

O-057-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3157430
BY THE UBIQUITY GROUP LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS
THE UBIQUITY GROUP
the ubiquity group**

**IN CLASSES 35 & 42
AND**

**IN THE MATTER OF APPLICATION No. 3157417
BY THE UBIQUITY GROUP LIMITED
TO REGISTER THE TRADE MARK**

Ubiquity

IN CLASSES 35 & 42

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER No. 407289 & 407290 BY
EBIQUITY PLC**

BACKGROUND

1) On 31 March 2016, The Ubiquity Group Ltd (hereinafter the applicant) applied to register the series of two trade marks “THE UBIQUITY GROUP / the ubiquity group” in respect of the following services:

Class 35: Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies; Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; Advertising and business services; Advertising and marketing services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising and commercial information services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising, marketing and promotion services; Advertising; Advertising and advertisement services; Advertising and marketing; Advertising, including on-line advertising on a computer network; Agency services for arranging business introductions.

Class 42: Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; Media asset management; Design, creation, hosting, maintenance of websites for others; Design, development and implementation of software; Design, drawing and commissioned writing of computer software; Design, drawing and commissioned writing of web pages for a global computer network; Design, drawing and commissioned writing, all for the compilation of web pages on the internet; Design, updating and maintenance of computer software; Design, maintenance and updating of computer software.

2) The application was examined and accepted, and subsequently published for opposition purposes on 1 July 2016 in Trade Marks Journal No.2016/027.

3) Also on 31 March 2016, the applicant applied to register the trade mark

Ubiquity

in respect of the following services:

Class 35: Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies; Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; Advertising and business services; Advertising and marketing services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising and commercial information services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising, marketing and promotion services; Advertising; Advertising and advertisement services; Advertising and marketing; Advertising, including on-line advertising on a computer network; Agency services for arranging business introductions.

Class 42: Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; Media asset management; Design, creation, hosting, maintenance of websites for others; Design, development and implementation of software; Design, drawing and commissioned writing of computer software; Design, drawing and commissioned writing of web pages for a global computer network; Design, drawing and commissioned writing, all for the compilation of web pages on the internet; Design, updating and maintenance of computer software; Design, maintenance and updating of computer software.

4) The application was examined and accepted, and subsequently published for opposition purposes on 1 July 2016 in Trade Marks Journal No.2016/027.

5) On 1 September 2016 Ebiquity plc (hereinafter the opponent) filed notices of opposition. The opponent is the proprietor of the trade mark shown below:

Mark	Number	Application & registration date	Class	Specification
EBIQUITY	2561284	13.10.10 14.01.11	35	Advertising and promotional services; placing advertisements; advertising consultancy; market research and marketing studies; analysis of advertising response and market research; business advisory services;

				computerised data-based management services; data processing; information and advisory services relating to all the aforementioned services.
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a) The opponent contends that the services applied for are identical and/or similar to the services for which its mark is registered. It also contends that the marks of the two parties are similar. Therefore the marks applied for offend against Section 5(2)(b) of the Act.

b) The opponent claims that it has reputation in its sign EBIQUITY in its class 35 services, such that use of the mark in suit would take unfair advantage of, or be detrimental to the distinctive character or repute of, its mark. Use of the mark in suit would dilute the distinctive character of the opponent's earlier mark; would take unfair advantage of the repute of the opponent's earlier mark by free-riding on its distinctive character or repute. The mark in suit therefore offends against section 5(3) of the Act.

6) On 19 January 2017 the applicant filed counterstatements, basically denying that the marks are similar; that the services applied for are similar to the services of the opponent and also putting the opponent to strict proof of use.

7) Both sides filed evidence and seek an award of costs in their favour. Neither side wished to be heard, but both filed written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

8) The opponent filed a witness statement, dated 13 April 2017 by Sagar Shah, the Senior Group Digital Marketing Manager of the opponent, a position he has held since January 2012. He states that he has full access to the opponent's records. He states that the business was founded in 1997 and has traded under the brand EBIQUITY since 2008. He claims that his company is a leading independent marketing analytics specialist with over 900 employees worldwide and offices in 14 countries. He states that the opponent works with brands worldwide and its clients include 80 of the world's 100 biggest advertisers. He provides the following exhibits:

- A1: Screenshots from the opponent’s website showing use of the mark Ebiquity which have been taken from the WayBack Machine internet archive. Some of these are dated April 2017, but others are dated between July 2011 and July 2016 and show that the company was talking about its services in market analytics and advising on advertising costs. Also provided are copies of the opponent’s twitter and LinkedIn accounts which also show use of the opponent’s mark and shows that the opponent had. At 5 April 2017, 2,400 and 10,438 followers respectively.

A2: Pages 25 -252. A selection of invoices sent to UK clients which show use of the opponent’s mark Ebiquity. These are dated between 7 January 2011 and 31 March 2016, and as such a number are prior to the relevant period. They mostly relate to media audits (81 invoices worth £3,575,767); media evaluations (15 invoices worth £313,073) and media monitoring (5 invoices worth £106,676). There are also individual invoices for items described as, inter alia, media tracking, media reports, media consultancy, media benchmarking, media support, econometrics, promotional effectiveness project, marketing performance, effectiveness, optimization and competitive advertising monitoring, data landscaping, competitive monitoring report, tag line tracking, monitoring solutions, forecasts, ad intelligence service, TV review, pitch support, film promotions, press ads, and TV and radio commercials. It is clear that whilst billed to UK addresses the work, in many cases, relates to worldwide activities. Some invoices are less than clear in what could have been provided, page 73 (£46) for instance, refers to the provision of “analgesics” which is puzzling. The only pages which appear to relate to advertising services i.e. the placing of advertisements are as follows and all of very low value which raises the question of what TV commercial could be provided for the sums involved. Unfortunately none of the terms used below are explained by the opponent.

Page	Description on invoice	Cost £	Date
58	TV commercial UK x 9	150.00	16.03.11*
60	TV & radio commercial; Press 1-5, Press additional; poster	302.50	15.02.11*
103	UK Press	74.40	21.06.13
104	TV single commercial	25.00	27.06.13
106	6 x Press / Banner Ads	60.00	12.08.13
141	UK Press x 5	35.00	18.02.15
157	TV single commercial	20.00	22.12.15

	Press International 1-5	32.00	
	Press additional international	6.60	
190	TV commercial western Europe x 11	275.00	29.07.14
	TV commercial rest of world x 4	100.00	
	Poster international x 3	60.00	
231	TV commercial x 2	28.80	30.03.16
233	UK Press x 5	35.00	29.03.16
234	TV commercial UK x 4	100.00	29.02.16
241	TV single commercial rest of world	19.07	31.01.16
	Press international 1-5	30.51	
	Press additional international 75	400.50	

*before relevant date

- A3: Copies of annual reports, dated 2011 to 2015 which show global revenue figures. Mr Shah has not highlighted any UK figures in these reports or extrapolated information which is supported by these documents. The reports suggest that over 90% of revenue is generated by Media Value Measurement, Market Intelligence and Marketing Performance Optimisation. In the company's own explanation of these terms no mention is made of placing advertisements or the provision of advertising services. The general statement explains the business as follows:

“Ebiquity is an independent marketing performance specialist. We help brands optimise the efficiency and effectiveness of their paid, earned and owned marketing communications worldwide. We collect, aggregate and analyse vast amounts of online and offline marketing data to provide brands with a better understanding of what is going on in their market, how they are performing, and what they can do to improve. Our consultancy and software services are built upon this data, our industry expertise, and our independence from the media transaction process.” (my emphasis).

- A4: A selection of invoices detailing the opponent's advertising spend promoting itself in the UK. Pages 324-329 & 331-334 inclusive are dated after the relevant date. Only five invoices are prior to the relevant date. Two refer to Google adwords and are for a total of £1,000. Two are to Survey Monkey and total £48. Whilst the last is for “sponsored updates” on LinkedIn and amounts to £121.

APPLICANT'S EVIDENCE

9) The applicant filed a witness statement, dated 12 June 2017, by Byron Lloyd the Managing Director of the applicant. He states that the opponent's evidence shows that they deal with the creation of advertisements and marketing material for their clients. At exhibit one he provides a search of the members of the Institute of Practitioners of Advertising (IPA), which shows that the applicant is such a member. The membership rules are also attached and it states that only agencies whose "principal business objectives are to create, maintain and enhance the value of its clients' brands through marketing communications" can be members. He compares this to the opponent's annual report filed in their evidence and reproduced as exhibit 2 by Mr Lloyd, which states that the opponent provides "online platforms, analysis and objective advice that helps brands worldwide to optimise their performance in a rapidly changing marketing landscape". At exhibit 5 he provides a dictionary definition of the word "Ubiquity" as: "the state, fact, or capacity of being, or seeming to be, everywhere at the same time; omnipresence". He points out that Twitter and LinkedIn are available globally. At exhibit 8 he provides copies of webpages from the Market Research Society which states that the UK research market generates up to £4.8billion as of 2017.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

11) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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

12) An "earlier trade mark" is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

13) The opponent relies upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. Given the interplay between the date that the opponent’s mark was registered (14 January 2011) and the date that the applicant’s marks were published (1 July 2016), the proof of use requirements bite. Section 6 states:

“6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14) Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication dates of the applications was 1 July 2016, therefore the relevant period for the proof of use is 2 July 2011 – 1 July 2016. In deciding this issue I take into account the case of *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, where Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall*

Radetsky' [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just

some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16) In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should

not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

17) In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be

assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18) Whether the use shown is sufficient for these purposes will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

19) In *Reber Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-355/09, the General Court found that the sale of 40-60Kg per annum of specialist chocolate under a mark was insufficient to constitute genuine use of the national trade mark, which was registered in Germany. On further appeal in Case C-141/13 P, the CJEU stated, at paragraph 32 of its judgment, that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The CJEU found that “*the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use*” (paragraphs 33 and 34 of the judgment of the CJEU).

20) Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark*” is therefore not genuine use.

21) The applicant has, in its evidence and its written submissions, challenged the opponent's evidence regarding use of the opponent's mark on advertising and promotional services in particular. I note that the applicant's written submissions were filed approximately two weeks prior to the opponent's written submissions (the opponent sought an extension of time to file) and yet in its written submissions the opponent makes no mention of the proof of use issue, other than in the most general of terms. Nor did it file or seek to file further evidence after its original evidence was challenged. Much of the evidence is dated after the relevant date (exhibit A1 & A4), a substantial amount is not specific to the UK (exhibit A3), whilst some is of such low value as to be irrelevant (A4). The only evidence which shows use within the UK and in the relevant period are exhibits A1 & A2. Even here there are issues, as pointed out by the applicant in its submissions where it states that, in A2, some of the invoices show amounts so small as to bring into question whether the services listed were actually provided. It lists by way of example the invoice at page 231 which states "TV Commercial UK – Oral B x 2" and yet the total bill is for £28.80. The applicant, by way of contrast points out that it typically charges its clients thousands if not tens of thousands of pounds for producing and placing a commercial. The opponent has not provided any information regarding the number of advertisements that it produced, in the relevant time period, the extent of its activity in the creation and placing of advertisements or even advising clients regarding advertisements. It would appear that it simply billed clients for extraordinarily low sums for TV and press advertisements, without offering any explanation of precisely what was provided for such minor amounts. This seems to be the epitome of token use, and one that is insufficiently quantified at that. It is clear that the opponent could easily have provided proper evidence of use, but for its own reasons chose not to do so. The only conclusion I can reach is because it would have made it even more obvious that the use to which the mark has been put is insufficient to amount to genuine commercial use of the mark in respect of advertising services.

22) In reaching this conclusion I look to the comments of Professor Ruth Annand, as the Appointed Person in *Memory Opticians Ltd's Application*, BL O/528/15, where she upheld the Hearing Officer's decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5 year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of goods under the mark, although the evidence indicated that they were only displayed in-store on occasions. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain market under the mark. Consequently, it was not genuine use. I also note the views of the Appointed Person in *Palmerwheeler Ltd v Prnnet* – BL-O/484/13

where it was stated that where evidence is filed to support a wide range of goods and services it is necessary to indicate what parts of the evidence relates to which goods and services.

23) The opponent's registered specification in Class 35 is as follows: "Advertising and promotional services; placing advertisements; advertising consultancy; market research and marketing studies; analysis of advertising response and market research; business advisory services; computerised data-based management services; data processing; information and advisory services relating to all the aforementioned services". The applicant contends that there has been no use on advertising services and have also questioned use regarding "business advisory services". I fully accept that the opponent has not shown genuine use on any advertising services. Regarding the business advice, this could be said to be partially covered by the advice given to companies regarding their brands. I am willing to accept that the opponent has provided use of its mark in respect of "market research and marketing studies; analysis of advertising response and market research; business advisory services; computerised data-based management services; data processing; information and advisory services relating to all the aforementioned services" as to my mind these terms encompass the market analytics, intelligence and performance optimisation and also the media audits, evaluations, monitoring and value measuring indicated by the exhibits A1-A3 inclusive.

24) I do not accept that the opponent has shown use of its mark in respect of "Advertising and promotional services; placing advertisements; advertising consultancy". In the comparison test in section 5(2)(b) I shall therefore use the following specification: "market research and marketing studies; analysis of advertising response and market research; business advisory services; computerised data-based management services; data processing; information and advisory services relating to all the aforementioned services".

25) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

- (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.

The average consumer and the nature of the purchasing decision

26) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which 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.”

27) The specifications of both parties cover a multitude of services most of which are aimed squarely at the business market, although I accept that some individuals may also avail themselves of such services on occasion. The consumers for such services has to be regarded as the general public including businesses. Whilst such services are likely to be the subject of different criteria for selection, in effect most are likely to be found via the internet, at a trade fair or in a magazine advertisement. Thus the visual aspect will be the most important element in selection although I must also consider aural issues as such services maybe recommended during a conversation. It is highly likely that the service provider will only be chosen after a face to face meeting and with the client carrying out research into the potential service provider. When seeking such services the average consumer is likely to ensure that the services on offer are tailored precisely to their requirements and that the

provider is in a position to deliver upon its promises. Given that such services will be relatively expensive and almost certainly will affect the future of their business **the average consumer for such items will take at least a medium degree of care in choosing such services.**

Comparison of services

28) In the judgment of the Court of Justice of the European Union (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”.

29) 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.

30) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 fur 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”.

31) 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."

32) 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."

33) 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."

34) I also note that if the similarity between the goods/services is not self-evident, the opponent must show how, and in which respects, they are similar. This was set out in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

35) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

36) In *Sanco SA v OHIM*, Case T-249/11, the General Court 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.

37) The specifications of both of the applicant’s marks are identical and so only one comparison is required. These are set out below:

Applicant’s services	Opponent’s services
<p>Class 35: Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies; Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; Advertising and business services; Advertising and marketing services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising and commercial information services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising, marketing and promotion services; Advertising; Advertising and advertisement services; Advertising and marketing; Advertising, including on-line advertising on a computer network; Agency services for arranging business introductions.</p> <p>Class 42: Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; Media asset management; Design, creation,</p>	<p>Class 35: market research and marketing studies; analysis of advertising response and market research; business advisory services; computerised data-based management services; data processing; information and advisory services relating to all the aforementioned services.</p>

hosting, maintenance of websites for others; Design, development and implementation of software; Design, drawing and commissioned writing of computer software; Design, drawing and commissioned writing of web pages for a global computer network; Design, drawing and commissioned writing, all for the compilation of web pages on the internet; Design, updating and maintenance of computer software; Design, maintenance and updating of computer software.	
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38) The opponent, in its written submissions states that the applicant's services are in advertising, marketing and public relations services; design, maintenance and development services for computer hardware, computer software, and websites, as well as media asset management services. Whilst its services are also in the field of advertising and promotional services; and marketing and advertising analysis and research. It contends that the services of both parties are used in connection with; for the same purposes; accessed by the same consumers in respect of the marketing, promotional and advertising endeavours of businesses and individuals. It also contends that they are complementary as advertising agencies provide associated services such as analytics in connection with the services they offer, such as analysing the feedback on an advertising campaign. It contends that the applicant's services in class 42 includes "media asset management" which its states is identical to its class 35 services. Whilst the applicant's services in class 42 which cover hardware and software are related to advertising and marketing and therefore complement the services of the opponent.

39) The applicant contends that the services it offers in class 35 are, for the most part, creative and fit within the IPA definition of an agency provided at paragraph 9 above. It contrasts this to the services of the opponent which it describes as research. With regard to its class 42 services the applicant contends that none of these are research services and that whilst they may be used by research services they are not indispensable for research services. It contends that its services are not in competition with or complementary to the services of the opponent.

40) I first turn to the class 35 services of the applicant. The first group of services relate to public relations (Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies;). Public relations can be described as the profession or practice of creating and maintaining goodwill of an organization's various publics (customers, employees,

investors, suppliers, etc.), usually through publicity and other nonpaid forms of communication. This is not necessarily connected to market research. It users may be different, for instance a celebrity trying to create a particular perception of themselves in the public's mind. **In my view, these services are wholly different to those of the opponent.**

41) The second group of services within class 35 are those relating to advertising (Advertising services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising and promotion services; Advertising; Advertising and advertisement services; Advertising; Advertising including on-line advertising on a computer network; Agency services for arranging business introductions). Broadly speaking "advertising" is a means of communication with the users of a product or service. Advertisements are messages paid for by those who send them and are intended to inform or influence people who receive them. This contrasts with the opponent's services which are market research based which involves assessing the viability of a new good or service through research conducted directly with the consumer which allows a company to discover the target market and record opinions and other input from consumers regarding interest in the product. Whilst one can be said to follow from the other in that having advertised a product the supplier might wish to carry out research into how the product was perceived by the consumer, who purchased it and why/why not, it does not follow that everyone business/individual who advertises its products or wares then carries out or commissions such research. Nor does it necessarily follow that the same organisation would do both aspects as one is, simplistically, creative the other "number crunching". The opponent has not shown that its "analysis of advertising service" is carried out by the average advertising agency rather than by specialist analytical companies. **These services of the applicant are therefore wholly different to those of the opponent.**

42) The next group of services in the applicant's class 35 specification are "Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; marketing services; marketing services; marketing". To my mind, these services must be encapsulated within the opponent's services of "market research and marketing studies". **In my opinion, these services are identical.**

43) This leaves two services within the applicant's class 35 specification. These are "commercial information services, via the internet" and "business services". The opponent has "information and

advisory services relating to all the aforementioned services” and “business advisory services” within its specification. In my view, the opponent’s specification encompasses the applicant’s specification shown earlier in this paragraph. **These services are therefore identical.**


44) I next turn to the class 42 specification applied for under the marks in suit. The opponent in its submissions set out in paragraph 38 above contended that these services include the term “Media asset management” which it states is identical to its class 35 services. To my mind, the term used in the applicant’s specification describes a process for storing and retrieving media such as photos, music, videos etc. and then managing digital rights and permissions. This, in my view, is wholly different to the activities of the opponent. Similarly, whilst the opponent may well utilise computers and software to carry out its services this does not make the design and development of computer hardware and software etc. complementary to the opponent’s class 35 services of market research. **Therefore, the whole of the applicant’s class 42 specification must be regarded as wholly different to the opponent’s class 35 services.**

Comparison of trade marks

45) 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 them, bearing in mind their distinctive and dominant components. The 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.”

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

Applicant's trade marks		Opponent's trade mark
1	THE UBIQUITY GROUP the ubuity group	EBIQUITY
2		

47) I shall first compare the applicant's series of two marks shown as mark 1 above to the opponent's mark. The series of two marks differ merely in that one is in upper case whilst the other is in lower case. Such a difference will not be taken into account by the average consumer and so I only need to consider one of the series. The applicant contends that "the most important part of a mark in the eyes of the relevant consumer is the beginning of the same". It states that its mark begins with the word "The" which is not present in the opponent's mark. It also points out that, if the word "THE" is ignored then the first letter of each party's mark begins with different letters "U" and "E" respectively (I note *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 in this aspect). The applicant also points out that the marks are of a different length. Whilst I do not believe that the average consumer will ignore the words "The" and "Group" it is clear that these words do not identify the origin of the services and will be given minor status by the average consumer. Undoubtedly the dominant and distinctive element of the applicant's mark is the word UBIQUITY. There are obvious visual similarities between the marks as well as visual differences. Aurally the marks also have differences and similarities. Conceptually the applicant contends that its mark has a clear meaning whereas the opponent's mark has no meaning. This is true if the average consumer is aware of the word UBIQUITY. It is not, in my view, a word which is routinely used and I can envisage that a considerable number of the population will be unaware of its meaning. Those who are aware of the word will recognise it and differentiate between it and the opponent's mark, those who do not will wonder if it is simply an invented term.

Overall there is, in my view, a medium degree of similarity between the marks.

48) I now turn to compare the opponent's mark 2 (above) to the mark in suit. The applicant's mark differs from its first mark in that it does not have the two indistinctive elements of "The" and "group". Instead it has the first letter of the single word underlined. The applicant also contends that the letter "U" is stylised. If it is, and I have doubts about that, it is very low key stylisation. The font looks quite

unremarkable and I doubt that the average consumer would notice the alleged styling. Whilst I accept that they will notice the fact that the letter “U” is underlined, it is my view that they will give this short shrift as it does not have origin significance. The comments in the previous paragraph regarding the conceptual issues apply here. Visually there is a difference in the initial letter whilst all the other letters are identical, aurally there are obvious differences and similarities. **Overall, there is a medium degree of similarity between the applicant’s mark 2 and the opponent’s mark.**

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 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).”

50) The opponent’s mark consists of the invented word EBIQUITY. **The mark is inherently distinctive to a high degree. The opponent has shown use of its mark, as set out in the evidence summary earlier in this decision and so can benefit from enhanced distinctiveness at least in relation to its media audits.**

Likelihood of confusion

51) 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 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 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. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the services by predominantly visual means, although not discounting aural considerations and that they will pay at least a medium degree of attention to the selection of such services.
- the following class 35 services of the applicant are identical to the opponent's class 35 services "Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; marketing services; marketing services; marketing; commercial information services, via the internet; business services".
- the following class 35 services of the applicant are wholly different to the opponent's class 35 services "Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies; Advertising services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising and promotion services; Advertising; Advertising and advertisement services; Advertising; Advertising including on-line advertising on a computer network; Agency services for arranging business introductions".

- the following class 42 services of the applicant are wholly different to the opponent's class 35 services "Class 42: Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; Media asset management; Design, creation, hosting, maintenance of websites for others; Design, development and implementation of software; Design, drawing and commissioned writing of computer software; Design, drawing and commissioned writing of web pages for a global computer network; Design, drawing and commissioned writing, all for the compilation of web pages on the internet; Design, updating and maintenance of computer software; Design, maintenance and updating of computer software".
- Overall, there is a medium degree of similarity between both of the applicant's marks (1 & 2) and the opponent's mark.
- the opponent's mark has a high degree of inherent distinctiveness and benefits from an enhanced distinctiveness through use at least in relation to its media audits.

52) In determining the issue of the likelihood of confusion I take into account the comments of Lady Justice Arden in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where she stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

53) I also take note of the comments of Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he explained 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.

54) Whilst in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

55) It is easy to envisage a situation whereby an average consumer looking for market research will carry out an internet search. If they came across a site under the applicant’s mark they would assume that the market research services were connected to the opponent. However, to my mind they would not assume any such link with the opponent if they came across computer hardware or software services or advertising services and the opponent has provided no evidence to the contrary. **The opposition under Section 5(2) (b) therefore succeeds in respect of the following services:**

- In class 35: Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; marketing services; marketing services; marketing; commercial information services, via the internet; business services.

56) **The opposition under Section 5(2) (b) therefore fails in respect of the following services:**

- In class 35: Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies; Advertising services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising and promotion services;

Advertising; Advertising and advertisement services; Advertising; Advertising including on-line advertising on a computer network; Agency services for arranging business introductions.

- In class 42: Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; Media asset management; Design, creation, hosting, maintenance of websites for others; Design, development and implementation of software; Design, drawing and commissioned writing of computer software; Design, drawing and commissioned writing of web pages for a global computer network; Design, drawing and commissioned writing, all for the compilation of web pages on the internet; Design, updating and maintenance of computer software; Design, maintenance and updating of computer software.

57) The next ground of opposition is under section 5(3) which reads:

“5(3) A trade mark which-

- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

58) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to

exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

59) It can be seen from the above that in order to succeed under these grounds the opponent needs to show that in respect of the marks/ signs it relies upon, it has a reputation with a significant proportion of the public and that it has goodwill. As can be seen from the evidence summary earlier in this decision the opponent has failed to provide any information such as UK sales figures, market share etc. It has not provided any independent evidence such as press coverage, awards or witness statements from the relevant industry bodies. All it can rely upon are the invoices addressed to UK based clients at exhibit A2. These show it has billed clients for significant amounts in respect of media auditing. This is the only service in which it can claim any reputation.

60) In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

61) Earlier in this decision I found that the marks of the two parties had a medium degree of similarity. However, given that the services will be chosen with some care and attention (as set out earlier in my

decision) and given the differences between the creative requirements of an advertising agency as opposed to the simple collation of press coverage and subsequent analysis involved in media auditing for which the opponent has reputation I do not believe that the average consumer will form the necessary link between the two parties. **The opposition under section 5(3) therefore fails.**

CONCLUSION

62) Although the opposition based upon section 5(3) has failed, the opponent did have a modicum of success under section 5(2)(b). The application will be rejected for the following services:

- In class 35: Marketing; Marketing agency services; Marketing assistance; Marketing by telephone; marketing services; marketing services; marketing; commercial information services, via the internet; business services.

63) However, the application will go forward to registration in respect of the following services:

- In class 35: Public relations; Public relations services; Public relations agency; Public relations consultancy; Public relations studies; Advertising services; Advertising and publicity; Advertising services for the promotion of e-commerce; Advertising services, via the internet; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising space (Rental of -); Advertising and promotion services; Advertising services provided over the internet; Advertising and promotion services; Advertising; Advertising and advertisement services; Advertising; Advertising including on-line advertising on a computer network; Agency services for arranging business introductions.
- In class 42: Design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; Media asset management; Design, creation, hosting, maintenance of websites for others; Design, development and implementation of software; Design, drawing and commissioned writing of computer software; Design, drawing and commissioned writing of web pages for a global computer network; Design, drawing and commissioned writing, all for the compilation of web pages on the internet; Design, updating and maintenance of computer software; Design, maintenance and updating of computer software.

COSTS

64) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 25th day of January 2018

George W Salthouse

For the Registrar,

the Comptroller-General