

O-053-18

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3185250
BY MR ADRIAN BRADLEY
TO REGISTER**



**AS A TRADE MARK
IN CLASS 42
AND OPPOSITION THERETO (UNDER NO. 408209)
BY
O2 WORLDWIDE LIMITED**

Background and pleadings

1. Mr Adrian Bradley ('the applicant') applied to register the trade mark outlined on the title page for various software services in class 42 on 12 September 2016. The mark was published on 7 October 2016. The class 42 specification of services was amended by means of a form TM21B dated 22 September 2017. The amended specification is set out later in this decision.

2. O2 Worldwide Limited ('the opponent') opposes the trade mark under section 5(2)(b) of the Trade Mark Act 1994 ('The Act') against all of the services in the application on the basis of classes 9, 35, 36, 37, 38, 39, 41, 42 and 45 of its UK and EU trade marks set out below. However the opponent has only set out its class 42 services in its written submission dated 3 November 2017.

<p>UK TM 2587310</p> <p>GENIE</p> <p>Filing Date: 11/7/2011 Registration date: 2/12/2011</p>	<p>Class 42 services relied on:</p> <p>Scientific and technological services and research and design relating thereto; industrial analysis and research services; information and consultancy services relating to information technology; consultancy services relating to information technology; engineering services relating to information technology; information services relating to information technology; technical consultancy services relating to information technology; computer programming services; programming of data processing apparatus and equipment; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of</p>
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	<p>computer programs; installation of computer software; maintenance of computer software; updating of computer software; computer system design; computer systems analysis; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites) of others; engineering services relating to telecommunications; technical consulting; rental of computers; monitoring of telecommunications network systems; services of information brokers and providers, namely product research for others; weather forecasting; research relating to telecommunications; research of field telecommunication technology; technical support services relating to telecommunications and apparatus; expert advice and opinion relating to technology; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.</p>
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EU TM 10113009

GENIE

Filing Date: 11/7/2011

Date of entry in register: 17/10/2012

Class 42 services relied on:

Scientific and technological services and research and design relating thereto; industrial analysis and research services; IT services; computer programming services; services of a programmer; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; installation of computer software; maintenance of computer software; updating of computer software; computer system design; computer systems analysis; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites); services of engineers; expert advice and expert opinion relating to technology; rental of data processing apparatus and computers; technical services relating to projection and planning of equipment for telecommunications; services of information brokers and providers, namely product research for others; weather forecasting; research in the field of telecommunication technology; monitoring of network systems in the

	<p>field of telecommunications; technical support services relating to telecommunications and apparatus information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.</p>
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3. The applicant filed a counterstatement denying the grounds of opposition.

4. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act, but as they have not been registered for five years or more before the publication date of the applicant's mark, neither are subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant has been represented in these proceedings by Hanna IP and the opponent by Stobbs.

6. Neither party filed evidence. Only the opponent has filed written submissions. No hearing was requested so this decision is taken from consideration of the papers before me.

Decision

7. Section 5(2)(b) of the Act is 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. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 services

9. The opponent has indicated that it relies on its earlier registrations insofar as they are registered for goods and services in classes 9, 35, 36, 37, 38, 39, 41, 42 and 45 of its UK and EU trade marks. As previously stated, the opponent has only set out its class 42 services in its written submission dated 3 November 2017. I intend to carry out the comparison only in respect of services in class 42, returning to consider the other classes only if it becomes necessary to do so.

The services to be compared are:

Opponent's services	Applicant's services
<p>UK TM 2587310: Scientific and technological services and research and design relating thereto; industrial analysis and research services; information and consultancy services relating to information technology; consultancy services relating to information technology; engineering services relating to information technology; information services relating to information technology; technical consultancy services relating to information technology; computer programming services; programming of data processing apparatus and equipment; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; installation of computer software; maintenance of computer software; updating of computer software; computer system design; computer systems analysis; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites) of others; engineering</p>	<p>Software as a service in the fields of business networking and marketing, employment, recruiting and recruitment advertising; Software as a service, namely, for uploading, managing and searching resumes, social profiles, job qualifications and personnel records; Software as a service, namely, providing search engines for obtaining and matching information from databases in the field of jobs and employment; Software as a service, namely, for the management of recruitment and personnel information; Software as a service in the nature of customised web pages featuring user-defined information, personal profiles and information; Software as a service, namely, hosting an interactive website and on-line non-downloadable software for uploading, downloading, posting and displaying recruitment information, personnel specifications, resumes, job qualification information and personal records; Software as a service, namely, providing a search engine for obtaining job listings, resume postings, and other job information via a global communications network; Software as a service, namely, hosting electronic</p>

<p>services relating to telecommunications; technical consulting; rental of computers; monitoring of telecommunications network systems; services of information brokers and providers, namely product research for others; weather forecasting; research relating to telecommunications; research of field telecommunication technology; technical support services relating to telecommunications and apparatus; expert advice and opinion relating to technology; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.</p> <p>EU TM 10113009: Scientific and technological services and research and design relating thereto; industrial analysis and research services; IT services; computer programming services; services of a programmer; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; installation of</p>	<p>facilities for others for organising and conducting recruitment and business events and interactive recruitment and business discussions via the Internet or other communications networks; Software as a service enabling users to search, locate and communicate with others via electronic communications networks for networking, for conducting polls and surveys, for tracking online references to businesses, organisations, career and job opportunities, and business topics; polls and surveys, for tracking online references to businesses, career and recruitment opportunities, and business topics; Software as a service providing online computer databases and online searchable databases in the fields of business and professional networking; Software as a service, enabling an online community for registered users to share business and recruitment information and to engage in communication and collaboration between and among themselves, to form groups and to engage in business and professional networking; Software as a service, for providing temporary and permanent employment positions, booking reservations for such temporary and permanent employment positions and for dispatching job and employment</p>
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computer software; maintenance of computer software; updating of computer software; computer system design; computer systems analysis; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites); services of engineers; expert advice and expert opinion relating to technology; rental of data processing apparatus and computers; technical services relating to projection and planning of equipment for telecommunications; services of information brokers and providers, namely product research for others; weather forecasting; research in the field of telecommunication technology; monitoring of network systems in the field of telecommunications; technical support services relating to telecommunications and apparatus information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services

agents to prospective employers in their geographical location; Software as a service for engaging and coordinating temporary and permanent employment positions by connecting employers with workers via a mobile application and for dispatching job and employment agents to prospective employers in their geographical location; Software as a service for use in reviewing, applying, uploading and editing temporary and permanent employment positions and for connecting employers with workers for such positions and for dispatching job and employment agents to prospective employers in the geographical location; Creation, design and development of software for use in the fields of business and professional networking; Creation, design and development of software for use in the fields of business networking and marketing, employment, recruiting, advertising, marketing and promotion; Creation, design and development of software for uploading, managing and searching recruitment resumes, social profiles, job qualifications and personnel records; Creation, design and development of software for providing search engines for obtaining and matching information from databases in the fields of jobs and employment;

<p>provided over a telecommunications network.</p>	<p>Creation, design and development of software for the management of recruitment and personnel information; Creation, design and development of software, namely software for use of organising and conducting recruitment and business events and interactive recruitment and business discussions via the Internet or other communications networks; Creation, design and development of software, namely software to enable users to search, locate and communicate with others via electronic communications networks for networking, for conducting polls and surveys, for tracking online references to businesses, organisations, career and job opportunities, and business topics; Creation, design and development of software, namely software to enable an online community for registered users to form groups and to share recruitment information and engage in communication and collaboration between and among themselves, and to engage in business and professional networking.</p>
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10. With regard to the comparison of services, in the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

11. 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.

12. In its counterstatement I have noted the applicant’s submission that the mark will “...operate in an industry totally separate to that of O2.” But the way in which either party currently uses their marks is irrelevant. I must compare the parties’ services on the basis of notional and fair use of the services listed in the parties’ specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the

Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

13. In its written submission the opponent states:

“Whilst the applicant has narrowed its specification to relate to more specific types of software as a service, software creation etc, it can be seen that the opponent still has identical, if not very similar coverage in relation to the challenged application’s specification. All of the applicant’s services are a subset of *IT services* or *maintenance of computer software*. They are also all similar to the opponent’s *computer programming services*.”

14. With regard to narrower terms falling within the ambit of broader terms, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (‘GC’) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. I agree with the opponent’s submission that the applicant’s *software as a service* terms, although they are limited to the employment sector, would be considered as highly similar to *computer programming*, in addition to *installation of computer software*; *maintenance of computer software* and *updating of computer software* in the Opponent’s specification under the *Meric* principle.

16. The same principle applies to the applicant's *creation, design and development of software services*. Although these terms are also limited to the employment sector, they would fall under the ambit of the broader term *computer system design services* in the opponent's specification.

Average consumer and the purchasing act

17. I must now consider the nature of the average consumer and how the services are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

18. 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.”

19. The parties' respective specifications include a wide range of technology services, for which the average consumer is both the general public and businesses. The level of attention paid to the purchase will vary according to the nature of the services. Commissioning the design of a bespoke software system will demand a higher level of attention to be paid than downloading a tablet based software application for example. As for the purchasing process for services, I would consider this to be primarily a visual act as consumers are likely to meet a provider face to face to discuss requirements or search the internet to find a suitable provider or chose from other

material outlining the services but I do not rule out an aural element whereby advice may be sought prior to purchase.

Comparison of the marks

20. The marks to be compared are:

Opponent's marks	Applicant's mark
GENIE	

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

22. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

23. The opponent's trade marks consist of a single word GENIE presented here in plain block capital letters. The overall impression of the mark and its distinctiveness rests solely on that word.

24. The applicant's mark is a composite word and device arrangement comprising a device of a genie, the words JOBZ GENIE and a dot com suffix, positioned below the word GENIE. The word JOBZ is positioned within the device and is rendered in white, whilst the device, the word GENIE and the dot com suffix are rendered in blue. The opponent's submits that,

“...the .com would be unnoticed by the average consumer as it would not be perceived as part of the trade mark, but merely as a reference to a domain extension”.

25. I agree with the opponent to the extent that an average consumer is familiar with internet domain suffixes and would pay less attention to this element, perhaps even more so in this case as the dot com suffix is in a much smaller font size than the words above it. This leaves me to consider the dominant and distinctive elements of the mark, namely words JOBZ GENIE and the device. In marks which consist of both words and devices, it is a general rule of thumb that the words will speak louder than the devices. I consider that rule to be applicable in this case. Although the device is significant in terms of its size, positioning and stylisation and will make a visual impact, the marks are likely to be referred to by the **JOBZ GENIE** word elements. In my view neither word dominates the other and both make an equal contribution to the overall impression.

26. In making a visual comparison, the point of similarity is the word GENIE. It is the whole of the opponent's mark and one of the two main word elements of the applicant's mark. The opponent's mark has no other elements to it whereas the applicant's mark contains the device element and the additional word JOBZ and the non- distinctive dot com suffix. The opponent submits in their visual comparison that,

“...Consumers would also see the jobz element as being descriptive of the type of services offered under the mark – i.e. related to employment. Whilst

the Z element is not normally how you would pluralise the word job (usually S), Z is a common misspelling that consumers would not see as distinctive, but simply a play on words of the element job. Therefore it is submitted that the jobz element is non distinctive.”

I note this submission regarding the descriptiveness of the word JOBZ. The word JOBZ is clearly misspelled, but nevertheless it does still closely resemble the non-distinctive word ‘jobs’. Overall I find there to be a medium degree of visual similarity.

27. In an aural comparison, the opponent’s marks GENIE is a well-known English word and will be given its usual pronunciation. The GENIE element of the applicant’s mark will be pronounced in an identical way, although there are two other word elements to the applicant’s mark which will be vocalised, namely JOBZ and the dot com suffix. Notwithstanding this, JOBZ is the phonetic equivalent of the word ‘jobs’, which is non-distinctive for the jobs markets. Overall I find there to be a medium degree of aural similarity.

28. In a conceptual comparison, the opponent’s marks will bring to mind the concept of a genie. The applicant’s mark will bring the same concept of a genie, which is reinforced by the device, and some concept relating to jobs (jobz). The addition of the dot com suffix will give the impression of a website address. I find that there is some similarity of ideas between the marks in relation to the GENIE element but that the applicant’s mark more directly specifies a concept relating to jobs. Taking all these factors into account, I find there to be a medium degree of conceptual similarity.

Distinctive character of the earlier marks

29. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

30. The opponent has not filed any evidence to indicate that the earlier marks enjoy any enhanced distinctiveness, therefore I only have the inherent position to consider. The opponent’s marks consists of an ordinary dictionary word which is not descriptive of the services it is registered for. On that basis, I find that there is an average level of inherent distinctiveness.

Likelihood of Confusion

31. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 8:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

32. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

33. So far I have found that the contested services are highly similar and that they will be primarily purchased visually by a member of the general public or businesses who will pay a normal to high level of attention during the purchasing process. In addition I have found that the earlier mark has an average level of inherent distinctiveness and that the contested marks are visually, aurally and conceptually similar to a medium degree. I have also found that the JOBZ word element closely resembles and is the phonetic equivalent of the word ‘jobs’ which is non-distinctive for services related to the jobs market.

34. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

35. The competing trade marks both contain the identical word GENIE. The applicant's mark also contains a device of a genie reinforcing the concept. With regard to the distinctiveness of the marks, I have taken the view that the word JOBZ is the weaker element given its resemblance to and phonetic equivalence of the word 'jobs'. So the strength of the applicant's mark lies in the word GENIE which is identical to the opponent's marks. This significantly increases the likelihood of the applicant's services being assumed to originate from the same commercial source as the opponent's. Taking these factors into account I find that there is a likelihood of confusion. Even if the consumer does not mistake one mark for the other, they are, at the very least, likely to believe that the respective services come from the same or linked undertakings.

Conclusion

36. The opposition succeeds under section 5(2)(b) of the Act for all the services claimed.

Costs

37. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Using the guidance in Tribunal Practice Notice 2/2016, I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£300 Preparing submissions

£600 Total

42. I order Mr Adrian Bradley to pay O2 Worldwide Limited the sum of £600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of January 2018

June Ralph

For the Registrar,

The Comptroller General