

BL O/1134/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 3695969
BY PROXIMA PTY LTD
TO REGISTER THE FOLLOWING SERIES OF TRADE
MARKS:**



IN CLASSES 9, 35 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 430089
BY DREEM MEDIA LTD**

Background and Pleadings

1. On 16 September 2021, Proxima Pty Ltd (“the applicant”) applied to register in the UK the series of two trade marks shown on the cover page of this decision, under number 3695969 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 12 November 2021, in respect of goods and services in Classes 9, 35 and 42.¹

2. On 11 January 2022, DREEM MEDIA LTD (“the opponent”) filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Section 5(2)(b) ground is directed at all the goods and services in the application.

3. The opponent relies upon its UK trade mark number 3494030, ‘PATTER’ (“the earlier mark”). The earlier mark was filed on 27 May 2020 and became registered on 04 September 2020, in respect of goods and services in Classes 9, 16, 35, 41 and 42. For the purposes of the opposition, the opponent relies upon all the goods and services in Classes 9, 35 and 42.²

4. The opponent claims that the marks at issue are visually highly similar and aurally and conceptually identical and the respective goods and services are identical, if not highly similar. As such, a likelihood of confusion exists.

5. In its counterstatement the applicant denies that there is a likelihood of confusion between the marks on the basis that there are insufficient similarities between the respective marks and the goods and services at issue.

6. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

¹ These will be listed in the goods and services comparison.

² These will be listed in the goods and services comparison.

7. The opponent is represented by Tennant IP Limited; the applicant is represented by Boulton Wade Tennant LLP. Neither party filed evidence, however during the evidence rounds the opponent filed written submissions. Neither party requested a hearing. Only the applicant chose to file written submissions in lieu. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

8. 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. That is why this decision continues to refer to EU trade mark case law.

Decision

Section 5(2)(b): Legislation and case law

9. Sections 5(2)(b) and 5A of the Act read 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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

11. 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.”

12. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

13. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is 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:

“82 ... there is a close connection between [the goods], 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...”.

14. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (‘Meric’)*, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

17. The competing goods and services are as follows:

Opponent’s goods and services:

Class 9 Downloadable electronic publications, instructional resources and materials; downloadable pre-recorded webcasts, podcasts, videos, audio clips, text, graphics and training content; recording discs, content and media; multi-media recordings; electronic, magnetic and digital data carriers in the nature of DVDs, CDs, tapes, videos and other digital recording media; audio, visual and audio-visual recordings; data recordings, including audio, video, still and moving images and text; electronic media and magnetic media all bearing music or sound; downloadable training and educational software; application software; downloadable software in the nature of digital products purchased via subscription.

Class 35 Digital advertising agency services; marketing agency services; digital marketing; advertising, marketing, public relations and promotional services and consultancy; digital advertising; search engine marketing services; affiliate marketing; targeted marketing; recruitment services; employment agency services; business recruitment consultancy; personnel recruitment advertising; providing information relating to recruitment; assistance relating to recruitment and placement of staff; business expertise services; information services relating to jobs and career opportunities; job matching services; job agency services; business project management; consultancy in the field of business change and change management;

business growth consultancy and advisory services; business consulting for enterprises; business risk assessment and management services; business strategy and planning services; business management, consultancy, advisory and support services; business process management and consulting; business consultation and management regarding marketing activities; creation and management of advertising and social media advertising campaigns; preparation, development and implementation of advertising campaigns and marketing strategies; business advice relating to strategic marketing; pay per click advertising; advertising copywriting; search engine optimisation services; search engine marketing services; website traffic optimisation services; corporate communications services; consultancy regarding public relations communications strategy; consultancy relating to the organisation of promotional campaigns for businesses; marketing advice and assistance in relation to websites; promotion, advertising and marketing of third party websites; advertising services to create corporate and brand identity; brand testing and positioning; brand creation, strategy and evaluation services; providing marketing consulting in the field of social media; marketing the goods and services of others; statistical evaluations of marketing data; provision and rental of advertising space online and on electronic media; preparation and dissemination of advertising and publicity matter; customer relationship management; copywriting for advertising and promotional purposes; advertising research; production of advertising materials; production of sound and video recordings for advertising purposes; data collection and processing; market research and analysis; business data analysis; marketing studies and reports; publication of printed matter for advertising purposes; design of advertising and marketing materials; business introduction services and arranging business introductions; business intermediary services; business networking; outsourcing and procurement services; accounting services; bookkeeping services; provision of reports relating to accounting information; tax planning, preparation, assessment, filing and consultancy services [accountancy]; preparation of tax returns; payroll assistance, preparation, processing and administration for others; account, business and financial auditing; financial statement preparation and analysis for businesses; compiling, storing, analysing, retrieving and systemising data and information; shareholder recording keeping services; business advisory services relating to company performance; company office secretarial services; business advice relating to growth financing; risk management consultancy;

appraisal and evaluation of business opportunities; business merger and acquisitions consultation; business analysis, research and information services; financial records management; economic forecasting; information, advice and consultancy in relation to all the aforesaid services; all of the aforesaid also provided from a computer database, the Internet or other electronic media.

Class 42 Design and development of computer software, computer systems, mobile applications and websites; planning, design, development and maintenance of websites; designing and implementing websites for others; design, creation, hosting and maintenance of websites and customised web pages for others; updating and managing websites for others; website design consultancy; design, drawing and commissioned writing for the compilation of websites; graphic design services; artwork design; brand design services; hosting of digital content and podcasts online; website usability testing services; design of printed matter, advertising and promotional material; SaaS services; providing temporary use of non-downloadable software; information, advice and consultancy in relation to all the aforesaid services; all of the aforesaid also provided from a computer database, the Internet or other electronic media.

Applicant's goods and services:

Class 9 Downloadable software featuring conversational artificial intelligence; communications software (downloadable); conversational artificial intelligence software (downloadable) for use with social media platforms; conversational artificial intelligence software (downloadable) for responding to and managing sales enquiries, complaints and questions; robots featuring artificial intelligence; computer hardware; data feeders for use with artificial intelligence; data feeders linked with artificial intelligence; none of the aforesaid for use in relation to marketing agency services.

Class 35 Business administration services; business advisory services; business consultancy services including strategic business consultancy services; business assistance services; business management services including commercial business management services; business intelligence services; management of sales

enquiries, complaints and questions for businesses; customer liaison services; corporate communication services; provision of business information; database management; all of the foregoing relating to the provision and application of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

Class 42 Software as a service (SaaS); platform as a service (Paas); online provision of web-based software including software featuring conversational artificial intelligence; online provision of web-based software; software design and development; software support services; software engineering; design of communication systems; provision of information relating to computer programming and software; application service provider (ASP) services; infrastructure as a service (IaaS); data security services; providing software applications through computer databases, the internet or other electronic networks; operation of search engines; creating and designing web pages relating to creating virtual communities for registered users to participate in discussions and engage in social, business, educational and community networking; hosting a platform that gives users the ability to upload, exchange and share messages, web-links and other information; hosting a platform featuring non-downloadable software that enables electronic communications network users to create, manage, upload, bookmark, view, transfer, annotate, share and discover data, information and media content; file sharing services, namely, hosting a website featuring technology enabling users to share, upload and download electronic files and web-links; hosting an interactive platform for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and user-generated content; providing non-downloadable software that facilitates sharing and discovering information and media content via local and global computer, mobile, cellular, electronic, wireless, and data communications networks; data storage; computer back up services; computer database development services; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

18. With regard to the similarity of the goods and services at issue, in its written submissions the opponent states the following:

“The Opponent submits that the inclusion of the Applicant’s limitations “all of the foregoing relating to the provision and application of communications or conversational artificial intelligence” and “none of the aforesaid relating to marketing agency services” will not mitigate the similarity between the goods and services in question.

Overall, the Opponent submits that all of the applied for goods and services in classes 9, 35 and 42 will be considered as being identical and highly similar to the Opponent’s earlier registered services, regardless of any limitations the Applicant has filed.

The identical and highly similar goods and services makes it undoubted that the goods and bearing the mark of “PATTR” by the Applicant would be confused into believing computer software, computer hardware, business advisory services and computer software services will originate from the Opponent.”

Class 9 of the contested application

19. In its submissions in lieu, the applicant states:

“The Applicant’s software goods are all related to artificial intelligence software, which is different from those of the Registration, which covers electronic goods, relating to audio and “dumb” media, namely data carriers of various sorts. Insofar as the Opponent’s mark covers software, it is for application software, which is not similar to the “big data” products of the Applicant. The Opponent’s remaining software for training and education and for the consumption of digital content is not similar to the functionality of the Applicant’s Class 9 goods. The respective goods would therefore not be classed as similar and would not be put in the same commercial sectors.

The Applicant's description of goods contains a limitation to the Class 9 specification, "none of the aforesaid for use in relation to marketing agency services".

The limitation makes the goods even more different, as the Applicant specifically excludes goods relating to marketing services."

Downloadable software featuring conversational artificial intelligence; communications software (downloadable); conversational artificial intelligence software (downloadable) for use with social media platforms; conversational artificial intelligence software (downloadable) for responding to and managing sales enquiries, complaints and questions; none of the aforesaid for use in relation to marketing agency services

20. The contested goods are all forms of *software* for use in relation to artificial intelligence, communications and social media platforms. As such, I find that these goods are included in the broad term *application software* contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric*.

Robots featuring artificial intelligence; none of the aforesaid for use in relation to marketing agency services

21. *Robots featuring artificial intelligence* consist of highly advanced robots shaped to resemble the human body and which may be designed to carry out certain functions normally carried out by a human. In order to function and operate, these highly technical goods use central processing units and specific computer software. Therefore, on the basis that computer software is essential for the performance, function and operational capability of such goods, I find that the contested *robots* and the opponent's *application software* can target the same relevant public and since software is essential for the performance, function and operational capability of *robots featuring artificial intelligence*, these goods are also complementary. Furthermore, in view of the highly technical nature of *robots featuring artificial intelligence*, these goods can overlap in trade channels and be produced by the

same undertakings as the opponent's *application software*. Therefore, I find that the competing goods are similar to a medium degree.

Computer hardware; none of the aforesaid for use in relation to marketing agency services

22. The contested *computer hardware* is a broad term referring to the physical components that make up a computer system. Computer hardware can be installed inside a computer or can be connected to the outside of a computer. The opponent's *software* goods, namely *downloadable training and educational software; application software* and *downloadable software in the nature of digital products purchased via subscription*, are essentially instructions, data or programs used to operate computers and execute specific tasks. Accordingly, I find that the competing goods are similar to a medium degree on the basis that software and hardware are likely to overlap as their relevant public, user channels and producers can coincide, and they can be found in the same retail outlets. Furthermore, they are complementary, insofar as hardware is indispensable or essential to the use and functionality of software.

Data feeders for use with artificial intelligence; data feeders linked with artificial intelligence; none of the aforesaid for use in relation to marketing agency services

23. A data feed is a way of delivering structured data, such as news and information, from one system to another, usually for use on a website, apps (application software) or other online tools. Consequently, the above contested goods and the opponent's *application software* are dependent on one another for their operation and therefore I find them to be complementary. Furthermore, I am of the view that the goods can coincide in end users and producers. Accordingly, I find that the competing goods are similar to a medium degree.

Class 35 of the contested application

24. In its submissions in lieu, the applicant states:

“The Applicant’s limitation “*all of the foregoing relating to the provision and application of communications or conversational artificial intelligence*” sufficiently differentiates the services of the Registration in Class 35, as the Registration does not include any artificial intelligence related services.

The Applicant’s exclusion “*none of the aforesaid relating to marketing agency services [sic] all of the foregoing relating to the provision and application of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services*” sufficiently differentiates the services of the Registration in Class 35, as the Registration covers marketing and advertising services. The respective services would therefore be classed as being in different sectors.”

Business advisory services; business consultancy services including strategic business consultancy services; business management services including commercial business management services; corporate communication services; all of the foregoing relating to the provision and application of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

25. The above contested services have direct equivalents in the opponent’s specification (although some are worded slightly differently). Accordingly, I find the competing services are identical due to their identical or near-identical wording.

Business administration services; business assistance services; business intelligence services; management of sales enquiries, complaints and questions for businesses; customer liaison services; provision of business information; database management; all of the foregoing relating to the provision and application of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

26. The opponent’s broad term *business management, consultancy, advisory and support services* are services that aim to help companies manage their business and

therefore will involve activities associated with the day to day running of a business. On this basis, I consider that these services share some similarities with the above contested services. Whilst the competing services may not overlap in methods of use, I find that they are likely to overlap in user, purpose, and trade channels. Furthermore, whilst they are not complementary, they may well be in competition. Therefore, I find the services at issue to be similar to a medium degree.

Class 42 of the contested application

Software as a service (SaaS); online provision of web-based software including software featuring conversational artificial intelligence; online provision of web-based software; software design and development; provision of information relating to computer software; providing software applications through computer databases, the internet or other electronic networks; creating and designing web pages relating to creating virtual communities for registered users to participate in discussions and engage in social, business, educational and community networking; computer database development services; providing non-downloadable software that facilitates sharing and discovering information and media content via local and global computer, mobile, cellular, electronic, wireless, and data communications networks; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

27. The above contested services have direct equivalents in the opponent's specification (although some are worded slightly differently). Accordingly, I find the competing services are identical due to their identical or near-identical wording.

Software engineering; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

28. In general terms, *software engineering* is an area of computer science that focusses on, amongst other things, the design and development of computer software. As such, the contested services are encompassed by the opponent's

broad term, *design and development of computer software*. Accordingly, I find that the competing services are identical.

Hosting a platform that gives users the ability to upload, exchange and share messages, web-links and other information; hosting a platform featuring non-downloadable software that enables electronic communications network users to create, manage, upload, bookmark, view, transfer, annotate, share and discover data, information and media content; file sharing services, namely, hosting a website featuring technology enabling users to share, upload and download electronic files and web-links; hosting an interactive platform for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and user-generated content; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

29. The above contested services all relate to the *hosting* of content in one form or another. Likewise, the opponent's services include *hosting* services relating to *digital content and podcasts online*. Accordingly, I find that the competing services overlap and as such, are identical in line with the principle set out in *Meric*.

Design of communication systems; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

30. Broadly speaking, a *communication system* involves an exchange of information between two points, such as a transmitter and receiver. This communication exchange can take place via different means such as power lines, or radio waves. The opponent's services include the *design and development of computer systems*. Computer systems also enable communication exchange, by, for example, electronic means, from one computer to one or more computers via a network. Accordingly, although the competing services have a different nature, there could be an overlap in their purpose, and can coincide in end users, and as such I find that they are similar to a low degree.

Software support services; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

31. Broadly speaking, the contested services relate to the provision of technical support in regard to software products, such as installation assistance and remote troubleshooting, etc. On this basis, I find that these services share points of similarity with the opponent's *providing temporary use of non-downloadable software; information, advice and consultancy in relation to all the aforesaid services*. The competing services have a similar purpose and can coincide in end users and producers. Accordingly, the services are similar to at least a medium degree.

Provision of information relating to computer programming; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services.

32. Generally speaking, a computer program is a piece of software and computer programming is the process of designing and building a program (software). The contested services are concerned with the provision of information relating to the design and build of programs. Therefore, I find that these services overlap with the opponent's *design and development of computer software and mobile applications; information, advice and consultancy in relation to all the aforesaid services*; Accordingly, I find that the competing services are identical in line with the principle set out in *Meric*.

Platform as a service (PaaS); all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

33. Platform as a service (PaaS) is a type of cloud computing service model that provides a cloud platform for developing, running and managing applications. As such, I find that these services share points of similarity with the opponent's *design and development of computer software and mobile applications*. The competing

services have a similar purpose and can coincide in end users and producers. Accordingly, the services are similar to a medium degree.

Application service provider (ASP) services; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

34. In general terms, the contested services are concerned with the provision of application software, through the web. On this basis, I find that these services share points of similarity with the opponent's *providing temporary use of non-downloadable software*. The competing services have a similar purpose and can coincide in end users and producers. Accordingly, the services are similar to at least a medium degree.

Infrastructure as a service (IaaS); all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

35. Broadly speaking, the contested services are a type of cloud computing service in which IT infrastructure, such as, hardware, software and storage, etc, are provided to end users through the internet. Therefore, as this service is concerned with the provision of software over the internet, amongst other things, I find that it shares a point of similarity with the opponent's *providing temporary use of non-downloadable software*. The competing services have a similar purpose and can coincide in end users and producers. Accordingly, the services are similar to a medium degree.

Data security services; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

36. The contested services relate to the IT field and are concerned with the protection of data from, amongst other things, file deletion, viruses, theft and unauthorised access, etc. The opponent's services also relate to the IT field and in terms of the *design and development of computer software, computer systems, mobile*

applications and websites; planning, design, development and maintenance of websites; designing and implementing websites for others; design, creation, hosting and maintenance of websites and customised web pages for others; updating and managing websites for others; website usability testing services. These services will also require compliance, etc., in regard to the way that data is stored and as well as general data protection. Accordingly, the competing services have a certain connection on the basis that there is a complementary relationship between these services because the contested services are essential for the provision of the opponent's services. Consequently, I find that the contested services are similar to a low degree.

Operation of search engines; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

37. Broadly speaking, a search engine is a web-based tool that enables users to locate information on the World Wide Web and even though the opponent's *design and development of computer software, computer systems, mobile applications and websites; planning, design, development and maintenance of websites; designing and implementing websites for others*, appear to differ in nature since the contested services do not involve the design and development of software and websites, etc., the providers of the respective services are likely to be the same since they are all computer related services. Accordingly, it is highly conceivable that the opponent's said design and development services would also logically provide the contested services. They are also likely to target the same end user via the same trade channels. As such, I find that the services at issue are similar to a low degree.

Data storage; computer back up services; computer database development services; all of the foregoing for the purpose of communications or conversational artificial intelligence; none of the aforesaid relating to marketing agency services

38. In general, *data storage* refers to the digital recording of files and documents that are saved in a storage system for future use; *computer back up services* are

concerned with the process of creating copies of data from a computer system which is used for recovery if the original data is lost or corrupted; and *computer database development services* are concerned with developing a collection of data which is stored in a logical and structured manner (database). Whilst the opponent's *design and development of computer software, computer systems, mobile applications and websites* differ in nature to the contested services since they do not involve the design and development of software and websites, etc., I am of the view that the providers of the respective services are likely to coincide on the basis that they are all computer related services. Consequently, it is likely that the opponent's design and development services at issue would logically also include the contested services. They are also likely to target the same end user via the same trade channels. As such, I find that the services at issue are similar to a low degree.

The average consumer and the nature of the purchasing act

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

40. 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.”

41. The average consumer of the goods and services at issue is likely to include members of the general public as well as business and professional users. The goods and services will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers' physical premises, the goods will be displayed on shelves and in cabinets and the services will be displayed on signs and placards, both being self-selected by the consumer. A similar process will apply when the goods and services are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Given the wide-ranging goods and services at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods and services at issue, the average consumer is likely to pay at least a medium degree of attention.


Comparison of the marks

42. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

44. The trade marks to be compared are as follows:

Opponent's mark	Contested marks
PATTER	

45. With regard to the similarity of the marks, in its written submissions, the opponent states the following:

“When looked at in details [sic], the Applicant's mark contains stylised elements. The colour scheme and the font are very basic and will not leave a significant impression on the average consumer, with only one colour is used as a background colour and a single colour by itself will not possess inherent distinctive character. Furthermore, the line adds very little to the overall impression of the mark and consumers will focus more on the word element. The Opponent's registered mark is only comprising of the sole word element “Patter”, meaning this word can only be considered as the dominant and distinctive element of the Opponent's mark.

Therefore, the Opponent submits that upon a comparison between both marks, the average consumer will recognise the dominant and distinctive elements of both marks are the words “Pattr” and “Patter”, which are confusingly similar.”

46. In its submissions in lieu, the applicant states:

“The Mark features a striking colour purple, in combination with a stylised wording PATTR and an underlined feature. The Mark also omits the letter E and hence the notable features of the Mark are its stylisation and the mis-spelling of the dictionary word “patter”. It is this divergence from the norm which will be memorised and sought for by the consumer in future transactions.

Consequently, the marks will be regarded as of low similarity, due to the Mark’s additional features, the colour, the stylisation and the missing letter E.”

47. The opponent’s mark comprises the word ‘PATTER’ presented in standard upper-case letters without any stylisation. The overall impression resides in this single element.

48. The applicant’s series of two marks contain the letters ‘Pattr’. The letters are presented in standard sentence case, with a capital first letter, and lower-case letters following. In the first mark the letters are presented in white and are underlined by a white broken line. Both the letters and the broken line are centrally placed on a square burgundy background; in the second mark, the letters are presented in burgundy and are underlined by a burgundy broken line. Whilst the figurative broken line element in the marks cannot be ignored and will contribute to the overall impressions of the marks, given their size and position in the marks, I find the letters ‘Pattr’ to be the dominant and distinctive element in the marks. I find that the burgundy background in the first mark will have little impact on the consumer.

Visual comparison

49. Visually, the competing marks share the same letters in the same order, with the exception of the fifth letter ‘E’ present in the earlier mark which has no counterpart in the contested marks, i.e ‘PATTER / Pattr’. Additionally, the competing marks are visually different in that the contested marks contain figurative elements which are not replicated in the earlier mark. Accordingly, bearing in mind that the beginnings of words tend to have more impact than the ends, and considering the overall

impression of the marks weighing up the similarities with the differences, I find the marks to be visually similar to at least a medium degree.

Aural comparison

50. With regard to the aural comparison of the marks, in its submissions in lieu the applicant states:

“We accept that there is an aural similarity between the respective marks.”

51. The competing marks have the same number of syllables, namely ‘PAT-TER’ and ‘Patt-r’ or ‘Pat-tr’. The aural difference created by the letter ‘E’ is negligible or non-existent and therefore both marks will be pronounced as the word ‘PATTER’, creating aural identity. However, if consumers do slightly alter their pronunciation based on the letter ‘E’, there still remains a very high degree of aural similarity. The figurative elements present in the contested marks would not be articulated.

Conceptual comparison

52. With regard to the conceptual similarity of the marks, in its written submissions the opponent states the following:

“The Opponent submits that the marks are conceptually identical.

“PATTER” has the Collins Dictionary meaning as a singular noun of “Someone's patter is a series of things that they say quickly and easily, usually in order to entertain people or to persuade them to buy or do something. There is a common reference to “sales patter” given by over-enthusiastic salesmen. The Opponent submits that the Applicant’s mark “PATTR” is a fanciful way of spelling “PATTER”. The Opponent submits that both marks would conjure up the word PATTER.

In relation to the services in question, the presence of the mark “PATTER” or “PATTR” would have a direct relevance, in that the marks would bring up the idea of communication, advertising or marketing through the concept of the thought of someone talking, most probably at length or persuasively.

The word “PATTER” also has the secondary meaning of a light tapping noise, although the Opponent submits that given the similarity of the marks, the conceptual interpretation from the average consumer would remain the same. Therefore, the marks would be regarded as conceptually identical.”

53. In its submissions in lieu, the applicant states:

“As the Opponent’s mark alludes to continuous talk, and the Mark is a meaningless invented word, any conceptual similarity must be low at best.”

54. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

55. In my view the word ‘PATTER’ in the earlier mark will be an immediately recognisable word for the average consumer, i.e. to walk or move with quick soft steps or to strike with or make a quick succession of light tapping sounds.³

56. With regards to the contested marks, there are two possible scenarios. The first is that consumers will see PATTR as an invented word, with the stylisation not creating any concept. For this group of average consumers, the marks are conceptually dissimilar. The second possibility is for consumers to see PATTR, articulate it in their heads as PATTERN, and immediately think of the ordinary meaning of that word. For this group of average consumers, the marks are conceptually identical as they immediately conjure the ordinary meaning of the dictionary word PATTERN.

Distinctive character of the earlier trade mark

³ Collins English Dictionary.com/patter

57. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

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

59. Whilst the opponent has not commented on the overall distinctiveness of its mark, the applicant, in its submissions in lieu, states the following:

“The Opponent’s mark is for the word PATTERN, a dictionary defined word meaning inter alia “rapid continuous talk” or “the jargon of a professional or social group”. Hence, for services relating to communications management, the word has a recognised meaning and lower distinctive character.”

60. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

61. The earlier mark comprises the word ‘PATTERN’. Whilst this word will be understood as reference to walking or moving with quick soft steps; to strike with or make a quick succession of light tapping sounds; or rapid continuous talking, it has no obvious connection with the goods or services for which the opponent’s mark is registered. On this basis, the mark is inherently distinctive to a medium degree. Even for consumers who see ‘PATTERN’ as a reference to continuous talking, any link between that meaning and the goods and services at issue is very tenuous and does not alter the medium distinctive character.

Likelihood of confusion

62. 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 trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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.

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where

the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

64. Earlier in the decision I concluded that the marks are visually similar to at least a medium degree, aurally identical and conceptually identical or dissimilar (depending on the consumer's view of PATTR). I have found that the earlier mark has a medium degree of inherent distinctive character for the goods and services at issue. Furthermore, I found the similarity between the goods and services at issue to range from similar to a low degree to identical. I have found that average consumers of the goods and services will include members of the general public and businesses or professional users. I have found that the average consumers will pay at least a medium degree of attention when selecting the goods or services. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations.

65. Bearing in mind the principle of imperfect recollection and recognising that the letters 'PATT_R / Pattr' are identically present in the competing marks, I consider that the marks are likely to be mistakenly recalled or misremembered as each other when used on the goods and services at issue. I am of this view given the visual similarity, aural identity and conceptual identity (for some consumers) between the marks and the predominantly visual purchasing process. The opponent's mark is a word mark and can therefore be produced in any colour or font, etc, and the figurative elements in the contested marks will not be articulated. Accordingly, taking all these factors into account, I find that there is a likelihood of direct confusion. Furthermore, based on the interdependency principle, this also extends to goods and services found to be similar to a low degree.

66. However, if I am wrong on this, I will now go on to consider indirect confusion.

67. 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.”

17. 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).”

68. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”.

Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

69. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

70. If consumers recognise the difference between the competing marks, namely the letter ‘E’ present in the earlier mark (PATTER) and note the common elements ‘PATT_R / Pattr’ identically present in both marks, whether consciously or unconsciously, this will lead consumers through a mental thought process, namely, that there is a difference between the marks, but there is also something in common. However, the addition or removal of the letter ‘E’ is not a logical brand extension or sub-brand and as such I do not see a logical step which would induce consumers to be indirectly confused. Rather, the average consumer would put the presence of the common element ‘PATT_R / Pattr’ in the marks down to coincidence rather than economic connection.

Conclusion

71. The opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused.

Costs

72. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I award costs to the opponent as follows:

Notice of opposition fee	£100
Preparing the Notice of Opposition and Considering the counter statement	£300

Preparing written submissions £200

TOTAL £600

73. I therefore order Proxima Pty Ltd to pay DREEM MEDIA LTD the sum of £600. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of December 2022

**Sam Congreve
For the Registrar**