

O/0505/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003671151

BY FINDR GLOBAL LIMITED

TO REGISTER THE TRADE MARK:



IN CLASSES 9, 35, 38 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427919 BY

HIVE EMPIRE PTY LTD

## BACKGROUND AND PLEADINGS

1. On 20 July 2021, Findr Global Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The trade mark was published for opposition purposes on 10 September 2021, and registration is sought for the goods and services set out in paragraph **19** below.

2. On 3 November 2021, Hive Empire Pty Ltd (“the opponent”) opposed the application based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both grounds, the opponent relies upon the following trade marks:



IR designating the UK no. 1460436

Registration date: 19 February 2019

Designation date: 19 February 2019

Date protection granted in the UK: 7 June 2021

Priority claimed: 23 January 2019 (Australia TM no. 1984651)

(“the First Earlier Mark”)

# FINDER.COM

IR designating the UK no. 1458998

Registration date: 19 February 2019

Designation date: 19 February 2019

Date protection granted in the UK: 4 June 2021

Priority claimed: 23 January 2019 (Australia TM no. 1984604)

(“the Second Earlier Mark”)

# FINDER

IR designating the UK no. 1447100

Registration date: 7 June 2018

Designation date: 7 June 2018

Date protection granted in the UK: 4 June 2021

("the Third Earlier Mark")



IR designating the UK no. 1391359

Registration date: 7 September 2017

Designation date: 7 September 2017

Date protection granted in the UK: 16 August 2018

("the Fourth Earlier Mark")

3. For both grounds, the opponent relies upon all goods and services for which the earlier marks are registered, as set out in the Annex to this decision. Under section 5(2)(b), the opponent claims that the marks are similar and that the goods and services are identical or similar, resulting in a likelihood of confusion.

4. Under section 5(3), the opponent claims a reputation for the goods and services identified and that use of the applicant's mark would lead the relevant public to believe that the marks are used by the same undertaking or to think that there is an economic connection between the users of the marks. No other basis for damage is pleaded.

5. The applicant filed a counterstatement denying the claims made.

6. The applicant is represented by Harper James and the opponent is represented by Barker Brettell LLP.

7. Both parties filed evidence in chief. The opponent did not file evidence in reply. Neither party requested a hearing, and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

8. The opponent filed evidence in chief in the form of the witness statement of David Chen dated 6 July 2022. Mr Chen is the Chief Legal Officer for the opponent, a position he has held since January 2022. His evidence is accompanied by 11 exhibits (A to K). Although parts of Mr Chen's evidence was originally described as confidential, a preliminary view was given that it should not be kept confidential and the opponent confirmed on 31 January 2023 that it was content for the evidence to remain unchanged, despite the lack of confidentiality.

9. The applicant filed evidence in chief in the form of the witness statement of Gregory Philip Edgar Watts dated 5 September 2022. Mr Watts is the CEO and founding director of the applicant, a position he has held since 10 March 2022. Mr Watts' evidence is accompanied by 4 exhibits (Annexes 1 to 4).

10. The applicant filed written submissions in lieu dated 9 March 2023.

11. I have taken the evidence and submissions into account and will refer to them below, where necessary.

## **RELEVANCE OF EU LAW**

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

## **DECISION**

### **Preliminary Issue**

13. I note that in Mr Chen's evidence he states:

“5. The Opponent is also the owner of a family of trade mark applications/registrations including the word FINDER around the world including but not limited to Europe, Australia, USA, Canada, New Zealand.”

14. I do not understand this to be an attempt to rely upon a ‘family of marks’ argument and, in any event, there is no such pleading. Consequently, I will not consider a ‘family of marks’ argument as part of this decision.

**Section 5(2)(b)**

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

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

(a)...

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

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

16. Section 5A of the Act is as follows:

“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.”

17. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not been granted protection in the UK more than 5 years before the application date of the mark in issue, they are

not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services identified.

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

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods and services**

19. I have included only those goods and services that I consider represent the opponent's best case in the table below. With that in mind, the competing goods and services are as follows:

<b>Opponent's goods and services</b>	<b>Applicant's goods and services</b>
<b>The First and Second Earlier Marks</b> <u>Class 35</u> Advertising; promotional advertising services; marketing; business advice;	<u>Class 9</u> Downloadable software to allow registered users to engage in communication and collaboration

<p>compilation and provision of online directories; compilation of information into computer databases.</p>	
<p><b>The Third Earlier Mark</b></p>	
<p><u>Class 9</u> Databases (electronic publications).</p>	<p>between and among themselves and to engage in business networking; downloadable software in the fields of business introductions and networking; downloadable software to enable voice over Internet protocol (VOIP) communications; downloadable software for downloading by others that allows subscribers to utilise VOIP communication services; downloadable software enabling users to communicate with others via electronic communications networks for networking; interactive database software in the fields of business and professional networking; downloadable software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; downloadable software for voice calling, video calling, video conferencing and user presence indication.</p>
<p><u>Class 35</u> Advertising; promotional advertising services; marketing; business advice; compilation and provision of online directories; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information.</p>	
<p><u>Class 38</u> Telecommunications; electronic communication services.</p>	
<p><u>Class 42</u> Development of software; software as a service (saas).</p>	
<p><b>The Fourth Earlier Mark</b></p>	<p><u>Class 35</u> Online community management services; providing online marketplace for providers of services; providing online marketplace for users of services; compiling and maintaining online directories; professional referral services; providing information about and making referrals concerning services provided by others; internet</p>
<p><u>Class 9</u> Databases (electronic publications); computer software.</p>	
<p><u>Class 35</u></p>	



<p>Advertising; promotional advertising services; marketing; business advice; compilation and provision of online directories.</p>	<p>based matchmaking between businesses; business introduction services; internet based business introductions; arranging business introductions; arranging business introductions relating to the sharing of information; arranging business introductions relation to the supply of services; internet based business matchmaking and business introduction services; online business and professional networking and introduction services; agency services for arranging business introductions; business introduction and networking services; business services provided through social networking; providing online business networking services; online business networking services; online business networking services by means of downloadable mobile applications; online business networking services, namely, allowing registered users to share information and engage in communication and collaboration between and among themselves; online business networking services, allowing registered users to form groups and to engage in business networking; providing online networking services and information in the field of business; providing and facilitating the sharing of business information intended to</p>
<p><u>Class 38</u> Telecommunications; electronic communication services.</p>	<p>based matchmaking between businesses; business introduction services; internet based business introductions; arranging business introductions; arranging business introductions relating to the sharing of information; arranging business introductions relation to the supply of services; internet based business matchmaking and business introduction services; online business and professional networking and introduction services; agency services for arranging business introductions; business introduction and networking services; business services provided through social networking; providing online business networking services; online business networking services; online business networking services by means of downloadable mobile applications; online business networking services, namely, allowing registered users to share information and engage in communication and collaboration between and among themselves; online business networking services, allowing registered users to form groups and to engage in business networking; providing online networking services and information in the field of business; providing and facilitating the sharing of business information intended to</p>
<p><u>Class 42</u> Software as a service (saas).</p>	<p>based matchmaking between businesses; business introduction services; internet based business introductions; arranging business introductions; arranging business introductions relating to the sharing of information; arranging business introductions relation to the supply of services; internet based business matchmaking and business introduction services; online business and professional networking and introduction services; agency services for arranging business introductions; business introduction and networking services; business services provided through social networking; providing online business networking services; online business networking services; online business networking services by means of downloadable mobile applications; online business networking services, namely, allowing registered users to share information and engage in communication and collaboration between and among themselves; online business networking services, allowing registered users to form groups and to engage in business networking; providing online networking services and information in the field of business; providing and facilitating the sharing of business information intended to</p>

	<p>enhance opportunities for businesses to work together; advertising, marketing and promotion services for businesses; promoting the services of others via computer and communication networks; promoting the services of others via a global computer network; online advertising on a computer network; advertising, marketing and promotion services, namely, providing information regarding the services of others; advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socialising opportunities for business purposes; sales promotion (for others); providing online interactive business advice.</p> <p><u>Class 38</u></p> <p>Providing online forums, chat rooms and electronic bulletin boards for users to post, search for services provided by others; organising, maintaining and promoting a forum for the exchange of information among businesses through the use of a global computer network; providing access to computer databases in the field of business introductions and networking; providing access to an interactive computer database for electronic transmission of data and documents to facilitate the</p>
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	<p>communication between users with service requirements and users who provide those services; internet telephony and videoconference services over a computer network; providing voice over Internet protocol (VOIP) peer-to-peer communications over a global network; providing communications services comprising voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network; Unified Communications (UC) services, namely services comprising simultaneous voice calling, video calling, video conferencing, or at least two such communication services simultaneously, all of the aforementioned communication services being made available to users within one software graphical user interface over a computer network; providing temporary use of online, non-downloadable computer software that allows subscribers to utilise VOIP communication services.</p> <p><u>Class 42</u> Computer services, namely, hosting electronic facilities for others; hosting</p>
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	<p>virtual communities for register users to engage in business networking; hosting of digital content online; hosting an online website community for registered users to engage in communication and collaboration between and among themselves and to engage in business networking; providing a website featuring non-downloadable software in the fields of business introductions and networking; providing online computer software to enable voice over Internet protocol (VOIP) communications; providing online software for downloading by others that allows subscribers to utilise VOIP communication services; providing non-downloadable software enabling users to communicate with others via electronic communications networks for networking; providing online computer databases and online searchable databases in the fields of business and professional networking; installing, updating, maintenance and providing of computer software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; installing, updating, maintenance and providing of computer software for voice calling, video calling, video conferencing and user presence indication, all of the aforementioned</p>
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	communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network.
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20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

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

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

23. 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.”

24. 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.”

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.

### Class 9

*Downloadable software to allow registered users to engage in communication and collaboration between and among themselves and to engage in business networking; downloadable software in the fields of business introductions and networking; downloadable software to enable voice over Internet protocol (VOIP) communications; downloadable software for downloading by others that allows subscribers to utilise VOIP communication services; downloadable software enabling users to communicate with others via electronic communications networks for networking; interactive database software in the fields of business and professional networking; downloadable software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; downloadable software for voice calling, video calling, video conferencing and user presence indication.*

25. All of these terms in the applicant’s specification fall within the broader category of “computer software” in the specification of the Fourth Earlier Mark. These goods are identical on the principle outlined in *Meric*.

26. There will also be an overlap in trade channels and user with “development of software” in class 42 in the specification of the Third Earlier Mark. They may be in competition as you may either purchase the software as a finished product or you may

commission the services of a software developer for your specific requirements. The nature, purpose and method of use of the goods and services clearly differ. I consider them to be similar to a medium degree.

27. I can see no obvious point of overlap with the specifications of the First and Second Earlier Marks, and the opponent has not identified any particular point of similarity. Consequently, I consider the goods and services to be dissimilar.

### Class 35

*Compiling and maintaining online directories;*

28. These services are self-evidently identical or identical on the principle outlined in *Meric* to “compilation and provision of online directories” in the specifications of the First, Second and Fourth Earlier Marks and “compilation and provision of online directories; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, new, analysis, research and comparison information” in the specification of the Third Earlier Mark. If I am wrong in this finding, they overlap in trade channels, users, method of use, nature and purpose and will be highly similar.

*Advertising, marketing and promotion services for businesses; promoting the services of others via computer and communication networks; promoting the services of others via a global computer network; online advertising on a computer network; advertising, marketing and promotion services, namely, providing information regarding the services of others; advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socialising opportunities for business purposes; sales promotion (for others);*

29. These services are self-evidently identical or identical on the principle outlined in *Meric* to “promotional advertising services”, “advertising” and “marketing” in the specifications of the First, Second and Fourth Earlier Marks.



30. Where the applicant's services are not limited, the same will apply to "advertising; marketing; promotional advertising services; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information" in the specification of the Third Earlier Mark. Where the services are aimed at differing purposes, there will still be some overlap in nature, method of use and trade channels, and they will be similar to a medium degree.

*Providing online interactive business advice.*

31. This term is identical on the principle outlined in *Meric* to "business advice" in the specifications of the First, Second and Fourth Earlier Marks.

32. As the term is not limited to a particular purpose, it will also be identical to "business advice; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information" in the specification of the Third Earlier Mark.

*Online community management services;*

33. I can see no point of overlap between these services and the specifications of the earlier marks and I have no submissions from the opponent on the point. Consequently, I find no similarity.

*Providing online marketplace for providers of services; providing online marketplace for users of services;*

34. The opponent's best case, in my view, in relation to these services is "advertising" in the specification of the First, Second and Fourth Earlier Marks. I accept that there may be some limited overlap in trade channels as online market places may also provide the facility for advertising on their websites. There will, inevitably, be an overlap in user. However, the nature, purpose and method of use of the services differ. They are not in competition, nor are they complementary. Consequently, any similarity is at a low degree.

35. I can see no point of overlap with the specification of the Third Earlier Mark and, consequently, I find no similarity.

*Professional referral services; providing information about and making referrals concerning services provided by others; internet based matchmaking between businesses; business introduction services; internet based business introductions; arranging business introductions; arranging business introductions relating to the sharing of information; arranging business introductions relation to the supply of services; internet based business matchmaking and business introduction services; online business and professional networking and introduction services; agency services for arranging business introductions; business introduction and networking services; business services provided through social networking; providing online business networking services; online business networking services; online business networking services by means of downloadable mobile applications; online business networking services, namely, allowing registered users to share information and engage in communication and collaboration between and among themselves; online business networking services, allowing registered users to form groups and to engage in business networking; providing online networking services and information in the field of business; providing and facilitating the sharing of business information intended to enhance opportunities for businesses to work together;*

36. These services are, essentially, business networking services. In my view, these can be considered a form of marketing/promotional services and will be identical on the principle outlined in *Meric* to “marketing” and “promotional advertising services” in the specifications of the First, Second and Fourth Earlier Marks. There will also be a medium degree of overlap with “marketing; promotional advertising services; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information” in the specification of the Third Earlier Mark due to an overlap in nature, method of use and trade channels.

Class 38

*Providing online forums, chat rooms and electronic bulletin boards for users to post, search for services provided by others; organising, maintaining and promoting a forum for the exchange of information among businesses through the use of a global computer network; internet telephony and videoconference services over a computer network; providing voice over Internet protocol (VOIP) peer-to-peer communications over a global network; providing communications services comprising voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network; Unified Communications (UC) services, namely services comprising simultaneous voice calling, video calling, video conferencing, or at least two such communication services simultaneously, all of the aforementioned communication services being made available to users within one software graphical user interface over a computer network; providing temporary use of online, non-downloadable computer software that allows subscribers to utilise VOIP communication services.*

37. These services are identical on the principle outlined in *Meric* to “electronic communication services” and “telecommunications” in the specifications of the Third and Fourth Earlier Marks.

38. I can see no obvious point of overlap with the specifications of the First and Second Earlier Marks and I have no submissions from the opponent on the point. Consequently, I find no similarity.

*Providing access to computer databases in the field of business introductions and networking; providing access to an interactive computer database for electronic transmission of data and documents to facilitate the communication between users with service requirements and users who provide those services;*

39. These services will overlap in trade channels and user with “databases (electronic publications)” in the specifications of the Third and Fourth Earlier Marks and “compilation of information into computer databases” in the specifications of the First and Second Earlier Marks. They will also be complementary as they are important or

indispensable for each other and users would think that the same business is responsible for providing a database and providing access to those databases. Consequently, I consider them to be similar to a medium degree.

#### Class 42

*Computer services, namely, hosting electronic facilities for others; hosting virtual communities for register users to engage in business networking; hosting of digital content online; hosting an online website community for registered users to engage in communication and collaboration between and among themselves and to engage in business networking; providing a website featuring non-downloadable software in the fields of business introductions and networking; providing online computer software to enable voice over Internet protocol (VOIP) communications; providing online software for downloading by others that allows subscribers to utilise VOIP communication services; providing non-downloadable software enabling users to communicate with others via electronic communications networks for networking;*

40. In my view, these services are identical on the principle outlined in *Meric* to “software as a services (saas)” in the specifications of the Third and Fourth Earlier Marks. If I am wrong in this finding, then they will overlap in trade channels, users, method of use, purpose and nature and will be highly similar. There will also be an overlap in user, purpose and trade channels with “computer software” in the specification of the Fourth Earlier Mark, as well as a degree of competition, resulting in at least a medium degree of similarity.

41. I can see no point of overlap with the specifications of the First and Second Earlier Marks and I have no submissions from the opponent on the point. Consequently, I find no similarity.

*Providing online computer databases and online searchable databases in the fields of business and professional networking;*

42. These services will overlap in trade channels and user with “databases (electronic publications)” in the specifications of the Third and Fourth Earlier Marks and

“compilation of information into computer databases” in the specifications of the First and Second Earlier Marks. They will also be complementary as they are important or indispensable for each other and users would think that the same business is responsible for providing a database and providing access to those databases. Consequently, I consider them to be similar to a medium degree.

*Installing, updating, maintenance and providing of computer software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; installing, updating, maintenance and providing of computer software for voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network.*

43. These services overlap in trade channels and user with “computer software” in the specifications of the Fourth Earlier Mark. They are also complementary because they are important or indispensable to each other and the average consumer would believe that the same businesses that provide the software would be responsible for maintaining and updating it. Consequently, I consider them to be similar to a medium degree.

44. I can identify no point of overlap with the specifications of the First, Second and Third Earlier Marks and the opponent has made no submissions on the point. Consequently, I find no similarity.

45. Similarity of goods and services is essential for a likelihood of confusion to arise and, consequently, for those goods and services that I have found to be dissimilar, there can be no likelihood of confusion.

### **The average consumer and the nature of the purchasing act**

46. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the

average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) 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.”

47. The average consumer for the parties’ goods and services will be either a member of the general public or a business user. Various factors will be taken into account, such as ease of use and reliability (for the services) and functionality and suitability for particular requirements (for the goods). Consequently, I consider a medium degree of attention is likely to be paid during the purchasing process, although I recognise it may be higher where there is a technical aspect to the goods/services or where they are being purchased in relation to a user’s business.

48. The goods and services are likely to be purchased following perusal of signage at physical premises, on packaging of goods or on websites. Consequently, visual considerations will dominate the selection process. However, given that advice may be sought from retail assistants or word-of-mouth recommendations may play a role, I do not discount an aural component.

### **Comparison of trade marks**

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

components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

50. 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.

51. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p>(the First Earlier Mark)</p> <p><b>FINDER.COM</b> (the Second Earlier Mark)</p> <p><b>FINDER</b> (the Third Earlier Mark)</p> 	 <p>The business matching experts.</p>

(the Fourth Earlier Mark)	
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### Overall Impression

52. The applicant's mark consists of the letters FINDR presented in lower case font, above the words "The business matching experts". The dot on the "i" has been replaced by an upside down teardrop symbol, and the first four letters are presented in orange (with the last presented in grey). The overall impression of the mark lies in the combination of these elements, with the letters FINDR playing the greater role due to their size.

53. The First Earlier Mark consists of the word FINDER presented in navy, lower case font, above the word ".com", in smaller, thinner text. Preceding the text is a lighter blue diagonal teardrop symbol containing a magnifying glass. The dot on the letter "i" is presented in the same blue as the teardrop device. The overall impression of the mark lies in the combination of these elements, with the word FINDER and the device playing the greater role due to their size.

54. The Second Earlier Mark consists of the words FINDER.COM, presented in standard black uppercase font. The overall impression of the mark lies in the combination of these elements, with the word FINDER being the more distinctive, due to ".COM" merely indicating a web address.

55. The Third Earlier Mark consists of the word FINDER. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself.

56. The Fourth Earlier Mark consists of the word FINDER presented in navy, lower case font, preceded by a lighter blue diagonal teardrop symbol containing a magnifying glass. The dot on the "i" is presented in the same blue as the teardrop device. The overall impression of the mark lies in the combination of these elements, with the text playing a greater role.



### Visual Comparison

57. The First Earlier Mark and the applicant's mark overlap in the first four letters – FIND- and the letter R. However, there is an E present in the First Earlier Mark which is absent from the applicant's mark. The ".com" and device in the First Earlier Mark also have no counterpart in the applicant's mark, and the 'dots' on the letter "I" in each mark differ. The slogan in the applicant's mark also acts as a point of visual difference. The words are presented in a similar font, although the use of colour differs. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

58. The Second Earlier Mark and the applicants mark also overlap in the presence of the letters FIND and R. However, the absent letter 'E' and the 'dot' in the applicant's mark, as well as the slogan and word ".COM", all act as points of visual difference. The Second Earlier Mark is a word only mark and so could be used in any standard typeface and colour. Consequently, I consider the marks to be visually similar to between a medium and high degree.

59. The Third Earlier Mark and the applicant's mark overlap in the presence of the letters FIND and R. However, the absent letter E, the differing 'dot' and the slogan all act as points of visual difference. The Third Earlier Mark is a word only mark and, consequently, can be used in any standard typeface or colour. I consider the marks to be visually similar to between a medium and high degree.

60. The Fourth Earlier Mark and the applicant's mark overlap in the letters FIND and R. However, the absent letter E, the differing 'dots', the device and the slogan all act as points of visual difference. The marks are presented in similar fonts, although the use of colour differs. Consequently, I consider the marks to be visually similar to a medium degree.

### Aural Comparison

61. The applicant's trade mark will, in my view, be pronounced in the same way as the word FINDER by a significant proportion of average consumers. I consider it unlikely that the slogan will be articulated at all. If that is correct, then it will be pronounced

identically to the Third and Fourth Earlier Marks. The only point of aural difference with the First and Second Earlier Marks would be the word “.COM” which will result in a high degree of aural similarity.

62. If I am wrong in this finding, and the mark is pronounced FIND-ARE, then there is still between a medium and high degree of aural similarity with all of the earlier marks.

63. If the slogan in the applicant’s mark is articulated, then the aural similarity between the marks will be between low and medium.

### Conceptual Comparison

64. The applicant submits that the letters FINDR in the applicant’s mark will be viewed as an invented word. I disagree. The average consumer, in my view, will identify the similarity between these letters and the common dictionary word FINDER and is likely to view it as a misspelling of that word. I consider it likely that the letters FINDR will be attributed the same meaning as that word by a significant proportion of average consumers. The words “the business matching experts” in the applicant’s mark identify that the goods/services are in the field of business networking/agency. The only distinctive conceptual message conveyed by the earlier marks is that of the dictionary word FINDER. Consequently, I consider that there is between a medium and high degree of conceptual similarity between the marks.

### **Distinctive character of the earlier trade marks**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).

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

66. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

67. The only distinctive element of the Second Earlier Mark and the Third Earlier Mark is the ordinary dictionary word FINDER. The applicant’s evidence focuses upon the fact that the word FINDER is descriptive of price comparison services. Whilst these are the opponent’s main area of trade, the opponent is entitled to rely upon the full breadth of its specifications. I do not consider that word to be obviously allusive/descriptive of the goods and services that I have found to be similar to the applicant’s specification; they do not, as Mr Watts puts it, obviously “help customers find things”.<sup>1</sup> Consequently, I consider these marks to be inherently distinctive to a medium degree. The First and Fourth Earlier Marks have the additional stylisation and device. I do not consider that the “.COM” in the First Earlier Mark will impact the distinctive character of the mark. Consequently, I consider the First and Fourth Earlier Marks to be inherently distinctive to a slightly higher than medium degree.

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<sup>1</sup> See paragraph 13 of the witness statement of Mr Watts.

68. The relevant market for assessing enhanced distinctiveness is the UK market. I note the following from the opponent's evidence:

- a) The FINDER logo mark has been used in the UK since 2017.
- b) Mr Chen states that the opponent is "an online comparison service which compares and advertises various products including, but not limited to, information, relating to business, reviews, insurance, mobile phones, home loans, mortgage brokers, credit cards, personal loans, car loans, savings accounts, travel insurance, online shopping discounts and codes".
- c) Sales under the FINDER logo trade mark and FINDER trade mark for the financial year 2019 was over £1million, for the financial year 2020 was over £2million and for the financial year 2021 was over £3million. No information is provided about how sales are generated.
- d) An average of 1.2million visitors from the UK visited the opponent's finder.com/uk website between 2017 and 2022.
- e) There are examples of the First and Second Earlier Marks being used on the opponent's website prior to the relevant date.<sup>2</sup>
- f) Mr Chen states that the opponent has built up a "good" market share for price comparison services in the UK since 2017.
- g) The opponent has spent an average of £2million per year on advertising since 2017 and has engaged in advertising via television, online, print, social media and radio.
- h) The UK CEO for the opponent was interviewed on Sky News in January 2018.<sup>3</sup> Although, as the applicant submits, without being able to see the content of this interview it is of limited assistance.

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<sup>2</sup>Exhibit D

<sup>3</sup> Exhibit H

- i) The opponent has won a number of awards but, as the applicant notes, none of these appear to relate to the goods and services relied upon.

69. The use of the mark has not been particularly longstanding in the UK prior to the relevant date. However, I recognise that the sales figures and advertising expenditure has not been insignificant. There is limited information about the geographical spread of the use, and no detail about the market share, other than Mr Chen's opinion that it is "good". In any event, it appears that the opponent's primary focus is upon price comparison services, which is not one of the services that I have found to be similar to those covered by the application. Consequently, I do not consider the evidence assists the opponent and the distinctiveness of the earlier marks has not been enhanced through use in relation to the relevant goods and services.

### **Likelihood of confusion**

70. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective 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 marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

71. I have found as follows:

- a) The goods and services vary from being similar to a low degree to identical (except where I have found them to be dissimilar).
- b) I have found the average consumer to be a member of the general public or a business user, who will pay a medium degree of attention during the purchasing process (although I recognise that it may be higher where the goods/services are technical in nature or the purchase is being made in relation to the user's business).
- c) The purchasing process is predominantly visual, although I do not discount an aural component.
- d) The First and Fourth Earlier Marks and the applicant's mark are visually similar to a medium degree. The Second and Third Earlier Marks and the applicant's mark are visually similar to between a medium and high degree.
- e) The Third and Fourth Earlier Marks are aurally identical to the applicant's mark and the First and Second Earlier Marks are highly similar. Alternatively, depending on how the applicant's mark is pronounced, the aural similarity may vary from between a low and medium degree to between a medium and high degree.
- f) The marks are conceptually similar to between a medium and high degree.
- g) The Second and Third Earlier Mark are inherently distinctive to a medium degree. The First and Fourth Earlier Mark are inherently distinctive to a slightly higher than medium degree.

72. Notwithstanding the fact that the average consumer will be paying at least a medium degree of attention during the purchasing process, I consider it likely that the marks could be mistakenly recalled or misremembered as each other. It would be easy for the average consumer to overlook the missing letter E from the applicant's mark and the word FINDER/FINDR is the only, or most, distinctive element of all the marks. Consequently, I consider there to be a likelihood of direct confusion for any goods/services that are similar to at least a medium degree.

73. I now turn to consider indirect confusion. 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)".

74. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (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.

75. Even if the colour/device differences between the marks are recognised, I consider that the missing letter E will still be overlooked. Consequently, I consider that the additional elements (.COM and the slogan) will be viewed as non-distinctive additions to the mark and the addition of a device/use of different colours, could be seen as consistent with a brand extension or brand variant. I consider there to be a likelihood of indirect confusion where the marks are used on goods/services that are similar to at least a medium degree.

76. The opposition based upon section 5(2)(b) succeeds in relation to the following goods and services:

Class 9      Downloadable software to allow registered users to engage in communication and collaboration between and among themselves and to engage in business networking; downloadable software in the fields of business introductions and networking; downloadable software to enable voice over Internet protocol (VOIP) communications; downloadable software for downloading by others that allows subscribers to utilise VOIP communication services; downloadable software enabling users to communicate with others via electronic communications networks for networking; interactive database software



in the fields of business and professional networking; downloadable software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; downloadable software for voice calling, video calling, video conferencing and user presence indication.

Class 35      Compiling and maintaining online directories; professional referral services; providing information about and making referrals concerning services provided by others; internet based matchmaking between businesses; business introduction services; internet based business introductions; arranging business introductions; arranging business introductions relating to the sharing of information; arranging business introductions relation to the supply of services; internet based business matchmaking and business introduction services; online business and professional networking and introduction services; agency services for arranging business introductions; business introduction and networking services; business services provided through social networking; providing online business networking services; online business networking services; online business networking services by means of downloadable mobile applications; online business networking services, namely, allowing registered users to share information and engage in communication and collaboration between and among themselves; online business networking services, allowing registered users to form groups and to engage in business networking; providing online networking services and information in the field of business; providing and facilitating the sharing of business information intended to enhance opportunities for businesses to work together; advertising, marketing and promotion services for businesses; promoting the services of others via computer and communication networks; promoting the services of others via a global computer network; online advertising on a computer network; advertising, marketing and promotion services, namely, providing information regarding the services of others; advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socialising opportunities for

business purposes; sales promotion (for others); providing online interactive business advice.

Class 38 Providing online forums, chat rooms and electronic bulletin boards for users to post, search for services provided by others; organising, maintaining and promoting a forum for the exchange of information among businesses through the use of a global computer network; providing access to computer databases in the field of business introductions and networking; providing access to an interactive computer database for electronic transmission of data and documents to facilitate the communication between users with service requirements and users who provide those services; internet telephony and videoconference services over a computer network; providing voice over Internet protocol (VOIP) peer-to-peer communications over a global network; providing communications services comprising voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network; Unified Communications (UC) services, namely services comprising simultaneous voice calling, video calling, video conferencing, or at least two such communication services simultaneously, all of the aforementioned communication services being made available to users within one software graphical user interface over a computer network; providing temporary use of online, non-downloadable computer software that allows subscribers to utilise VOIP communication services.

Class 42 Computer services, namely, hosting electronic facilities for others; hosting virtual communities for register users to engage in business networking; hosting of digital content online; hosting an online website community for registered users to engage in communication and collaboration between and among themselves and to engage in business networking; providing a website featuring non-downloadable software in the fields of business introductions and networking; providing

online computer software to enable voice over Internet protocol (VOIP) communications; providing online software for downloading by others that allows subscribers to utilise VOIP communication services; providing non-downloadable software enabling users to communicate with others via electronic communications networks for networking; providing online computer databases and online searchable databases in the fields of business and professional networking; installing, updating, maintenance and providing of computer software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; installing, updating, maintenance and providing of computer software for voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network.

### **Final remarks**

77. For the avoidance of doubt, even if I had found enhanced distinctiveness, this would not have put the opponent in any stronger position. Firstly, this is due to the fact that the opponent's primary services are price comparison services. These are further removed from the applicant's goods and services in terms of similarity than those that I have identified above. Secondly, whilst I do not agree with the applicant that the word FINDER is descriptive of price comparison services, I do consider it to be allusive. Consequently, the opponent would be starting from a position of low inherent distinctiveness and any enhancement based upon the evidence filed could put it in no stronger position than I have already found above in relation to the other goods and services relied upon.

### **Section 5(3)**

78. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

79. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

80. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

82. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

83. I have summarised the key points of the opponent's evidence above. My primary finding is that the opponent's evidence does not satisfy the requirement for reputation. This is because, whilst the evidence of sales and advertising is not insignificant, I am not convinced that this would represent a particularly significant market share in relation to price comparison services (which appears to be the opponent's main field of business). Further, I have no information about geographical spread of the use within the UK and the length of use is relatively short. Taking all of the evidence into account, I do not consider that the requisite reputation has been established.

84. However, even if the opponent had been able to demonstrate the requisite reputation, the similarity between price comparison services (which are the only services for which the opponent could demonstrate a reputation on the evidence provided) and those goods and services covered by the applicant's specification is less (in terms of degree and scope) than under the section 5(2)(b) ground. As the only head of damage pleaded under this ground is, essentially, one of confusion, I do not consider that this ground could put the opponent in any stronger position than it is under section 5(2)(b).

85. The opposition based upon section 5(3) is dismissed.

## **CONCLUSION**

86. The opposition is successful in relation to the following goods and services for which the application is refused:

Class 9      Downloadable software to allow registered users to engage in communication and collaboration between and among themselves and

to engage in business networking; downloadable software in the fields of business introductions and networking; downloadable software to enable voice over Internet protocol (VOIP) communications; downloadable software for downloading by others that allows subscribers to utilise VOIP communication services; downloadable software enabling users to communicate with others via electronic communications networks for networking; interactive database software in the fields of business and professional networking; downloadable software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; downloadable software for voice calling, video calling, video conferencing and user presence indication.

Class 35      Compiling and maintaining online directories; professional referral services; providing information about and making referrals concerning services provided by others; internet based matchmaking between businesses; business introduction services; internet based business introductions; arranging business introductions; arranging business introductions relating to the sharing of information; arranging business introductions relation to the supply of services; internet based business matchmaking and business introduction services; online business and professional networking and introduction services; agency services for arranging business introductions; business introduction and networking services; business services provided through social networking; providing online business networking services; online business networking services; online business networking services by means of downloadable mobile applications; online business networking services, namely, allowing registered users to share information and engage in communication and collaboration between and among themselves; online business networking services, allowing registered users to form groups and to engage in business networking; providing online networking services and information in the field of business; providing and facilitating the sharing of business information intended to enhance opportunities for businesses to work together; advertising, marketing



and promotion services for businesses; promoting the services of others via computer and communication networks; promoting the services of others via a global computer network; online advertising on a computer network; advertising, marketing and promotion services, namely, providing information regarding the services of others; advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socialising opportunities for business purposes; sales promotion (for others); providing online interactive business advice.

Class 38 Providing online forums, chat rooms and electronic bulletin boards for users to post, search for services provided by others; organising, maintaining and promoting a forum for the exchange of information among businesses through the use of a global computer network; providing access to computer databases in the field of business introductions and networking; providing access to an interactive computer database for electronic transmission of data and documents to facilitate the communication between users with service requirements and users who provide those services; internet telephony and videoconference services over a computer network; providing voice over Internet protocol (VOIP) peer-to-peer communications over a global network; providing communications services comprising voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network; Unified Communications (UC) services, namely services comprising simultaneous voice calling, video calling, video conferencing, or at least two such communication services simultaneously, all of the aforementioned communication services being made available to users within one software graphical user interface over a computer network; providing temporary use of online, non-downloadable computer software that allows subscribers to utilise VOIP communication services.

Class 42 Computer services, namely, hosting electronic facilities for others; hosting virtual communities for register users to engage in business networking; hosting of digital content online; hosting an online website community for registered users to engage in communication and collaboration between and among themselves and to engage in business networking; providing a website featuring non-downloadable software in the fields of business introductions and networking; providing online computer software to enable voice over Internet protocol (VOIP) communications; providing online software for downloading by others that allows subscribers to utilise VOIP communication services; providing non-downloadable software enabling users to communicate with others via electronic communications networks for networking; providing online computer databases and online searchable databases in the fields of business and professional networking; installing, updating, maintenance and providing of computer software that allows subscribers to utilise voice over Internet protocol (VOIP) communications via a computer network; installing, updating, maintenance and providing of computer software for voice calling, video calling, video conferencing and user presence indication, all of the aforementioned communication services being made available to users within one software application graphical user interface and all provided via the Internet or via a peer-to-peer computer network.

87. The opposition is unsuccessful in relation to the following services, for which the application may proceed to registration:

Class 35 Online community management services; providing online marketplace for providers of services; providing online marketplace for users of services.

## **COSTS**

88. The opponent has enjoyed the greater degree of success and is, consequently, entitled to a contribution towards its costs based upon the scale published in Tribunal

Practice Notice 2/2016. I have applied an appropriate reduction for the only partial success and have awarded only £100 as the official fee, because the opponent was unsuccessful in relation to the section 5(3) ground which attracted the higher fee of £200. With this in mind, I award the opponent the sum of **£975**, calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£275
Preparing evidence and considering the applicant's evidence	£600
Official fee	£100
<b>Total</b>	<b>£975</b>

89. I therefore order Findr Global Limited to pay Hive Empire Pty Ltd the sum of £975. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 1<sup>st</sup> day of June 2023**

**S WILSON**

**For the Registrar**

## ANNEX

The opponent relies upon the following goods and services:

### **The First and Second Earlier Marks**

#### Class 35

Price comparison services; commercial information services provided by access to a computer database; compilation of business data; advertising; advertising services provided over the internet; advertising services provided by television; advertising services provided via a data base; electronic advertising services; outdoor advertising services; press advertising services; promotional advertising services; price analysis services; direct marketing; marketing; marketing advisory services; marketing analysis; marketing information; planning of marketing strategies; product marketing; promotional marketing; promotional services; computerised database management; pricing surveys; dissemination of advertising material; dissemination of business information; dissemination of commercial information; providing information, including online, about advertising, business management and administration and office functions; business advice; commercial information and advice for consumers in the choice of products and services; data management advice; arranging price quotations (for others); arranging subscriptions to telecommunication services (for others); classified advertising; surveys (opinion polling); collection of data; collection of information relating to advertising; collection of information relating to market analysis; collection of information relating to market research; compilation and provision of online directories; data search in computer files (for others); business management advisory services; business management consultancy; business administration; administration of business affairs; compilation of business information; office functions; commercial business management; sales promotions by issuing redeemable coupons (for others); business organization and management of discount services; discount services (retail, wholesale, or sales promotion services); organisation and management of discount card loyalty schemes; management of a retail enterprise for others; retail services; provision of an online marketplace for buyers and sellers of goods and services; conducting exhibitions for trade purposes; compilation of commercial information; conducting of trade shows; arranging business shows; conducting business shows; business promotion services; promotion

(advertising) of business; design of publicity material; preparation of publicity material; publicity; compilation of advertisements for use as web pages on the internet; conducting exhibitions for advertising purposes; compilation of directories for publishing on the internet; design of advertising materials; compilation of information into computer databases; systemization of information into computer databases.

### Class 36

Financial services; financial valuation appraisals for companies; collection of financial information; conducting financial feasibility studies; consultation services relating to financial matters; economic financial research services; financial advisory services; financial advisory services for companies; financial advisory services for individuals; financial assessments; financial asset management; provision of information relating to financial services; financial assistance; financial banking; financial brokerage; financial appraisals for companies; financial clearing house service; financial consultancy; financial consultation services; financial credit services; financial economic advisory services; financial economic analysis; financial evaluations; financial evaluation (insurance, banking, real estate); providing information, including online, about insurance, financial and monetary affairs and real estate affairs; provision of information relating to mortgages; provision of credit information; financial analysis; housing agency services; consultancy services relating to personal finance; consultancy services relating to investment; insurance advice; insurance consultancy; financial affairs; insurance information; insurance investigations; insurance services; mortgage and savings services; provision of investment savings plans; savings account services; savings bank services; savings scheme services; advice regarding credit; advice regarding lending services; advisory services relating to (financial) risk management; advice relating to insurance; advice relating to investments; advice relating to loan recovery services; advice relating to mortgages for residential properties; financial advice; independent financial planning advice; provision of online financial calculators; advisory services relating to investment finance; information services relating to insurance; advisory services relating to financial investment; advisory services relating to financial matters; advisory services relating to financial planning; agencies for the exchange of financial operations.

### **Third Earlier Mark**

#### Class 9

Databases (electronic publications); electronic publications (downloadable); downloadable image files; apparatus for searching electronic information; directories (electric or electronic); computer databases; computer programs for use in database management; computer software; downloadable software applications (apps); data recorded electronically from the internet; computer programs (downloadable software); database programs; all of the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information.

#### Class 35

Price comparison services; price analysis services; pricing surveys; surveys (opinion polling); compilation of business information; compilation of commercial information; compilation of directories for publishing on the internet; compilation of information into computer databases; systemization of information into computer databases; commercial information services provided by access to a computer database; compilation of business data; advertising; advertising services provided over the internet; advertising services provided by television; advertising services provided via a data base; electronic advertising services; outdoor advertising services; press advertising services; promotional advertising services; direct marketing; marketing; marketing advisory services; marketing analysis; marketing information; planning of marketing strategies; product marketing; promotional marketing; promotional services; computerised database management; dissemination of advertising material; dissemination of business information; dissemination of commercial information; providing information, including online, about advertising, business management and administration and office functions; business advice; commercial information and advice for consumers (consumer advice shop); data management advice; management advice; arranging price quotations (for others); arranging subscriptions to telecommunication services (for others); classified advertising; collection of data; collection of information relating to advertising; collection of information relating to market analysis; collection of information relating to market research; compilation and provision of online directories; data search in computer files (for others); business management advisory services; business management consultancy; business

administration; administration of business affairs; office functions; commercial business management; sales promotions by issuing redeemable coupons (for others); business organization and management of discount services; discount services (retail, wholesale, or sales promotion services); organisation and management of discount card loyalty schemes; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information.

### Class 36

Financial services; provision of information relating to financial services; financial evaluations; administration of financial affairs; advisory services relating to (financial) risk management; advisory services relating to financial investment; advisory services relating to financial matters; advisory services relating to financial planning; agencies for the exchange of financial operations; financial appraisals for financial valuation; collection of financial information; conducting financial feasibility studies; consultation services relating to financial matters; economic financial research services; financial advisory services; financial advisory services for companies; financial advisory services for individuals; financial assessments; financial asset management; financial assistance; financial banking; financial brokerage; financial business appraisals; financial clearing house service; financial consultancy; financial consultation services; financial credit services; financial database services; financial economic advisory services; financial economic analysis; financial evaluation (insurance, banking, real estate); providing information, including online, about insurance, financial and monetary affairs and real estate affairs; provision of information relating to mortgages; provision of credit information; financial analysis; housing agency services; consultancy services relating to personal finance; consultancy services relating to investment; insurance advice; insurance consultancy; insurance information; insurance research; insurance services; information services relating to insurance; mortgage and savings services; provision of investment savings plans; savings account services; savings bank services; savings scheme services; advice regarding credit; advice regarding money lending services; advice relating to insurance; advice relating to investments; advice relating to loan recovery services; advice relating to mortgages for residential properties; financial advice; independent financial planning advice; provision of online financial calculators; advisory services relating to

investment finance; all the foregoing in the field of comparison and research services relating to a website and search engine for obtaining purchasing information, news, analysis, research and comparison information.

#### Class 38

Message storage and transmission (telecommunications); providing information, including online, about telecommunications; telecommunications; telecommunications advisory services; communication services for the transmission of information; advisory services relating to communications; electronic communication services; electronic transmission of data; web portal services (providing user access to a global computer network); providing on-line communications links which transfer the web site user to other local and global web pages; transmission of information on a wide range of topics, including online and over a global computer network.

#### Class 39

Advisory services relating to travel; provision of travel information; travel arrangement.

#### Class 41

Electronic desktop publishing; electronic publication of information on a wide range of topics, including online and over a global computer network; online (electronic) publication of news; providing online electronic publications (not downloadable); publication of electronic books and journals online; publishing by electronic means; education services; entertainment information; information services relating to education; information services relating to entertainment; sports information services; publication of educational texts; training; arranging and conducting of workshops (training); arranging and conducting of in-person educational forums; business educational services; educational seminars.

#### Class 42

Design of computer databases; compilation of data-processing programs; design services; provision of research services; research to develop new products; research and development of products; web site design; web site design consultancy; online provision of web-based applications (non-downloadable); development of software;



software as a service (saas); computer software design; computer software consultancy.

### **The Fourth Earlier Mark**

#### **Class 9**

Databases (electronic publications); electronic publications (downloadable); downloadable image files; apparatus for searching electronic information; directories (electric or electronic); computer databases; computer programs for use in database management; computer software; downloadable software applications (apps); data recorded electronically from the internet; computer programs (downloadable software); database programs.

#### **Class 35**

Price comparison services; price analysis services; pricing surveys; surveys (opinion polling); compilation of business information; compilation of commercial information; compilation of directories for publishing on the internet; compilation of information into computer databases; systemization of information into computer databases; commercial information services provided by access to a computer database; compilation of business data; advertising; advertising services provided over the internet; advertising services provided by television; advertising services provided via a data base; electronic advertising services; outdoor advertising services; press advertising services; promotional advertising services; direct marketing; marketing; marketing advisory services; marketing analysis; marketing information; planning of marketing strategies; product marketing; promotional marketing; promotional services; computerised database management; dissemination of advertising material; dissemination of business information; dissemination of commercial information; providing information, including online, about advertising, business management and administration and office functions; business advice; commercial information and advice for consumers (consumer advice shop); data management advice; management advice; arranging price quotations (for others); arranging subscriptions to telecommunication services (for others); classified advertising; collection of data; collection of information relating to advertising; collection of information relating to market analysis; collection of information relating to market research; compilation and provision of online directories; data search in computer files (for others); business

management advisory services; business management consultancy; business administration; administration of business affairs; office functions; commercial business management; sales promotions by issuing redeemable coupons (for others); business organization and management of discount services; discount services (retail, wholesale, or sales promotion services); organisation and management of discount card loyalty schemes.

### Class 36

Financial services; provision of information relating to financial services; financial evaluations; administration of financial affairs; advisory services relating to (financial) risk management; advisory services relating to financial investment; advisory services relating to financial matters; advisory services relating to financial planning; agencies for the exchange of financial operations; financial appraisals for financial valuation; collection of financial information; conducting financial feasibility studies; consultation services relating to financial matters; economic financial research services; financial advisory services; financial advisory services for companies; financial advisory services for individuals; financial assessments; financial asset management; financial assistance; financial banking; financial brokerage; financial business appraisals; financial clearing house service; financial consultancy; financial consultation services; financial credit services; financial database services; financial economic advisory services; financial economic analysis; financial evaluation (insurance, banking, real estate); providing information, including online, about insurance, financial and monetary affairs and real estate affairs; provision of information relating to mortgages; provision of credit information; financial analysis; housing agency services; consultancy services relating to personal finance; consultancy services relating to investment; insurance advice; insurance consultancy; insurance information; insurance research; insurance services; information services relating to insurance; mortgage and savings services; provision of investment savings plans; savings account services; savings bank services; savings scheme services; advice regarding credit; advice regarding money lending services; advice relating to insurance; advice relating to investments; advice relating to loan recovery services; advice relating to mortgages for residential properties; financial advice; independent financial planning advice; provision of online financial calculators; advisory services relating to investment finance.

### Class 38

Message storage and transmission (telecommunications); providing information, including online, about telecommunications; telecommunications; telecommunications advisory services; communication services for the transmission of information; advisory services relating to communications; electronic communication services; electronic transmission of data; web portal services (providing user access to a global computer network); providing on-line communications links which transfer the web site user to other local and global web pages; transmission of information on a wide range of topics, including online and over a global computer network.

### Class 39

Advisory services relating to travel; provision of travel information; travel arrangement.

### Class 41

Electronic desktop publishing; electronic publication of information on a wide range of topics, including online and over a global computer network; online (electronic) publication of news; providing online electronic publications (not downloadable); publication of electronic books and journals online; publishing by electronic means; education services; entertainment information; information services relating to education; information services relating to entertainment; sports information services; publication of educational texts; training; arranging and conducting of workshops (training); arranging and conducting of in-person educational forums; business educational services; educational seminars.

### Class 42

Design of computer databases; compilation of data-processing programs; design services; provision of research services; research into new products; research and development of products; web site design; web site design consultancy; online provision of web-based applications (non-downloadable); development of software; software as a service (saas); computer software design; computer software consultancy.