

O/112/15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3040880
BY THE DANWOOD GROUP LIMITED
TO REGISTER THE TRADE MARK:

DCS

IN CLASSES 9, 16, 35, 37 & 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 402705 BY
D.VELOP AG

BACKGROUND

1. On 5 February 2014, The Danwood Group Limited (“the applicant”) applied to register the trade mark **DCS**. The application was published for opposition purposes on 23 May 2014, for the following goods and services:

Class 9 - Apparatus for recording, transmission or reproduction of images, data processing equipment, networked and stand-alone scanning, printing and photocopying equipment and document management technology equipment.

Class 16 - Office requisites - photocopying, scanning and printing equipment and document management.

Class 35 - Business administration; office functions; data processing; provision of business information - retail services connected with the sale of networked and stand-alone scanning, printing and photocopying equipment with document management services.

Class 37 - Installation, maintenance and repair of computer hardware, and maintenance of networked and standalone scanning, printing and photocopying equipment.

Class 42 - Installation, maintenance and repair of computer software; computer consultancy services - consultancy, advisory and analysis services for networked and standalone scanning, printing and photocopying equipment and document management services.

2. The application was opposed in full by d.velop AG (“the opponent”) on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon all of the goods and services (shown below) in Community Trade Mark (“CTM”) registration no. 8334121 for the trade mark: **d.ecs** which was applied for on 2 June 2009 and the registration process for which was completed on 24 December 2009:

Class 9 - Programs; Apparatus for recording, transmission and reproduction of sound and/or images; Data processing equipment and computers and individual parts and peripheral devices therefor, in particular keyboards, monitors, printers, drives, interfaces, cards, scanners, optical storage devices (included in class 9); machine-readable data carriers of all kinds with programs/data installed, including magnetic data carriers; ancillary equipment for computers and data processing equipment, in particular scanners and optical storage devices; electric apparatus and instruments (included in class 9).

Class 16 - Printed matter; folders for papers, archive bags.

Class 35 - Business consultancy, in particular with regard to EDP and software, and the optimisation of business work processes; organization consultancy;

business consultancy and advisory services; marketing; online provider services, namely the gathering of information; online provider services, namely gathering of information, in particular on the Internet; dissemination of advertising for others via the Internet; On line advertising on a computer network; systematic ordering of data in computer databases; business consultancy, namely with regard to software.

Class 38 - Online provider services, namely transmission of information and providing of information in the field of telecommunications, in particular on the Internet (included in class 38); database services and operating databases, namely with regard to providing archived data for authorised parties; leasing access time to a computer database; data transmission for archiving and information purposes; transmission of advertising on the Internet; telecommunications; Internet provider services (included in class 38); online provider services, namely transmission of information and providing of information in the field of telecommunications (included in class 38).

Class 41 - Providing of training and further training; conducting training courses in connection with computers, computer programs, computer peripheral devices and computer ancillary equipment, and in connection with the archiving of data and archive management; consultancy with regard to the archiving of data and archive planning; archive management consultancy; archiving, archive management, archive maintenance.

Class 42 - Computer programming; technical consultancy, in particular with regard to the archiving of data and archive planning; rental of web servers and providing of memory space on the Internet; design and creation of World Wide Web presentations, homepages, Internet applications and e-commerce applications; Internet and IT security consultancy; creation, design, writing and updating of websites, for others, creating, design and maintenance of websites; consultancy in connection with computers, computer programs, computer peripheral devices and computer ancillary equipment; creation of data-processing programs; creating software for databases; conversion of data or documents from physical to electronic media.

3. On the same day the Notice of opposition was filed, the applicant amended its specification of goods and services in classes 9 and 42 (the remaining classes were not affected). The amended classes now read as follows:

Class 9 - Networked and stand-alone scanning, printing and photocopying equipment and document management technology equipment.

Class 42 - Installation, maintenance and repair of document management and printing software; computer consultancy services for document management and for printing; consultancy, advisory and analysis services for networked and

standalone scanning, printing and photocopying equipment and document management services.

4. In a letter dated 2 September 2014, the opponent's professional representatives indicated that the amendments did not dispose of the opposition.
5. The applicant filed a counterstatement in which the basis of the opposition is denied.
6. Although neither party filed evidence, the opponent filed written submission during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing; I will keep these submissions in mind and refer to them, as necessary, below.

DECISION

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

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

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

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

8. 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.”

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

6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods and services for which its earlier trade mark is registered.

Section 5(2)(b) – case law

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

11. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<p>Class 9 - Programs; Apparatus for recording, transmission and reproduction of sound and/or images; Data processing equipment and computers and individual parts and peripheral devices therefor, in particular keyboards, monitors, printers, drives, interfaces, cards, scanners, optical storage devices (included in class 9); machine-readable data carriers of all kinds with programs/data installed, including magnetic data carriers; ancillary equipment for computers and data processing equipment, in particular scanners and optical storage devices; electric apparatus and instruments (included in class 9).</p> <p>Class 16 - Printed matter; folders for papers, archive bags.</p> <p>Class 35 - Business consultancy, in particular with regard to EDP and software, and the optimisation of business work processes; organization consultancy; business consultancy and advisory services; marketing; online provider services, namely the gathering of information; online provider services, namely gathering of information, in particular on the Internet; dissemination of advertising for others via the Internet; On line advertising on a computer network; systematic ordering of data in computer databases; business</p>	<p>Class 9 - Networked and stand-alone scanning, printing and photocopying equipment and document management technology equipment.</p> <p>Class 16 - Office requisites - photocopying, scanning and printing equipment and document management.</p> <p>Class 35 - Business administration; office functions; data processing; provision of business information - retail services connected with the sale of networked and stand-alone scanning, printing and photocopying equipment with document management services.</p> <p>Class 37 - Installation, maintenance and repair of computer hardware, and maintenance of networked and standalone scanning, printing and photocopying equipment.</p> <p>Class 42 - Installation, maintenance and repair of document management and printing software; computer consultancy services for document management and for printing; consultancy, advisory and analysis services for networked and standalone scanning,</p>

<p>consultancy, namely with regard to software.</p> <p>Class 38 - Online provider services, namely transmission of information and providing of information in the field of telecommunications, in particular on the Internet (included in class 38); database services and operating databases, namely with regard to providing archived data for authorised parties; leasing access time to a computer database; data transmission for archiving and information purposes; transmission of advertising on the Internet; telecommunications; Internet provider services (included in class 38); online provider services, namely transmission of information and providing of information in the field of telecommunications (included in class 38).</p> <p>Class 41 - Providing of training and further training; conducting training courses in connection with computers, computer programs, computer peripheral devices and computer ancillary equipment, and in connection with the archiving of data and archive management; consultancy with regard to the archiving of data and archive planning; archive management consultancy; archiving, archive management, archive maintenance.</p> <p>Class 42 - Computer programming; technical consultancy, in particular with regard to the archiving of data and archive planning; rental of web servers and providing of memory space on the Internet; design and creation of World Wide Web presentations, homepages, Internet applications and e-commerce applications; Internet and IT security consultancy; creation, design, writing and updating of websites, for others, creating, design and maintenance of websites; consultancy in connection with computers, computer programs, computer peripheral devices and computer ancillary equipment; creation of data-processing programs; creating software for databases; conversion of data or documents from physical to electronic media.</p>	<p>printing and photocopying equipment and document management services.</p>
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12. The opponent uses the word “namely” and the formulation “in particular” in a number of its specifications. Whilst the word “namely” must be approached, as indicated

in the Trade Mark Registry's classification guidance on the basis shown below, the use of the formulation "in particular" has no such limiting effect.

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

The correct approach to the comparison of goods and services

13. In its counterstatement, the applicant comments, inter alia, upon what goods and services it considers the opponent uses its trade mark. However, as the opponent points out in its submissions, that is not the correct approach. As the opponent's earlier trade mark is not subject to proof of use, what I am required to do is compare the goods and services which appear in the application with the goods and services in the opponent's earlier trade mark.

The opponent's submissions on the comparison of goods and services

14. The opponent argues that the applicant's goods and services in classes 9, 35 and 42 are "encompassed by and consequently identical to" its goods and services in the corresponding classes. Alternatively, it argues that applicant's services in class 42 are complementary to its goods in class 9. Insofar as class 16 is concerned, it argues that "to the extent that these goods appear proper to class 16 (as opposed to class 9), these are identical to [its] goods in classes 9 and 16." Finally, in relation to the applicant's services in class 37, it argues that as these services relate to the installation, maintenance and repair of goods covered by its registration in class 9, the applicant's services in this class are complementary to its goods.

The case law relating to similarity of goods and services

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This 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.

16. 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.”

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 *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

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

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

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

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

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

21. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM* - Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM* - Case T-105/05, at paragraphs [30] to [35] of the judgment upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* - Case C-398/07P, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that a registration for ‘retail services’, which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

Class 9

22. The applicant has limited its specification in this class to:

Networked and stand-alone scanning, printing and photocopying equipment and document management technology equipment.

23. As the opponent's specification in this class includes a range of "data processing equipment" including, inter alia, "printers", "scanners" and "optical storage devices", I find that the applicant's goods are to be regarded as identical to the opponent's goods mentioned on the principles outlined in *Meric*.

Class 16

24. In my view, the applicant's specification is to be interpreted as meaning:

Office requisites for use with photocopying, scanning, printing and document management equipment.

25. As this would include "folders for paper" and "archive bags" in the opponent's specification in this class, the competing goods are, to that extent at least, identical on the *Meric* principle. However, if one interprets the applicant's specification in the manner I have suggested, it is likely to include goods in class 16 (staples for example) which are unlikely to be considered similar to the opponent's goods in either class 9 or class 16. For reasons which will become obvious later in this decision, there is no need for me to resolve this issue here.

Class 35

26. The applicant's services in this class fall into a number of categories i.e. (i) Business administration, office functions, (ii) data processing, (iii) provision of business information and (iv) retail services connected with the sale of networked and stand-alone scanning, printing and photocopying equipment with document management services. In comparing the competing services, I will keep in mind the comments in *Avnet* mentioned above, and will approach the terms "business administration" and "office functions" on the basis that the terms involve the provision of assistance in the running of a business in terms of its organisation and assistance in relation to administrative tasks respectively.

27. As "business administration" in the application would be included in (at least) "business consultancy...the optimisation of business work processes" and as "office functions" in the application would include (at least) "systematic ordering of data in computer databases" in the opponent's specification in class 35, these services are identical on the principles outlined in *Meric*. As "systematic ordering of data in computer databases" is a sub-set of "data processing" which appears in the application, these services are also identical on the *Meric* principle. Insofar as "provision of business

information” in the application is concerned, as this would include “online provider services, namely gathering of information” in the opponent’s specification in class 35, the competing services are, once again, identical on the principles outlined in *Meric*.

28. That leaves “retail services connected with the sale of networked and stand-alone scanning, printing and photocopying equipment with document management services” to be considered. The case law above indicates that retail services may be considered complementary to goods if the complementarity between them is sufficiently pronounced that the average consumer assumes the goods and services come from the same undertaking. As I have no evidence to assist me, I have only my own experience and the relevant case law above upon which to draw. The opponent’s “data processing equipment” including, inter alia, “printers”, “scanners” and “optical storage devices” in class 9 will be retailed through a wide variety of outlets both on the high street, in catalogues and on-line. The applicant is providing a service retailing scanning, printing and photocopying equipment, all of which are goods which would be encompassed by the opponent’s goods mentioned above. As it is not, in my experience, unusual to find a trader in the goods mentioned in the opponent’s specification also conducting a retail trade in such goods, as well as providing a range of ancillary services (the latter perhaps as part of an ongoing service contract of some kind), the link between the opponent’s goods and the applicant’s retail services is, in my view, likely to be sufficiently well established that the average consumer will assume that the goods and services are being offered by the same undertaking. The competing goods and services are, as a consequence, complementary, and similar to at least a low degree.

Class 37

29. The applicant’s specification in this class reads:

Installation, maintenance and repair of computer hardware and maintenance of networked and standalone scanning, printing and photocopying equipment,

whereas the opponent’s earlier trade mark includes, inter alia, “data processing equipment and computers...printers, scanners, optical storage devices” in class 9 and “consultancy in connection with computers...computer peripheral devices and computer ancillary equipment” in class 42. Given my comments in relation to class 35, the fact that some undertakings trading in the opponent’s goods and services may also provide a range of ancillary services, such as, installation, maintenance and repair, leads me to conclude that the respective users, intended purpose and trade channels of the competing goods and services are likely to be similar. As a consequence, there is, in my view, a complementary relationship between the applicant’s services and the opponent’s goods and services I have identified, leading to the competing goods and services being similar to a reasonable degree.

Class 42

30. The applicant's specification in this class reads:

Installation, maintenance and repair of document management and printing software; computer consultancy services for document management and for printing; consultancy, advisory and analysis services for networked and standalone scanning, printing and photocopying equipment and document management services.

31. For the reasons mentioned above, the applicant's "installation, maintenance and repair of document management and printing software" is, in my view, complementary/reasonably similar to "programs", "machine readable data carriers of all kinds with programs/data installed...", "computer programming" and "consultancy in connection with...computer programs...", "creation of data processing programs" and "creating software for databases" in classes 9 and 42 of the opponent's earlier trade mark. As the services which remain i.e. "computer consultancy services for document management and for printing; consultancy, advisory and analysis services for networked and standalone scanning, printing and photocopying equipment and document management services" would all be encompassed by "consultancy in connection with computers, computer programs, computer peripheral devices and computer ancillary equipment" appearing in the opponent's specification in class 42, these services are identical on the *Meric* principle.

The average consumer and the nature of the purchasing decision

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

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

33. In its submissions in lieu of a hearing, the opponent states:

"21...The goods and services offered under both marks relate primarily to office equipment and computer software and hardware. The purchasing public are increasingly "I.T. literate" and therefore these goods are not highly specialised.

Consequently we submit that the level of attention of the public concerned will be average.”

34. The average consumer of the goods and services at issue is, in relation to the goods and the retail services in class 35, a member of the general public, or in relation to all the goods and services, a business user selecting on behalf of a commercial undertaking. Absent evidence or submissions to assist me, the vast majority of the goods and services at issue are, in my view, likely to be self selected from, for example, retail outlets on the high street or from the pages of a website or catalogue; all of which suggests that visual considerations are likely to loom large in the selection process, but not to the extent that aural considerations (perhaps in the form of orders placed by telephone or personal recommendations) can be ignored. As to the degree of care taken during the selection process, the opponent pitches this as average. Whilst I understand the opponent’s submission regarding the average consumer’s familiarity with IT equipment and services, given the likely cost and relatively technical nature of many of the goods and services at issue, I think a member of the general public or a business user (where, in relation to the latter, long term strategic considerations and much more significant sums of money are likely to be in play), will pay a relatively high degree of attention to the selection of the majority of the goods and services at issue.

Comparison of trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

37. The competing trade marks are: **DCS** (the application) and **d.ecs** (the opponent’s trade mark). The opponent’s trade mark consists of the letter “d” presented in lower case followed by a full stop and the letters “e-c-s” also presented in lower case. Although the presence of the full stop will not, in my view, be overlooked and serves to

separate the letter “d” from the letters “ecs”, that does not mean that any one element is more distinctive or dominant than the other; the overall impression created will be of either a string of four letters “d-e-c-s” or of a word containing these letters. As to the applicant’s trade mark, this consists of the three letters “DCS” presented in upper case. As no part of the trade mark is highlighted or emphasised in any way, there are no distinctive or dominant components; the overall impression will be of a string of three letters.

38. The competing trade marks consist of three letters and four letters and a punctuation mark presented in upper and lower case respectively. Both begin with the letter “D/d” and contain the letters “CS/cs” as the last two letters. They differ to the extent that the opponent’s trade mark also contains a full stop and the letter “e” as the second letter (a letter which is absent from the applicant’s trade mark). The fact that the competing trade marks are relatively short combined with the fact that the opponent’s trade mark also contains a full stop and the additional letter “e”, results, in my view, in a low to medium degree of visual similarity between them.

39. Insofar as aural similarity is concerned, the parties agree, as do I, that the applicant’s trade mark will be pronounced as three individual letters. As to the opponent’s trade mark, the opponent suggests that its trade mark will also be pronounced as four individual letters. Although in its counterstatement the applicant suggests that the opponent’s trade mark may be pronounced as “decks”, it accepts that its pronunciation as individual letters is also likely. My own view is that both variants are equally possible. If the applicant’s trade mark is pronounced as the word “decks” there is no aural similarity between the competing trade marks. However, if it is pronounced as individual letters, the opponent argues that as the sound of the letter “e” in its trade mark is partially included in the letter “d” which appears at the beginnings of both trade marks, the letter “e” becomes lost within the pronunciation of the letter “d” and the competing trade marks are, as a consequence, aurally highly similar. Whilst I appreciate the opponent’s argument, in short trade marks such as these which may be pronounced as letters, the inclusion of an additional letter (even in the body of the trade mark) is likely, in my view, to have a greater impact than in longer trade marks where I accept it is more likely to be lost. However, if pronounced as letters, the fact that both trade marks begin with a letter “D/d” and end with the letters “CS/cs” still, in my view, results in at least a medium degree of aural similarity between them.

40. Finally, if both trade marks are construed as a string of letters, they are unlikely to send any conceptual messages and the conceptual position will be neutral. The fact that both trade marks consist of a string of letters does not, as the opponent argues, make them conceptually identical. However, if the average consumer pronounces the opponent’s trade mark as “decks” (deck being a word with which the average consumer will be familiar), this is likely to impact on the conceptual image the trade mark conjures up in his mind; in those circumstances, the opponent’s trade mark is likely to send a concrete conceptual message whereas the applicant’s trade mark will not.

Distinctive character of the opponent's earlier trade mark

41. 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. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider. Regardless of how it is construed, there is nothing to suggest that the opponent's trade mark is anything other than distinctive for the goods and services for which it stands registered. It is, as consequence, a trade mark possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

42. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

43. Earlier in this decision, I concluded that (i) for the most part, the competing goods and services were either identical or similar to a reasonable degree, (ii) the average consumer was either a member of the general public or a business user who would select the goods and services by primarily visual means and who would, for the most part, pay a relatively high degree of attention when doing so, (iii) the competing trade marks were visually similar to a low to medium degree, aurally similar to, at least, a medium degree, and that the conceptual position was, when considered from the opponent's standpoint, at best, neutral. Finally, I found the opponent's earlier trade mark to be possessed of a fairly high degree of inherent distinctive character.

44. I now need to determine whether there will be a likelihood of confusion. In my view, there will not. Of course, where there is no similarity in the goods (my comments in relation to class 16 refer), there can be no likelihood of confusion. However, even where I have found the competing goods and services to be identical or reasonably similar (and even if I had found all the competing goods and services to be identical), if the

opponent's trade mark is remembered and articulated by the average consumer as the word "decks", there will be no aural similarity and the conceptual imagery created will, as per the comments of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P, be more than sufficient to counteract any visual similarity that exists between the competing trade marks. However, (proceeding once again on the basis that all of the competing goods and services are identical), if the opponent's trade mark is remembered and verbalised as letters, the visual and aural differences created by the inclusion of the full stop and the presence of the additional letter "e" in the opponent's trade mark is, notwithstanding the lack of a conceptual hook to aid the average consumer's recollection, sufficient, in my view, in circumstances where the average consumer pays a relatively high degree of attention when selecting the goods and services at issue to avoid confusion. Although a lower degree of attention is likely to be paid to the selection of what may be lower cost goods in class 16, the difference in the competing trade marks I have identified, is still, in my view, just, sufficient to avoid a likelihood of confusion in those circumstances.

Conclusion

45. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

46. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of TPN 4 of 2007. Using that TPN as a guide, but bearing in mind that the applicant has not been professionally represented in these proceedings, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement/submissions:	£200
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Total:	£200
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47. I order d.velop AG to pay to The Danwood Group Limited the sum of **£200**. This sum is to 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 16th day of March 2015

C J BOWEN
For the Registrar
The Comptroller-General