

O-591-21

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST FOR
PROTECTION IN THE UK OF INTERNATIONAL
REGISTRATION NO. 1413403**

**IN THE NAME OF ATTENTI ELECTRONIC MONITORING LTD
FOR THE TRADE MARK**

ATTENTI

IN CLASS

9, 16, 24, 25, 35, 38, 41 & 45

AND

THE OPPOSITION THERETO UNDER NUMBER OP000415447

BY

SERVICIOS DE TELEASISTENCIA, S.A.

Background and pleadings

1. Attenti Electronic Monitoring Ltd (“the Holder”) is the proprietor of International Registration (“IR”) No. 1413403 for the mark **ATTENTI**; which has an international registration date of 12 December 2017. The mark covers goods and services in classes 9, 16, 24, 25, 35, 38, 41 and 45.¹
2. Following the Holder’s request to seek protection in the UK on the same date, the designation of the IR was published in the Trade Marks Journal for opposition purposes on 16 November 2018.
3. On 14 February 2019, Servicios De Teleasistencia, S.A. (“the Opponent”) filed a notice of opposition (which was later amended) against the conferring of protection of the International Registration in the UK. It is a partial opposition, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”),² directed against the following goods and services:

Class 9 Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems, personnel tracking devices; GPS tracking and location devices, namely, one piece GPS offender tracking devices, two piece GPS offender tracking devices, ankle monitor; electronic surveillance apparatus; video surveillance apparatus; electric and electronic video surveillance installations; downloadable computer software for remote monitoring and analysis; downloadable radio frequency monitoring software; radio frequency monitoring device; downloadable software for security management, ankle monitoring, offender tracking and business intelligence; application programming interface for

¹ The specifications of which, are reproduced and shown in the Annex to this decision.

² The Opponent initially included an additional ground based upon section 5(3); however, it subsequently decided against pursuing this ground and the case stands to be decided upon the section 5(2)(b) ground only.

security management, ankle monitoring, offender tracking and business intelligence.

- Class 16 User manuals, brochures and printed guides in the field of security and security devices; holiday cards; business cards; envelopes; paper; cardboard packaging; packaging bags of paper; presentation folders.
- Class 35 Presentation of security products and services to the public; advertising services in the field of security.
- Class 41 Training services, namely, training in the field of security; educational consultancy in the field of security, training and further training, provided via telephone call centers and hotlines.
- Class 45 Consultancy services in the field of home security; surveillance services; surveillance services relating to the physical safety of persons; surveillance services relating to the security of tangible property; security services for the protection of property and individuals; police and civil protection services; security monitoring services; consultancy services in the field of the safety needs of commercial and industrial companies; monitoring of burglar and security alarms; monitoring telephone calls from subscribers and notifying emergency facilities; night guard services; providing information on the development of privacy, security and data governance law from a web site; providing reconnaissance and surveillance services; provision of information, advice and consultancy in relation to security services for the protection of property and individuals; security guard services for the protection of property and individuals; surveillance services; surveillance services relating to the physical safety of persons; surveillance services relating to the security of tangible property; providing expert testimony in the field of security.

4. The Opponent relies upon its two earlier European Union Trade Marks: EU012623161 (“the first earlier mark”) and EU012779914 (“the second earlier mark”). The services relied upon in this opposition are as follows:
5. **EU012623161** – Filing date: 21 February 2014; date of entry in the register: 15 July 2014

ATENZIA

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| Class 39 | Ambulance transport. |
| Class 41 | Education and providing of training relating to safety in the home for elderly, sick and disabled people, cultural, training and leisure activities aimed at promoting active and healthy ageing amongst elderly people, teaching relating to hygiene. |
| Class 42 | Technical services, namely, Monitoring of the effective providing of medical and social services, management of the operation of medical electronic systems for identifying incidents and events which require action; Monitoring of warning signals. |
| Class 43 | Home catering services. |
| Class 44 | Monitoring of patients and care of residents, consultancy relating to personal well-being of elderly, sick and disabled people (health); Health and social care in the home; Advisory services relating to pharmaceuticals; Consultancy relating to medical assistance and health care provided by doctors, psychologists and other specialised medical personnel, care of persons in the home, professional consultancy relating to health services; Consultancy relating to pharmacy, hygiene and beauty services, assessment of health risks. |

Class 45 Personal, social and health services rendered by others to meet the everyday needs of elderly, disabled and sick people, who cannot manage on their own; Monitoring of alarm systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems; Assistance to victims of gender-based violence; In-person assistance in emergencies; call monitoring services and call assistance services, All the aforesaid relating to social and community care, residential care of patients and emergency care, holding, safekeeping and management of keys.

6. EU012779914 – Filing date: 10 April 2014; Date of entry in register: 3 September 2014 - Mark Description/Limitation - Colour Claimed: Blue: “PANTONE:298”, black.



Relying on the services registered in classes 39, 41, 42, 43, 44 and 45, which are almost identically worded to its first earlier EU registration.

7. The Opponent contends that the Holder’s mark is similar to its marks and that the contested goods and services in classes 9, 16, 35, 41 and 45 are identical or similar to the services covered by the earlier marks under classes 39, 41, 42, 43, 44 and 45.
8. In its defence and counterstatement, the Holder denies that the marks are similar and that the applied for goods and services are identical or similar to those of the earlier registrations.
9. The Holder filed a witness statement, clarifying the nature of its undertaking, with “illustrative samples” of use of its mark in the UK market.

10. In these proceedings the Opponent is represented by Potter Clarkson LLP; and the firm Briffa represents the Holder.

11. A hearing was neither requested nor considered necessary; however, both parties filed written submissions in lieu of a hearing. I therefore give this decision after careful review of all the papers before me.

DECISION

Section 5(2)(b)

12. The opposition is founded upon section 5(2)(b) of the Act, which stipulates that:

“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”.

13. An earlier trade mark is defined under section 6 of the Act, the relevant parts of which state:

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

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.”

14. The Opponent’s trade mark registrations, having been registered in July 2014 and September 2014 respectively, qualify as earlier trade marks under section 6 of the Act. Further, given that they had not been registered for more than five years at the date the contested international registration was filed, they are not subject to the proof of use provisions contained in section 6A of the Act.³ The Opponent is, as a consequence, entitled to rely upon its earlier marks in relation to all of the services indicated without having to prove that genuine use has been made of them. Therefore, I must make the assessment based upon the full width of the services relied upon by the Opponent, regardless of whether or not the marks have actually been used in relation to those services. This is because the Opponent is entitled to protection across the breadth of what it has registered on a ‘notional’ use basis.

15. Having considered the earlier marks, in the interest of procedural efficiency, I will approach the assessment, at least initially, on the basis of the Opponent’s first earlier mark; as this word-only mark *prima facie* presents the best prospect of success. I will only consider the Opponent’s second earlier mark should it prove necessary to do so.

Relevant law

16. 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 Trade Marks Act relied on in these proceedings are derived

³ As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the filing date of the contested international registration.

from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

17. The following principles are gleaned from the decisions of the courts of the European Union 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.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that

it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“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”.

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

- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of services;
- (c) The respective trade channels through which the goods or services reach the market;
- (d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods and services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

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

22. 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, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

23. 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.

Nice Classification

24. The Holder submits that: “The Opponent has not secured protection in classes 9, 16, 24, 25, 35, or 38 and so the Opposition is bound to fail on these points. Therefore, I must point out that the classification of goods and services does not in itself provide a basis for drawing conclusions as to the similarity of goods and services. Section 60A of the Act provides:

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

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.

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.”

25. The Holder asserts in its written submissions dated 21 June 2021, that “the Opponent offers telecare services for the elderly whilst the [Holder] specialises in the electronic monitoring and tagging of offenders and other parties of interest to the state”. Although the Holder makes reference to the Opponent’s website, no evidence (in the correct form) is provided to substantiate this submission. The Holder also contends that “[t]he only conceivable cross over between the Application and the Registrations Applicant’s (sic) is in Class 45: despite the Opponent’s assertion that the services sought by the [Holder] are identical to the Registrations, this is clearly not the case however”.

26. In its submissions in reply, the Opponent contends, amongst other things, that “it is commonplace for providers of security and monitoring apparatus and hardware to also provide the related services. The application in suit evidences this perfectly. Consequently, there is an established association, in the eyes of the relevant public, between security monitoring apparatus and the related security and monitoring services”. The Opponent further “reiterates that according to Section 5(2)(b) TMA, a trade mark is to be refused if “it is similar to an earlier trade mark and is to be registered for goods and services identical with or similar to those for which the earlier trade mark is protected. It is, therefore, clear that the comparison is between the goods/services applied for and the services for which the earlier mark is registered. The commercial exploitation of the mark is not a relevant factor in this assessment”.

27. It is important, not least because of the Holder’s apparent concession on the “conceivable cross over” between its goods and services and the earlier class 45 services, to address the limitation contained in the latter specification. That is: “*All the aforesaid relating to social and community care, residential care of patients and emergency care, holding, safekeeping and management of keys*”.

28. In line with the *POSTKANTOOR* principle,⁴ I find that the limitation does not change the nature of the services; it relates to the way in which they are delivered or used. The limitation may therefore be considered to exclude potential characteristics of the services, rather than interpreted as excluding a particular category or sub-category of services. Furthermore, I also consider that “social and community care or residential care of patients (for example), refer to a broad range of services, which may have relevant connections (for trade mark purposes) with the Holder’s devices and services.

29. As alluded to earlier, the Holder has made a number of submissions (with supporting evidence) on the actual goods and services it offers, to substantiate its argument on the apparent differences between the respective goods and services on the market. Although the actual goods and services offered by the parties may differ, the comparison must be made on the basis of notional use of the mark across the full width of the specification, as explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) and endorsed by the Court of Appeal in *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84).

The applied-for class 9 goods

30. I consider that the Opponent’s class 45 terms (“*Monitoring of alarm systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems*”, in particular) are wider than the applied-for class 9 terms and may include, for example, the monitoring of “*GPS tracking and location devices, namely, one piece GPS offender tracking devices, two piece GPS offender tracking devices, ankle monitor*”, and “*electronic surveillance apparatus*”. Therefore, I find that the contested goods under class 9 of the Holder’s mark (*Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems, personnel tracking devices; GPS tracking and location devices,*

⁴ Guidance on the application of the *POSTKANTOOR* principle, is provided by Arnold J in *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), § 43 - 50 and 56 - 57.

namely, one piece GPS offender tracking devices, two piece GPS offender tracking devices, ankle monitor; electronic surveillance apparatus; video surveillance apparatus; electric and electronic video surveillance installations; downloadable computer software for remote monitoring and analysis; downloadable radio frequency monitoring software; radio frequency monitoring device; downloadable software for security management, ankle monitoring, offender tracking and business intelligence; application programming interface for security management, ankle monitoring, offender tracking and business intelligence), are similar to a medium degree to the Opponent's earlier terms: *Monitoring of alarm systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems*. I consider that these services will include aspects of work that are indispensable to the Holder's class 9 goods. These goods and services share the same purpose, insofar as they relate to security and/or monitoring of alarm and surveillance systems; they are complementary and may share the same channels of trade. It is not uncommon (for example) for security/electronic monitoring services to be offered in conjunction with security apparatus.

31. A point of potential contention is the inclusion of the provision, "*business intelligence*", in two terms of the Holder's class 9 specification (*downloadable software for security management, ankle monitoring, offender tracking and business intelligence; application programming interface for security management, ankle monitoring, offender tracking and business intelligence*). It may be argued that business intelligence is not covered by the competing terms. Business intelligence, however, relates to "the methods and technologies that gather, store, report, and analyse business data to help people make business decisions"⁵; and if this business intelligence pertains to security goods and services, it is reasonable to acknowledge a moderate degree of similarity between these terms. In the context, for example, of business intelligence being derived from the Opponent's monitoring services, which is sufficiently broad to include gathering, recording and analysing data to assist its clients in making

⁵ Dictionary.com - <https://www.dictionary.com/browse/business-intelligence>.

improvements, or to enable the efficient and effective provision of said competing services.

The applied-for class 16 goods

32. In its submissions dated 7 December 2020, the Opponent states that: “The Contested goods in class 16 for ‘User manuals, brochures and printed guides in the field of security and security devices’, are highly similar to the services covered by the Earlier Marks in class 45. As such these goods and services are highly complementary and are aimed at the same consumers”. The Opponent does not specify which terms of its class 45 specification it considers to be similar to the Holder’s class 16 goods. Furthermore, no submissions are made as to the similarity of the remaining terms of the class 16 specification, namely: *holiday cards; business cards; envelopes; paper; cardboard packaging; packaging bags of paper; presentation folders*.

33. There is a link (to some extent) between “*User manuals, brochures and printed guides in the field of security and security devices*” and the Opponent’s: “*Monitoring of alarm systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems*” (in class 45). I find that these products and services are similar as a complementary character exists; and though their nature might be different, there may be trade channel overlap, as the service provider may provide a brochure or guide as information about such services. Therefore, they are similar to at least a low degree.

34. On the remaining class 16 terms (“*holiday cards; business cards; envelopes; paper; cardboard packaging; packaging bags of paper; presentation folders*”), I find that there is no similarity between these goods and the Opponent’s earlier services in classes 39, 41, 42, 43, 44 and 45; as they have different natures, purposes and methods of use. They do not have the same producers/providers or distribution channels. Furthermore, they are neither complementary nor in competition.

The applied-for class 35 services

35. The contested class 35 services: “*Presentation of security products and services to the public*”; and “*advertising services in the field of security*”, consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or to reinforce an entity’s position in the marketplace and to acquire competitive advantage through publicity. These services are provided by specialist companies which study their client’s needs and provide all the necessary information and advice for the marketing of their goods and services; to create a bespoke strategy regarding the advertising of their goods and services through television, paper publications and the internet, for example.

36. The Opponent asserts that the “services in class 35... are highly are similar to the services covered by the Earlier Marks, including in class 45. The services in question go hand in hand and consumers will think the responsibility for the provision of the Opponent’s services and the [Holder’s] services lies with the same undertakings”. I do not agree. The fact that the goods and services at issue may appear in advertisements, or even that the Opponent may make use of advertising as a means of promoting its own services, is not a strong enough link to establish similarity. The expertise needed to provide the contested class 35 services is entirely different from the expertise required to render (any of) the Opponent’s services. The natures and purposes of these services are different. In addition to having different providers, the services under comparison also target different publics and have different distribution channels. They are neither complementary nor in competition. Consequently, they are considered dissimilar.

The applied-for class 41 services

37. In comparing the applied-for class 41 specification (“*Training services, namely, training in the field of security; educational consultancy in the field of security, training and further training, provided via telephone call centers and hotlines*”)

against the earlier terms, “*Education and providing of training relating to safety in the home for elderly, sick and disabled people...*” (in class 41), I find that there are shared elements in relation to the nature and intended purpose of these services. Furthermore, training in the field of security may include training relating to safety in the home; and the latter may be provided via telephone call centres and hotlines, for example. Some of the users of these services may overlap; and so, there will also be an element of competition. Therefore, I find that the respective services are similar to a medium degree. I maintain this view, in considering the alternative wording (“*Education and providing of training in the field of home security for elderly...*”) in the second earlier mark [my emphasis].

The applied-for class 45 services

38. The contested “*surveillance services; surveillance services relating to the physical safety of persons; surveillance services relating to the security of tangible property; security services for the protection of property and individuals; police and civil protection services; security monitoring services; monitoring of burglar and security alarms; monitoring telephone calls from subscribers and notifying emergency facilities; providing reconnaissance and surveillance services; surveillance services; surveillance services relating to the physical safety of persons; surveillance services relating to the security of tangible property*” (in class 45), are identical to the Opponent’s: “*Monitoring of alarm systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems; call monitoring services and call assistance services*” (also under class 45); either because they are identically contained in the competing specifications (including under the principle outlined in *Meric*) or because the Opponent’s services include, or overlap with, the aforementioned contested services.

39. In the alternative, if my finding on the identity of these terms, particularly “*police and civil protection services*”, is challenged, I consider further that they are closely linked to the purpose of the earlier services (*Monitoring of alarm*

systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems; In-person assistance in emergencies; call monitoring services and call assistance services, for example); that is, protection of life and property against various threats or risks. The channels of trade will be identical and these services are highly complementary, with the same users. Therefore, in the alternative, they are highly similar.

40. The Opponent contends that the applied-for class 45 terms: “*Consultancy services in the field of home security; consultancy services in the field of the safety needs of commercial and industrial companies; providing information on the development of privacy, security and data governance law from a web site; provision of information, advice and consultancy in relation to security services for the protection of property and individuals*”; are also highly similar to the services in class 44 covered by the Earlier Marks, and also similar to the services in class 42 covered by the Earlier Marks, especially for “Technical services, namely, Monitoring of the effective providing of medical and social services, management of the operation of medical electronic systems for identifying incidents and events which require action; Monitoring of warning signals. All of these services relate to surveillance, security or home security. The purpose and nature of these services are the same, and all services are complementary, and have the same intended purpose and the same target consumer. The Opponent submits these services are highly similar”. I do not agree with the sum of this submission.

41. The scope of protection of the Opponent’s class 42 specification is restricted by the inclusion of the term “namely”, to only those services specifically listed.⁶ Therefore, “*Technical services, namely, Monitoring of the effective providing of*

⁶ “Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are.” Manual of Trade Marks Practice, The Classification Addendum, under the letter “I”, heading: “Including, for example, namely, as well as, in particular, specifically i.e.”; section last updated November 2020.

medical and social services, management of the operation of medical electronic systems for identifying incidents and events which require action; Monitoring of warning signals [my emphasis], cover these services only. Further, it could not be said that these services are highly similar to: “Consultancy services in the field of home security; consultancy services in the field of the safety needs of commercial and industrial companies; providing information on the development of privacy, security and data governance law from a web site; provision of information, advice and consultancy in relation to security services for the protection of property and individuals”. The Opponent’s class 42 services, with the exception of “monitoring of warning signals”, specifically relate to medical electronic systems/services and social services. On similar grounds, I find that the said applied-for services are dissimilar to the earlier specification of class 44. The consultancy services under this class pertain to (for example): “personal well-being”, “health and social care”, “pharmaceuticals” and “medical assistance”.

42. The contested service, *“providing information on the development of privacy, security and data governance law from a web site,* is not encompassed by any of the Opponent’s services in classes 39, 41, 42, 43, 44 and 45. The respective services have different relevant publics. The average consumer will not expect these services to be rendered by the same undertakings, and they are not delivered through the same channels of trade. Moreover, they are not complementary, nor in competition with each other. Therefore, they are dissimilar.

43. *“Consultancy services in the field of home security”; “consultancy services in the field of the safety needs of commercial and industrial companies”; “provision of information, advice and consultancy in relation to security services for the protection of property and individuals”; and “providing expert testimony in the field of security”* (in the Holder’s specification), essentially pertain to the provision of expert advice within the field of security (without limitation to the type of security). The nature of advice differs to the actual security service, which is the provision of protection. However, I find that the purpose of security advice is usually linked to the purpose of the security service itself; for example,

to determine and provide the appropriate protection. The channels of trade will be identical and the services are highly complementary, with the same users. They are therefore at least moderately similar to the Opponent's services: *Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems; Assistance to victims of gender-based violence*"; (under class 45, for example).

44. The Opponent's "*Monitoring of alarm systems; Monitoring of security systems; Monitoring of surveillance systems; Monitoring of alarms and monitoring systems; Assistance to victims of gender-based violence; In-person assistance in emergencies; and call monitoring services and call assistance services*" may include "*night guard services*" and "*security guard services for the protection of property and individuals*" (as listed under the Holder's class 45 specification). They share a similar purpose (the provision of protection) and end consumers; and are complementary. They are also likely to be available via the same distribution channels. Therefore, I find that they are similar to a high degree.

Average consumer and the purchasing act

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person

is typical. The term “average” does not denote some form of numerical mean, mode or median”.

46. For the purpose of assessing the likelihood of confusion, it must also 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*.

47. In its Counterstatement, “[t]he [Holder] proposes that the average consumer of GPS tracking devices and security and or surveillance services will display a high level of attention owing to the specialised nature of the services and because they will be inherently concerned with issues of safety and/or compliance. Following from the above, the relevant public would exercise more than an average degree of attentiveness and accordingly there does not exist a likelihood of confusion or association”.

48. The Opponent submits that “[t]he goods and services are aimed at both the professional public and the average consumer. Both will use the applied for goods and services, either to obtain video surveillance for their home or professional work place. Training in the field of security, and consultancy in the field of security are likely to be given both to the professional public and the average consumer. In view of the nature of the goods and services in question, the awareness of the relevant public will be high from the perspective of the professional, as well as being that of the average consumer who is reasonably well-informed and reasonably observant and circumspect. Therefore visual and aural considerations are likely to dominant (sic) the selection process”.

49. I agree that the average consumer for some of the goods and services notionally covered by both parties' specifications, such as video surveillance apparatus, in-person assistance in emergencies; call monitoring services and call assistance services, surveillance services relating to the physical safety of persons and tangible property, will be the general public. However, there are other types of services that will especially attract the professional public, with

specialist knowledge or expertise (on this point I note the client base profile and supporting information provided by the Holder).

50. The goods and services are likely to vary both in cost and in terms of technical/logistical specifications. Although I consider that the level of attention will vary correlatively across the spectrum (taking into account additional factors such as the reasons for purchase, the value of the property or occasion and/or the level of risk or vulnerabilities at issue), security is a very serious matter; and its purchase will necessitate a close level of attention.

51. In some cases the level of attention will be very high; in others, it will be of at least a higher than average degree. The purchasing process will be primarily visual as research will be undertaken before commitment is made; although I do not ignore the potential for an aural dimension to the purchasing process, as the selection may be discussed with sales representatives or, (as is more likely) for the business user, technical advisors.


Comparison of the marks

52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

54. The respective trade marks are shown below:

<p style="text-align: center;">ATENZIA</p> 	<p style="text-align: center;">ATTENTI</p>
Earlier trade marks	Contested trade mark

Overall Impression

55. As I have previously indicated, I will make the first earlier mark the focus of my comparison on the basis that the second earlier mark offers no advantage over the former. I will, of course, revisit the position should it become necessary to do so.

56. In comparing the marks there is no difference between the variation in the casing; because a word trade mark registration protects the word itself, irrespective of the font capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.⁷

57. The Holder's mark consists of a seven-letter word, ATTENTI. There are no other elements to contribute to the overall impression, which lies in the word itself. The Opponent's first earlier mark also consists of a seven-letter word ATENZIA. There are no other elements in the mark to contribute to its overall impression, which is contained in the word itself.

⁷ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

Visual Comparison

58. The Opponent submits that:

“The marks at issue are both comprised of 7 letters, the majority of which are the same and appear in the same sequence. Notably, the beginning of the marks are practically identical (ATEN and ATTEN). The only distinction is the double consonant in the Opponent’s mark. The Opponent submits that the relevant public, exercising only an average degree of attention, will not notice whether or not there is a double consonant or will otherwise forget this when recalling the Opponent’s mark to mind. It is accepted that the degree of similarity between the ends of the respective marks is lower.

“There is a body of case law establishing that the beginning of the mark is more significant as part of the comparative analysis (*Case T-109/07 L’Oreal -v- OHIM, paragraph 30*). Therefore, where the beginning of the marks are identical (or practically identical, as is the case here), then the marks as a whole are likely to be considered similar. Furthermore, it follows that differences between the end of the marks will attract less attention and, therefore, do not substantially alter the visual similarity between the 2 marks (*Joined Cases T-183/02 and T-184/02 at paragraph 80 (El Corte Ingles -v- OHIM)*). The difference between the marks in suit is principally in the last few letters. It is respectfully submitted that the marks are of average to high visual similarity.”

59. I agree with these submissions in principle. I take note that as a general rule, beginnings of words tend to have more visual and aural impact than their endings. However, this does not apply in all cases. I consider that this is one such case; where the overall impression resides in the marks alone; which are relatively short, single-word marks that are uncomplicated to read, with the addition of different single syllables at the end of each mark. I therefore consider that the relevant public is likely to perceive the marks as wholes and notice the

difference in the respective marks' endings. Consequently, I find that the marks share a medium degree of visual similarity.

Aural Comparison

60. On the aural comparison, the Opponent contends that “the consumer’s attention is usually directed to the beginning of the word and that where both marks share a prefix, this will result in the marks sounding very similar. There is also long-standing precedent, acknowledging *“the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words are accentuated in comparison, and in my judgement, the first syllable of a word is, as a rule, by far the most important for the purpose of distinction”* (London Lubricants (1920) Ltd’s application (Tripcastroid) (1925) 42 RPC 264 at page 279 lines 36-40). It is respectfully submitted, therefore, that the identical first two syllables of these marks and the tendency of the relevant public to slur the endings of words, will result in the marks being phonetically highly similar”.

61. The Holder submits that the “Registrations comprise four (sic) syllables whilst the Application contains three. When spoken, the Application is pronounced “AH-TEN-TEE” as opposed to the registrations which are pronounced “AH-TEN-ZIA”.

62. Although I agree that the beginning of both marks will be pronounced in an identical way, despite the double consonant in the Holder’s mark, I do not agree with the Opponent’s submission on the syllabic emphasis or slurring in the marks at issue. I find that the different suffixes between the marks present a clear distinction with respect to their articulation. Therefore, I consider the marks are aurally similar to an average degree.

Conceptual Comparison

63. Conceptually, both parties are agreed that the respective marks have no meaning. For a conceptual message to be relevant it must be immediately grasped by the average consumer.⁸ The average consumer is unlikely to overanalyse or dissect the marks in either case. In my view, both marks will be perceived as invented words with no particular meaning. Therefore, they are conceptually neutral.

Distinctive character of the earlier trade mark

64. The degree of distinctiveness of the earlier mark 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 confusion⁹. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

65. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings” - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

66. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of

⁸ *Ruiz Picasso v OHIM* [2006] e.c.r.I-643; [2006] E.T.M.R.29

⁹ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

a mark can be enhanced by virtue of the use made of it. In this case, however, the Opponent has not pleaded that its marks have acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

67. The Opponent's marks consist of an invented word, ATENZIA. As explained earlier, I do not consider that the average UK consumer would attribute any particular meaning to this word. It has no connection with the services for which the marks are registered. Therefore, I consider the mark to have a high degree of inherent distinctive character. The second earlier mark, a stylised version of the word ATENZIA, with a figurative element in Blue: "PANTONE: 298", also retains a high degree of inherent distinctiveness.

Conclusions on Likelihood of Confusion

68. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have retained in their mind.

69. I have found the parties' marks to be visually and aurally similar to a medium degree. The earlier marks are inherently distinctive to a high degree. However, the competing marks are conceptually neutral, to the extent that the average consumer would attach no particular meaning to them.

70. I have identified the average consumer as members of the general and professional publics, who will select the goods primarily by visual means (though

I do not discount an aural component). I have concluded that the degree of attention paid will be above average to high, depending on the nature or objective of the purchase and the group of average consumers concerned. I have found the parties' goods and services to range from being identical to similar to a low or medium degree (save and except for those I have found to be dissimilar; against which, the opposition cannot succeed).

71. In approaching the question on likelihood of confusion, consideration has to be given to the cumulative effect of all of the aforesaid findings. The overall impressions of the respective marks are distinct; and neither mark evokes a concept. This tends to point towards imperfect recollection, as there is no conceptual hook to assist the consumer in retaining a perception of the mark in its mind. In this case, however, this is counterbalanced by the at least above average degree of attention the average consumer will exercise in the selection process (which is the lower end of the spectrum of my finding). This level of attention means that the average consumer may recall the marks with a greater degree of precision, thus lessening the impact of imperfect recollection.

72. A further significant factor is the degree of visual and aural similarity between the marks, which I have found to be medium. As the purchasing process is likely to be mainly visual this is of particular importance in the global assessment. I also consider that the visual differences between the marks are sufficient to avoid them being mistakenly recalled as each other.

73. Further factors of importance are the kinds of goods and services at issue and the type of consumers who are likely to purchase them. On the issue of the goods/services I found to be identical (or similar to medium or low degrees), I find that this is offset against the fact that they are purchased after some research or consideration (as to the type/level of protection required, or whether the product or service addresses the risk at issue, the reputation of the supplier or whether they are regulated, for example); and in the case of the goods, after they have been seen. It is unlikely that such consumers would confuse the marks in relation to these goods and services.

74. At the very highest, in my view, it might be said that there was a possibility that one mark might bring the other to the mind of a small number of members of the relevant public; but I consider that it would not be sufficient to lead consumers to associate the origin of the products/services at issue to the respective parties. It is of importance to note that what has to be identified is the likelihood of confusion; and not simply that one mark brings another to mind.

75. After having carefully considered all of these factors and weighed them against each other, I come to the view that, the level of attention that is likely to be paid during the mainly visual purchase and the no more than moderate degree of visual similarity between the marks, in particular, means that there is no likelihood of direct confusion (where one mark is mistaken for the other). Nor do I see any reason to conclude that there is a likelihood of indirect confusion (where the average consumer believes that the relevant goods and services come from the same or economically linked undertaking(s)). As said earlier, at most there might be a fleeting bringing to the mind; however, this is not enough for confusion, either of the direct or indirect kind.

Conclusion

76. The opposition under section 5(2)(b) fails in its entirety. Accordingly, subject to any successful appeal, the IR designation may proceed to protection, inclusive of the goods and services that were not opposed, as shown in the Annex to this decision.

COSTS

77. As the Holder has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying this guidance, I award costs to the Holder on the following basis:

Reviewing the Notice of Opposition
and filing the Counterstatement: £300

Reviewing the Opponent's submissions and
filing written submissions: £700

Total: £1,000

77. I considered it unreasonable to include preparation of the Holder's evidence in my costs award, as the evidence was unnecessary for the decision made in this case.

78. Accordingly, I hereby order Servicios De Teleasistencia, S.A. to pay to Attenti Electronic Monitoring Ltd the sum of **£1,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of August 2021

**Denzil Johnson,
For the Registrar**

ANNEX

- Class 9 Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems, personnel tracking devices; vehicle tracking devices; GPS tracking and location devices, namely, one piece GPS offender tracking devices, two piece GPS offender tracking devices, ankle monitor; electronic surveillance apparatus; video surveillance apparatus; electric and electronic video surveillance installations; radio signal tuners; radio transmitters, namely, radio frequency module; downloadable computer software for remote monitoring and analysis; downloadable radio frequency monitoring software; radio frequency monitoring device; downloadable software for security management, ankle monitoring, offender tracking and business intelligence; application programming interface for security management, ankle monitoring, offender tracking and business intelligence; computer servers; accessories, apparatuses, battery chargers and battery cords related to the aforementioned; USB flash drives; CDs; downloadable templates for designing audiovisual presentations.
- Class 16 User manuals, brochures and printed guides in the field of security and security devices; holiday cards; business cards; envelopes; paper; cardboard packaging; packaging bags of paper; presentation folders.
- Class 24 Tablecloths, not of paper.
- Class 25 Shirts.

- Class 35 Marketing, market research and market analysis; business marketing; presentation of security products and services to the public; distribution and dissemination of advertising matter; organization of trade fairs for advertising purposes; arranging and conducting of fairs and exhibitions for business and advertising purposes; arranging and conducting of auctions and reverse auctions via computer and telecommunication networks; social media strategy and marketing consultancy; providing business information in the field of social media; invoicing; advertising services, namely press releases; design of advertising logos; advertising services in the field of security.
- Class 38 Video broadcasting and transmission of films and movies via the Internet.
- Class 41 Training services, namely, training in the field of security; educational consultancy in the field of security, training and further training, provided via telephone call centers and hotlines; production of movies; photography.
- Class 45 Consultancy services in the field of home security; surveillance services; surveillance services relating to the physical safety of persons; surveillance services relating to the security of tangible property; security services for the protection of property and individuals; police and civil protection services; security monitoring services; civil defense services; consultancy and legal services in the field of privacy and security laws, regulations, and requirements; consultancy in the field of litigation; consultancy services in the field of the safety needs of commercial and industrial companies; monitoring of burglar and security alarms; monitoring telephone calls from subscribers and notifying emergency facilities; night guard services; preparation of legal reports; providing information on the development of privacy,

security and data governance law from a web site; providing reconnaissance and surveillance services; provision of information, advice and consultancy in relation to security services for the protection of property and individuals; security guard services for the protection of property and individuals; surveillance services; surveillance services relating to the physical safety of persons; surveillance services relating to the security of tangible property; providing expert testimony in the field of security.