

O/773/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003321759

IN THE NAME OF WHICHDISH LTD

TO REGISTER THE FOLLOWING TRADE MARKS (SERIES OF 2):

whichdish

and

which dish

IN CLASSES 35 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 414154 BY

WHICH? LIMITED

BACKGROUND AND PLEADINGS

1. On 2 July 2018, Whichdish Ltd (“the applicant”) applied to register the trade marks (series of 2) **whichdish** and **which dish** in the UK. The application was published for opposition purposes on 20 July 2018. The applicant seeks registration for the following services:

Class 35 Administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; Advertising and marketing; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising the goods and services of online vendors via a searchable online guide; Marketing; Marketing, advertising, and promotional services; Marketing the goods and services of others; Business and market research.

Class 42 Software as a service [SaaS]; Software design and development.

2. The application is opposed by Which? Limited (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For its oppositions based upon section 5(2)(b) of the Act, the opponent relies on the following trade marks:

WHICH

(UK registration no. 2432015)

Filing date 7 September 2006; registration date 28 December 2007

Relying on all services in class 35 and 42

(“the First Earlier Mark”)

WHICH?

(UK registration no. 2532716)

Filing date 26 November 2009; registration date 18 June 2010

Relying on all services in class 35

("the Second Earlier Mark")



(UK registration no. 3134582)

Filing date 4 November 2015; registration date 25 March 2016

Relying on all goods and services in classes 9, 35 and 42

("the Third Earlier Mark")

WHICH?

(EUTM no. 196477)

Filing date 1 April 1996; registration date 7 September 1999

Relying on all goods and services in classes 9, 38 and 42

("the Fourth Earlier Mark")



(EUTM no. 10605285)

Filing date 31 January 2012; registration date 11 January 2013

Relying on all goods and services in classes 9, 35 and 42

("the Fifth Earlier Mark")

4. The opponent claims that there is a likelihood of confusion because the parties' respective marks are similar, and the goods and services are identical or similar.

5. For the purposes of its opposition under section 5(3), the opponent relies upon all five of the earlier marks and claims a reputation for all goods and services for which

the earlier marks are registered, as listed in the Annex to this decision. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

6. For the purposes of its opposition based upon section 5(4)(a), the opponent relies on the following signs:

WHICH

("the First Sign")

The opponent claims to have used the sign throughout the UK since at least 2006 in relation to all goods and services covered by UK registration no. 2432015.

WHICH?

("the Second Sign")

The opponent claims to have used the sign throughout the UK since at least 2009 in relation to all goods and services covered by UK registration no. 2532716 and 3134582 and EU registration no. 196477 and 10605285.



("the Third Sign")

The opponent claims to have used the sign throughout the UK since at least 2015 in relation to all goods and services covered by UK registration no. 3134582.

7. The applicant filed a counterstatement denying the grounds of opposition. The applicant did not put the opponent to proof of use.

8. The applicant is unrepresented, and the opponent is represented by Groom Wilkes & Wright LLP. The opponent filed evidence in the form of the witness statements of Emily Cox dated 9 April 2019 and Robert James Hawley dated 10 April 2019. The applicant filed written submissions during the evidence rounds. No evidence in reply was filed by the opponent. No hearing was requested, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

9. Ms Cox is the Head of Media Law (Interim) for the Consumers' Association (a registered charity and company limited by guarantee), a role she has held since 11 February 2019. The Consumers' Association is the parent company of the opponent. I have read Ms Cox's evidence in its entirety.

10. Ms Cox explains that the first Which? magazine was published in October 1957, with its aim being to improve the standard of goods and services available to the UK public.¹ By 1959, circulation of the magazine had reached 150,000 and in December 1960, the opponent was incorporated and subsequently adopted the name Which? Limited on 1 April 1995.²

11. Which? Online was launched in 1996. Since then, the opponent has continuously operated at least one website with a domain name featuring the trade mark "WHICH".³ The opponent also introduced an online energy comparison service in 2005, which received the Energywatch Confidence Code accreditation in 2006. In 2010, Which? was ranked fifth in the "Media – Newspapers and Magazines" category in the Superbrand index. It was ranked 256th overall.⁴

12. The opponent is one of seven organisations that are empowered under the Enterprise Act 2002 to issue "super-complaints" on behalf of consumers. Which? has issued a number of super-complaints including in relation to Scottish legal services (in

¹ Witness statement of Emily Cox, para. 3

² Witness statement of Emily Cox, para. 4

³ Witness statement of Emily Cox, para. 7

⁴ Witness statement of Emily Cox, para. 8

2007), credit and debit surcharges (in 2011), practices in the grocery market (in 2015), rail compensation (in 2015) and bank transfer scams (in 2016).⁵

13. An undated article marking the 60th anniversary of the opponent (which was, presumably, issued in 2017 being 60 years after incorporation in 1957) states that “today, [the opponent has] more than 1.5million members and supporters, making us the largest independent consumer body in the UK”.⁶

14. The opponent offers both subscription and free-to-use services. Specifically, the opponent offers a full-package membership service in which members pay a subscription fee and in return receive monthly Which? magazines, full access to online content, impartial advice on personal financial matters via the Which? Money Helpline and impartial consumer legal advice.⁷

15. An extract from the opponent’s website, which is undated save for the print date of 21 March 2019, shows the range of sectors across which the opponent provides information and guidance under the Which? mark.⁸ These include electronics, vehicles, home and garden, shopping, food and drink, home security, money, baby and child and travel.

16. A selection of articles dated prior to the relevant date show companies advertise the fact that they had achieved accreditations from Which? such as “Which? Best Buy” and “Which? Large Appliance Brand of the Year”.⁹

17. For the year ending 30 June 2018, the opponent had an operating turnover in excess of £90million.¹⁰ The opponent’s Annual Review 2010/2011 report identifies successes such as “our free Consumer Rights app has been downloaded 100,000 times” and “we’ve provided over 700 videos in the last few years offering information

⁵ Exhibits EC-03 and EC-04

⁶ Exhibit EC-05

⁷ Witness statement of Emily Cox, para. 15

⁸ Exhibit EC-06

⁹ Exhibit EC-08

¹⁰ Witness statement of Emily Cox, para. 22

on a range of subjects”.¹¹ The report confirms that revenues had increased to £75.6million and identifies the total number of subscriptions as follows:

2007	1,038,000
2008	1,098,000
2009	1,125,000
2010	1,226,000
2011	1,331,000

18. By the 2016/2017 Financial Report, group income exceeded £100million, with a greater proportion of this being generated by services such as Which? Legal, Which? Trusted Traders and Which? Mortgage Advice.¹² By 2017/2018, the opponent had 1.35million subscribers and members.¹³

19. Ms Cox states that a significant proportion of the opponent’s revenue is generated by sales of subscription packages to Which? magazine and the Which? website. These amounts are broken down as follows:¹⁴

Year	Magazine Revenue (£)	Website Revenue (£)
2013	65,988,345	12,374,237
2014	70,314,604	12,597,096
2015	73,081,669	12,774,184
2016	67,332,679	12,555,086
2017	64,693,634	11,415,748
2018	62,112,106	10,931,823

20. Ms Cox has provided copies of magazine covers dated between 1978 and 2017, which display the following marks:¹⁵

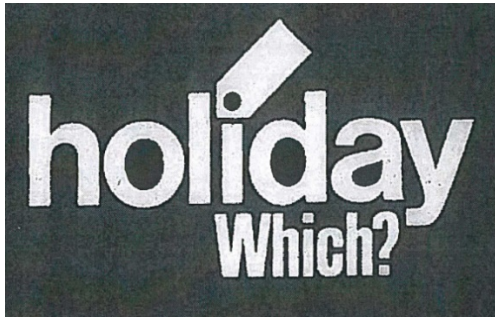
¹¹ Exhibit EC-10

¹² Exhibit EC-10

¹³ Exhibit EC-10

¹⁴ Witness statement of Emily Cox, para. 23

¹⁵ Exhibit EC-11



21. The opponent has or has had various domain names which feature the word “which”, including trustedtraders.which.co.uk, university.which.co.uk and computing.which.co.uk.¹⁶ Ms Cox has provided the following tables which show the number of visits to these websites each year:¹⁷

USERS						
Website	2013	2014	2015	2016	2017	2018
Trusted Traders	22,714	266,346	498,203	1,051,806	1,290,592	1,504,602
Legal Service	159,556	188,543	227,880	222,681	230,327	234,140
Which? University	1,484,519	3,284,708	3,993,673	5,227,501	5,020,924	4,584,958
Which? Local	952,783	1,245,204	1,485,112	1,453,976	1,269,448	239,189
Which? Gardening					31,557	184,835
Which? Switch	219,941	125,807	770,026	832,797	854,625	891,962
Which? Computing					299,913	864,512

¹⁶ Witness statement of Emily Cox, para. 24

¹⁷ Witness statement of Emily Cox, para. 25

SESSIONS						
Website	2013	2014	2015	2016	2017	2018
Trusted Traders	28,807	356,496	729,144	1,531,953	1,916,679	2,194,836
Legal Service	191,083	220,132	274,649	269,710	272,781	266,110
Which? University	2,002,170	4,473,786	5,589,196	7,532,929	7,127,959	6,604,739
Which? Local	1,360,805	1,682,020	1,918,929	1,835,771	1,577,047	278,637
Which? Gardening					35,532	206,215
Which? Switch	277,284	158,601	1,008,192	1,103,266	1,110,511	1,131,489
Which? Computing					342,021	979,720

22. Ms Cox explains that “users” refers to the total number of single customers who visited each website, and “sessions” refers to the total visits to each website.

23. Ms Cox confirms that the following amounts have been spent in respect of advertising the opponent’s marks:¹⁸

Year	Spend (£)
2013	5,501,583
2014	6,210,235
2015	6,947,858
2016	9,612,094
2017	6,532,243
2018	2,817,737

¹⁸ Witness statement of Emily Cox, para. 26

24. These include articles published between 2015 and 2018 in a variety of publications including the Daily Mail, the Daily Telegraph, the Daily Express, the Independent, the Times Magazine, the Sunday Telegraph, the Sun, the Evening Standard, BBC Gardeners World, Take A Break, Waitrose Kitchen, Woman's Weekly, Radio Times, National Trust Magazine, the Guardian and the Daily Standard.¹⁹

25. The opponent receives additional media coverage as a result of the Which? Awards which have taken place every year since 2007.²⁰

26. Mr Hawley is the trade mark attorney representing the opponent in these proceedings. I have read Mr Hawley's evidence in its entirety. He notes that the applicant provides a website which lists restaurants and provides a review facility.²¹

27. The parties have both filed written submissions. I have taken these into consideration and will refer to them below where necessary.

DECISION

Section 5(2)(b)

28. Section 5(2)(b) of the Act reads as follows:

“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;

¹⁹ Exhibit EC-12

²⁰ Witness statement of Emily Cox, para. 29

²¹ Exhibit RJH-01

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

29. The opponent’s marks qualify as earlier trade marks pursuant to section 6 of the Act. A number of the opponent’s marks are subject to proof of use under section 6A of the Act. However, as the applicant has not requested that the opponent provide proof of use of its marks, the opponent can rely upon all of the earlier marks identified.

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

(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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 trade marks

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


components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

32. 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.

33. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade marks
<p style="text-align: center;">WHICH (“the First Earlier Mark”)</p> <p style="text-align: center;">WHICH? (“the Second Earlier Mark”)</p> <div style="text-align: center;">  </div> <p style="text-align: center;"> (“the Third Earlier Mark”)</p> <p style="text-align: center;">WHICH?</p>	<p style="text-align: center;">whichdish</p> <p style="text-align: center;">which dish</p>

<p>("the Fourth Earlier Mark)</p>  <p>("the Fifth Earlier Mark")</p>	
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Overall Impression

34. The First Earlier Mark consists of the word WHICH. There are no other elements to contribute to the overall impression which lies in the word itself.

35. The Second and Fourth Earlier Marks consist of the word WHICH followed by a question mark. The word WHICH itself plays a greater role in the overall impression, with the question mark playing a slightly lesser role adding emphasis that WHICH is a question.

36. The Third Earlier Mark consists of the word WHICH, presented in white title case font. This is followed by a black question mark and presented on a red rectangular background. The word WHICH plays the greater role in the overall impression with the question mark, use of colour and background playing a lesser role.

37. The Fifth Earlier Mark is the same as the Third Earlier Mark but presented in black and white. The word WHICH plays the greater role in the overall impression, with the question mark playing a lesser role and the background playing a much lesser role.

38. The applicant's marks both consists of the words WHICH DISH presented in lower case. In the first mark, these words are conjoined. However, as they both clearly consist of the words WHICH and DISH this does not make a significant difference. As the word WHICH is typically the start of a question, the word DISH becomes the

subject matter of that question. The overall impression, therefore, lies in the combination of these words as a unit.

Visual Comparison

The Applicant's Marks and the First Earlier Mark

39. Visually, the marks overlap in the presence of the word WHICH. They differ in the addition of the word DISH in the applicant's marks which have no counterpart in the opponent's mark. Registration of a word only mark covers use of that word in any standard typeface and so differences created by use in upper or lower case fonts are not relevant. I consider the marks to be visually similar to a medium degree.

The Applicant's Marks and the Second and Fourth Earlier Marks

40. Visually, the marks overlap in the presence of the word WHICH. They differ in the addition of the word DISH in the applicant's marks which has no counterpart in the opponent's mark and the presence of the question mark in the opponent's mark which has no counterpart in the applicant's mark. I consider the marks to be visually similar to a slightly lower than medium degree.

The Applicant's Marks and the Third Earlier Mark

41. Visually, the marks overlap in the presence of the word WHICH. They differ in the addition of the word DISH in the applicant's mark which has no counterpart in the opponent's mark and the presence of the question mark and use of colour in the opponent's mark which have no counterpart in the applicant's mark. Registration of a word only mark covers use in any standard typeface and so differences between the use of lower and title case fonts is not relevant. Similarly, registration of a mark in black and white covers use of the mark in any colour. I consider the marks to be visually similar to a low to medium degree.

The Applicant's Marks and the Fifth Earlier Mark

42. The same comparison applies as for the Third Earlier Mark, except for the use of colour that is not present in the Fifth Earlier Mark but is present in the Third Earlier Mark. However, as registration of a mark in black and white covers use of that mark in any colour, this does not alter my finding to any material extent. Overall, I consider the marks to be similar to a low to medium degree.

Aural Comparison

43. In all five of the opponent's marks, the only element that will be pronounced is WHICH. Aurally, this will be pronounced identically in both the opponent's and the applicant's marks. The point of aural difference between the marks is the presence of the word DISH in the applicant's marks which has no counterpart in the opponent's marks. I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

44. The word WHICH will be given its ordinary dictionary meaning in all three marks. The word WHICH would normally be followed by the subject of a question. This makes the use of the word WHICH on its own in the opponent's marks unusual; that is, there is some ambiguity to its meaning. This is further enhanced for the Second, Third, Fourth and Fifth Earlier Marks which include a question mark, but have no subject matter. The use of colour in the Third Earlier Mark does not add anything to the conceptual meaning conveyed by it. In the applicant's marks, the word WHICH is followed by the word DISH. This makes it clear that it is the 'dish' that is the subject matter of the question. Whilst both marks appear to ask a question, when considered as a whole, I consider them to be conceptually similar to a low degree.

Comparison of goods and services

45. The First, Second and Fourth Earlier Marks share the greatest degree of similarity with the applicant's marks. I note that the Second and Fourth Earlier Marks are identical and the Fourth Earlier Mark has a broader specification. I also note that the

Fifth Earlier Mark, although sharing a lesser degree of similarity with the applicant's marks, shares a greater degree of overlap with the applicant's class 35 services. Consequently, I will consider the First, Fourth and Fifth Earlier Marks in the first instance, returning to the Second and Third Earlier Marks only if it is necessary to do so. The competing goods and services are, therefore, as follows:

Opponent's Goods and Services	Applicant's Services
<p>First Earlier Mark</p> <p><u>Class 35</u> Preparation, provision and dissemination of information on line and via multimedia, all concerning the characteristics, quality and prices of goods offered to the public; provision of information and advice concerning the characteristics, quality and prices of goods offered to the public; operation and maintenance of data storage and retrieval services for the transmission and reception of communication signals.</p> <p><u>Class 42</u> Operation and maintenance of file server and data storage and retrieval services for trial submission and reception of communication signals; legal services; arbitration and conciliation services; the testing of consumer products.</p> <p>Fourth Earlier Mark</p> <p><u>Class 9</u> Encoded cards; optical discs, magnetic tapes, magnetic discs, and players for all</p>	<p><u>Class 35</u> Administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; Advertising and marketing; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising the goods and services of online vendors via a searchable online guide; Marketing; Marketing, advertising, and promotional services; Marketing the goods and services of others; Business and market research.</p> <p><u>Class 42</u> Software as a service [SaaS]; Software design and development.</p>

the aforesaid goods, computer programmes; computer memories; compact disc read-only memories and compact disc-interactive memories; keyboards, control units, visual display units, recording and reproducing apparatus and instruments, print-out apparatus, all for use with computers; television receivers and video display units; data storage, data processing and data display apparatus, all being electronic; light pens; microfilm prepared for exhibition; illuminated optical devices for use in reading microfilm; materials all for use in carrying sound recordings and audio-visual recordings; parts and fittings for all the aforesaid goods; all for use in the provision by means of visual display units, telephonic apparatus, telegraphic apparatus or mechanical or electronic means of information wholly or partly concerning the characteristics, quality and prices of goods and services offered to the public.

Class 38

Online transmission services; cable transmission; other transmission services; all concerning the characteristics quality and prices of goods and services offered to the public; operation and maintenance of file server and data storage and retrieval services

for transmission and reception of communication signals; telecommunications services, data transmission and data network services, electronic mail services.

Class 42

Preparation, provision and dissemination of information on-line and via multi media; all concerning the characteristics, quality and prices of goods and services offered to the public; provision of information and advice concerning the characteristics, quality and prices of goods and services offered to the public.

Fifth Earlier Mark

Class 9

Electronic publications (downloadable); encoded cards; magnetic tapes; magnetic discs, optical discs, and players for all the aforesaid goods; computer programmes; computer memories; compact disc read-only memories and compact disc-interactive memories; keyboards, control units, visual display units, recording and reproducing apparatus and instruments, and print-out apparatus, all for use with computers; television receivers and video display units; data storage, data processing and data display apparatus, all being electronic; light pens; microfilm

prepared for exhibition; illuminated optical apparatus for use in reading microfilm; materials all for use in carrying sound recordings and audio-visual recordings, and parts and fittings for all the aforesaid goods; all for use in the provision by means of visual display units, telephonic apparatus, telegraphic apparatus or mechanical or electronic means of information wholly or partly concerning the characteristics, quality and prices of goods and services offered to the public; parts and fittings for the aforesaid.

Class 35

Preparation, provision and dissemination of information on-line and via multi-media, all concerning the characteristics, quality and prices of goods and services offered to the public; providing a comparison service relating to the characteristics, quality and prices of goods and services of others; operation and maintenance of data storage and retrieval services for transmission and reception of communication signals; advertising; business promotion; business management; business administration; business information services; business advisory services; provision of impartial price information relating to the supply of consumer goods

<p>and services; provision of impartial price information relating to the supply of consumer goods and services relating to computers, telecommunications, telephony, ISP, electricity, gas, water, insurance, financial services, travel, holidays, accommodation, restaurants, catering services, health and medical products and providers; facilitating change of suppliers on behalf of consumers of goods and services; collation, storage and provision of information and advice relating to the aforementioned services; comparison services and business advisory services for consumers regarding telecommunication service providers, energy suppliers, insurance and financial services suppliers, travel and holiday suppliers, health and medical product and service providers; data storage and retrieval services for transmission and reception of communication signals; provision of consumer advice and information; provision of consumer advice and information relating to health and medical products and services; provision of consumer advice relating to food products and services; conducting consumer opinion polls and operating opinion polls; conducting consumer opinion polls and operating opinion polls</p>	
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including those provided online from a computer database or the Internet.

Class 42

Operation and maintenance of file server services for transmission and reception of communication signals; preparation, provision and dissemination of information online and via multimedia; testing of home appliances and fast moving consumer goods; testing garden equipment; testing of consumer products; safety testing of apparatus; advisory services relating to safety of products; testing of vehicles; operation of file servers.

46. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, C-39/97, the court stated at paragraph 23 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.”

47. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

48. 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.”

Class 35

49. “Business promotion” in the opponent’s specification would include administration of schemes intended to promote a particular undertaking. “Business administration” in the opponent’s specification would cover a range of services relating to the supervision and overseeing of business activities. I, therefore, consider “administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card” in the applicant’s specification will fall within the broader categories of “business promotion” and “business administration” in

the opponent's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong in this finding, then the services will overlap in purpose, user and nature. They may also overlap in trade channels. They will be highly similar.

50. Marketing involves organising the sale of a product or services which includes identifying pricing, supply streams and advertising approaches.²² I, therefore, consider "advertising" in the opponent's specification to be self-evidently or *Meric* identical to "advertising and marketing", "marketing" and "marketing the goods and services of others" in the applicant's specification.

51. "Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors" and "advertising the goods and services of online vendors via a searchable online guide" in the applicant's specification fall within the broader category of "advertising" in the opponent's specification. These services can, therefore, be considered identical on the principle outlined in *Meric*.

52. Marketing and advertising are both types of promotional activity. Consequently, I consider "marketing, advertising and promotional services" in the applicant's specification to be self-evidently or *Meric* identical to "advertising" in the opponent's specification.

53. I recognise that it may be argued that there is some similarity between "electronic publications (downloadable)" in the opponent's specification and the applicant's advertising and marketing services referred to above. I accept that businesses pay magazines and other providers of publications to use space for advertising and promotional purposes. Consequently, there will be overlap in trade channels between these services as the sellers of magazines may also be selling advertising space. However, the nature, method of use, user and purpose of the goods and services clearly differ. They will be similar to only a low degree.

²² <https://www.collinsdictionary.com/dictionary/english/marketing>

54. “Business and market research” in the applicant’s specification will cover research relating to a wide range of topics, such as consumer patterns and competitor activities, which are all intended to enable a business to make the best decisions for growth and profitability. These services, therefore, fall within the broader category of “business advisory services” in the opponent’s specification and can be considered identical on the principle outlined in *Meric*. If I am wrong in this finding, then there will be overlap in user, purpose, nature and trade channels and the services will be highly similar. I recognise that it may be argued that there is overlap between “business and market research” in the applicant’s specification and “provision of consumer advice and information” in the opponent’s specification because businesses that provide consumer information and advice may undertake a degree of research into businesses in order to provide that service. However, I do not consider that this is sufficient for a finding of similarity. Business and market research as a service itself will be provided to assist businesses. Providing consumer information is, of course, intended to assist consumers. The purpose and users will, therefore, differ. I do not consider there to be an overlap in trade channels and the services are not in competition. I do not consider them to be complementary within the meaning of the case law.²³ I consider them to be dissimilar. Even if I am wrong in this finding, they will be similar to only a low degree.

Class 42

55. “Computer programmes” in the opponent’s specification are a type of computer software. These will, therefore, be in competition with “software as a service [SaaS]” in the applicant’s specification, in that consumers may choose to buy either the software itself or the software as a service. The user of the goods and services will overlap. There may also be overlap in trade channels as businesses that provide software as a service may also provide software goods. The purpose of the goods and services may overlap. The goods and services will differ in nature and method of use. I consider the goods and services to be similar to a medium degree.

²³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

56. “Software design and development” in the applicant’s specification is similar in purpose to “computer programmes” in the opponent’s specification. There will also be overlap in user and they may also be in competition. For example, a consumer may decide to commission bespoke software or may purchase equivalent software goods. There may be overlap in trade channels, as businesses that design and develop software may also sell software in its finalised form to consumers. I consider the goods and services to be similar to at least a medium degree.

The average consumer and the nature of the purchasing act

57. 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 *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.”

58. In my view, the average consumer for the goods and services will be members of the general public or business users. The opponent submits that the level of attention paid during the purchasing process will be relatively low. I disagree. For all of the goods and services, various factors will be taken into consideration during the purchasing process (such as suitability for user’s specific needs and requirements). Further, these are not goods and services that are particularly inexpensive or purchased very regularly. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

59. The goods and services are most likely to be purchased from a retailer or service provider's physical premises or online equivalent. Consequently, the purchasing process will be predominantly visual. However, given that word-of-mouth recommendations may also play a part and advice may be sought from sales representatives, I do not discount that there may also be an aural component to the purchase of the goods and services.

Distinctive character of the earlier trade marks

60. 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-2779, 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).”

61. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

62. I will begin by considering the inherent distinctive character of the opponent's marks. The First Earlier Mark consists of the word WHICH. The word WHICH is an ordinary dictionary word which is used commonly as the start of a question. However, in this context it is ambiguous in its meaning as it is normally followed by the subject matter of a question. I consider the First Earlier Mark to be inherently distinctive to a low to medium degree.

63. The Fourth Earlier Mark consists of the word WHICH followed by a question mark. The same assessment applies as for the First Earlier Mark. The addition of the question mark simply serves to reinforce that the word WHICH normally forms part of a question. I consider this mark to be inherently distinctive to a low to medium degree.

64. The Fifth Earlier Mark consists of the wording WHICH? presented in white, slightly stylised font on a black background. The stylisation of the wording is minimal and I do not consider that the background adds to the mark's distinctive character to any meaningful extent. I consider the mark to be inherently distinctive to no more than a medium degree.

65. I now turn to consider the enhanced distinctiveness of the opponent's marks. The opponent has been publishing Which? Magazines since 1957. In 2010, the magazine was ranked fifth in the "Media – Newspapers and Magazines" category of the Superbrand index. The opponent has also been involved in taking action in relation to a number of "super-complaints" which have been well-documented in the press. By 2016/2017, the opponent had £1.35million subscribers and members. The opponent confirms that membership gives access to both the magazine, information and guidance about various sectors and legal and financial advice. By 2016/2017, the opponent's group income exceeded £100million and the opponent's websites received a significant number of views each year. The profile of the opponent's Which? mark is further enhanced by its involvement in giving awards to different businesses, which themselves receive press coverage, and the amount spent on advertising (which was over £6million per year between 2014 and 2017). This advertising includes articles

published in well-known newspapers and magazines (such as the Daily Mail, Woman's Weekly and the Guardian), all of which undoubtedly have significant circulation numbers.

66. Although the majority of the opponent's evidence relates to the mark WHICH? (i.e. the Fourth Earlier Mark), there are also examples of the slightly stylised version (the Fifth Earlier Mark) in use. As the addition of the question mark may go unnoticed by some average consumers and will not be apparent when the marks are spoken, I am satisfied that the enhanced distinctive character demonstrated by the opponent's evidence will also apply to the First Earlier Mark. Taking the evidence as a whole into account, I am satisfied that the earlier marks have acquired enhanced distinctiveness through use to a high degree in relation to electronic publications and magazines relating to consumer information and providing consumer information and advice.

Likelihood of confusion

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 goods and services may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

68. Direct and indirect confusion were described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

69. I have found the applicant’s marks and the First Earlier Mark to be visually similar to a medium degree. I have found the applicant’s marks and the Fourth Earlier Mark to be visually similar to a slightly lower than medium degree. I have found the applicant’s marks and the Fifth Earlier Mark to be visually similar to a low to medium degree. I have found all of the marks to be aurally similar to a medium degree and conceptually similar to a low degree. I have found the opponent’s marks to be inherently distinctive to between a low and medium degree. I recognise that the opponent has demonstrated that its marks have been used in relation to magazines and electronic publications relating to consumer information and providing consumer information and advice to the extent that would establish enhanced distinctiveness for those goods and services. I have identified the average consumer to be a member of the general public or a business user, who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be medium. I have found the parties’ goods and services to vary from being identical to similar to a medium degree.

70. I consider that the visual, aural and conceptual similarities between the marks are sufficient to avoid them being mistakenly recalled or misremembered as each other. I consider that this will be the case even where the goods and services are identical. I do not consider there to be a likelihood of direct confusion.

71. Having identified the differences between the marks, I do not consider that the average consumer will conclude that they originate from the same or economically linked undertakings. The word WHICH in the applicant's marks does not have a distinctive significance that is independent of the whole.²⁴ I do not, therefore, consider that the average consumer will view it as a logical brand extension or variant of the opponent's marks. I consider that even where the opponent has established enhanced distinctiveness (i.e. for providing consumer information and advice and electronic publications and magazines relating to consumer information) this will be offset by the low (or dissimilar) goods and services and the fact that the word WHICH will be viewed as part of a unit in the applicant's mark in any event.

72. I note that the opponent's evidence shows use of its mark in combination with additional descriptive wording (such as WHICH? Trusted Traders and WHICH? Legal Advice). There are also examples of the opponent's mark used in combination with laudatory wording (such as WHICH? Large Appliance Brand of the Year. However, the opponent has not sought to rely upon any of these marks and is not, therefore, able to rely upon a family of marks argument. The opponent has not pleaded that there is a family of marks. In any event, when viewed visually, none of these marks form a grammatical unit in the same way as the applicant's mark because of the use of punctuation after the word WHICH. Even when spoken (with the presence of the punctuation going unnoticed) the applicant's mark does not follow the same pattern. The addition of the word "dish" is not laudatory (as perhaps it would be if DISH OF THE YEAR or BEST DISH were added). The word "dish" in the applicant's mark, whilst suggesting a reference to food in some way, is not as clear in its meaning as WHICH? Legal Advice and WHICH? Trusted Traders. For example, it would not be clear whether the applicant's mark is referring to food retailers or food service providers (as

²⁴ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

it would be, for example, in WHICH? Restaurant). Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion.

73. The opposition under section 5(2)(b) is unsuccessful.

Final Remarks

74. As I have found there to be no likelihood of confusion in respect of those goods and services that I have found to be identical, the opponent would be in no better position had I considered the specification of the Second Earlier Mark. Further, as I have found there to be no likelihood of confusion in respect of those marks that share the greatest degree of similarity with the applicant's marks, the opponent would be in no better position had I considered the Third Earlier Mark (which shared the lowest degree of similarity with the applicant's marks).

Section 5(3)

75. I now turn to the opposition based upon section 5(3) of the Act. Section 5(3) of the Act states as follows:

“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 repute of the earlier trade mark.”

76. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* 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*).

77. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of the application - 2 July 2018.

Reputation

78. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”²⁵

79. For the same reasons set out above in relation to enhanced distinctiveness, particularly the number of members/subscribers, income and advertising expenditure, I am satisfied that the opponent has demonstrated a strong reputation in relation to electronic publications and magazines relating to consumer information and providing consumer information and advice. As it is the First, Second and Fourth Earlier Marks which share the greatest degree of similarity with the applicant’s marks I will proceed on this basis.

Link

80. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I have found the applicant’s marks and the First Earlier Mark to be visually similar to a medium degree. I have found the applicant’s mark and the Second and Fourth Earlier Marks to be visually similar to a slightly lower than medium degree. I have found all of the opponent’s marks to be aurally similar to the applicant’s marks to a medium degree and conceptually similar to a low degree.

²⁵ *General Motors*, Case C-375/97

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The goods and services for which the opponent has demonstrated a reputation are electronic publications and magazines relating to consumer information and providing consumer information and advice.

For the reasons set out above I consider electronic publications and magazines relating to consumer information to be similar to the applicant's services to a low degree. I consider providing consumer information to be dissimilar to the applicant's services. However, if I am wrong in this finding, they will be similar to only a low degree.

I can see no further point of similarity between the applicant's services and the goods and services for which the opponent has demonstrated a reputation. Consequently, the remaining services in the applicant's specification are dissimilar to the opponent's goods and services.

The strength of the earlier mark's reputation

The opponent's marks have a strong reputation in relation to electronic publications and magazines relating to consumer information and providing consumer information and advice.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I have found the earlier marks to be inherently distinctive to between a low and medium degree. For those goods and services for which the opponent has a reputation, this will be enhanced to a high degree.

Whether there is a likelihood of confusion

I have found there to be no likelihood of confusion.

81. I recognise that the opponent has a significant reputation for consumer information and advice services and electronic publications and magazines relating to consumer information. I also recognise that a lesser degree of similarity between the marks than that required for a likelihood of confusion may be sufficient for a relevant section of the public to make a connection between those marks.²⁶ That is, to make a link between them. Further, similarity of goods and services is not necessary for a link to be made. However, notwithstanding the opponent's significant reputation, I do not consider that the relevant public will make the requisite link. In the applicant's mark, the word WHICH forms part of the unit WHICH DISH. It is the 'dish' element that becomes the subject matter of the question. Consequently, I consider the consumer would view the word WHICH in this context, when used on different goods and services or goods and services that are similar to only a low degree, to be use of the ordinary dictionary word as part of a question, rather than a reference to the opponent or its trade marks. If any link is made, it would be too fleeting for the image of the earlier marks to transfer to the later mark in such a way that would give it an unfair advantage.

82. The opposition under section 5(3) is unsuccessful.

Section 5(4)(a)

83. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

²⁶ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

84. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

85. Whether there has been passing off must be judged at a particular point (or points) in time. Clearly, the applicant has been trading as reviews on its website date back to September 2018. However, there is no evidence to suggest that they were trading prior to the application for the trade marks in issue. The relevant date for assessing whether section 5(4)(a) applies is, therefore, the date of the application which is the subject of these proceedings i.e. 2 July 2018.

Goodwill

86. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

87. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

88. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

89. I have already found that the opponent has a strong reputation for electronic publications and magazines relating to consumer information and providing consumer information and advice. It is clear from the opponent's evidence that there has been significant income arising from these goods and services and that the opponent had £1.35million members in 2016/2017. As goodwill arises from trading activities, I am satisfied that the opponent has extensive goodwill for providing consumer information and advice and electronic publications and magazines relating to consumer information. I am also satisfied that the earlier signs are distinctive of that goodwill.

Misrepresentation and damage

90. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

91. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

92. I have found the opponent to have extensive goodwill in relation to magazines and electronic publications relating to consumer information and providing consumer information and advice. I have found the earlier signs to be distinctive of that goodwill. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). However, the closeness of the parties' respective fields is a factor which must be taken into account. The applicant's services are either dissimilar or similar to only a low degree to the goods and services for which the opponent has a reputation. The marks are, at best, visually and aurally similar to a medium degree and conceptually similar to a low degree. I have already found that use of the word WHICH in the applicant's mark forms part of a unit.

93. Taking all of the above factors into account, I consider that the significant reputation of the opponent will be offset by the differences between the marks and the goods and services. I consider that these differences are sufficient to avoid consumers purchasing the applicant's goods and services in the mistaken belief that they are provided by the opponent's business. In my view, in the context of the applicant's mark, and used on different goods and services (or those that are similar to only a low degree) the relevant public will view the presence of the word WHICH to be use of the ordinary dictionary word as part of a question, rather than a reference to the opponent or its trade marks.

94. The opposition under section 5(4)(a) is unsuccessful.

CONCLUSION

95. The opposition is unsuccessful, and the application can proceed to registration.

COSTS

96. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,300** as a contribution towards the costs of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£300
Preparing written submissions and considering the opponent's evidence	£700
Preparing written submissions in lieu	£300
Total	£1,300

97. I therefore order Which? Limited to pay Whichdish Ltd the sum of £1,300. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of December 2019

S WILSON

For the Registrar

ANNEX

WHICH

(UK registration no. 2432015) (the First Earlier Mark)

Class 16

Printed matters, books, periodicals, printed articles, directories, pamphlets, posters, lists, publications; cardboard and goods made from cardboard all concerning the characteristics, quality and prices of goods and services offered to the public.

Class 35

Preparation, provision and dissemination of information on line and via multimedia, all concerning the characteristics, quality and prices of goods offered to the public; provision of information and advice concerning the characteristics, quality and prices of goods offered to the public; operation and maintenance of data storage and retrieval services for the transmission and reception of communication signals.

Class 41

Publication of books, journals, magazines, text and articles online; publishing; education, training and instruction services; arranging seminars, conferences and exhibitions.

Class 42

Operation and maintenance of file server and data storage and retrieval services for trial submission and reception of communication signals; legal services; arbitration and conciliation services; the testing of consumer products.

WHICH?

(UK registration no. 2532716) (the Second Earlier Mark)

Class 9

Microfilm for exhibition; magnetic tapes and discs, computer programmes; all bearing, wholly or substantially wholly, information about the characteristics, quality, and about prices of goods or services offered to the public.

Class 16

Printed publications and pamphlets.

Class 35

Preparation, provision and dissemination of information online and via multi-media all relating to the characteristics, quality and prices of goods and services offered to the public; provision of information and advice concerning the characteristics, quality and prices of goods and services offered to the public.

Class 41

Publication of books, journals, magazines, text and articles online; publishing; education, training and instruction services; arranging seminars, conferences and exhibitions.

Class 42

Operation and maintenance of file server and data storage and retrieval services for trial submission and reception of communication signals; legal services; arbitration and conciliation services; the testing of consumer products.

Class 45

Legal services; legal research; dispute resolution services; including case management and all forms of litigation, arbitration and mediation; professional legal consultancy and advisory services; title searching; consultancy services relating to legal aspects of product liability trading law consumer protection, health, insurance, conveyancing, probate and wills, health and family matters; registration services; company formation and registration services.



(UK registration no. 3134582) (the Third Earlier Mark)

Class 9

Electronic publications (downloadable); encoded cards; magnetic tapes; magnetic discs, optical discs, and players for all the aforesaid goods; computer programmes; computer memories; compact disc read-only memories and compact disc-interactive memories; keyboards, control units, visual display units, recording and reproducing apparatus and instruments, and print-out apparatus, all for use with computers; television receivers and video display units; data storage, data processing and data display apparatus, all being electronic; light pens; microfilm prepared for exhibition; illuminated optical apparatus for use in reading microfilm; materials all for use in carrying sound recordings and audio-visual recordings, and parts and fittings for all the aforesaid goods; all for use in the provision by means of visual display units, telephonic apparatus, telegraphic apparatus or mechanical or electronic means of information wholly or partly concerning the characteristics, quality and prices of goods and services offered to the public; parts and fittings for the aforesaid.

Class 16

Printed matter; books; periodicals; printed articles; directories; pamphlets; posters; lists; publications; magazines; cardboard; paper; printed matter, books, periodicals, printed articles, directories, pamphlets, lists, publications and magazines, all concerning the characteristics, quality and prices of goods and services offered to the public.

Class 35

Advertising; advertising services; provision of advertising space in publications; marketing services; providing an online marketplace to promote and support contractors to advertise their services by bringing them together with potential customers; trade directories available for tradespeople; providing an online advertising marketplace for customers to search for specified contractors; providing customers with an online advertising marketplace to obtain quotes from contractors; providing an online advertising marketplace for contractors to bid for jobs online; business management; business administration; preparation, provision and dissemination of information on-line and via multi-media, all concerning the characteristics, quality and prices of goods and services offered to the public; providing a comparison service relating to the characteristics, quality and prices of goods and services of others; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; opinion polling; data processing; provision of business information; acquisition of commercial information; administration of business affairs; advice for consumers; advisory services for business and consumers; collection of data; direct marketing; document preparation; business information and business services; advertising; business management, business advisory and business administration services; marketing, publicity, public relations and promotional services; business enquiries; business investigations; business research and business consultancy services; company secretarial services; administration of the business affairs of retail stores; business advisory services relating to franchising; procuring services for third parties; providing business and consumer information by way of computer terminals; preparation, provision and dissemination of information on-line and via multi-media, all concerning the characteristics, quality and prices of goods and services offered to the public; providing a comparison service relating to the characteristics, quality and prices of goods and services of others; operation and maintenance of data; retrieval services for transmission and reception of communication signals; advertising; business promotion; business management; business administration; business information services; business advisory services; provision of impartial price information relating to the supply of consumer goods and services; provision of impartial price information relating to the supply of consumer goods and services relating to computers, telecommunications, telephony, ISP, electricity, gas, water, insurance, financial services, travel, holidays, accommodation, restaurants, catering services, health and medical products and providers; commercial services, namely facilitating change of suppliers on behalf of consumers of goods and services; collation and provision of information and advice relating to the aforementioned services; comparison services and business advisory services for consumers regarding telecommunication service providers, energy suppliers, insurance and financial services suppliers, travel and holiday suppliers, health and medical product and service providers; data storage and

retrieval services for transmission and reception of communication signals; provision of consumer advice and information; provision of consumer advice and information relating to health and medical products and services; preparation, provision and dissemination of information relating to the goods and services of others, all provided online and via multimedia; provision of consumer advice relating to food products and services; conducting consumer opinion polls and operating opinion polls; conducting consumer opinion polls and operating opinion polls including those provided online from a computer database or the Internet.

Class 36

Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services; provision of financial information; provision of information and advice regarding insurance, equity release, pensions, trusts, real estate administration, financial and monetary affairs and provision of credit, including information and advice regarding services provided by others; provision of advice relating to savings, investments, credit cards, loans, retirement funds, insurance, mortgages, property, tax, bank accounts; provision of a mortgage finder; provision of credit card calculator; provision of mortgage calculator; business liquidation services.

Class 38

Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; on line transmission services; cable transmission; other transmission services; data transmission and data network services; operating web blogs; cable television broadcasting; chat room services; internet portal services; radio and television broadcasting; transferring and disseminating information and data via computer networks and the Internet; Internet service provider services; the provision of an on-line forum for the exchange of advice and information; provision of an online interactive forum to enable contractors to provide informational, instructional and educational services in relation to their trade to potential customers.

Class 39

Provision of advice and information concerning all aspects of travel and transportation, including provision and advice of services of others; information and advice relating to breakdown recovery services provided by others; provision of information and advice relating to boat rental, booking of seats for travel, car parking, car rental, car transport, chauffeur services, coach rental, courier services, delivery of goods, delivery of goods by mail order, garage rental, packaging of goods, parcel delivery, parking place rental, rental of vehicle roof racks, rental of wheelchairs, storage, taxi transport, travel reservation, truck rental, vehicle rental and wrapping of goods, including such services provided by others.

Class 41

Education and training services; publishing; publication of information and editorial content, including text reports, and of commercial information, including classifieds, advertisements, contract tenders,

on electronic communications media, in particular via Internet platforms, e-mail newsletters or mobile communications messages; publication of books, journals, magazines, text and articles online; publication of product, address and classified directories and information contained therein; arranging and conducting colloquiums, conferences, seminars, symposiums, workshops and exhibitions; providing on-line electronic publications; arranging seminars, conferences and exhibitions; production of radio and television programmes; television and radio entertainment services; publishing surveys information, consultancy and advisory services relating to the aforesaid, including such services provided online from a computer network and/or via the Internet.

Class 42

Operation and maintenance of file server services for transmission and reception of communication signals; testing of home appliances and fast moving consumer goods; testing garden equipment; testing of consumer products; safety testing of apparatus; advisory services relating to safety of products; testing of vehicles; operation of file servers; creation and maintenance of websites, for others; provision of search engines for the Internet; electronic data storage; storage services for transmission and reception of communication signals; computer program maintenance; operating an Internet search engine; electronic storage of information relating to business information and consumer advice issues, and advice relating thereto.

Class 43

The provision of advice and information concerning holidays, hotels, guest houses, accommodation, provision of food and beverages, restaurants and catering services.

Class 44

The provision of advice and information concerning health and medical services, health and medical products and health and medical service providers; the provision of advice and information concerning beauty and spa treatments and beauty and spa treatments provided by others; the provision on advice and information concerning dentistry and dentistry treatments provided by others; the provision of advice and information concerning tattooing and tattooing services provided by others; the provision of advice and information concerning cosmetic treatments and cosmetic treatments provided by others.

Class 45

Legal services; legal research; legal information provided on-line from computer data bases and from the Internet; dispute resolution services; including case management and all forms of litigation, arbitration and mediation; professional legal consultancy and advisory services; title searching; provision of advice and consultancy services relating to legal aspects of product liability trading law consumer protection, health, insurance, conveyancing, probate and wills, health and family matters, employment and consumer affairs; registration services; company formation and registration services; political lobbying of government to change company policies for the benefit of the consumer;

provision of consumer advice and information; safety evaluation; advisory services relating to consumer rights; writing of wills; information, consultancy and advisory services relating to the aforesaid.

WHICH?

(EUTM no. 196477) (the Fourth Earlier Mark)

Class 9

Encoded cards; optical discs, magnetic tapes, magnetic discs, and players for all the aforesaid goods, computer programmes; computer memories; compact disc read-only memories and compact disc-interactive memories; keyboards, control units, visual display units, recording and reproducing apparatus and instruments, print-out apparatus, all for use with computers; television receivers and video display units; data storage, data processing and data display apparatus, all being electronic; light pens; microfilm prepared for exhibition; illuminated optical devices for use in reading microfilm; materials all for use in carrying sound recordings and audio-visual recordings; parts and fittings for all the aforesaid goods; all for use in the provision by means of visual display units, telephonic apparatus, telegraphic apparatus or mechanical or electronic means of information wholly or partly concerning the characteristics, quality and prices of goods and services offered to the public.

Class 16

Printed publications, pamphlets, periodicals, printed matter, directories, lists, posters, printed articles, cardboard and goods made out of cardboard all concerning the characteristics, quality and prices of goods and services offered to the public.

Class 38

Online transmission services; cable transmission; other transmission services; all concerning the characteristics quality and prices of goods and services offered to the public; operation and maintenance of file server and data storage and retrieval services for transmission and reception of communication signals; telecommunications services, data transmission and data network services, electronic mail services.

Class 42

Preparation, provision and dissemination of information on-line and via multi media; all concerning the characteristics, quality and prices of goods and services offered to the public; provision of information and advice concerning the characteristics, quality and prices of goods and services offered to the public.



(EUTM no. 10605285) (the Fifth Earlier Mark)

Class 9

Electronic publications (downloadable); encoded cards; magnetic tapes; magnetic discs, optical discs, and players for all the aforesaid goods; computer programmes; computer memories; compact disc read-only memories and compact disc-interactive memories; keyboards, control units, visual display units, recording and reproducing apparatus and instruments, and print-out apparatus, all for use with computers; television receivers and video display units; data storage, data processing and data display apparatus, all being electronic; light pens; microfilm prepared for exhibition; illuminated optical apparatus for use in reading microfilm; materials all for use in carrying sound recordings and audio-visual recordings, and parts and fittings for all the aforesaid goods; all for use in the provision by means of visual display units, telephonic apparatus, telegraphic apparatus or mechanical or electronic means of information wholly or partly concerning the characteristics, quality and prices of goods and services offered to the public; parts and fittings for the aforesaid.

Class 16

Printed matter; books; periodicals; printed articles; directories; pamphlets; posters; lists; publications; magazines; cardboard and goods made from cardboard; all concerning the characteristics, quality and prices of goods and services offered to the public.

Class 35

Preparation, provision and dissemination of information on-line and via multi-media, all concerning the characteristics, quality and prices of goods and services offered to the public; providing a comparison service relating to the characteristics, quality and prices of goods and services of others; operation and maintenance of data storage and retrieval services for transmission and reception of communication signals; advertising; business promotion; business management; business administration; business information services; business advisory services; provision of impartial price information relating to the supply of consumer goods and services; provision of impartial price information relating to the supply of consumer goods and services relating to computers, telecommunications, telephony, ISP, electricity, gas, water, insurance, financial services, travel, holidays, accommodation, restaurants, catering services, health and medical products and providers; facilitating change of suppliers on behalf of consumers of goods and services; collation, storage and provision of information and advice relating to the aforementioned services; comparison services and

business advisory services for consumers regarding telecommunication service providers, energy suppliers, insurance and financial services suppliers, travel and holiday suppliers, health and medical product and service providers; data storage and retrieval services for transmission and reception of communication signals; provision of consumer advice and information; provision of consumer advice and information relating to health and medical products and services; provision of consumer advice relating to food products and services; conducting consumer opinion polls and operating opinion polls; conducting consumer opinion polls and operating opinion polls including those provided online from a computer database or the Internet.

Class 36

Provision of information and advice regarding insurance, equity release, pensions, trusts, real estate administration, financial and monetary affairs and provision of credit, including information and advice regarding services provided by others; provision of advice relating to savings, investments, credit cards, loans, retirement funds, insurance, mortgages, property, tax, bank accounts; provision of a mortgage finder; provision of credit card calculator; provision of mortgage calculator.

Class 38

Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; on line transmission services; cable transmission; other transmission services; data transmission and data network services; operating web blogs.

Class 39

Provision of advice and information concerning all aspects of travel, including provision and advice of services of others; provision of advice and information concerning all aspects of travel, including provision of information and advice regarding travel services provided by others.

Class 41

Publication of books, journals, magazines, text and articles online; publishing; education, training and instruction services; arranging seminars, conferences and exhibitions; production of radio and television programmes; television and radio entertainment services; publishing surveys.

Class 42

Operation and maintenance of file server services for transmission and reception of communication signals; preparation, provision and dissemination of information online and via multimedia; testing of home appliances and fast moving consumer goods; testing garden equipment; testing of consumer products; safety testing of apparatus; advisory services relating to safety of products; testing of vehicles; operation of file servers.

Class 43

The provision of advice and information concerning holidays, hotels, guest houses, accommodation, restaurants and catering services.

Class 44

The provision of advice and information concerning health and medical services, health and medical products and health and medical service providers.

Class 45

Legal services; legal research; dispute resolution services; including case management and all forms of litigation, arbitration and mediation; professional legal consultancy and advisory services; title searching; provision of advice and consultancy services relating to legal aspects of product liability trading law consumer protection, health, insurance, conveyancing, probate and wills, health and family matters, employment and consumer affairs; registration services; company formation and registration services; political lobbying of government to change company policies for the benefit of the consumer; provision of consumer advice and information; safety evaluation; advisory services relating to consumer rights; writing of wills.