

O/532/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3291384 & 3291395

BY WORKSMART LTD

TO REGISTER THE FOLLOWING TRADE MARKS:

ACCORD

AND



accord
accord

IN CLASSES 9, 35, 41 & 42

AND

IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 413154 & 413162

BY ACORD CORPORATION

BACKGROUND AND PLEADINGS

1. On 20 February 2018, Worksmart Ltd (“the applicant”) applied to register the trade mark **ACCORD**, under number 3291384 (“the first contested mark”). On the same date, the applicant applied to register the series of two trade marks displayed on the cover page of this decision, under number 3291395. As the only difference between the marks in the series is the use of colour in one and greyscale in the other, I will refer to them in the singular (i.e. “the second contested mark”) unless it is necessary to distinguish between them. Both applications were published for opposition purposes on 20 April 2018 for a range of goods and services in classes 9, 35, 41 and 42.

2. On 20 July 2018, ACORD Corporation (“the opponent”) opposed the applications under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of the following trade marks:

ACORD

EUTM no. 6180541

Filing date: 8 August 2007

Registration date: 12 April 2012

(“the first earlier mark”)



EUTM no. 6225015

Filing date: 11 October 2007

Registration date: 23 March 2012

(“the second earlier mark”)

3. The earlier marks are registered in respect of an identical list of goods and services in classes 16, 41 and 42. However, for the purposes of the oppositions, the opponent only relies on some of the services for which the earlier marks are registered, namely:¹

Class 42: Developing, maintaining and updating standards for electronic interfacing among entities within the insurance industry; designing, maintaining and updating standardized forms and software containing specifications and standards for use by entities within the insurance industry; information, advisory and consultancy services relating to the aforementioned services.

4. The opponent's marks are earlier marks in accordance with section 6 of the Act.² As they had both been registered for more than five years at the filing date of the applications, they are subject to the proof of use requirements as specified in section 6A of the Act. In its notices of opposition, the opponent made statements of use in relation to the services listed at paragraph 3.

5. The opponent contends that the competing trade marks are highly similar and that the applied-for goods and services are identical and/or similar to the services of the earlier marks. On this basis, the opponent submits that there is a likelihood of confusion.

6. Following extended cooling off periods for both sets of proceedings, the applicant filed counterstatements denying the claims made. The applicant also indicated that it would require the opponent to provide proof of use of its earlier marks.

7. On 19 February 2020, the proceedings were consolidated pursuant to rule 62(g) of the Trade Marks Rules 2008.

¹ The opponent originally indicated that it was relying upon all the goods and services of the earlier marks. However, within its skeleton arguments dated 25 May 2021, the opponent confirmed that it only sought to rely upon the narrower list of services shown.

² Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

8. By way of Form TM21B filed on 6 November 2020, the applicant removed class 41 from the applications and restricted the scope of its specifications in classes 9, 35 and 42.³ Registration of the applications is now sought for the goods and services set out at paragraph 42.

9. Both parties filed evidence in chief. The opponent also filed written submissions during the evidence rounds. A hearing took place before me, by video conference, on 19 May 2021. The opponent was represented by Ms Georgina Messenger of Counsel, instructed by Wynne-Jones IP Limited. The applicant was represented by Mr Jamie Muir Wood of Counsel, instructed by Trade Mark Wizards Limited.

10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

EVIDENCE AND SUBMISSIONS

11. The opponent's evidence consists of the witness statement of Mr Christopher Newman dated 16 June 2020, together with Exhibits CN1 to CN17. Mr Newman confirms that he is the Managing Director (Global) of the opponent, a position he has held since March 2017.

12. The applicant filed evidence in the form of the witness statement of Mr Andrew James Nightingale dated 9 November 2020. Mr Nightingale confirms that he is the Managing Director of the applicant, a position he has held since October 2017. He was also its Client Services Director prior to his current post.

13. As noted above, the opponent also filed written submissions during the evidence rounds.

³ The applicant had previously amended its specifications by filing Form TM21Bs on 3 May 2018 and 28 June 2018.

14. Whilst I do not propose to summarise the evidence and submissions here, I have taken it all into consideration in reaching my decision and will refer to them below, as and where necessary.

PRELIMINARY ISSUE

15. In the applicant's evidence and submissions, it argues that there has been a lack of actual confusion between the competing trade marks. I must, at this early stage, clarify that an absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the applied-for marks and the opponent's earlier marks.

16. While evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the marks themselves.⁴ In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

⁴ *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

DECISION

Proof of use

17. I must firstly deal with the issue of whether, or to what extent, the opponent has shown genuine use of its earlier marks. The relevant statutory provisions are as follows:

“6A - (1) This section applies where

(a) an application for registration of a trade mark has been published, (b)

there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

18. The onus is on the opponent, as the proprietor of the earlier marks, to show use made of the marks because section 100 of the Act states:

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

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the filing date of the applications at issue, i.e. 21 February 2013 to 20 February 2018.

20. At the hearing, Mr Muir Wood accepted that the earlier marks had been put to genuine use during the relevant period in respect of the following services:

Class 42: Developing, maintaining and updating standards for electronic interfacing among entities within the insurance industry; designing, maintaining and updating standardized forms for use by entities within the insurance industry; information, advisory and consultancy services relating to the aforementioned services; information, advisory and consultancy services relating to designing, maintaining and updating software containing specifications and standards for use by entities within the insurance industry.

21. Therefore, my assessment will focus on the services for which genuine use remains in dispute, namely, *‘designing, maintaining and updating software containing specifications and standards for use by entities within the insurance industry’*.

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v*

Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTMs, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant five-year period. In making the assessment I am required to consider all relevant factors, including the scale and frequency of the use shown; the nature of the use shown; the goods and services for which use has been shown; the nature of those goods/services and the market(s) for them; and the geographical extent of the use shown.

24. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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

[...]

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has

been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

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

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

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

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

26. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵ However, following a careful consideration of the evidence, I am not satisfied that the opponent has demonstrated genuine use of its earlier marks in relation to any services other than those that have been accepted by Mr Muir Wood.

27. I acknowledge that there is evidence of use of the earlier marks in the form that they are registered from within the relevant period. This is clear from various prints of the opponent’s website,⁶ a sample membership application form,⁷ newsletters,⁸ presentations,⁹ forum literature,¹⁰ membership reports,¹¹ informative guides¹² and a sample certificate of liability insurance.¹³ The earlier marks are also prominently displayed in the exhibited invoices that were sent to customers in, inter alia, France, Germany, Italy and the UK.¹⁴ Nevertheless, in my view, none of the foregoing establishes that the opponent used the earlier marks in relation to designing, maintaining or updating software containing specifications and standards. Rather, the evidence demonstrates that the earlier marks were used in the relevant period in connection with what appears to be the opponent’s primary going concern, that being

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

⁶ Exhibits CN2, CN4, CN5, CN6, CN7 & CN10

⁷ Exhibit CN4

⁸ Exhibit CN6

⁹ Exhibits CN7 & CN10

¹⁰ Exhibit CN9

¹¹ Exhibit CN10

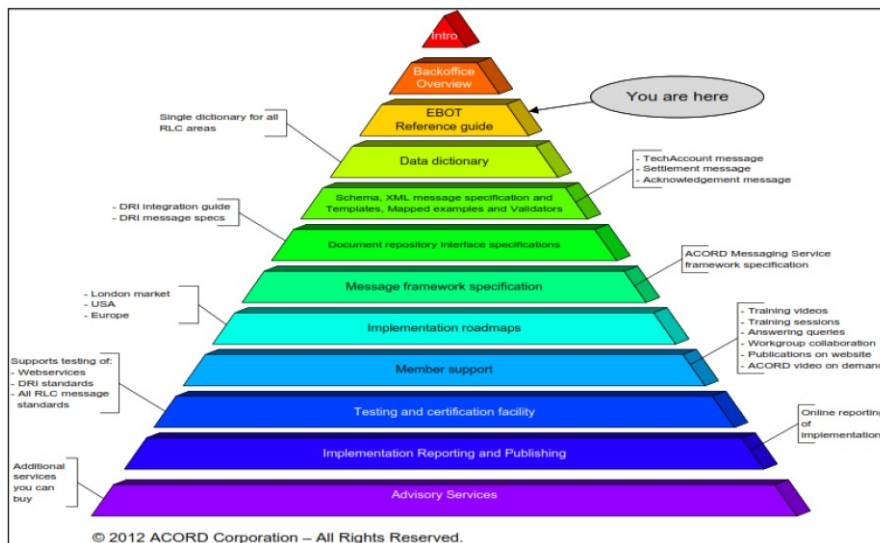
¹² Exhibit CN14

¹³ Exhibit CN14

the development of standards and standardised forms for its members within the insurance industry, as well as providing related information and support.

28. At the hearing, Ms Messenger contended that the standards designed and provided by the opponent, particularly those that relate to electronic interfacing, are, by their very nature, dependent on software to be implemented. She argued that neither electronic interfacing nor the transferring of standardised data is possible without standardised software. Moreover, Ms Messenger submitted that the form in which the opponent's standards are provided to consumers is by way of downloadable instructions for use with existing software. She argued that this establishes that the opponent is designing and updating software, albeit by providing instructions, rather than the software itself.

29. In support of these arguments, Ms Messenger directed me to the evidence of Mr Newman, where he states that the opponent enables the transmission of data in a singular electronic format via software,¹⁵ and that part of the opponent's service is to assist its customers with implementing the standards in their respective computer systems.¹⁶ Ms Messenger also referred me to the following diagram from the 'Reinsurance and Large Commercial EBOT Quick Reference Guide' in the opponent's evidence, dated April 2015:¹⁷



¹⁵ Witness statement of Mr Christopher Newman, §3

¹⁶ Newman, §11

30. Specifically highlighted was the reference in the diagram to “schema, XML specifications and templates, mapped examples and validators”. This, according to Ms Messenger, demonstrates that the opponent provides instructions for programming and implementing in a software format. She explained that XML is an extensible mark-up language (similar to HTML) and argued that this is only meaningful once it is read by, and implemented in, software. While Ms Messenger accepted that this does not show the opponent providing software directly, she submitted that it was evidence that it provides instructions for designing and updating software.

31. Whilst it may be true that the opponent’s standards are used in conjunction with software and that electronic interfacing is dependent on software, to my mind, that does not equate to the opponent designing, maintaining or updating software as a service. Similarly, I do not accept Ms Messenger’s contention that providing customers with instructions for designing and updating existing software is evidence that the opponent provides these services to third parties; providing consumers with information that could enable them to undertake these activities is not the same as actually providing those services. Neither, in my view, is it a particular example of a service that consumers would consider falls within the remit of designing, updating, or maintaining software. Mr Newman’s comments regarding the opponent’s activities do not convince me otherwise: enabling the transmission of data between third parties via software and assisting with the implementation of its standards in third party computer systems do not signify that the opponent designs, updates or maintains software per se. Finally, the references to XML in the opponent’s evidence do not establish that the opponent is providing any of the services under consideration. Simply providing instructions in a mark-up language does not automatically mean that those instructions should be taken to be software, or that the opponent is designing, updating or maintaining computer software.

32. In light of the above, I find that the evidence falls a long way short of the sufficiency and solidity needed to meet the standards of proof required for the services in issue. Accordingly, the opponent may not rely upon *‘designing, maintaining and updating software containing specifications and standards for use by entities within the*

insurance industry' in class 42. I will proceed to determine the oppositions on the basis of only the services for which genuine use has been accepted.

Section 5(2)(b)

Legislation and case law

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

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

[...]

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

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

34. 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 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

35. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

36. In *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) 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”.

37. 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.

38. Furthermore, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

39. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

40. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

41. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person confirmed at paragraph 5 that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

42. As a consequence of my finding at paragraph 32, the goods and services to be compared are as follows:

Opponent’s services	Applicant’s goods and services
Class 42: Developing, maintaining and updating standards for electronic interfacing among entities within the insurance industry; designing, maintaining and updating standardized forms for use by entities within the insurance industry;	Class 9: Computer software for processing data for business advice, management, regulatory and compliance requirements, quality assurance, business process management, and customer service management; all of the aforementioned for

information, advisory and consultancy services relating to the aforementioned services; information, advisory and consultancy services relating to designing, maintaining and updating software containing specifications and standards for use by entities within the insurance industry.

use in human resource management and/or regulatory compliance with the requirements of financial services regulatory bodies; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 35: Information and advisory services; all relating to processing data for business advice, management, regulatory and compliance requirements, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management and/or regulatory compliance with the requirements of financial services regulatory bodies; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 42: Computer software design and development; software as a service [SaaS]; consultancy services in the field of software as a service [SaaS]; installation, maintenance, modification and upgrading of computer software systems; all the above relating to processing data for business advice, management, regulatory and compliance requirements, quality assurance,

	<p>business process management, and customer service management; all of the aforementioned for use in human resource management and/or regulatory compliance with the requirements of financial services regulatory bodies; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.</p>
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43. I have lengthy submissions from both parties on the similarity (or otherwise) between the respective goods and services which I do not propose to reproduce in full here. However, I have taken them all into consideration in reaching my decision.

Class 9

44. Although there is an exclusion to the effect that the applicant's goods do not include computer software relating to the design, maintenance or updating of standardised forms and software containing specifications and standards, I note that it does include computer software for regulatory and compliance requirements. Moreover, the applicant's goods explicitly include those in the field of financial regulatory compliance. Accordingly, while I accept that the applicant's goods and the opponent's *'developing, maintaining and updating standards for electronic interfacing among entities within the insurance industry'* have a different nature and method of use, regulatory compliance and the development of standards are interrelated. Standards, in the context of the insurance industry, could reasonably include those which pertain to conformity with financial regulations.

45. Therefore, in respect of the applicant's *'computer software for processing data for [...], regulatory and compliance requirements, [...]; all of the aforementioned for use in [...] regulatory compliance with the requirements of financial services regulatory*

bodies' there is an overlap in intended purpose. Furthermore, given that the opponent's services and the applicant's goods are in the field of insurance and financial regulatory compliance, respectively, there is likely to be an overlap in trade channels. It is, in my view, entirely likely that an undertaking which, for example, develops standards for electronic interfacing within the insurance industry may also offer software that enables businesses to comply with financial regulations regarding their data. It is also likely that the same businesses may be users of the respective goods and services. I do not consider that the respective goods and services are important or indispensable to the use of one another. As such, they are not complementary in the sense outlined in case law. However, one can envisage circumstances in which a business may choose computer software for the purposes of processing its data in line with financial regulations, or, instead, obtain standards from a developer and implement those within its own computer system. To this extent, there is a degree of competition between the respective goods and services. Balancing the similarities against the differences, I find that there is between a low and medium degree of similarity between the goods and services under consideration.

46. However, this similarity does not extend to the remaining goods in class 9 of the applications. Although these goods are also subject to the same exclusion, they do not include computer software for regulatory compliance, or for use in the field of financial regulatory compliance. As such, it is considered that the overlap in intended purpose is not likely to arise and the respective goods and services will not reach the market through shared trade channels. Moreover, due to the different purposes and fields of application, there is no obvious competition between the goods and services and users are likely to be different.

47. For the avoidance of doubt, I have considered the opponent's other services. However, to my mind, these do not put the opponent in a more favourable position than those compared above.

Class 35

48. As above, the applicant's list of services includes an exclusion in respect of the design, maintenance or updating of standardised forms and software containing

specifications and standards. However, I note that it does include information and advisory services relating regulatory and compliance requirements. In addition, the applicant's services explicitly include information and advisory services in the field of financial regulatory compliance. As such, while I accept that the applicant's services and the opponents '*developing, maintaining and updating standards for electronic interfacing among entities within the insurance industry*' are different in nature and method of use, there is a closeness between the development of standards and regulatory compliance. In the context of insurance, standards could reasonably include those which relate to financial regulations.

49. Accordingly, the applicant's '*information and advisory services; all relating to processing data for [...], regulatory and compliance requirements, [...]; all of the aforementioned for use in [...] regulatory compliance with the requirements of financial services regulatory bodies*' have a similar intended purpose to the opponent's services. Further, given that the respective services are in similar fields, i.e. insurance and financial regulatory compliance, there is likely to be an overlap in trade channels. They may be offered by the same undertakings; it is likely that an undertaking which develops standards for electronic interfacing within the insurance industry may also offer information and advisory services relating to processing data in line with financial regulations. They may also be used by the same businesses. The services under consideration are not complementary as they are not important or indispensable to the use of one another. Neither is there any meaningful competition between them. Overall, I find that there is a low degree of similarity between the respective services.

50. This similarity does not, in my view, extend to the applicant's other class 35 services. This is because these services do not relate to data processing for regulatory compliance and are for use in fields other than financial regulatory compliance. There is no obvious overlap in intended purpose. Furthermore, the respective services are unlikely to be offered by the same undertakings or reach the market through the same trade channels. Finally, due to the different purposes and fields of application, the respective services are unlikely to share users.

51. I have also considered the opponent's other services, though, in my view, these do not put the opponent in a more favourable position than those already compared.

Class 42

52. The applicant's list of services in this class includes an exclusion in respect of software services relating to standardised forms or software containing specifications and standards. Nevertheless, I note that it does include such services for regulatory and compliance requirements, and that it explicitly includes those in the field of financial regulatory compliance. I accept that the applicant's services and the opponents '*developing, maintaining and updating standards for electronic interfacing among entities within the insurance industry*' do not have the same nature or method of use. However, as previously outlined, regulatory compliance and the development of standards are interrelated; in the field of insurance, those standards could reasonably include those which are designed for compliance with financial regulations.

53. As such, in respect of '*computer software design and development; software as a service [SaaS]; consultancy services in the field of software as a service [SaaS]; installation, maintenance, modification and upgrading of computer software systems; all the above relating to processing data for [...], regulatory and compliance requirements, [...]; all of the aforementioned for use in [...] regulatory compliance with the requirements of financial services regulatory bodies*' there is likely to be an overlap in intended purpose. In my view, the respective services are also likely to share overlapping trade channels insofar as an undertaking which, for example, develops software for financial regulatory compliance may also develop standards for electronic interfacing within the insurance industry. The respective services may also be used by the same businesses. The services under consideration are not important or indispensable to the use of one another and are not, therefore, complementary. There is a degree of competition between the respective services as, in some circumstances, one could be selected over the other: a business may choose to have software developed for processing its data in accordance with financial regulations or, instead, obtain standards which can be implemented within its pre-existing computer system. In light of the above, I find that there is a medium degree of similarity between the services under consideration.

54. However, given that they do not include software services relating to processing data for regulatory compliance, or for use in the field of financial regulatory compliance, this similarity does not extend to the other services in class 42 of the applications. There is unlikely to be an overlap in intended purpose for services which are for different uses in different fields. Due to these differences, the respective services are not in direct competition. Neither, in my view, are such services likely to have the same users. Finally, the respective services are not likely to reach the market through shared channels of trade or to be offered by the same undertakings.

55. It should be noted that I have considered the other services relied upon by the opponent. However, none put the opponent in a more favourable position.

The average consumer and the nature of the purchasing act

56. The average consumer is deemed to be reasonably well informed, 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.¹⁸

57. 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.”

¹⁸ *Lloyd Schuhfabrik Meyer*, Case C-342/97

58. At the hearing, both parties submitted that the average consumer of the goods and services at issue will be professional users. I agree that, due to the nature and purpose of the goods and services, the average consumer will be members of the business community.

59. Mr Muir Wood sought to distinguish the consumers of the respective goods and services by asserting that those of the opponent would be businesses in the field of insurance, whereas those of the applicant would be more general or, alternatively, highly specialised. Further, he argued that the individuals responsible for purchasing or using the respective goods and services are likely to be in different parts of each business. I reject these submissions for three reasons. Firstly, when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.¹⁹ As a result, although the applicant has suggested the ways in which its marks may be used and its target market, my assessment must take into account only the applied-for marks – and their specifications – and any potential conflict with the earlier marks; differences between the actual goods and services provided by the parties, or differences in their trading styles, are not relevant unless they are apparent from the applied-for and registered marks. Secondly, the applicant's goods and services explicitly include those in the field of financial regulatory compliance, while the opponent's services are specified for use within the insurance industry. It is clear that the average consumer of the respective goods and services will be businesses potentially operating in the same, or at least overlapping, fields. Finally, the supposed difference between individuals within each business that will purchase the respective goods and services is an artificial distinction; as outlined above, the average consumer will be businesses and it is not relevant for the purposes of my assessment as to which hypothetical individuals within those particular organisations are responsible for the purchasing of the goods and services.

60. The frequency at which the goods and services are purchased will, inevitably, vary. However, overall, they may be purchased relatively frequently for the ongoing operational, administrative and technological needs of the business. Some, such as

¹⁹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

software as a service, for example, may be purchased by way of subscription or an ongoing, periodic licence. The cost of the goods and services is also likely to vary but, overall, is likely to require an above average outlay. The purchasing process would be far from casual and is likely to follow a measured thought process. In my view, selection of the goods would be a relatively important choice for business users as they will wish to ensure that they are choosing products that reflect their specification requirements and enable successful and legally compliant data processing. To this end, businesses may consider various factors including technological functionality when selecting the goods. As for the services, it is maintained that selection of the same would be an important choice for business users as they will wish to ensure that they are provided to a professional standard and well-suited to the needs of the business. The use or implementation of the services may also have legal ramifications. In this regard, businesses may consider factors such as the provider's expertise and prior outcomes when choosing the services. In light of the above, it is considered that the average consumer will demonstrate a higher than normal level of attention when purchasing the goods and services.

61. The goods are likely to be purchased from the physical outlets of specialist suppliers, or their online equivalents, where they will be selected after viewing information on physical displays or the internet. I am of the view that the purchasing process for the goods would be predominantly visual in nature, though I do not discount an aural component in the form of discussions with sales representatives about products of this nature. The services are likely to be purchased after viewing information on the internet, in business prospectuses or brochures. Overall, it is considered that the purchasing process for the goods and services would be largely visual in nature. However, aural considerations will play their part as it is likely that businesses will engage in verbal consultations with prospective service providers prior to selecting the services.

Distinctive character of the earlier mark

62. 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).”

63. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

64. Ms Messenger submitted that, as 'ACORD' is an invented word with no allusive qualities, the earlier marks have a high degree of inherent distinctive character. She contended that this would remain the case even if they were misread as the word 'accord'. In respect of the second earlier mark, Ms Messenger argued that the figurative elements increase its distinctive character. Ms Messenger also submitted that the distinctive character of the earlier marks has been enhanced by virtue of the use made of them. For his part, Mr Muir Wood accepted that the earlier marks have at least a moderate degree of inherent distinctive character as they are not descriptive of the services relied upon by the opponent. He also highlighted that no plea of acquired distinctiveness was advanced in the opponent's pleadings.

65. The first earlier mark is in word-only format and consists of the word 'ACORD'. As the mark is comprised of one plain word, its distinctiveness lies in the word itself. In my view, it is likely that the average consumer would perceive it as a misspelling of the word 'accord', meaning agreement or harmony.²⁰ I agree with Ms Messenger that the word has no descriptive or allusive qualities in respect of the services relied upon by the opponent. Nevertheless, it will be perceived as a misspelling of a dictionary word or, if the misspelling is not noticed, it will be perceived as the word 'ACCORD'. As such, I find that the first earlier mark has a medium level of inherent distinctive character.

66. As for the second earlier mark, my findings in respect of the word 'ACORD' are equally applicable, i.e. it is likely to be perceived as a misspelling of the word 'accord'. However, the second earlier mark is figurative. Above and below the word appear crescent shapes, which, together, give the impression of an ellipse. Although the figurative elements are likely to be seen as decoration, they still contribute to the distinctiveness of the mark. In light of the foregoing, I find that the second earlier mark has between a medium and high level of inherent distinctive character.

67. Although, as Mr Muir Wood has correctly identified, the argument was not advanced at pleadings stage, the opponent has filed evidence of use in these proceedings and I now turn to consider whether, at the relevant date of 20 February

²⁰ <https://www.lexico.com/definition/accord>

2018, the opponent has demonstrated that the earlier marks had an enhanced degree of distinctive character. The earlier marks relied upon by the opponent are EUTMs. However, as this assessment is to determine how strongly the earlier marks indicate to consumers in the UK that the services originate from the opponent, only use of the marks in the UK is relevant.

68. No specific details have been provided by the opponent to indicate the size of the relevant market or its share of that market; neither is there any evidence before me to that effect. The opponent had 25 to 30 UK-based members per annum between 2013 and 2018.²¹ While some of these members are very large organisations, such as Lloyd's, these membership figures represent a modest number of consumers. It is clear that there had been continuous and regular use of the earlier marks prior to the relevant date; use of both earlier marks can be seen in the evidence in connection with the opponent's standards and standardised forms membership programs since 2009 and consistently throughout the relevant period.²² Nevertheless, much of this evidence is from the opponent's global website and, therefore, does not demonstrate that consumers in the UK have been exposed to the marks. There is evidence that the opponent was active in the London market.²³ It has had an office in this location since 2001.²⁴ Sample invoices from 2013, 2015 and 2017 that were sent to companies in London in connection with electronic standards membership fees have been exhibited.²⁵ However, there is a distinct lack of evidence that the earlier marks have been used in any other locations in the UK. Whilst I accept that some of the opponent's customers are likely to have been based in London (for proximity to trading markets, for example), the insurance industry is not specific to this area. To my mind, the geographical reach of the earlier marks prior to the relevant date was limited. The evidence demonstrates that the opponent's total revenue in the UK between 2013 and 2018 was in excess of \$4 million, peaking in 2018 at in excess of \$950,000.²⁶ Although no details have been provided as to what proportion of this income related to particular goods and/or services, it appears to have been generated from various membership

²¹ Exhibit CN3

²² Exhibits CN4 & CN5

²³ Exhibits CN7 & CN9

²⁴ Exhibit CN1

²⁵ Exhibit CN13

programs connected with standards and standardised forms. Sales in the millions of dollars over a five-year period seem respectable, though there is nothing in the evidence to put this into the context of the relevant market. Mr Nightingale has provided evidence that the opponent spent in excess of \$120,000 in promoting the mark in the EU between 2013 and 2018.²⁷ However, there are no details as to what proportion of this was in respect of promotional activities in the UK. A sample invoice sent from a third party to the opponent's office in London for "installing new brand logos" prior to the relevant date has been exhibited.²⁸ This suggests that at least some promotion of the earlier marks has been conducted in the UK. Nevertheless, this would only represent a very small proportion of the figures quoted by Mr Nightingale. The other sample invoices of promotional expenditure that have been provided are from 4 July 2018 to 4 December 2018 and, therefore, cannot go to the position at the relevant date. In my view, overall, the evidence does not support a finding that the distinctiveness of the earlier marks had been enhanced through use by the relevant date. Even if the distinctiveness of the mark has been enhanced above its inherent characteristics, it is not to any extent that will make a material difference.

Comparison of trade marks

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



²⁷ Nightingale, §12

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

70. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

71. At the hearing, Ms Messenger submitted that, as it is registered as a word-only mark, the first earlier mark represents the opponent’s best case. All other factors being equal, I agree with this submission. As a result, my approach to the comparison between the marks is based on the first earlier mark only.

72. The competing trade marks are as follows:

The first earlier mark	The contested marks
ACORD	ACCORD  

Overall impressions

73. The first earlier mark is in word-only format and consists of the word ‘ACORD’. As this is the only element of the mark, the overall impression is dominated by the word itself.

74. The first contested mark is in word-only format and consists of the word ‘ACCORD’. Given that it is the only element of the mark, the overall impression is dominated by the word itself.

75. The second contested mark is figurative and comprises the word 'accord'. The overall impression of the mark is dominated by this word. The word is presented in a standard typeface. As the font is, ultimately, unremarkable, it will be overlooked by the average consumer. The letters in the first mark of the series appear in a variety of colours, while those in the second mark of the series appear in different shades of grey. These elements will not be entirely overlooked, though will certainly play much lesser roles in the overall impression of the marks.

Visual comparison

The first earlier mark and the first contested mark

76. Visually, the competing marks are similar as they share five identical letters. They both begin with a letter 'A' and four of those letters, i.e. 'C-O-R-D', are in the same order and in the same position within the marks. As highlighted by Mr Muir Wood, the marks differ through the presence of an additional letter 'C' in the first contested mark. Bearing in mind my assessment of the overall impressions, I consider there to be a high degree of visual similarity between the marks.

The first earlier mark and the second contested mark

77. These marks share the same visual similarities and differences that have been identified at paragraph 76. I accept that the first earlier mark is in word-only format and the second contested mark is figurative. Notwithstanding this, I do not consider the font in the second contested mark or the distinction in letter case to be points of significant difference between the marks. This is because the registration of word-only marks provides protection for the word itself, irrespective of whether it is presented in upper or lower case. Moreover, notional and fair use would allow the first earlier mark to be presented in any standard typeface. While it should nominally be considered that the first earlier mark could be used in any colour, this does not extend to complex

colour arrangements.²⁹ In my view, the use of colour and greyscale in the second contested mark are not simple colour combinations. Therefore, these elements create a visual difference between the competing marks. Overall, I find that there is between a medium and high degree of visual similarity between the marks.

Aural comparison

78. The first and second contested marks comprise a two-syllable word, which will be given its ordinary English pronunciation, i.e. (“AC-CORD”). The first earlier mark also consists of a two-syllable word, which will be pronounced as (“A-CORD”). I am prepared to accept that there may be a very subtle difference in the way in which the competing marks are articulated. Therefore, while they may not be aurally identical, I find that there is a very high degree of aural similarity between the competing marks.

Conceptual comparison

79. Conceptually, the first and second contested marks will be understood by consumers as meaning agreement or harmony. Mr Muir Wood contended that the word ‘ACORD’ in the first earlier mark will be understood as an acronym for the ‘Association for Cooperative Operations Research and Development’. I reject this submission for two reasons. While very limited parts of the evidence suggest that ‘ACORD’ could be an acronym, there is insufficient evidence to find that the average consumer would immediately perceive the mark in this manner. Secondly, it is important to point out that reputation and conceptual meaning are not the same thing. Reputation, in a trade mark sense, concerns the factual extent to which a sign is recognised by a significant part of the public as a trade mark, whereas conceptual meaning is a level of immediately perceptible notoriety or independent meaning, outside of a purely trade mark context.³⁰ Although there are cases where an extensive reputation has transferred into conceptual meaning, these are the exception rather than the rule and depend on their own facts.³¹ Exceptional cases where trade mark

²⁹ *Specsavers* [2014] EWCA Civ 1294, paragraph 5, and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, paragraph 47

³⁰ *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20, paragraphs 74-75

³¹ *Retail Royalty Company*, O/593/20, paragraph 76

reputation evolves into a conceptual meaning need to be properly proven. Even if the average consumer did perceive the mark as this acronym, the evidence falls a long way short for finding that this had evolved into a conceptual meaning and I am disinclined to take judicial notice of it. Although the first earlier mark is an invented word, it closely resembles the dictionary word 'ACCORD'. In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).”

80. For this reason, it is likely that the average consumer will perceive the word 'ACORD' as a misspelling of the word 'ACCORD' or, if the misspelling is not noticed, as the dictionary word 'ACCORD'. Accordingly, the first earlier mark will evoke the meaning associated with that word, rendering the competing marks conceptually identical.

Likelihood of confusion

81. 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. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier

See, for example, Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, *EUIPO v Messi Cuccittini* and *J.M.-E. V. e hijos v Messi Cuccittini*

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 they have retained in their mind.

82. 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. 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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

83. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

84. Earlier in this decision, I concluded that:

- Some of the goods in class 9 of the applications are similar to the services relied upon by the opponent to between a low and medium degree, while others are dissimilar;
- There is a low degree of similarity between some of the applicant’s class 35 services and the services relied upon by the opponent, whereas others are dissimilar;
- There is a medium degree of similarity between some of the applicant’s class 42 services and those relied upon by the opponent, whereas others are dissimilar;
- The average consumer of the goods and services at issue are likely to be members of the business community, who would demonstrate a higher than normal level of attention during the purchasing act;
- The purchasing process for the goods and services will be primarily visual in nature, though aural considerations will play their part;

- The first earlier mark has a medium level of inherent distinctive character;
- The overall impression of the first earlier mark is dominated by the word 'ACORD', being the only element of the mark;
- The overall impression of the first contested mark is dominated by the word 'ACCORD', being the only element of the mark;
- The overall impression of the second contested mark is dominated by the word 'accord', while the use of colour and greyscale will play lesser roles in the first and second marks of the series, respectively;
- The first earlier mark and the first contested mark are visually similar to a high degree;
- The first earlier mark and the second contested mark are visually similar to between a medium and high degree;
- There is a very high degree of aural similarity between the competing marks;
- The competing marks are conceptually identical.

85. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

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

86. As I have found some of the opposed goods and services to be dissimilar to the services of the earlier mark, the oppositions under section 5(2)(b) of the Act must necessarily fail in relation to those goods and services, namely:

Class 9: Computer software for processing data for business advice, management, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 35: Information and advisory services; all relating to processing data for business advice, management, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 42: Computer software design and development; software as a service [SaaS]; consultancy services in the field of software as a service [SaaS]; installation, maintenance, modification and upgrading of computer software systems; all the above relating to processing data for business advice, management, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for

tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

The first contested mark

87. In respect of the remaining goods and services, I acknowledge that the first contested mark differs from the first earlier mark in the repetition of the letter 'C' and that there may be a very subtle difference in pronunciation. Nevertheless, the words 'ACCORD' and 'ACORD' are otherwise identical. I have found that the average consumer will perceive the first earlier mark as a misspelling of the word 'ACCORD' or, if the misspelling is not noticed, as the dictionary word 'ACCORD'. Taking into account the high levels of overall similarity, as well as the medium level of distinctive character of the first earlier mark, I am of the view that the differences between the competing marks are likely to be insufficient to distinguish the goods and services of the applicant from the services of the opponent, even for consumers paying a higher than normal level of attention. Considering imperfect recollection, the average consumer may not recall the respective marks with sufficient accuracy to differentiate between them. As the marks will convey the same meaning, consumers may misremember, or misread, one for the other, assuming they are one and the same; to my mind, it is entirely foreseeable that consumers may misremember whether the letter 'C' is repeated. Consequently, I consider there to be a likelihood of direct confusion, even for goods and services that are similar to a low degree.

The second contested mark

88. I have already found that the average consumer may misremember, or misread, the word 'ACORD' as the word 'ACCORD', or vice versa. This finding is equally applicable to the second contested mark. However, I acknowledge that the word in the second contested mark is presented in lowercase and a variety of colours or shades of grey. In my view, neither the font used nor the fact that the second contested mark is in lowercase are sufficient to distinguish the competing marks. This is because notional and fair use would allow the first earlier mark to be presented in any standard typeface, such as the font used in the second contested mark. Further, the registration

of word-only marks (such as the first earlier mark) provides protection for the word itself, irrespective of whether it is presented in upper or lower case. I have found that the use of colour or shades of grey in the second contested mark would not simply be overlooked. Nevertheless, it plays a much lesser role in the overall impression of the mark, which is dominated by the word 'accord'. It is considered that this additional element in the second contested mark is not sufficient by itself – or in combination with a repeated letter 'C' – to enable consumers to distinguish between the competing marks. Even when paying a higher than normal level of attention, consumers may misremember the particular graphic representation of the word. This is particularly the case in light of my finding that the first earlier mark has a medium level of distinctive character. Taking into account imperfect recollection, the average consumer may not recall the respective marks with sufficient accuracy to differentiate between them; consumers may misremember one for the other, assuming they are one and the same. Therefore, I consider there to be a likelihood of direct confusion, even for goods and services that are similar to a low degree.

89. In the event that the average consumer immediately notices and recalls the particular graphic representation of the second contested mark, it is likely that the word 'accord' will still be misremembered as the word 'ACORD', or vice versa. Whether consciously or unconsciously, this will lead the average consumer through the mental process described by Mr Purvis, namely, that there is a difference between the marks, but there is also something in common. In these circumstances, it is likely that the average consumer would perceive the competing marks as variant brands originating from the same undertaking. I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared highly similar element 'ACORD/accord'. As such, I consider there to be a likelihood of indirect confusion, even for goods that are similar to a low degree.

CONCLUSION

90. The oppositions under section 5(2)(b) of the Act have been partially successful. Subject to any successful appeal against my decision, the applications will be refused in respect of the following goods and services:

Class 9: Computer software for processing data for regulatory and compliance requirements; all of the aforementioned for use in regulatory compliance with the requirements of financial services regulatory bodies; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 35: Information and advisory services; all relating to processing data for regulatory and compliance requirements; all of the aforementioned for use in regulatory compliance with the requirements of financial services regulatory bodies; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 42: Computer software design and development; software as a service [SaaS]; consultancy services in the field of software as a service [SaaS]; installation, maintenance, modification and upgrading of computer software systems; all the above relating to processing data for regulatory and compliance requirements; all of the aforementioned for use in regulatory compliance with the requirements of financial services regulatory bodies; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for

use by entities in the insurance industry for tasks unrelated to regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

91. The applications will proceed to registration for the following goods and services, against which the oppositions have failed:

Class 9: Computer software for processing data for business advice, management, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 35: Information and advisory services; all relating to processing data for business advice, management, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management; none of the aforementioned in respect of the design, maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

Class 42: Computer software design and development; software as a service [SaaS]; consultancy services in the field of software as a service [SaaS]; installation, maintenance, modification and upgrading of computer software systems; all the above relating to processing data for business advice, management, quality assurance, business process management, and customer service management; all of the aforementioned for use in human resource management; none of the aforementioned in respect of the design,

maintenance or updating of standardised forms and software containing specifications and standards for use by entities in the insurance industry for tasks unrelated to human resource management and/or regulatory compliance; none of the aforementioned for use in or relating to the fields of pharmaceuticals, medicine, pharmacy, clinical sciences and/or healthcare.

COSTS

92. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 14th day of July 2021

**James Hopkins
For the Registrar,
The Comptroller-General**