

O-388-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2482744  
BY INTERNET CHARGE BACK REGISTER LIMITED  
TO REGISTER THE TRADE MARK:**



**AND**

**IN THE MATTER OF OPPOSITION NO 98111 BY  
AMBERFIN LIMITED**

## TRADE MARKS ACT 1994

**In the matter of trade mark application no 2482744  
by Internet Charge Back Register Limited**

**and**

**In the matter of opposition no 98111  
by Amberfin Limited**

### **Background**

1. Amberfin Limited (“Amberfin”) opposes the registration of Internet Charge Back Register Limited’s (“Register”) trade mark application. Amberfin’s ground of opposition is under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on an earlier trade mark (UK Registration 2455856) of which it is the proprietor.
2. Register denies the ground on which the opposition is based.
3. Neither side filed evidence in support of its case. Neither side requested a hearing. Amberfin filed written submissions in lieu of attending a hearing, Register did not. I note, however, that Register made a number of submissions in its counterstatement when denying the ground of opposition; I will take this into account.

### **Register’s application**

4. Register’s application was filed on 18 March 2008. It has no international priority date. The mark was published in the Trade Marks Journal on 18 July 2008. The mark is depicted below:



5. The application relates to a range of goods and services in classes 9, 35, 36 & 38. However, the opposition is directed only at some of them, namely:

**Class 09:** Anti-theft warning apparatus; computer software, recorded; data media (magnetic); data media (optical); data processing equipment and computers; data recorded electronically from the Internet; data recorded in machine-readable form from the Internet; downloadable software programs (computer); electronic publications, downloadable; intercommunication apparatus; readers (data processing equipment);

transmitters of electronic signals; terminals for processing credit card transactions.

**Class 38:** Communications by computer terminals; electronic communications services relating to credit card authorization; providing access to databases; telecommunications.

### **Amberfin's earlier trade mark**

6. The mark was filed on 17 May 2007. It has no international priority date. The mark was published in the Trade Marks Journal on 11 January 2008 and it was subsequently registered on 18 April 2008. The mark consists of the letters iCR.

7. The relevance of the above dates are that: 1) Amberfin's mark has an earlier date of filing compared to that of Register's application and, therefore, it constitutes an earlier trade mark as defined by section 6(1) of the Act; 2) Amberfin's mark completed its registration procedure only three months before Register's mark was published, this means that the proof of use provisions contained in section 6A<sup>1</sup> of the Act do not apply; consequently, the earlier mark may be taken into account in these proceedings for its specification as registered, which reads:

**Class 09:** Video, audio, image and metadata (for video, audio or image), signal or file processing apparatus and software; electronic equipment, electronic networks, modules, circuit boards, integrated circuits, and software, all for use in the creation, management or delivery of terrestrial, cable, satellite, mobile, direct-to-home or Internet Protocol television; apparatus and software for use in the archiving, artefact-removal, asset-tracking, audio-embedding, audio de-embedding, broadcast, capture, channel-branding, closed captioning, colour-correction, colour-processing, colour-timing, communication, compression-decoding, compression-encoding, compression-transcoding, conversion, creation, cut-detection, delivery, de-spotting, dirt-removal, dust removal, digital rights management, display-processing, display, distribution, dropout-compensation, editing, effect-generation, encryption, exhibition, frame sequence detection, film-to-video transfer, flicker-reduction, filtering, grain reduction, ingest, keying, logo-generation, management, mastering, motion-compensation, motion-estimation, motion-measurement, motion-prediction, noise-reduction, packaging, picture-stabilisation, play-out, post-production, production, proxy-handling, publishing, recording, re-purposing, restoration, retrieval, scene change detection, serializing, de-serializing, scratch concealment, shooting, storage, sub-titling, teletext, thumb-nailing, timebase-correction, transcoding, trans-rating, unsteadiness-correction, watermarking, and weave-correction, of

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<sup>1</sup> Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

television, video, audio, audio-visual, film or multimedia material or content, digital intermediates thereof, or metadata associated therewith; accelerators; amplifiers; apparatus for recording, transmission or reproduction of sound, video or images; aspect-ratio-converters; circuit boards; colour correctors; computer accelerator boards; computer graphics boards; computer graphics software; computer hardware; computer interface boards; computer network hubs, switches and routers; computer programs for editing images, sound and video; computer software for use in relation to digital animation and special effects of images; computer software for use in the encryption and decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files; hardware and software for the repurposing of video content; converters; data compression software; decoders; demodulators; de-multiplexers; digital signal processors; digitizers; display cards; distributors; editors; electronic coding units; electronic control systems for machines; electronic controllers; electronic indicator panels; encoders; fibre optics; integrated circuit modules; integrated circuits; logo generators; mixers; monitors; multiplexers; noise reducers; pre-amplifiers; receivers; signal processors; software for processing images, graphics and text; standards converters, transmission apparatus; TV and video converters; video servers; video processors; all for use with television, film, video, image or audio signals or files, whether compressed, partially compressed or uncompressed; apparatus and software for the analysis, communication, conversion, formatting, generation, mapping, modification, playing, processing, storage, synchronisation, transmission, wrapping or unwrapping of television, video, audio, film, picture, test, multimedia, SDI, MPEG, metadata, MXF, or AAF signals, files or formats; apparatus and software for the analyzing, automation, backup and restore, controlling, disaster recovery, guiding, logging, measurement, monitoring, quality control, redundancy switching, securing, testing, or visualization of any of the foregoing; software, integrated circuits, circuit boards, modules, tapes, discs or spare parts for use with any of the foregoing.

## **Section 5(2)(b) - decision**

### **Legislation**

8. Section 5(2)(b) of the Act states:

“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.”

### **Case-law and the relevant factors**

9. The European Court of Justice (“ECJ”) has issued a number of judgments germane to this issue. These include: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). I will draw upon these judgments, where relevant, in the case before me.

10. It is clear, though, that the likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods/services are similar (and to what degree), other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor

because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods/services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

### ***The average consumer***

11. As matters must be judged through the eyes of the average consumer, I will begin with an assessment of this factor.

12. In relation to Register's opposed goods and services, it is fair to say that they are a mixed bag. I say this because there are some goods and services (e.g. terminals for processing credit card transactions and electronic communications services relating to credit card authorization) which are clearly specialist products/services where the average consumer will be a business user, particularly a business user operating in a retail or service environment where the processing of credit cards is required. Other goods, on the face of it, can also be said to be specialist in nature and used in the same environment (e.g. anti-theft warning apparatus), however, such goods would also extend to members of the general public for the protection of their own property. There are then goods and services (e.g. computer software (recorded), data processing equipment and computers, electronic publications (downloadable), telecommunication services) that could clearly be purchased or utilised by either a business user or by a member of the general public.

13. In its counterstatement, Register says that it provides goods and services concerned with the implementation and provision of money payment services and that evidence can be provided to support this. However, Register provided no evidence at all in support of its application and whilst some of the terms in its specification naturally reflects the area of trade it refers to, this is not the case with other terms. I also note that Register has not limited its specification, be it conditionally or otherwise.

14. The average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*). This general presumption (or at least the degree of care and attention likely to be utilised by the average consumer) can, however, change depending on the particular goods/services in question (see, for example, the decision of the CFI<sup>2</sup> in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In relation to the business user specialist goods/services, this strikes me as an appropriate circumstance where the average consumer would display a higher degree of care and attention than the norm. Such goods and services are unlikely to be low cost and, furthermore, they

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<sup>2</sup> The Court of First Instance of the European Communities

will represent an important choice because the reliability of the goods/services will be paramount to the average consumer's business running smoothly. This is an important point because this will mitigate, to some extent, against the concept of imperfect recollection due to the additional care and attention being used.

15. In relation to the goods where the average consumer could be the general public, the range of goods means that there will be varying levels of care and attention. For example, the purchase of a computer (a term covered by Register's specification) will be a more considered purchase than that of a downloadable electronic publication which will be a more casual purchase. I will take into account this range when considering whether there exists a likelihood of confusion.

16. In terms of the manner of purchase, no evidence has been provided to inform me as to how the goods/services are routinely selected. It seems reasonable to assume that selection could come from research on the Internet, reference to trade publications or other catalogues, or even, particularly in relation to the general public goods, from a shelf in a retail environment. Most of this suggests that the visual similarity of the marks will take on more significance, however, this does not mean that aural similarity should be ignored completely.

17. Amberfin's goods and services also represent a mixed bag. Some represent goods (such as network hubs) that could equally be used by a business user or by a member of the general public. Whilst many of the goods appear to have an element of video production/editing etc. to them and could be professional goods sold to businesses, such goods could just as easily be used by a member of the general public for use at home for home video editing/production purposes. I would say, though, that all the goods strike me as fairly technical ones and even though some may not be high in cost, the technical nature and the function they are intended to perform is likely to mean that the purchasing act will be more considered than the norm (although not of the highest degree). In terms of the manner of purchase, a variety of methods (as identified in the preceding paragraph) could be applicable.

18. Register also highlights that Amberfin's actual business is aimed at video production professionals, however, it has provided no evidence to that effect. In any event, Amberfin's earlier mark is not subject to the proof of use provisions. The goods must, therefore, be considered on a notional and objective basis based on their attributable meanings. The current marketing strategy of a proprietor is not relevant<sup>3</sup>.

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<sup>3</sup> See, for example, *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03*

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

19. There are number of factors to bear in mind when comparing the respective specifications. Firstly, in terms of words used in specifications, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>4</sup>. I must, though, bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>5</sup>. In relation to services, I must be conscious not to give a listed service too broad an interpretation as such terms should be limited to the substance or core of the possible meaning<sup>6</sup>.

20. Before assessing similarity, I will deal with where Amberfin considers there to be identical goods in play. In its written submission, Amberfin highlights which goods of the applied for mark it considers to be identical with goods covered by its earlier mark, namely:

- 1) Computer software, recorded; downloadable software programs (computer);
- 2) Data media (magnetic); data media (optical);
- 3) Data processing equipment;
- 4) Transmitters of electronic signals.

21. In terms of approach, if a terms falls within the ambit of another term, either way, then it must be regarded as identical (*Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*). This is the case even if the broader term is that of Register because, even though there may be goods within its broader term that may only be similar or potentially not similar at all, Register has not put forward any form of revised specification for consideration.

22. In relation to computer software/downloadable software programs (computer), Amberfin highlights that its specification includes various items of software. As such, it must be held that Register’s term includes identical goods to those of Amberfin.

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<sup>4</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>5</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>6</sup> *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16

23. In relation to data media (magnetic)/data media (optical), Amberfin highlights that its specification includes “tapes, discs for use with the foregoing”, the foregoing being the rest of its specification. Whilst the limitation to the foregoing of its specification gives such terms a more limited scope (compared to Register’s) such goods still strike me as data media, magnetic and optical respectively. As such, it must be held that Register’s term includes identical goods to those of Amberfin.

24. In relation to data processing equipment, Amberfin highlights that its specification covers:

“video, audio, image and metadata (for video, audio or image), signal or file processing apparatus”

and

“apparatus ...for..processing...of television, video, audio, film, picture, test, multimedia, SDI, MPEG, metadata, MXF, or AAF signals, files or formats”

25. The term data processing equipment strikes me as a broad term. It would cover various pieces of equipment that process data. There is no evidence to suggest how it is regarded by the trade or that it should be given a narrower definition compared to the plain understandable meaning. The goods in Amberfin’s specification it highlights consists of apparatus that process what appears to be a range of data. As such, it must be held that Register’s term includes identical goods to those of Amberfin.

26. In relation to transmitters of electronic signals, Amberfin highlights that its specification covers:

“apparatus for...transmission ...of sound, video or images; apparatus...for the transmission...of television, video, audio, film, picture, test, multimedia, SDI, MPEG, metadata, MX, or AAF signals, files or formats”.

27. There is no reason why the various items being transmitted under Amberfin’s goods could not be classed as electronic signals. The respective goods are both transmitters thereof. As such, it must be held that Register’s term includes identical goods to those of Amberfin.

28. Having concluded that the above goods are, indeed, identical, I turn to consider whether the remaining goods/services in Register’s specification are similar, and if they are, to what degree. The ECJ has provided guidance on the assessment of goods/services similarity. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated:

“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.”

29. In *British Sugar Plc v James Robertson & Sons Limited*, Jacob J also gave guidance on goods/services similarity and how this should be assessed. The factors he highlighted were:

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

30. In relation to having a complementary relationship (one of the factors mentioned in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*) I note the judgment of the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 where the CFI stated:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

31. The remaining goods and services in Register's specification that need to be assessed are:

Anti-theft warning apparatus; computers; data recorded electronically from the Internet; data recorded in machine-readable form from the Internet; electronic publications, downloadable; intercommunication apparatus; readers (data processing equipment); terminals for processing credit card transactions.

Communications by computer terminals; electronic communications services relating to credit card authorization; providing access to databases; telecommunications.

32. No evidence has been filed by either side as to the similarity, or otherwise, of the respective goods/services. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated:

"22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

The court required evidence of similarity to be adduced. This finding has been reiterated by the ECJ and the CFI<sup>7</sup>.

33. It may not always be practical to adduce evidence of similarity, for example, it may be that the nature of the goods/services is so well-known that it would be a waste of effort and resource to do so. However, beyond that type of circumstance evidence should be filed. Such an approach was advocated by Mr Hobbs QC (sitting as the Appointed Person) in *Raleigh International trade mark* [2001] R.P.C. 11 where he stated:

"If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22. Paragraph 23 of the Judgment in Canon indicates that it is appropriate to consider the pattern of trade with reference to factors such as those (uses, users and physical nature of the relevant goods and services; channels of distribution,

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<sup>7</sup> See, for example, *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-316/07

position in retail outlets, competitive leanings and market segmentation) identified by Jacob J. in *British Sugar Plc v James Robertson v Sons Ltd.* [1996] RPC 281 at 296, 297.”

34. On the basis of the above, my approach will be to go through Register’s terms and see if I can identify anything that is self-evidently similar. If I cannot find as much, my finding will be that there is no similarity. My findings are set out in the following table:

<b>Register’s term and my finding</b>	<b>Analysis</b>
Anti-theft warning apparatus.  <b>No similarity.</b>	I have gone through Amberfin’s specification and can find nothing remotely similar. Nothing has been brought to my attention by way of evidence or submission.
Computers.  <b>Highly similar.</b>	Amberfin has the broad and unqualified term “computer hardware” in its specification. A computer is, essentially, computer hardware and it could therefore be argued that such goods are identical. However, the submission is that they are similar, and given the relationship in terms of nature, purpose, channels of trade etc, I agree that they are highly so.
Data recorded Electronically from the Internet/data recorded in machine readable form from the internet”  <b>Not similar.</b>	Collins English Dictionary defines “data” as “information”. I note that Amberfin’s specification is predominantly concerned with apparatus and software that process certain electronic file formats (video, audio etc), therefore, it is possible that such file formats could contain “data”. However, even if this is the case, the purpose of data itself is not the same as the software and apparatus used for handling or processing it. The nature is also likely to be different as are the users. Absent any evidence to the contrary, I do not regard these goods as similar to anything covered by Amberfin’s specification.
Electronic publications (downloadable)  <b>Not similar.</b>	I can see no similar term in Amberfin’s specification. In the absence of anything highlighted by Amberfin my finding is that there is no similarity here.

<p>Readers (data processing equipment).</p> <p><b>Highly similar.</b></p>	<p>Although there is no evidence to inform me as to what a “reader” is, it is, nevertheless, qualified as being a piece of data processing equipment. Given that Amberfin’s specification includes apparatus for processing various data (video, audio, image, metadata) then I have little option other than to conclude that the goods are highly similar.</p>
<p>Terminals for processing credit card transactions.</p> <p><b>Not similar.</b></p>	<p>This is a specific device used by retailers and service providers to handle credit card payments. There is nothing so specific in Amberfin’s specification that can be considered as similar. Even taking into account its broad terms (such as computer hardware and various data processing equipment) and even taking into account that a terminal could have an element of computation, or that it could be said to process data (credit card data) I do not consider that such a definition would be the manner in which the trade would regard them. No evidence has been filed to offset this doubt. I, therefore, do not consider there to be any similarity here.</p>
<p>Telecommunications</p> <p><b>A moderate degree of similarity</b></p>	<p>Register cites the judgment of the CFI in case T-336/03 <i>Les Editions Albert Rene v OHIM</i> ecr ii-4777. I note this, but I also note that the CFI’s judgement was made against the backdrop that the goods of the earlier mark related to the trade sectors of “photography, cinema, optics, teaching and video games” and not “telecommunications”.</p> <p>By contrast, I note that Amberfin’s specification includes various electronic equipment that enables delivery of electronic information (e.g. “electronic equipment” and “electronic networks” for use in “delivery of terrestrial cable, satellite, mobile, direct to home or Internet Protocol television” and apparatus for transmission of sound, video or images). Its specification also includes specific types of electronic products used for electronic communication purposes e.g. network hubs, switches and routers. I see no reason why such goods would not be regarded as telecommunication apparatus and, therefore, why there would not be a complementary relationship with a telecommunication service provider. Neither would operate without the other (so meeting the important/indispensable test) and it seems to me that a supplier of a telecommunication service could also</p>

	supply its own branded equipment for use in the use of its service. I consider there to be a moderate degree of similarity here.
Communications by computer terminals.  <b>A moderate degree of similarity.</b>	Amberfin's specification covers computer hardware including specific devices which computers use for communication (such as network hubs, switches, routers). As with the preceding category, a service provider offering this service may well offer an associated router or other networking device to facilitate the service which it considers the best in terms of interoperability. As above, there is a moderate degree of similarity.
Intercommunication apparatus  <b>Highly similar.</b>	As identified above, Amberfin's specification covers goods used for communication between computers and for telecommunication purposes. Intercommunication apparatus could take the form of such goods when one considers that this could relate to intercommunication between computers. If they are not identical (that is not claimed) then they must, at the least, be highly similar.
In relation to electronic communications services relating to credit card authorization  <b>No similarity.</b>	As with terminals for credit card processing, this seems a specialist service for retailers and service providers. I have already found in relation to the goods that there were no similar terms in Amberfin's specification so I do not consider it to be in any better position here.
Providing access to databases  <b>No similarity.</b>	Computers and computer hardware enables a user to make use of a service which provides them with access to a database. However, this strikes me as a stand-alone service and I see no reason to assume that a service provider would offer a particular piece of equipment to facilitate this. The normal communication devices of a computer would normally be sufficient to do so. Therefore, although there may be a degree, one way, of complementarity, in that the service cannot be utilized without computer equipment, the second aspect of complementarity is not present in terms of the average consumer believing the responsibility of the equipment was that of the service provider.

35. As can be seen from the above, the following goods were not found to be similar to anything in Amberfin's specification. It is a prerequisite for a finding under section 5(2) for there to be similarity between the respective goods and services<sup>8</sup> and, therefore, the opposition is dismissed in so far as it relates to:

Anti-theft warning devices;

Data recorded electronically from the Internet

Data recorded in machine-readable form from the internet;

Electronic publications, downloadable;

Terminals for processing credit card transactions;

Electronic communications services relating to credit card authorization.

36. For the goods and services found to be identical or similar, I will go on to consider the rest of the relevant factors and whether these factors combine to create a likelihood of confusion.

### ***Comparison of the marks***

37. When comparing the respective marks there are a number of factors to consider. Firstly, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The analysis must be conducted with reference to the visual, aural and conceptual similarities by reference to the overall impressions created by the marks, but bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). In relation to composite marks, the overall impression conveyed to the average consumer may, in certain circumstances, be dominated by one or more of its components (*Matratzen Concord v OHIM - Case C-3/03P*) 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 element (*Shaker di L. Laudato & C. Sas v OHIM – Case C-334/05*). The marks to be compared are:

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<sup>8</sup> See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

Register's mark:



Amberfin's mark

iCR

38. In terms of dominant and distinctive elements, the letters in Amberfin's mark will not be split up and will not be considered as separate elements. They will be seen and spoken as a single string of letters "iCR". This is the only element and, therefore, the dominant and distinctive element in the mark.

39. In terms of Register's mark, there is a dispute between the parties on what the dominant and distinctive elements are. Amberfin says that the letters "icr" is the dominant and distinctive element given that it is the most prominent and that the word element "internet chargeback register" merely informs the consumer what the "icr" element relates to. It also highlights the logo which starts at the bottom of the letter "r", but suggests that this provides a circle around the letters which actually brings more focus to them. It also highlights that the dot above the letter "i" in the mark consists of a small letter "e", but that this is not dominant.

40. Register highlights the same elements as Amberfin but suggests that the letters "icr" cannot be the dominant and distinctive element. It highlights that there are a number of other marks on the register that consist of the letters ICR and suggests, therefore, that such common use means that this cannot constitute the dominant element. It draws an analogy with the judgment of the CFI in *Jose Alejandro SL v OHIM* (case T-129/01) which suggests the same regarding a descriptive element (although Register does not say that the term ICR is descriptive but merely commonly used).

41. Register claims that the letters "icr" cannot be a dominant and distinctive element because of commonality of use, yet it has filed no evidence in the proceedings. This claim cannot, therefore, stand. Providing mere examples from the register is not relevant as it tells me nothing about how the average consumer will view matters<sup>9</sup>. Whilst I agree with Registrar's further submission that there

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<sup>9</sup> See *British Sugar Plc v James Robertson & Sons Limited*

are other elements in its mark which are not negligible in its overall impression, and, thus, it is still a whole mark comparison that is required (see *Shaker di L. Laudato & C. Sas v OHIM*), my view is that the letters “icr” in its mark will be seen as the dominant and distinctive element given its construction and impact (including distinctive impact) on the average consumer.

42. In terms of visual similarity, the fact that the dominant and distinctive elements of the respective marks are so similar (icr/iCR”) means that there is, inevitably, a strong degree of similarity. The presentational difference in Register’s mark together with its additional wording does create a difference, but not so much so as to reduce what I regard as a strong degree of visual similarity between the marks as a whole.

43. In terms of aural similarity, the analysis is similar. The dominant and distinctive elements of the respective marks will be pronounced in exactly the same way. Even if the words “internet chargeback register” were to be pronounced when Register’s mark is spoken, the ICR element will be spoken first and will be regarded as the more distinctive element indicating origin.

44. In terms of concept, Amberfin agrees (with Register) that Register’s mark may be given context by the inclusion of the words “internet chargeback register” but argues that this does not avoid confusion. Register highlights this concept (of an internet charge back register) and argues that this is a relevant factor. In *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally

different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

45. I can see no meaning, let alone one capable of immediate grasp, that the average consumer will take from Amberfin’s mark. In relation to Register’s mark, whilst it is true that the presence of the additional wording may give the letters some context, it seems to me that the letters “icr” will still be stored away by the average consumer as those letters and, therefore, whilst there may be context, I do not see how this will create any significant counteraction to the visual and aural similarity.

46. Taking all of the above into account, it seems to me that the net effect of assessing the visual, aural and conceptual aspects of the respective marks is that the degree of similarity between them is reasonably high.

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

47. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view, Amberfin’s mark is simply made up of the letters iCR. There is no evidence to suggest that these words have any particular meaning or that they are an abbreviation of a known series of words. There is, therefore, nothing suggestive in the construction of the mark. All things considered it has, at the least, a reasonable degree of inherent distinctiveness. The only reason I fall short of saying that the mark is highly distinctive per se is that consumers are often faced with strings of letters which may or may not mean something and, furthermore, their inherent quality does not make them the most memorable of signs.

48. There is no evidence filed to show what use, if any, has been made of the mark. Enhanced distinctiveness cannot, therefore, be considered.

### ***Likelihood of confusion***

49. As stated earlier, the relevant factors have a degree of interdependency and a global assessment must be made when determining whether there exists a likelihood of confusion. However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether these factors result in a likelihood of confusion.

50. In terms of confusion, this can take the form of direct confusion (effectively mistaking one mark for the other) or indirect confusion (where the average consumer, even though they may notice that the marks are different, will believe that the goods are the responsibility of the same or an economically linked undertaking – see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). I note,

though, that mere association in the sense that one mark may bring the other to mind is not sufficient (*Sabel BV v Puma*).

51. In view of the interdependency principle, I will deal firstly with those goods I found to be identical or highly similar, namely:

- 1) Computer software, recorded; downloadable software programs (computer); *identical*
- 2) Data media (magnetic); data media (optical); *identical*
- 3) Data processing equipment; *identical*
- 4) Transmitters of electronic signals; *identical*
- 5) Readers (data processing equipment); *highly similar*
- 6) Computers; *highly similar*.
- 7) Intercommunication apparatus; *highly similar*

52. In relation to identical goods, Register's greatest prospect of success (in avoiding a likelihood of confusion) must lie with goods such as data processing equipment and transmitters of electronic signals and computer software. I say this because, as identified earlier, these are the sorts of goods that a higher degree of care and attention will be paid during the purchasing process which, in turn, will mitigate, to some extent, against the significance of imperfect recollection. Despite this, it seems to be that the sharing of such a similar distinctive and dominant element consisting of identical letters (albeit with differing type case), notwithstanding the presentational differences and additional wording, must result in the average consumer putting this down to economic connection. I struggle to see what else this would be put down to. Even the most attentive of average consumers who may notice and observe the key differences between the marks, will put the key similarity down to economic connection. Register is in no better position regarding the other identical goods (data media), in fact, it is in a worse position because only a reasonable degree of attention is being displayed and, therefore, the concept of imperfect recollection creates an even stronger finding of confusion. There is a likelihood of confusion in relation to identical goods. In relation to the highly similar goods (readers, computers, intercommunication apparatus) I extend the same finding, for similar reasons.

53. That leaves me to consider the services which I have found to be moderately similar, namely:

- 1) Telecommunications

2) Communications by computer terminals.

54. The respective marks are highly similar. The goods/services moderately so but there is key complementary relationship. The earlier mark has a reasonable degree of distinctive character. Balancing all the relevant factors, it, again, seems to me that the average consumer will put the shared dominant and distinctive element down to economic connection as opposed to coincidence. There is a likelihood of confusion.

### **Summary of conclusions**

55. The opposition succeeds in relation to:

Class 9: Computer software, recorded; downloadable software programs (computer); data media (magnetic); data media (optical); data processing equipment and computers; transmitters of electronic signals; readers (data processing equipment); intercommunication apparatus.

Class 38: Communications by computer terminals; telecommunications.

56. But fails in relation to:

Class 9: Anti-theft warning devices; data recorded electronically from the Internet; data recorded in machine-readable form from the internet; electronic publications, downloadable; terminals for processing credit card transactions.

Class 38: Electronic communications services relating to credit card authorization; providing access to databases.

57. None of this, of course, affects the goods/services that were not the subject of the opposition.

### **Costs**

58. Both sides have achieved a measure of success. In view of this, I do not propose to favour either of them with an award of costs.

**Dated this 16 day of December 2009**

**Oliver Morris  
For the Registrar  
The Comptroller-General**