

O-398-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2629333
BY HIBU (UK) LIMITED TO REGISTER THE TRADE MARK:

SNAP IT

IN CLASSES 35, 39, 41, 43 & 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 104380 BY
AMSPHERE LIMITED

BACKGROUND

1. On 25 July 2012, Yell Limited applied to register the mark shown on the cover page of this decision. The application which, following a change of name, now stands in the name of hibu (UK) Limited (“the applicant”), was published for opposition purposes on 19 October 2012 for a range of goods and services in classes 9, 35, 38, 39, 41, 42, 43 and 45. On 18 January 2013, Amsphere Limited (“the opponent”) filed opposition to the application based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition was directed against all of the goods and services in the application with the opponent relying upon all the goods and services in the following Community Trade Mark (“CTM”) registration:

No. 9668997 for the trade mark:



snap-IT

“Mark Description - The word "snap-IT" in stylised text. Colour is not a claimed feature of the mark.”

The mark was applied for on 19 January 2011 and the registration process was completed on 28 June 2011.

Class 9 - Computer software and computer programs for the management of business processes including: computer software supplied from the Internet; computer software and programs for searching, retrieving, managing, sorting, selecting and/or storing information via the Internet and other computer networks and systems; computer software and programs for providing on-line access to the Internet and for running website searches off-line; teaching apparatus and instruments; apparatus and instruments for access protection and control; data storage apparatus and equipment; data storage units for use with computers; pre-recorded video and audio tapes, cassettes, discs and records and read-only-memories; magnetic data carriers; CD-ROMs; inter-active CDs; video CDs; DVDs; computer peripheral apparatus and instruments; information stored in or on electronic magnetic and/or optical means; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks; parts and fittings for the aforesaid goods; all such goods relating to computer systems knowledge transition, software testing, software application management, software dispute and computer systems knowledge retention.

Class 42 - Design, creation, implementation, analysis, development, maintenance and servicing of computer software and computer programs for the management of business processes; IT consultancy and support services for the management of business processes; rental and leasing of computer software and programs for the management of business processes; leasing and rental of computer software for the searching and retrieval of information via computer

systems and computer networks for the management of business processes; provision of information relating to computer software products for the management of business processes; information and advisory services relating to all the aforesaid services; all such services relating to knowledge transition services, software testing services, software application management services, software dispute services and knowledge retention services.

Class 45 - Legal services; software dispute and software dispute resolution services.

2. On 17 January 2013, the applicant filed a form TM21 to amend its specifications in classes 9 and 35. Following a cooling off period which expired on 31 October 2013, on 1 November 2013, the applicant filed a counterstatement in which the basis of the opposition was denied. Both parties filed submissions in the period allowed for evidence and/or submissions to be filed. On 18 March 2014, the applicant filed a form TM21B in which it requested deletion of classes 9, 38 and 42 from the application. Following the various amendments/deletions, the specifications of the classes which remain in the application now read as follows:

Class 35 - Business networking services provided via an internet site.

Class 39 - Information and advisory services relating to travel, transport and packaging and storage of goods; travel and tour agency services, including ticket reservation services for travel; booking agency services; tourist information services.

Class 41 - Information and advisory services relating to education, training, entertainment, sporting, recreation and cultural activities; news reporting services in the nature of news analysis and news commentary; publishing services, including publication of market analysis and research, business reviews, directories, books, guides, maps, magazines, manuals and other printed matter; electronic game services and competitions provided by means of the Internet; arranging, conducting and organising seminars, conferences and exhibitions; entertainment services, including reservation, booking and ticketing services for entertainment.

Class 43 - Reservation services for accommodation and restaurants; information and advisory services relating to accommodation and restaurants.

Class 45 - Social networking services provided via an Internet site.

3. In an e-mail to the Tribunal dated 29 July 2014, the opponent confirmed that these amendments/deletions did not overcome its opposition. The opponent stated:

“...the services in class 35 and 45 in particular are confusingly similar to the goods and services registered in classes 9 and 42 in the opponent’s earlier snap-IT registration.”

4. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing. I will, however, refer to the submissions filed during the evidential rounds, as necessary, below.

DECISION

5. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act which read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark 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.

(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 earlier trade mark is protected, or

(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.

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

6. An earlier trade mark is defined in section 6 of the Act, 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 application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,


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

7. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 1 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years when the

application was published, the earlier trade mark is not subject to proof of use, as per section 6A of the Act.

Comparison of marks

8. The competing marks are as follows:

Opponent's mark	Applicant's mark
	SNAP IT

The case law

Sections 5(1)/5(2)(a)

9. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the CJEU commented on what constitutes an identical trade mark in the following terms:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819 at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that 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 an average consumer.”

Section 5(2)(b)

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, 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 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 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.”

11. In its Notice of opposition, the opponent states:

“The application in suit is directed to SNAP IT as a word mark, i.e. not restricted to any representation. The scope of protection applied for by [the applicant] is not restricted to a specific representation of the mark, and therefore encompasses a representation which amounts to an identical reproduction of the stylised word mark as registered in [the opponent’s earlier mark]. The marks are therefore identical in this respect.”

12. In its counterstatement, the applicant denies that the competing marks are identical and states:

“2...There are a number of visual, phonetic and conceptual differences between the applicant’s mark and the opponent’s mark which lead to a different overall impression. These differences render the applicant’s mark distinguishable from the opponent’s mark.”

13. The applicant expanded upon these comments in its submissions. It states:

“16. The marks are not identical. The differences between [the competing marks] are not insignificant and would be immediately noticed by the average consumer.

18. The opponent’s mark constitutes a one word conjoined mark, due to the hyphenation in the opponent’s mark, rather than two separate words. The hyphen brings a feature to the mark that is not present in the opponent’s (sic) mark. Further, the text in the opponent’s mark is in two different fonts. The “snap”

part of the mark is in a rounded font that emphasises the curves of the letters, whereas the font of the “IT” part of the mark emphasises the straight lines. The various letters are two different shades, with the letter “a” being much lighter than the other letters. These features result in the opponent’s mark giving an overall different impression to the applicant’s mark.

19. As well as bringing visual differences to the mark, the combination of upper and lower case letters help to distinguish the mark phonetically and conceptually. It is clear that the letters “IT” in the opponent’s mark are referring to IT, the short form for “information technology”. In contrast, in the applicant’s mark, they take the same form as the word “snap” and would therefore be understood as being the pronoun “it”.

20. Conceptually, this brings differences to the marks. The applicant’s mark connotes an action, to “snap it”, whereas in the opponent’s mark the “IT” services serve a descriptive function and connote information technology (IT) services. This meaning would be reinforced when the opponent’s mark is used for the opponent’s goods and services. This also brings phonetic differences to the opponent’s mark. When spoken, the applicant’s mark comprises two syllables “snap” and “it”. The opponent’s mark on the other hand would contain three syllables “snap”, “I” and “T”. The sounds of “I” and “T” are different to the sound of the pronoun “it”.

21. The visual, conceptual and phonetic differences render the applicant’s mark not similar to the opponent’s mark, or at least not so similar as to establish a likelihood of confusion...”

14. Whilst I understand the opponent’s submission regarding the scope of protection of the applicant’s mark, that, in my view, is not the correct test for determining whether two marks are identical for the purposes of sections 5(1) and 5(2)(a) of the Act. Rather, what I must do is compare the applicant’s mark in the form for which registration has been sought with the opponent’s mark in the form in which it stands registered. As the CJEU stated, a sign is to be considered identical “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 an average consumer.” Considered from that perspective, I agree with the applicant that the visual differences between the competing marks will not go unnoticed by the average consumer. **The consequence of that conclusion is that the opposition based upon sections 5(1) and 5(2)(a) of the Act fail and are dismissed accordingly.**

15. Having found that the competing marks are not identical, I must now assess them for the purposes of the opposition based upon section 5(2)(b) of the Act. Although in its submissions the applicant speculates as to how the competing marks will be pronounced and the conceptual messages they may convey, its submissions are just that, speculation. Irrespective of the differences in the presentation of the competing

marks, I can see absolutely no reason why the competing marks may not be pronounced in an identical fashion and convey identical conceptual impressions. **Whilst not identical, the competing marks are, in my view, similar to the highest degree.**

The average consumer and the nature of the purchasing decision

16. At this point in my decision I would, as the case law dictates, normally determine who the average consumer is for the respective parties' goods and services and how such an average consumer would select such goods and services in the course of trade. However, the small differences between the competing marks means that it matters not whether the average consumer is a member of the general public or a professional user, whether the goods are selected by the eye or ear (or a combination of the two), or the degree of care (be it high, medium or low) taken during the selection process. Notwithstanding the small differences between the competing marks, if used on goods or services which are identical or similar (even to a low degree) there is, in my view, a likelihood that the average consumer will confuse the marks either directly, or assume that the identical or similar goods and services at issue share a common trade origin.

Distinctive character of the opponent's earlier trade mark

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

18. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its mark to consider. Depending on how it is viewed, the opponent's mark consists of either two well known hyphenated English language words or an English language word accompanied by a well known abbreviation for information technology, presented in a stylised format. Irrespective, there is no evidence or submissions which indicate that the opponent's mark is, when considered as a whole, either descriptive of or non-distinctive for any of the goods and services for which it is registered. It is, in my view, a mark possessed of an average degree of inherent distinctive character.

Comparison of goods and services

19. The competing goods and services are as follows:

Opponent's goods and services	Applicant's services
<p>Class 9 - Computer software and computer programs for the management of business processes including: computer software supplied from the Internet; computer software and programs for searching, retrieving, managing, sorting, selecting and/or storing information via the Internet and other computer networks and systems; computer software and programs for providing on-line access to the Internet and for running website searches off-line; teaching apparatus and instruments; apparatus and instruments for access protection and control; data storage apparatus and equipment; data storage units for use with computers; pre-recorded video and audio tapes, cassettes, discs and records and read-only-memories; magnetic data carriers; CD-ROMs; interactive CDs; video CDs; DVDs; computer peripheral apparatus and instruments; information stored in or on electronic magnetic and/or optical means; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks; parts and fittings for the aforesaid goods; all such goods relating to computer systems knowledge transition, software testing, software application management, software dispute and computer systems knowledge retention.</p> <p>Class 42 - Design, creation, implementation, analysis, development, maintenance and servicing of computer software and computer programs for the management of business processes; IT consultancy and support services for the management of business processes; rental and leasing of computer software</p>	<p>Class 35 - Business networking services provided via an internet site.</p> <p>Class 39 - Information and advisory services relating to travel, transport and packaging and storage of goods; travel and tour agency services, including ticket reservation services for travel; booking agency services; tourist information services.</p> <p>Class 41 - Information and advisory services relating to education, training, entertainment, sporting, recreation and cultural activities; news reporting services in the nature of news analysis and news commentary; publishing services, including publication of market analysis and research, business reviews, directories, books, guides, maps, magazines, manuals and other printed matter; electronic game services and competitions provided by means of the Internet; arranging, conducting and organising seminars, conferences and exhibitions; entertainment services, including reservation, booking and ticketing services for entertainment.</p> <p>Class 43 - Reservation services for accommodation and restaurants; information and advisory services relating to accommodation and restaurants.</p> <p>Class 45 - Social networking services provided via an Internet site.</p>

<p>and programs for the management of business processes; leasing and rental of computer software for the searching and retrieval of information via computer systems and computer networks for the management of business processes; provision of information relating to computer software products for the management of business processes; information and advisory services relating to all the aforesaid services; all such services relating to knowledge transition services, software testing services, software application management services, software dispute services and knowledge retention services.</p> <p>Class 45 - Legal services; software dispute and software dispute resolution services.</p>	
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20. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12], Floyd J stated:

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

In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

"82 It is true that goods 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 *Sergio 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 Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander Q.C., sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

"20. In my judgment, the reference to "legal definition" suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*."

Finally, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 are also relevant:

“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.”

21. In view of the conclusions I have already reached on, inter alia, the degree of similarity in the competing marks, the assessment of either the identity or degree of similarity in the competing goods and services (if indeed there is any) will, given the principle of interdependency, have a pivotal effect on whether there is or is not a likelihood of confusion. Given the obvious importance of this issue, I have (insofar as they are still relevant following the various amendments/deletions that have been made to the application), reproduced below the parties’ competing submissions. In this regard, it is, I think, fair to say, that the majority of the opponent’s submissions on the similarity in the competing goods and services were directed at the clash between the competing specifications in classes 9 and 42 (both of which have now been deleted from the application). In relation to the goods and services which remain, in its Notice of opposition, the opponent stated:

“With regards the services in...45...and providing a networking website are closely related to the IT services [in the opponent’s earlier mark]. With regards the services in 35, 39, 41 and 43 when provided via computer, internet or other electronic means, particularly a SNAP IT website, there is a likelihood of confusion...with respect to computer software and certain related IT services” (my emphasis).

In its submissions filed during the evidential rounds, the opponent commented:

“The opponent further submits that the services specified in classes 35, 41 and 45 [I note that classes 39 and 43 are not mentioned] of the application in suit are so closely related to the goods and services specified in [the earlier mark]...” (my emphasis).

I also remind myself that in its e-mail to the Tribunal dated 29 July 2014, the opponent stated:

“...the services in class 35 and 45 in particular are confusingly similar to the goods and services registered in classes 9 and 42 in the opponent’s snap-IT registration.”

In its submissions, the applicant states:

“10. For example, the social and business networking services covered by the application in classes 35 and 45 are not similar to the opponent’s goods and

services. The nature of these services is different. The applicant's services in class 35 [this should refer to class 45] relate to building connections and relationships between people socially and in their personal lives, and the business networking services covered by the application in class 45 [this should refer to class 35] relate to building connections and relationships between colleagues and business contacts. The opponent's goods and services, on the other hand, are technical goods and services relating to [the opponent's goods and services as limited and legal services etc.].

11. The applicant's services in classes 35 and 45 have a different purpose and serve a different function to the opponent's goods and services. They are used in different contexts and the public would not expect them to be provided by the same businesses. The provision of the applicant's services in class 35 through the internet does not make them similar to the opponent's goods and services. The internet is just the delivery means, and does not detract from the fact that these services are fundamentally not similar to the opponent's goods and services. These days almost anything can be provided on or through the internet.

12. The applicant's services in classes 39, 41 and 43, also clearly have no similarity whatsoever to all of the opponent's goods and services. The nature of these services is different to the opponent's goods and services. They have different users and uses. They serve different functions and they are not in competition with the opponent's goods and services. They are used in different contexts and the public would not expect them to be provided by the same businesses."

22. The manner in which the opponent has framed its case in relation to the services which remain is, in my view, extremely vague. It refers to goods and services being "closely related", to "certain IT related services" and uses the phrase "in particular"; it does not, however, explain precisely why it considers the competing goods and services to be closely related nor does it identify the related IT services in its registration to which it refers. I should add that in its submissions, the opponent does not (as least as far as I can tell) appear to be relying upon its services in class 45 (the opponent's e-mail of 29 July 2014 refers).

23. In approaching the comparison, I remind myself of the comments in *Avnet* i.e. specifications of services should be scrutinised carefully and should not be given a wide construction covering a vast range of activities, and that the opponent's specifications in classes 9 and 42 are limited to goods/services relating to knowledge transition, software testing, software application management, software dispute and knowledge retention. Whilst I understand the meanings of the terms software testing, software application management and software dispute, I am less certain how the terms knowledge transition and knowledge retention should be construed (and have been provided with no evidence/submissions in this respect). I approach the comparison with those observations/reservations in mind.

24. Taking the best view I can of the opponent's specifications in classes 9 and 42 in light of my comments above, they suggest to me an undertaking whose interests lie in providing specific types of computer software, items of hardware and related services including, inter alia, design, maintenance, servicing, rental and leasing of computer software; all of these goods and services are for the very specific and limited purposes mentioned above. The opponent's goods and services are, in my view, most likely to be provided to business users.

25. As to the applicant's services, these point to an undertaking who is providing or intends to provide, broadly speaking, information and advisory services relating to travel, transport, packaging and storage of goods, education, training, entertainment, sport, recreation, cultural activities, accommodation and restaurants, a range of travel related services, restaurant reservation services, publishing services, entertainment and related services, arranging conducting and organising seminars, conferences and exhibitions and business and social networking services. The applicant's services will be provided to the public at large, including business users.

26. The applicant points out in its submissions that the mere fact that its services may be provided via the Internet does not, without more, make them similar to the opponent's goods and services in classes 9 and 42; I agree. Whilst I accept that the users of the competing goods and services which remain may be the same, in reality, that point alone tells one little. In my view, "publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks" in the opponent's specification in class 9 and: "publishing services, including publication of market analysis and research, business reviews, directories, books, guides, maps, magazines, manuals and other printed matter" in class 41 of the application are, given, inter alia, the similarities in the users, intended purpose and complementary nature and notwithstanding the limitation to the opponent's specification, similar goods and services (in this respect, it should be noted that the use of the word "including" in the phrase shown above does not limit the applicant's publishing services to only those areas identified). However, without evidence or focused submissions to assist me, and given what appears to be the very specific and specialised nature of the opponent's goods and services, it appears to me that the intended purpose and trade channels of the competing goods and services which remain are likely to be quite different. In addition, I see no reason why the competing goods and services which remain should be regarded as being either complementary to or in competition with one another.

27. I have already highlighted above the importance that the comparison of the competing goods and services was likely to have on the outcome of these proceedings. However, having taken the best view I can of the matter in light of the competing specifications and the submissions before me, and with the exception of the applicant's publishing services in class 41, I can see no meaningful similarity between the services which remain in the application and the opponent's goods and services.

Likelihood of confusion

28. As per the comments of the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07, there must be some similarity in the competing goods and services to engage the test for the likelihood of confusion. As I have concluded that (with the exception of publishing services in class 41 of the application) there is no similarity in the opponent's goods in classes 9 and 42 and the applicant's services which remain, there can, despite the high degree of similarity in the competing marks, be no likelihood of confusion and the opposition based upon section 5(2)(b) of the Act is dismissed accordingly. Insofar as the applicant's publishing services in class 41 are concerned, the high degree of similarity in the marks combined with the obvious similarity in the goods and services is, in my view, bound to lead to a likelihood of (at least) indirect confusion, and, more likely, direct confusion.

Conclusion

29. As a consequence of the above conclusions, the opposition under section 5(2)(b) of the Act succeeds in relation to:

“Publishing services, including publication of market analysis and research, business reviews, directories, books, guides, maps, magazines, manuals and other printed matter”,

but fails in relation to all of the remaining services. Subject to any successful appeal, the application will proceed to registration for all the services which remain in the application with the exception of the publishing services in class 41 mentioned above.

Costs

30. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In approaching this issue, I am guided by the comments of the Appointed Person in BL O/197/11 *Wm Morrison Supermarkets Plc v Nisa-Today's (Holdings) Limited*. The applicant originally applied for registration in 8 classes. As a consequence of the filing of the opposition, the applicant deleted three classes in their entirety (i.e. 9, 38 and 42), significantly limited its specification in class 35 and the opponent has been successful in relation to one phrase within class 41 of the application. Applying the “rough and ready approach” advocated, I view this as more or less a “score draw” and, as a consequence, both parties should bear their own costs.

Dated this 9th day of September 2014

C J BOWEN
For the Registrar
The Comptroller-General