

O-479-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2616188
BY BUBBLE CARD LIMITED
TO REGISTER:**



&



**AS A SERIES OF 2 TRADE MARKS IN CLASSES
9, 16, 35, 36, 38 & 42**

AND:

**OPPOSITION THERETO UNDER NO. 103738
BY O2 HOLDINGS LIMITED**

BACKGROUND

1. On 30 March 2012, Bubble Card Limited (“the applicant”), applied to register the series of 2 marks shown on the cover page of this decision in classes 9, 16, 35, 36, 38 and 42. The application was accepted and published for opposition purposes on 25 May 2012. On 18 April 2013, the applicant restricted its goods and services in classes 9 and 38. The full list of goods and services now reads as follows:

Class 9 - Software relating to the organisation, operation and supervision of a loyalty card franchise scheme; electronic marketing material; application software; mobile phone application software; software in the nature of a mobile device applications for receiving, transmitting and displaying vouchers and receiving and transmitting data for the purchase of goods and services; software in the nature of a mobile device application providing consumers with information regarding discounts, vouchers and special offers for the goods or services of others; software for displaying and sharing the location of users and for searching, locating and interacting with other users and places; computer application software, namely, downloadable mobile application for smartphones to facilitate financial transactions and social networking by use of location based data; parts and fittings for all the aforesaid goods.

Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter and publications; printed marketing material, books, cards, catalogues, programmes, writing paper, envelopes, pads, notebooks, greeting cards, magazines, pens, pencils, postcards, posters, stickers, tickets, beer mats; coasters of paper and cardboard, brochures and pamphlets; printers' type; printing blocks; stationery and printed forms, book binding material; photographs; stationery; adhesives for stationery; plastic materials for packaging (not included in other classes); training materials; instructional and teaching material; instructional and teaching material for use in connection with operating and franchising a loyalty card scheme; directories; reports; briefings; office requisites; booklets; books; writing pads; writing articles; photographs; seat and admission tickets for concerts, films, shows, sporting events, festivals, nightclubs, discotheques, live performances and other forms of entertainment; Membership cards; Discount cards; Loyalty cards; vouchers; gift vouchers; coupons; tokens; savings stamps; handbooks; diaries; wall charts; guide books; calendars; posters; leaflets; badges; pens; printed matter and promotional materials; parts and fittings for all the aforesaid goods.

Class 35 - Advertising, marketing and business promotion services; market research and information services; promoting the goods and services of others; promotion of retail outlets; promotion of brands; promotion of entertainment service providers; promotion of entertainment venues; retail services connected with the sale of clothing; retail services connected with the sale of tickets; promotion of events; promotion of entertainment events; promotion of nightclubs; promotion of nightclub and discotheque events; promotion of shopping events;

promotion of sporting events; promotion of musical concerts; on-line retail services connected with the sale of tickets; on-line retail services connected with the sale of clothing; Advertising; classified advertising; advertising services provided via the internet; dissemination of advertising for others via the internet; advertising namely, online and offline advertising for affiliate retailers offering voucher codes, offers and discounts on products and services; promotional services; promoting the goods and services of others; providing an online directory information service featuring classifieds; data processing and distribution of business information; sales incentive schemes; on-line business administration and supervision of a discount, special offer and gift voucher scheme; operation of incentive and loyalty schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; promotion and advertising of retail services connected with the sale of clothing, travel services, financial services, health and beauty goods and services, sports and leisure goods and services, restaurant services, food, entertainment, business, utilities, phones and internet; marketing; mobile marketing; analysis relating to marketing; marketing reports; compilation of business data; compilation of information into computer database; employment agency services; recruitment services; consultancy services; provision of business information relating to employment, recruitment and jobs; Publishing and advertising job vacancies on any medium including the Internet; the provision of jobs boards on the Internet or other computer network; arranging and conducting seminars and exhibitions for business purposes; organisation, arrangement of and conducting exhibitions and fairs for commercial or advertising purposes; production of advertising matter; rental of advertising space; arrangement of advertising; arranging the distribution of advertising space and samples; classified advertising; graphic advertising services; leasing of advertising space; sales of advertising space; business administration services; advertising via mobile communication networks; compiling, systemisation promotional offers, printable vouchers, coupons and others tokens of value, into computer databases; operation and supervision of incentive scheme in the form of offering discount and promotional offers, voucher codes, gift codes and claim codes; advertising of the goods or services of other vendors; compilation of advertisements for use as web pages on the Internet and via mobile communications; dissemination of advertising for others via the Internet; on-line marketing and promotional services accessible via mobile communications; compilation of adverts for use on web based maps accessible via the Internet and mobile communications; Organisation, operation and supervision of a loyalty card and incentive scheme; business services rendered or associated with operating, supervising and franchising a loyalty card scheme, magnetic cards, magnetic data carriers, cash registers, calculating machines, data processing equipment and computers, computer hardware, computer software, computer software downloadable from the Internet; business advice services relating to operating and franchising a loyalty card scheme, computer software recorded onto CD Rom and SD-Cards (secure digital cards); computerised data verification; on-line data processing services; market research data collection services; interpretation and analysis of

market research data; information, consultancy and advisory services for all the aforesaid services; information and consultancy services relating to the aforesaid, information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services.

Class 36 - Financial affairs; Monetary affairs; issuing of vouchers; financial services relating to the provision of vouchers for the purchase of goods and services; computerised financial data services; electronic payment services; automated payment of accounts; payment administration services; issuing gift vouchers; issuing of a variety of vouchers enabling customers to purchase goods and services on an Internet website and by telecommunication means; Credit card and charge card services; financial loyalty programmes offered to credit and charge card customers; fund raising for charity; information, consultancy and advisory services for all the aforesaid services.

Class 38 - Transmission of electronic vouchers via mobile devices and the internet.

Class 42 - Computer services relating to franchising and loyalty card schemes; maintaining and hosting a website relating to the franchising and operation of loyalty card schemes; design services; Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; maintaining websites; application service provider (ASP); application service provider (ASP) featuring software for receiving, transmitting and displaying vouchers and receiving and transmitting data for the purchase of goods and services; application service provider (ASP) featuring software for providing consumers with information regarding discounts, vouchers and special offers for the goods or services of others; application service provider services regarding social networking software; provision of an Internet platform for social networking services; hosting of digital content online; hosting a website that features technology that enables the donation of money and gifts to charitable organisations; information, consultancy and advisory services for all the aforesaid services.

2. The application is opposed by O2 Holdings Limited (“the opponent”). The opposition, which is directed against all of the goods and services in the application, is based solely upon a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which the opponent relies upon all of the goods and services in 16 of its trade mark registrations. These registrations fall into 3 categories i.e. the word only mark THE BUBBLE, the word only mark O2 BUBBLE and a range of device marks which the opponent describes as “its BUBBLE devices”. In its notice of opposition the opponent states:

“2. The opponent owns a wide range of prior registrations for its trade marks including the word BUBBLE and its distinctive BUBBLE devices. [The application] is visually, aurally and conceptually very similar to the opponent’s earlier marks.

3...[The goods and services covered by the application] are identical to the goods and services covered by the earlier rights owned by the opponent. [The goods and services covered by the application] are also at least very similar to the other goods and services owned by the opponent...”

3. The applicant filed a counterstatement in which the ground of opposition is denied. In its counterstatement, the applicant sets out the background to its business and choice of mark. In relation to the latter it states:

“1...The business has been established by a graduate entrepreneur to offer a new student lifestyle card providing discounts and special offers on products and services through retailers and outlets which are signed up to the scheme. As well as a card and associated website to search for offers, the business has developed a phone app to provide the same information on the move...

2. The choice of brand comes from Loughborough where the concept of the student bubble refers to everything from the town itself to student life in general.”

In relation to the categories of marks upon which the opponent relies, the applicant states:

“6...The opponent’s earlier trade marks consist of a variety of very broad lists of goods and services, mainly being akin to class headings and for areas in which the opponent is not known to operate...

7. Dealing first with the comparison between the application and the opponent’s registrations for THE BUBBLE, it is considered that when the marks are compared as a whole, in particular taking into account the distinctive logo which forms part of the application and the positioning of the word bubble within the application, in comparison with the opponent’s THE BUBBLE, the emphasis on the spoken elements of the marks, the word bubble appearing at different points where there will be different emphasis, and the impression which is left, are wholly distinct from each other, and that when the marks are compared as a whole there is no real likelihood of confusion.

8. When comparing the application and the opponent’s earlier trade mark O2 BUBBLE, it is clear that the well known and distinctive O2 trade mark is the distinctive and distinguishing element of the opponent’s trade mark and when compared as a whole to the application that there is no real likelihood of confusion given the focus and initial emphasis on the O2 element incorporated within the opponent’s registration.”

4. Insofar as the opponent's earlier device marks are concerned, having noted how many of them are classified using the Vienna Classification system, the applicant states:

"9...It is therefore apparent that the perception of the opponent's bubble devices are not necessarily or automatically as bubbles. Furthermore, the opponent's bubble devices consist of other matter within the images covered by the registrations and in many cases are in colour...Indeed, in the case of some of the opponent's bubble devices the perception and image brought to mind would not necessarily be bubbles but more water droplets or spilled water....It is considered that with the requirement for the average consumer to perceive the images as being specifically just bubbles and then comparing this against the application with its overall different imagery that there is no likelihood of confusion..."

5. Having identified a range of goods and services in classes 16, 35, 36 and 38 which it considers are not identical to the opponent's goods and services, the applicant states that given the lack of specificity in the notice of opposition, it is unable to respond to the opponent's allegation that the competing goods and services are "at least very similar". Finally, the applicant states:

"12. It is also noted that the opponent does not have exclusivity in bubble trade marks on the UK Trade Marks Register and that there are a large number of proprietors who own bubble trade marks in the various classes covered by the opponent's registrations. It is therefore considered that the scope of the opponent's claimed distinctive rights should be viewed accordingly and in a narrow context."

6. Whilst not abandoning any of its earlier rights, in his skeleton argument and at the hearing, Mr Stobbs indicated that insofar as the opponent's case based upon its word only marks is concerned, CTM no. 5583646 for the words THE BUBBLE offered it its best prospect of success. That trade mark was applied for on 14 December 2006 and completed its registration procedure on 16 June 2011. It is registered in a wide range of classes which includes the following:

Class 9 - Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDA's (Personal Digital Assistants), pockets PC's, mobile telephones, laptop computers; telecommunications network apparatus; drivers software for

telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; computer software onto CD Rom, SD (secures digital) card; optical apparatus and instruments; glasses, spectacle glasses, sunglasses protective glasses; cameras; camera lenses; contact lenses; parts and fittings for all the aforesaid goods.

Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

Class 35 - Advertising; business management business administration; office functions; retail and wholesale services relating to bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting, common metals and their alloys, metal building materials, transportable buildings of metal, materials of metal for railway tracks, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, pipes and tubes of metal; safes, goods of common metal, ores, badges of metal for vehicles, metal badges (not for wear), signs, hand tools and implements (hand operated), cutlery, side arms, razors, electric and non-electric depilation appliances, shaving blades, shaving cases, razor cases, manicure sets, pedicure sets, clippers for personnel use, nail files, scissors tongs, tweezers, curlers; hair trimmers, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer software, computer software downloadable from the Internet, PDA's (Personal Digital Assistants), pockets PC's, mobile telephones, laptop computers; telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, computer software onto CD Rom, SD (secures digital) card; optical apparatus and instruments, glasses, spectacle glasses, sunglasses protective glasses, cameras, camera lenses, contact lenses, parts and fittings for all the aforesaid goods, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones,

horological and chronometric instruments, keyrings, cufflinks, paper, cardboard and goods made from these materials, printed matter, book binding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging, printers' type, printing blocks, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, household or kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, brushes (except paint brushes), brush-making materials, articles for cleaning purposes, steel wool, un-worked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, textiles and textile goods, bed and table covers, clothing, footwear, headgear, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder; salt, mustard, vinegar, sauces (condiments), spices, ice, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, tobacco, smokers' articles, matches; business management relating to broadcasting stations; telecommunications installations; provision of information relating to the aforesaid.

Class 36 - Insurance; financial affairs; monetary affairs; real estate affairs; payment processing; online payment processing; information services relating to finance, monetary affairs and real estate affairs; information and advisory services relating to the aforesaid.

Class 38 - Telecommunications; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line, telecommunication services, provision of broadband telecommunications access; broadband services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging service; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid.

Class 42 - Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services; IT services; computer programming services; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; computer rental; computer software design; installation of computer software;

maintenance of computer software; updating of computer software; rental of computer software; computer system design; computer systems analysis; consultancy in the field of computer software; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites); services of engineers; researches in matter business legal protection (technical and legal); technical consulting and expert activities; rental of data processing apparatus and computers; management and use of copyright; applying business property right; projection and planning of equipment for telecommunication; services of network operating company, information broker and providers, handling and rental of access time for data networks and data banks, Internet; services of database; weather forecasting; arbitration services; research of field telecommunication technology; information and advisory services relating to the aforesaid.

7. In relation to its opposition based upon its registered device marks, Mr Stobbs identified CTM nos. 8128035 and 8110298 as representing the opponent's best prospect of success. The first of these marks was applied for on 27 February 2009 and completed its registration procedure on 22 November 2009. It is registered in, inter alia, classes 9, 35, 36, 38 and 42. The representation of the first of these marks is as follows:



8. The second mark identified by Mr Stobbs (which claims the colours blue and white) was applied for on 18 February 2009 and completed its registration procedure on 15 September 2009. It too is registered for goods and services in, inter alia, classes 9, 16, 35, 36, 38 and 42. The representation of the mark is as follows:



9. Only the applicant filed evidence. A hearing took place before me on 14 October 2013, at which the opponent was represented by Mr Julius Stobbs of Stobbs IP; Mr Sam Gould (a shareholder in the applicant) made submissions on its behalf.

The applicant's evidence

10. This consists of three witness statements. The first, which is accompanied by 12 exhibits, is from the applicant's Managing Director Jack Jenkins and shows, inter alia, how the mark the subject of the application has been used. This statement provides a chronology of the development of the applicant since its incorporation in February 2012. As Mr Stobbs pointed out in his skeleton argument and as I explained to Mr Gould at the hearing, as the opponent has not filed any evidence in these proceedings (and even if it had, as all of the applicant's evidence relates to activities which took place just prior to or after the material date of 30 March 2012), Mr Jenkins' evidence does not assist the applicant. There is, as a consequence, no need for me to summarise it here.

11. The second statement is from Timothy Evans who was employed by the applicant as a sales representative until 21 December 2012. The content of his statement (which recounts a conversation which took place between him, a colleague and a person managing the O2 stand at a Fresher's Fair held at the Royal Welsh College of Music and Drama in the week commencing 24 September 2012) is, once again, after the material date and not germane to the issues before me.

12. The final statement is from Michelle Ward, a trade mark attorney at Urquhart Dykes & Lord LLP, the applicant's professional representatives at the time the statement was filed. Attached to her statement are four exhibits. Exhibit MW1 consists of a search conducted on the website of the UK IPO on 17 April 2013: "against live trade marks incorporating the string bubble" in the classes for which registration is sought. Exhibit MW2 consists of full printouts of the marks listed in exhibit MW1 where the status is shown as registered, protected, opposed, examination or application published. Exhibit MW3 is a screen print obtained from the website of the World Intellectual Property Organisation on 17 April 2013. Ms Ward explains that the printout shows the meanings of the Vienna Classification codes 1.15.11, 1.15.15 and 1.15.21: "being the device classification codes allocated to the opponent's earlier registrations relied upon in these proceedings". I note that section 1.15 is entitled "Natural Phenomena" with codes 1.15.11, 1.15.15 and 1.15.21 entitled: "Clouds, fog, vapour, smoke", "Drops" and "Bubbles, frothy masses, including speech bubbles" respectively. Exhibit MW4 is a screen print obtained on 17 April 2013 from the website of protectyourbubble.com, which Ms Ward notes is one of the marks revealed by her search.

DECISION

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

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

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

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

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. In these proceedings, the opponent is relying upon the 16 trade marks referred to in paragraph 2 above, all of which constitute earlier trade marks under the above provisions. Given the interplay between the date on which the application was published and the dates on which the opponent’s trade marks completed their registration procedure, the earlier trade marks are not, with the exception of UK no. 2417895F, subject to proof of use, as per section 6A of the Act. As the opponent has not provided any evidence in these proceedings, and as Mr Stobbs acknowledged in his skeleton argument, the UK mark identified above cannot, as a consequence, be taken into account. In paragraph 6 above, I highlighted the word only mark Mr Stobbs identified as providing the opponent with its best prospect of success; I agree that insofar as its word only marks are concerned, CTM no. 5583646 represents the opponent’s strongest case and it is this mark upon which I will base my comparison. As to the opponent’s best case based upon its device marks, and notwithstanding that the opponent also owns a number of other device mark registrations on a similar theme, I will, should it prove necessary, base my comparison on those marks identified by Mr Stobbs and mentioned above.

Section 5(2)(b) – case law

16. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this

section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 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; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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


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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade. In view of the wide ranging and disparate nature of the goods and services at issue in these proceedings, it was agreed at the hearing that the average consumer will vary as will the nature of the purchasing process. That being the case, it was further agreed that there was little to be gained in conducting a detailed analysis in this regard. I will, as I explained at the hearing, deal with the average consumer when I come to consider the likelihood of confusion.

Comparison of marks

| The opponent’s mark (best case – word only) | The applicant’s marks |
|--|---|
| THE BUBBLE |  |

18. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must

compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective trade marks.

Distinctive and dominant components

19. The opponent's mark THE BUBBLE is presented as two separate words in upper case. BUBBLE is an English language word the meaning of which will be well known to the average consumer. The opponent argues that the word THE in its mark "is itself inherently devoid of distinctive character"; I agree. As far as I am aware, the word BUBBLE is neither descriptive of, nor non-distinctive for, inter alia, the goods and services in classes 9, 16, 35, 36, 38 and 42 upon which the opponent relies in these proceedings. It is the word BUBBLE which is the distinctive and dominant element of the mark.

20. The application consists of a series of two marks. Although the first mark in the series is presented in light blue and the second in white against a dark blue rectangular background, as the opponent's mark is presented in black and white, the colours in the applicant's marks, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1, do not assist in distinguishing the competing marks; I shall, therefore, conduct the comparison on the basis of the first mark in the series.

21. The applicant's mark consists of two elements. The first is an incomplete circular device from which the stylised letters BC (stemming no doubt from the words BubbleCard) have been formed. To the bottom left of this device (but still forming part of the first element of the mark) are two further circular devices one of which is approximately twice the size of the other. At the hearing, Mr Stobbs argued that these circular devices will be seen as bubbles; given the inclusion in the applicant's mark of the word Bubble, this is not, in my view, an unreasonable submission. This first element is both a distinctive and independent element of the applicant's mark.

22. The second element in the mark consists of the words Bubble and Card presented as separate words in title case in a slightly stylised font. In his skeleton argument, Mr Stobbs argued that: "the word card is descriptive in the context of the majority of the goods and services of interest to the applicant (where they offer a loyalty scheme where all of their services appear to be related to a loyalty card)". Bearing in mind the applicant's own description of its business contained in its counterstatement (see paragraph 3 above), I am inclined to agree that, in the context of many of the goods and services for which registration is sought, the word Card will be considered descriptive. However, even in circumstances where the word Card is not directly descriptive, as a word whose meaning will be well known to the average consumer it is, when considered in the context of the applicant's description of its business, I think, likely to lack distinctive character. In those circumstances, in my view, the word Bubble is an independent and distinctive element of both the second element in the applicant's mark

and the mark itself. Considered overall, the device and word elements are equally dominant within the mark.

Visual similarity

23. The distinctive device element present in the applicant's mark is completely alien to the opponent's earlier mark. As the only point of visual similarity between the competing marks is the presence in both of the word BUBBLE/Bubble, this creates, in my view, only a moderate degree of visual similarity between them.

Aural similarity

24. It is well established that where a mark such as the applicant's contains both a device and word element, it is by the words that the average consumer is most likely to refer to the mark. Although the words THE and Card provide points of aural difference, as both marks will be articulated as three syllables (two of which involve articulating the identical word BUBBLE), there is, in my view, a fairly high degree of aural similarity between them.

Conceptual similarity

25. In my view, the opponent's mark is likely to create a conceptual image in the mind of the average consumer of either a single bubble, or where emphasis is placed on the word THE, the best or most notable bubble. Insofar as the application is concerned, the combination Bubble Card, in my view, is unlikely to create any concrete conceptual picture in the average consumer's mind. However, as the presence of the word Bubble (and to a much lesser extent the two circular devices which may, given the totality of the applicant's mark, be construed as bubbles) will also bring to the average consumer's mind the concept of Bubbles, I consider the competing marks are conceptually similar to a high degree.

Comparison of goods and services

26. I have outlined the competing specifications above; I do not intend to repeat them both here. However, for the sake of convenience, I will reproduce the applicant's specifications by class and indicate with which of the opponent's goods and services (if any) I consider them to clash.

27. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

28. At the hearing, I explained to Mr Gould the principles outlined in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, in which the GC stated:

"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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

29. In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“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 (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

In reaching a conclusion, I will also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test when considering complementarity.

30. Finally, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 are also relevant:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Class 9

31. The applicant’s specification in this class reads:

Class 9 - Software relating to the organisation, operation and supervision of a loyalty card franchise scheme; electronic marketing material; application software; mobile phone application software; software in the nature of a mobile device applications for receiving, transmitting and displaying vouchers and receiving and transmitting data for the purchase of goods and services; software in the nature of a mobile device application providing consumers with information regarding discounts, vouchers and special offers for the goods or services of others; software for displaying and sharing the location of users and for searching, locating and interacting with other users and places; computer application software, namely, downloadable mobile application for smartphones to facilitate financial transactions and social networking by use of location based data; parts and fittings for all the aforesaid goods.

The applicant’s goods in this class break down into three distinct areas i.e. a range of software for various purposes, electronic marketing material and parts and fittings for

these goods. The opponent's specification in this class includes "computer software" at large, which, on the principles outlined in *Meric*, is identical to the applicant's software for specific purposes. The opponent's specification in this class also includes the identically worded phrase "parts and fittings for all the aforesaid goods". That leaves "electronic marketing material". At the hearing, Mr Stobbs argued these goods were similar to "downloadable computer software" in class 9, to "printed matter" in class 16 and to "advertising" in class 35. Marketing materials in class 9 are the electronic version of goods which, when printed, are proper to class 16. As the opponent's earlier mark is registered in class 16 for, inter alia, "printed matter" at large, there can be little doubt that the competing goods (which vary only in their format) are similar to a high degree. **In summary, the applicant's goods in class 9 are identical (either literally or on the principle outlined in *Meric*) or highly similar to the opponent's goods in classes 9 and 16.**

Class 16

32. The applicant's specification in this class reads:

Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter and publications; printed marketing material, books, cards, catalogues, programmes, writing paper, envelopes, pads, notebooks, greeting cards, magazines, pens, pencils, postcards, posters, stickers, tickets, beer mats; coasters of paper and cardboard, brochures and pamphlets; printers' type; printing blocks; stationery and printed forms, book binding material; photographs; stationery; adhesives for stationery; plastic materials for packaging (not included in other classes); training materials; instructional and teaching material; instructional and teaching material for use in connection with operating and franchising a loyalty card scheme; directories; reports; briefings; office requisites; booklets; books; writing pads; writing articles; photographs; seat and admission tickets for concerts, films, shows, sporting events, festivals, nightclubs, discotheques, live performances and other forms of entertainment; Membership cards; Discount cards; Loyalty cards; vouchers; gift vouchers; coupons; tokens; savings stamps; handbooks; diaries; wall charts; guide books; calendars; posters; leaflets; badges; pens; printed matter and promotional materials; parts and fittings for all the aforesaid goods.

The opponent's specification in class 16 includes a number of identically worded terms and phrases; these are shown above in bold. The terms underlined would all be encompassed by either the phrase "paper, cardboard and goods made from these materials, not included in other classes" or "printed matter" (or in some cases both) in the opponent's specification and would be identical on the *Meric* principle. Of the terms which remain, "envelopes" is a sub-set of both "paper, cardboard and goods made from these materials, not included in other classes" and "stationery", "pens" and "pencils" is a sub-set of "stationery", "training materials" is an alternative way of describing "instructional and teaching material", and "instructional and teaching material for use in connection with operating and franchising a loyalty card scheme" is a sub-set of

“instructional and teaching materials”. As the “parts and fittings” in the applicant’s specification are for goods which are identical to those for which the opponent’s mark is registered, they too must be regarded as identical. **In summary, all of the applicant’s goods in class 16 are identical (either literally or on the principle outlined in *Meric*) to the goods in the opponent’s specification in class 16.**

Class 35

33. The applicant’s specification in this class reads:

Advertising, marketing and business promotion services; market research and information services; promoting the goods and services of others; promotion of retail outlets; promotion of brands; promotion of entertainment service providers; promotion of entertainment venues; retail services connected with the sale of clothing; retail services connected with the sale of tickets; promotion of events; promotion of entertainment events; promotion of nightclubs; promotion of nightclub and discotheque events; promotion of shopping events; promotion of sporting events; promotion of musical concerts; on-line retail services connected with the sale of tickets; on-line retail services connected with the sale of clothing; Advertising; classified advertising; advertising services provided via the internet; dissemination of advertising for others via the internet; advertising namely, online and offline advertising for affiliate retailers offering voucher codes, offers and discounts on products and services; promotional services; promoting the goods and services of others; providing an online directory information service featuring classifieds; data processing and distribution of business information; sales incentive schemes; on-line business administration and supervision of a discount, special offer and gift voucher scheme; operation of incentive and loyalty schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; promotion and advertising of retail services connected with the sale of clothing, travel services, financial services, health and beauty goods and services, sports and leisure goods and services, restaurant services, food, entertainment, business, utilities, phones and internet; marketing; mobile marketing; analysis relating to marketing; marketing reports; compilation of business data; compilation of information into computer database; employment agency services; recruitment services; consultancy services; provision of business information relating to employment, recruitment and jobs; Publishing and advertising job vacancies on any medium including the Internet; the provision of jobs boards on the Internet or other computer network; arranging and conducting seminars and exhibitions for business purposes; organisation, arrangement of and conducting exhibitions and fairs for commercial or advertising purposes; production of advertising matter; rental of advertising space; arrangement of advertising; arranging the distribution of advertising space and samples; classified advertising; graphic advertising services; leasing of advertising space; sales of advertising space; business administration services; advertising via mobile communication networks; compiling, systemisation promotional offers, printable vouchers, coupons and others tokens of value, into

computer databases; operation and supervision of incentive scheme in the form of offering discount and promotional offers, voucher codes, gift codes and claim codes; advertising of the goods or services of other vendors; compilation of advertisements for use as web pages on the Internet and via mobile communications; dissemination of advertising for others via the Internet; on-line marketing and promotional services accessible via mobile communications; compilation of adverts for use on web based maps accessible via the Internet and mobile communications; Organisation, operation and supervision of a loyalty card and incentive scheme; business services rendered or associated with operating, supervising and franchising a loyalty card scheme, magnetic cards, magnetic data carriers, cash registers, calculating machines, data processing equipment and computers, computer hardware, computer software, computer software downloadable from the Internet; business advice services relating to operating and franchising a loyalty card scheme, computer software recorded onto CD Rom and SD-Cards (secure digital cards); computerised data verification; on-line data processing services; market research data collection services; interpretation and analysis of market research data; information, consultancy and advisory services for all the aforesaid services; information and consultancy services relating to the aforesaid, information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services.

In his skeleton argument, Mr Stobbs stated:

“13...The application covers a range of advertising, market research and promotional services. Insofar as the specification covers any type of promotional services or advertising or marketing then these services are either identical or extremely similar to the “advertising” covered [by the earlier mark]. Advertising as a service is in one form the promotion of goods or services for others and so cannot be distinguished from the terminology used by the applicant in their specification. The applicant’s services are simply sub categories of the opponent’s coverage. Insofar as the application covers information relating to dissemination of business information or online business administration or operation of incentive and loyalty schemes then these terms are identical or at least extremely similar to the opponent’s business management and business administration...In addition, the opponent’s coverage relates to a very wide range of retail services and it is the opponent’s contention that these would also be considered extremely similar to any loyalty scheme related services in the application...”

34. The applicant’s services fall into a number of categories; I will, applying the guidance in *Separode* (BL-O-399-10), group them together insofar as it is possible to do so. In approaching the comparison, I will keep in mind the comments in *Avnet* mentioned above, and will approach the terms “business administration”/“office functions” and “business management” on the basis that the terms involve the provision of assistance in relation to administrative tasks and assistance in the running of a business in terms of its organisation and strategy respectively. The application includes

the general terms “advertising, marketing and business promotion services” as well as a range of services which would be included within these terms. Collinsdictionary.com defines “advertising” as:

“the promotion of goods or services for sale through impersonal media, such as radio or television”, “the business that specializes in creating such publicity” and “advertisements collectively; publicity”,

“marketing” as:

“the provision of goods or services to meet customer or consumer needs”,

and “promotion” as, inter alia:

“the act or process of encouraging the sale of (a product) by advertising or securing financial support.”

35. I agree with Mr Stobbs that advertising: “is in one form the promotion of goods or services for others.” **If not identical (which many are, either literally or on the *Meric* principle), the following services in the application are, given the similarity in their respective users, intended purpose, method of use and complementarity, highly similar to “advertising” in the earlier mark:**

Advertising, marketing and business promotion services; market research and information services; promoting the goods and services of others; promotion of retail outlets; promotion of brands; promotion of entertainment service providers; promotion of entertainment venues; promotion of events; promotion of entertainment events; promotion of nightclubs; promotion of nightclub and discotheque events; promotion of shopping events; promotion of sporting events; promotion of musical concerts; Advertising; classified advertising; advertising services provided via the internet; dissemination of advertising for others via the internet; advertising namely, online and offline advertising for affiliate retailers offering voucher codes, offers and discounts on products and services; promotional services; promoting the goods and services of others; providing an online directory information service featuring classifieds; sales incentive schemes; promotion and advertising of retail services connected with the sale of clothing, travel services, financial services, health and beauty goods and services, sports and leisure goods and services, restaurant services, food, entertainment, business, utilities, phones and internet; marketing; mobile marketing; analysis relating to marketing; marketing reports; Publishing and advertising job vacancies on any medium including the Internet; production of advertising matter; rental of advertising space; arrangement of advertising; arranging the distribution of advertising space and samples; classified advertising; graphic advertising services; leasing of advertising space; sales of advertising space; advertising via mobile communication networks; advertising of the goods or services of other vendors; compilation of advertisements for use as

web pages on the Internet and via mobile communications; dissemination of advertising for others via the Internet; on-line marketing and promotional services accessible via mobile communications; compilation of adverts for use on web based maps accessible via the Internet and mobile communications; market research data collection services; interpretation and analysis of market research data.

36. The application includes a number of references to retail services i.e.

Retail services connected with the sale of clothing; retail services connected with the sale of tickets; on-line retail services connected with the sale of tickets; on-line retail services connected with the sale of clothing.

I am not certain what is intended by retail services connected with the sale of tickets (ticket agency services are proper to class 41). However, to the extent that there may be a retail trade in tickets per se, the earlier mark includes a wide range of retail and wholesale services which includes “printed matter” in class 16 (which would include tickets) and “clothing, footwear and headgear”. **As a consequence, the applicant’s retail services are identical to those included in the earlier mark.**

37. All of the following services in the application are identical (either literally) or fall within the definition of business administration and office functions mentioned above and are identical on the *Meric* principle:

Data processing and distribution of business information; operation of incentive and loyalty schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; on-line business administration and supervision of a discount, special offer and gift voucher scheme; compilation of business data; compilation of information into computer database; business administration services; compiling, systemisation promotional offers, printable vouchers, coupons and others tokens of value, into computer databases; operation and supervision of incentive scheme in the form of offering discount and promotional offers, voucher codes, gift codes and claim codes; Organisation, operation and supervision of a loyalty card and incentive scheme; business services rendered or associated with operating, supervising and franchising a loyalty card scheme, magnetic cards, magnetic data carriers, cash registers, calculating machines, data processing equipment and computers, computer hardware, computer software, computer software downloadable from the Internet; computerised data verification; on-line data processing services.

38. The following services fall within the definition of business management mentioned above and are identical on the *Meric* principle:

Business advice services relating to operating and franchising a loyalty card scheme, computer software recorded onto CD Rom and SD-Cards (secure digital cards); consultancy services.

39. That leaves the following services to consider:

employment agency services; recruitment services; provision of business information relating to employment, recruitment and jobs; the provision of jobs boards on the Internet or other computer network; arranging and conducting seminars and exhibitions for business purposes; organisation, arrangement of and conducting exhibitions and fairs for commercial or advertising purposes;

And:

information, consultancy and advisory services for all the aforesaid services; information and consultancy services relating to the aforesaid, information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services.

40. Insofar as the first category of services shown above is concerned, at the hearing Mr Stobbs argued that these services all fell within one or more of the following terms: business management, business administration and office functions. Whilst keeping the comments in *Avnet* firmly in mind, given the nebulous nature of the terms in the earlier mark (which renders them open to various interpretations), it is, I think, not unreasonable to conclude that the services identified by Mr Stobbs are sufficiently wide ranging to include assistance in employment/recruitment matters as well as the arranging and conducting of seminars, exhibitions etc.; **I shall proceed on the basis that the competing services identified are identical on the principle outlined in *Meric*.**

41. Finally, in relation to the second category of services mentioned above i.e. information, consultancy and advisory services, as I have already concluded that all of the applicant's services in this class are either identical or highly similar to the services in class 35 of the earlier mark, it follows that the information, consultancy and advisory services relating to these services are also identical/highly similar to "provision of information relating to the aforesaid" in the earlier mark.

Class 36

42. The applicant's specification in this class reads:

Class 36 - Financial affairs; Monetary affairs; issuing of vouchers; financial services relating to the provision of vouchers for the purchase of goods and services; computerised financial data services; electronic payment services; automated payment of accounts; payment administration services; issuing gift vouchers; issuing of a variety of vouchers enabling customers to purchase goods and services on an Internet website and by telecommunication means; Credit card and charge card services; financial loyalty programmes offered to credit and

charge card customers; fund raising for charity; information, consultancy and advisory services for all the aforesaid services.

The opponent's specification in class 36 includes, inter alia, "financial affairs" and "monetary affairs" which are identical to the same terms in the application and which are, in my view, broad enough terms to encompass all of the services in the application. In addition, the earlier mark also includes "payment processing" and "online payment processing", which are identical to "electronic payment services", "automated payment of accounts" and "payment administration services" in the application. Finally, the "information, consultancy and advisory services for all the aforesaid services" in the application are identical to "information services relating to finance, monetary affairs and real estate affairs" and "information and advisory services relating to the aforesaid" in the earlier mark. **In summary, all of the applicant's services in class 36 are identical (either literally or on the principle outlined in *Meric*) to services in the opponent's specification in class 36.**

Class 38

43. The applicant's specification in this class reads:

Transmission of electronic vouchers via mobile devices and the internet.

As the applicant's services are a sub-set of the opponent's "telecommunications services" in class 38, **they are identical on the *Meric* principle.**

Class 42

44. The applicant's specification in this class reads:

Computer services relating to franchising and loyalty card schemes; maintaining and hosting a website relating to the franchising and operation of loyalty card schemes; design services; Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; maintaining websites; application service provider (ASP); application service provider (ASP) featuring software for receiving, transmitting and displaying vouchers and receiving and transmitting data for the purchase of goods and services; application service provider (ASP) featuring software for providing consumers with information regarding discounts, vouchers and special offers for the goods or services of others; application service provider services regarding social networking software; provision of an Internet platform for social networking services; hosting of digital content online; hosting a website that features technology that enables the donation of money and gifts to charitable organisations; information, consultancy and advisory services for all the aforesaid services.

In his skeleton argument, Mr Stobbs stated:

“13...All of the services covered by the applicant can be characterised as either being an IT service, a hosting service (application service provider services are in essence hosting services) or scientific or design services all of which are covered in general terms by the opponent’s specification.”

45. At the hearing, Mr Stobbs reiterated his understanding of the services of an application service provider (ASP) mentioned above, an understanding with which Mr Gould did not take issue. Once again many of the terms in the application find either exact counterparts in the opponent’s specification or are identical on the principles outlined in *Meric* to, inter alia, “IT services”, “creating and maintaining websites for others”, “hosting computer sites (web sites)” and “information and advisory services relating to the aforesaid”. **In summary, all of the applicant’s services in class 42 are identical (either literally or on the principles outlined in *Meric*) to services in the opponent’s specification in class 42.**

Distinctive character of the earlier trade mark

46. I must now assess the distinctive character of the earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence, I only have the inherent distinctiveness of its earlier mark to consider. In its counterstatement, the applicant stated:

“12. It is also noted that the opponent does not have exclusivity in bubble trade marks on the UK Trade Marks Register and that there are a large number of proprietors who own bubble trade marks in the various classes covered by the opponent’s registrations. It is therefore considered that the scope of the opponent’s claimed distinctive rights should be viewed accordingly and in a narrow context.”

47. In support of this statement the applicant filed the witness statement of Ms Ward which I have summarised above (exhibits MW1, 2 and 4 refer). In relation to this evidence Mr Stobbs stated in his skeleton argument:

“8...It is not clear exactly why this evidence has been provided, but the opponent can only assume that it is to suggest that the element BUBBLE is in some way inherently descriptive, non-distinctive or weak. However, it is a well established principle of trade mark law that the state of the trade marks register cannot be taken into account in this regard.”

Mr Stobbs went on to refer to the following passage from *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281:

“...In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

48. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the General Court (GC) stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

49. This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-400/06.) Whilst I am aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24, in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues.

50. Other than the extract from www.protectyourbubble.com which was downloaded on 17 April 2013 (but which I note refers to “What Mobile Awards 2012 Winner Best Insurance Provider”) and “MyBubble”, there is no evidence to demonstrate that any of the marks revealed in Ms Ward’s searches are actually in use in the market place. In the absence of such evidence, her investigations do no more than (as Jacob J put it *British Sugar*):

“...confirm that this is the sort of word in which traders would like a monopoly.”

51. Although an English language word with a well known meaning, as I mentioned above, as far as I am aware, the word BUBBLE is neither descriptive of nor non-distinctive for, inter alia, the goods and services in classes 9, 16, 35, 36, 38 and 42 upon which the opponent relies. As a consequence, the opponent’s THE BUBBLE mark is, in my view, possessed of an above average degree of inherent distinctive character.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind.

53. In his skeleton argument, Mr Stobbs referred me to the decision of the CJEU in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 and stated:

“14...the Medion case which comments on the comparison of marks where there is a common element which plays some form of independent role in the marks in question. In this case BUBBLE is clearly inherently distinctive in relation to the goods and services in question and the inclusion of the element “the” in the opponent’s mark and the element “card” in the applicant’s mark does not do enough to avoid similarity...”

In *Medion* the CJEU stated:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible

that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

54. Earlier in this decision I concluded that all of the goods and services in the application were either identical or highly similar to the goods and services in the opponent’s earlier mark and that the earlier mark possessed an above average degree of inherent distinctive character. I also concluded that whilst there was only a moderate degree of visual similarity between the competing marks, there was a fairly high degree of aural similarity and a high degree of conceptual similarity. As I mentioned above, given the disparate and wide ranging nature of the goods and services at issue in these proceedings, the average consumer will vary as will the manner in which the goods and services are selected and the degree of care taken during their selection.

55. If I assume (in the applicant's favour) that the average consumer (be it either a member of the general public or a business user) will pay an above average degree of attention to the selection of all the goods and services at issue in these proceedings (thus making them less susceptible to the effects of imperfect recollection), I think it most unlikely, given the visual differences between them, that the competing marks will be confused directly (i.e. one will not be mistaken for the other). However, bearing in mind the identity/high degree of similarity in the goods and services at issue, the fairly high/high degree of aural and conceptual similarity in the competing marks, the fact that the word BUBBLE plays an independent and distinctive role in both parties' marks and that the earlier mark enjoys an above average degree of inherent distinctive character, the same average consumer is, in my view, likely to conclude that the competing marks originate from undertakings which are economically linked i.e. there will be indirect confusion.

56. As a consequence of the above conclusions, the opposition to the application succeeds in full and it is unnecessary for me to consider the opponent's alternative case based upon its other marks.

Conclusion

57. The opposition to the application based upon the registration of CTM no. 5583646 for the mark THE BUBBLE succeeds in full.

Costs

58. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. At the hearing, Mr Stobbs argued that as all of the applicant's evidence was irrelevant (and its legal representatives at the time it was filed ought to have known that was the case) an award to the opponent at the higher end of the scale was appropriate. As the opponent did not file any evidence in these proceedings, it is, as Mr Stobbs argued, difficult to understand why the applicant chose to file evidence of the use it had made of its mark. However, insofar as the evidence of Ms Ward is concerned, exhibit MW3 related to the manner in which the opponent's device marks are classified by WIPO and the inferences the applicant wanted the tribunal to draw as a result of this classification; this evidence is, I think, relevant. Whilst the state-of-the-register evidence provided as exhibits MW1 and MW2 was unlikely to be of great assistance (particularly as only one of the marks revealed by the search was shown to be in use, exhibit MW4 refers), this fact would have been well known to the opponent and ought not to have resulted in a great deal of extra work on its part. With those considerations in mind, and using the TPN mentioned above as a guide, I award costs to the opponent on the following basis:

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| Preparing a statement and considering the applicant's statement: | £300 |
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| Considering the applicant's evidence: | £600 |
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| Opposition fee: | £200 |
| Preparing for and attending a hearing: | £500 |
| Total: | £1600 |

59. I order Bubble Card Limited to pay to O2 Holdings Limited the sum of **£1600**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of November 2013

C J BOWEN
For the Registrar
The Comptroller-General