

O/058/21

TRADEMARKS ACT 1994

IN THE MATTER OF TRADEMARK APPLICATION 3411020

BY

Jewellery Validation Service Limited

TO REGISTER THE FOLLOWING TRADEMARK IN CLASS 9

Jade

AND THE OPPOSITION UNDER NO. 418371 THERETO

BY

Jade Software Corporation Limited

Background and pleadings

1. Jewellery Validation Service Limited (“the applicant”) applied to register the trade mark ‘Jade’ in the UK on 2 July 2019. It was accepted and published in the Trade Marks Journal on 9 August 2019 in respect of:

Class 9: Computer Software for the purpose of Jewellery appraisal [valuation], valuation of diamonds and valuation of watches.

2. Jade Software Corporation Limited (“the opponent”) opposes the trade mark on the basis of Section 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act). This is on the basis of two earlier UK Trade Marks, namely:

2008370 for the mark ‘JADE’ which was registered on 23 August 1996 for:

Class 9: computer software; computer programmes; computer storage media; encryption devices; but not including any such goods relating to music and not including any such goods relating to recording, broadcasting or sound mixing.

2239151 for the mark ‘JADE’ which was registered on 8 March 2002 for:

Class 42: Computer research, development and advisory services including services for software development; computer systems analysis; computer consultancy; design of computer hardware; computer programming; design, maintenance, updating and implementation of computer software; computer time-sharing; consultations in the field of computer hardware; leasing of access time to databases; services relating to the design and development of application software; computer equipment rental; computer monitoring services; remote computer minding services; back-up and recovery computer services being services related to the maintaining of back up data records and software to enable data recovery in the event of systems shut down or disaster; computer equipment, software, systems and installations support and consultancy services.

3. The following goods and services are relied upon in this opposition:

Class 9: Computer software; but not including any such goods relating to music and not including any such goods relating to recording, broadcasting or sound mixing.

Class 42: Design, maintenance, updating and implementing of computer software.

4. The Opponent argues that the respective goods and services are identical or similar and that the marks are identical. It states that the respective goods are of the same nature, have the same intended purpose, method of use, users and channels of trade.
5. The applicant filed a counterstatement denying the claims made and stating that the goods and services provided by the Opponent are totally different.
6. Neither side filed evidence in these proceedings.
7. The Applicant is unrepresented. The Opponent is represented by Gill Jennings & Every LLP.
8. Both sides filed written submissions which will not be summarised here but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Decision

9. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

10. Section 5(2)(a) of the Act is also being relied upon and is as follows:

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

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

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

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

12. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2, above, which qualify as earlier trade marks under the above provisions.

13. For the purposes of procedural economy, I will begin by considering the opposition based on Section 5(1) relying on the opponent’s earlier registration in class 09, namely 2008370. I will consider the opponent’s other earlier right later in my decision.

Identity of the Marks

14. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

15. Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14 found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

16. The contested mark comprises solely the word ‘Jade’ in plain script. The earlier mark comprises solely the word ‘JADE’, also in plain script. Taking note of the comments of Mr Purvis above, I consider that the marks at issue are identical.

Comparison of goods

17. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective 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.

19. The opponent has protection under its earlier registration 2008370, for the broad term 'Computer software' (notwithstanding the exceptions listed above in paragraph 2).

20. The contested goods are 'Computer software for the purpose of Jewellery appraisal [valuation], valuation of diamonds and valuation of watches.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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".

22. The Opponent's goods include the broad category of 'computer software' which wholly encompasses the contested goods and therefore the goods in this matter can be said to be identical.

23. As the marks and the goods have been found to be identical, the opposition based on Section 5(1) is successful.

24. In the event that I am found to be wrong in my finding under Section 5(1), I will now assess the opposition insofar as it is based on Section 5(2)(a) and relying on the opponent's second earlier mark, namely UK registration 2239151. I note that the opponent relies on only part of the services covered under this earlier mark.

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

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

26. The parties' respective specifications are:

Opponent's services	Applicant's goods
Class 42: Design, maintenance, updating and implementing of computer software.	Class 09: Computer Software for the purpose of Jewellery appraisal [valuation], valuation of diamonds and valuation of watches.

27. The contested goods are computer software for the purpose of valuing and appraising jewellery, diamonds and watches.

28. The earlier services are computer software design, maintenance, updating and implementation.

29. In *Boston Scientific*¹, the General Court described goods/services as “complementary” in circumstances where “... *there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking*”. I also take note that in *Kurt Hesse v OHIM*², the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.

30. I find that an undertaking that designs computer software will also generally sell the end product as a good. These goods and services may share end-users as the average consumer of software design services will expect to receive a finished article, being a piece of computer software, once the design process has concluded. These goods and services may also be said to be complementary as each is important or indispensable to the other and the average consumer will likely expect that the responsibility for both the goods and services lies with a single undertaking.

31. I therefore find that the goods and services at issue are similar to at least a low degree.

Average consumer and the purchasing act

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

33. 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

¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

² Case C-50/15 P

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.”

34. The Opponent states that the average consumer for both goods and services would be the same. The Applicant disagrees with this suggestion. My assessment must be based on the average consumer of computer software and the average consumer of design, maintenance, updating and implementation of computer software services. I consider this to be quite a broad area. Software may be purchased by the general public for personal use, or by businesses for use in a professional environment. However, the purchase of software is not likely to be a regular one and perhaps may even be a one-off event.
35. The selection of such goods will largely be a visual process mainly from websites online and possibly within retail establishments. However, I do not dismiss the potential for the marks to be expressed aurally in conversation with salespersons, on the phone, or when visiting retail outlets.
36. The purchase process will likely require more attention than casual inexpensive purchases (*e.g. daily consumables*) as this is more likely to be a less frequent and more expensive purchase and the software is likely to be used on an ongoing basis. The cost of software is likely to vary depending on the type of software and the needs of the user.
37. Depending on the value and purpose of the software in question, I consider the average consumer would pay somewhere between a medium and a high degree of attention in its purchase.
38. The selection of computer software design, maintenance, updating and implementation services, is also likely to be an infrequent event and one that will be taken with some care and a reasonable degree of attention. The average consumer may be both the general public and a professional consumer. The selection will largely be a visual one but may also be aural, when dealing with telephone interaction or speaking to salespersons in a retail environment. I consider that the average

consumer of these services will pay at least a medium degree of attention in the selection and purchase process.

Comparison of marks

39. The respective trade marks are shown below:

Earlier mark	Contested trade mark
JADE	Jade

40. As both marks are comprised of the same single word, the overall impression of the marks is the same and lies in that word.

41. The marks share the same four letters presented in the same order. Whilst the earlier mark is registered in capital lettering and the contested mark has been applied for in a combination of upper and lower case lettering, I remind myself of the comments of Mr Purvis in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* (see paragraph 16 above) and conclude that the marks may be considered to be identical.

42. Aurally the marks will be articulated in precisely the same way and are therefore identical.

43. Conceptually the word Jade has a number of meanings such as a hard stone, usually green in colour, that is used for making jewellery and ornaments, or the colour itself.³ As both marks are comprised solely of this term, they are conceptually identical.

44. In conclusion, I find the marks to be visually, aurally and conceptually identical.

³ <https://www.collinsdictionary.com/dictionary/english/jade>

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

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

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

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

47. The opponent did not file any evidence and has made no claim of an enhanced level of distinctiveness of its earlier mark. I must therefore consider the position based on the inherent distinctiveness of the mark.

48. The earlier mark consists of the word ‘JADE’ which can be said to be an ordinary dictionary term that will be readily understood. The word does not directly describe the services being provided and does not appear allusive or suggestive of computer software services. Therefore, the opponent’s earlier mark can be said to be inherently distinctive to a medium degree.

Likelihood of Confusion

49. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

50. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

51. To determine whether there is a likelihood of confusion, I must bear in mind a number of factors. I have found the marks to be visually, aurally and conceptually identical. The goods and services at issue are similar to at least a low degree. I have found the average consumer to be applying at least a medium degree of attention in selecting these goods and services. I have also found the earlier mark to be inherently distinctive to a medium degree.

52. This leads me to conclude that there would be direct confusion between the marks and therefore the Opposition succeeds under Section 5(2)(a).

Conclusion

53. As I have found that there is a likelihood of confusion, the opposition has been successful. Subject to appeal, the contested mark is refused for all of the applied for goods.

Costs

54. The opponent has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs is calculated as follows:

Official fee	£100
Preparing a Notice of Opposition and reviewing Counter Statement	£200
Preparing written submissions And considering the Applicant's written submissions in lieu	£500
Total	£800

55.I therefore order Jewellery Validation Service Limited to pay Jade Software Corporation Limited the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 22nd day of January 2021

**L Nicholas
For the Registrar**