *Meric* they must also be considered as identical.

23) The one remaining term is *charitable services, namely financial services*. This is a very broad term that will encompass any financial service relating to charitable work. Consequently, it will include the opponent's *charitable fund raising services* and, once again, applying the guidance in *Meric* they cover identical services.

Class 38 specification

Weblog or blog services related to on-line publication of journals or diaries.

24) The opponent submits that when the application as a whole is considered, it is clear that the applicant's Class 38 services relate to charitable services and that the applicant's term is not limited to any particular field and, consequently, includes blog services relating to charitable work. However, I agree with the applicant when it submits that the scope of a specification cannot be inferred by the scope of the rest of the application. When approaching the analysis it is necessary to do so from a notional and fair use perspective. When doing so, there is no obvious similarity between the applicant's services and those of the opponent. Whilst I recognise that the subject of a blog might be charitable in nature, it is not normal for an individual or organisation wishing to procure blog services to approach a provider of charitable fund raising services. Rather, they will approach a specialist blog manager. The nature of fund raising is different to weblog and blog services. The intended purpose is different; one is a method of communication, the other a money raising service. They will not be in competition with each other and, because neither is essential or even important for the

existence of the other, they are not complementary. Therefore, when applying the guidance of the courts, I conclude there is no similarity.

Class 41 specification

Entertainment; provision of news in relation to education, training, entertainment or sporting and cultural activities; news reporters services; library services provided by means of a computerized database containing information extracted by newspapers; information and advisory services relating to current events; publication of reviews and critiques; publication of electronic books and journals on-line; providing on-line electronic publications (not downloadable); electronic publishing services; web-based publication consisting primarily of periodic articles, news feeds, publication of text, audio, video and graphic works online featuring news, diaries, commentary, photos, poetry, mini-essays, project updates, non-fiction and fiction; preparation of news programmes for broadcasting; on-line publication of journals or diaries; advisory, information and consultancy services relating to all the aforesaid; charitable services, namely academic mentoring; charitable services, namely education and training; educational services; training services; arranging and conducting of conferences, congresses, seminars, symposiums and training workshops.

25) Firstly, I will consider the applicant's *charitable services, namely academic mentoring; charitable services, namely education and training*. For the same reasons as I explained in paragraph 19, I do not agree with the opponent when it submits that there is similarity with the opponent's services. The services of *education* and *training* are different in nature and intended purpose. They are not normally accessed from the same providers and the average consumers are different. Charities are disparate in nature and to assume all operate in the same or overlapping fields would provide an overly broad level of protection. Charitable fund raising and provision of education and training, even if provided by a charity, are not in competition with each other. In summary, I conclude that there is no similarity.

26) Having reached the finding that I have in the previous paragraph, there is nothing in the remainder of the applicant's Class 41 specification that I consider to be more similar than those that I considered in paragraph 25. It follows that all of the applicant's remaining services are not similar to those of the opponent

The average consumer

27) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting

goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

28) The average consumer of *charitable fund raising services* is likely to be members of the public or organisations either wishing to assist in the fund raising or in need of access to the funds. Where the average consumer is involved, the level of attention is likely to be higher than “reasonably observant and circumspect” because the intended beneficiary of these services is often “close to the heart” of the individual accessing the services either because they are in need of the support offered or because they wish to support the cause. I also recognise that on occasions, the purchasing act can be casual, with an individual having a one off encounter with the provider. Where third party organisations are involved, the level of attention will be reasonably high.

29) The services of the applicant are wide ranging that, in addition to covering identical services to the opponent, also include services such as *entertainment* at large where the average consumers can range from members of the public to corporate clients requiring entertainment for corporate events. This range will have a commensurately broad range of purchasing acts with little attention being paid when encounters with the entertainment experience are casual (for example where the entertainment is provided on the street) to close attention where an organisation is booking entertainment for a corporate event.

Comparison of marks

30) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
TOUCH	TEMASEK TOUCH

31) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

32) There cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of the them and is deemed to be reasonably well informed and reasonably circumspect and observant . The assessment of the similarity of the marks must be made by reference to the perception of the relevant public.

33) The applicant's mark is readily divided into separate components, namely the words TEMASEK and TOUCH. The word TEMASEK is unusual and with no obvious meaning. Because of this and by virtue of it being at the beginning of the mark (which I accept is just a rule of thumb), it is the dominant and distinctive element. The word TOUCH is an ordinary dictionary word that may have an allusive quality. That said, it also has distinctive character. Consequently, whilst not being the dominant element of the mark, it is nonetheless, an independent distinctive element. The opponent's mark consists of the single word TOUCH and, being a single word, is not readily divided. Its distinctiveness resides in its entirety.

34) Having considered the nature of each marks' distinctive character, I must also consider the level of similarity between the two marks. Visually, the applicant's mark consists of two distinct words, the first word being longer than the second. These are obvious points of difference with the opponent's mark. However, the whole of the opponent's mark is present in the applicant's mark (as the second word). Taking all of this into account, I conclude that the respective marks share a reasonable level of visual similarity.

35) Aurally, the applicant's mark consists of the four syllables TEM-A-SEK-TUCH. The opponent's mark consists of a single syllable being the same as the final syllable of the applicant's mark. Taking this into account, I consider there to be a reasonable level of aural similarity.

36) When considering the respect concepts, I have already commented that the word TEMASEK has no meaning. The word TOUCH present in both marks is an everyday word meaning "to come into contact with"¹. Insofar as the applicant's mark has any conceptual significance it will be as the result of this word. Taking this into account, I conclude the respective marks also share a reasonable level of conceptual similarity.

Distinctive character of the earlier trade mark

37) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of

¹ "touch." *Oxford Dictionary of English*. Ed. Stevenson, Angus. : Oxford University Press, 2010. *Oxford Reference*. 2010. Date Accessed 19 May. 2014 <http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0873290>.

the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). There is no evidence before me as to the extent of use of the opponent's mark and, consequently, I am unable to conclude that any distinctive character has been enhanced through use.

38) Considering the inherent level of distinctive character, I have already observed that the mark consists of a common and well understood dictionary word. This may explain why, as the applicant has identified in its evidence, the word is used by a number of organisations as part of their name or as part of a trade mark. Therefore, it is not endowed with the same level of distinctive character of, for example, an invented word. Further, it may have some allusive quality in respect to charitable-type services in that it may be intended to bring to mind a service that is supportive and reassuring (as a touch can be). However, this is only a weak allusion. Taking all of this into account, I conclude that the earlier mark is endowed with a average level of distinctive character, not the lowest or the highest level.

Likelihood of confusion

39) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). Further, I must also keep in mind the guidance of the CJEU in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, C-120/04 that assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components.

40) I have found that the respective marks share a reasonable level of similarity with the opponent's mark wholly contained in the applicant's mark as its second element. In *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) Arnold J undertook an analysis of the case law regarding the application of the principals set out by the CJEU in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04. Insofar as they relevant to the current case, Arnold J stated:

44. I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole. Thus when the well-known pharmaceutical company Glaxo plc acquired the well-known pharmaceutical company Wellcome plc, the average consumer of pharmaceutical goods confronted with the composite sign GLAXO WELLCOME or GLAXOWELLCOME would perceive the significance of both the whole and its constituent parts and conclude that this was an undertaking which combined the two previously separate undertakings (see *Glaxo Group Ltd v Glaxowellcome Ltd* [1996] FSR 388). The essence of the Court of Justice's reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.

41) I have already found that the word TOUCH in the applicant's mark is an independent and distinctive part of the mark, even though it is not the dominant element. I have also found that there is a level of similarity between many, but not all, of the respective services. Further, I have found that the respective marks, when considered as a whole, share a reasonable level of similarity, the relevant consumer will pay a higher level of attention but that the purchasing act may vary from the casual to the well considered and the opponent's mark is endowed with a moderate level of distinctive character.

42) When all of the above is factored into the global analysis together with the guidance provided in *Medion* and *Aveda*, I find that there is a likelihood of confusion in respect of the services where I have found identity or similarity. Whilst the presence of the TEMASEK element of the applicant's mark will remove the likelihood of direct confusion where one mark is confused with the other, there is a likelihood of indirect confusion where the consumer will assume that the respective services originate from the same or linked undertaking.

43) The applicant filed evidence of numerous other marks on the register that also feature the word TOUCH and are in respect of charitable services. I do not find this to be a persuasive argument. The GC in *Zero Industry Srl v OHIM*, T-400/06 has commented on this issue as follows:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include

the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

44) The applicant also provided evidence of a number of other organisations recorded on either of the UK's charity registers whose name includes the word TOUCH. Again, I do not find this to be persuasive. There is no evidence to illustrate whether these charities are operating, or if so, to what extent. Their mere presence on the register of charities in no way affects my considerations.

45) In summary, the opposition succeeds in respect of the following list of services:

Class 35: *organising and conducting volunteer programmes and community service projects.*

Class 36: *Charitable collections; Charitable fund raising; Charitable services, namely financial services; Organising of charitable collections.*

46) The opposition fails in respect of the following services:

Class 35: *Charitable services, namely business management and administration*

Class 38: *Weblog or blog services related to on-line publication of journals or diaries.*

Class 41: *Entertainment; provision of news in relation to education, training, entertainment or sporting and cultural activities; news reporters services; library services provided by means of a computerized database containing information extracted by newspapers; information and advisory services relating to current events; publication of reviews and critiques; publication of electronic books and journals on-line; providing on-line electronic publications (not downloadable); electronic publishing services; web-based publication consisting primarily of periodic articles, news feeds, publication of text, audio, video and graphic works online featuring news, diaries, commentary, photos, poetry, mini-essays, project updates, non-*

fiction and fiction; preparation of news programmes for broadcasting; on-line publication of journals or diaries; advisory, information and consultancy services relating to all the aforesaid; charitable services, namely academic mentoring; charitable services, namely education and training; educational services; training services; arranging and conducting of conferences, congresses, seminars, symposiums and training workshops.

COSTS

47) The opposition has been partially successful. In *Wm Morrison Supermarkets Plc v Nisa-Today's (Holdings) Limited*, BL O/197/11, Ms Amanda Michaels, sitting as the Appointed Person, said in a case where one party was largely, but not wholly, successful:

“22. The starting point for the exercise of the discretion, as set out in CPR 44.3 and reflected in *Johnsey*, is that costs should follow the event. As CPR 44.3(2)(a) puts it “the general rule is that the unsuccessful party will be ordered to pay the costs of the successful party”. Nevertheless, as CPR 44.3(4) indicates, the judge “must have regard to all the circumstances” which may include “whether a party has succeeded on part of his case, even if he is not be wholly successful.” The court may therefore make different orders for the costs incurred in relation to discrete issues and should consider doing so where a party has been successful on one issue but unsuccessful on another.”

48) With this in mind and with the opponent being successful in respect of only a few services in Class 35 and Class 36, I find it is appropriate to award reasonable costs in respect of the official fee and other costs but reduced by 80% to reflect the approximate measure of success. Taking this into account, I award costs on the following basis:

Official fee	£200
Preparing Notice of Opposition and considering statement	
Statement of case in reply	£300
Preparing and filing evidence & considering other side's evidence	£400
Filing written submissions	£400
Discount for partial success (80%)	(£1040)
TOTAL	£260

49) I, therefore, order Temasek Holdings (Private) Limited to pay Touch Foundation, Inc the sum of £260. The above sum should be paid within seven

days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of June 2014

**Mark Bryant
For the Registrar,
the Comptroller-General**