

O-286-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2624817
BY IDEAS.ORG LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 35:**

iNeed

AND

**OPPOSITION THERETO (NO. 104153) BY INEED NETWORKING TOGETHER
LIMITED**

The background and the pleadings

1) The protagonists to this dispute are ideas.org Limited (the “applicant”) on the one hand and Ineed Networking Together Limited (the “opponent”) on the other. Put simply, the opponent opposes the registration of the applicant’s mark under section 5(2)(b) of the Trade Mark Act 1994 (“the Act”), claiming a likelihood of confusion with an earlier trade mark it owns. The competing marks are:

The application	The earlier mark
<p>UK application 2624817 for the mark:</p> <p>iNeed</p> <p>Registration is sought for:</p> <p>Class 35: Local community services directory; Online business & tradespeople directory & networking services; Advertising; business management; business administration; office functions; electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information</p> <p>The application was filed on 18 June 2012 and published in the Trade Marks Journal on 31 August 2012.</p>	<p>UK registration 2622667 for the mark:</p> <p> the UK’s gateway to people who care.</p> <p>The mark is registered for:</p> <p>Class 38: Arranging access to data bases on the Internet for licence holders and members.</p> <p>Class 42: Development and design of data bases for collecting user input for the voluntary and public sector.</p> <p>Class 45: On-line social networking services.</p> <p>The mark was filed on 30 May 2012 and completed its registration process on 28 September 2012.</p>

2) Given its recent date of registration, the earlier mark is not subject to the requirement to prove genuine use¹. The applicant filed a counterstatement simply denying the claim. Only the applicant filed evidence. Neither side requested a hearing or filed written submissions. I will, though, take all of the parties’ comments into account that have been made in the papers before me.

The evidence

3) The applicant’s evidence is given by Mr Simon Grice, one of its directors. Documents are provided to demonstrate the nature of the applicant’s service; it

¹ Proof of use is only required if the earlier mark completed its registration process more than five years prior to the date of publication of the applicant’s mark; section 6A of the Act refers.

can be characterised as a service which links people who need a particular job done (e.g. babysitting, cleaning, building, computer help) with a relevant local trade person. It has had a domain name since June 2012 and started distributing leaflets about the service in October 2012 in Milton Keynes and Sudbury. Mr Grice states (and provides evidence) that the opponent has not yet traded. He adds that there has been no confusion, however, this is not surprising as if the opponent has not been trading no opportunity for confusion will have yet arisen.

4) The other aspect of Mr Grice's evidence relates to a meeting that took place between the parties on 18 September 2012. It was agreed that "the applicant would not make an opposition to the opponent's application (2622667) and that the opponent would not make an opposition to the Applicant's application (2624817)". Whilst this is noted, no suggestion has been made that this gives rise to any form of estoppel which may otherwise have prevented the opposition from being considered. Nor is it obvious to me that any form of estoppel would be in play because there is an absence of the required reliance (on the applicant's part). Whilst it was agreed that the applicant would not oppose the opponent's earlier mark, it does not appear that it would have been able to so because the opponent has the senior mark and any use made by the applicant (which may have given rise to a claim under passing-off) was after the opponent filed its mark in May 2012. In view of all this, this aspect of the evidence is not pertinent to the matters that need to be determined.

The legislation and the leading case-law

5) Section 5(2)(b) of the Act states that:

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

.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

6) The Court of Justice of the European Union ("CJEU") has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases¹:

"(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

7) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can, of course, vary depending on what is involved.

8) Certain of the applicant's services (e.g. business administration and management) are aimed squarely at businesses, for which a reasonably considered degree of care and attention will be deployed given the likely cost and infrequency of purchase. Certain services are aimed at both business and the general public (such as advertising and directory services) for which a reasonable (but no higher than the norm) degree of care and consideration will be deployed. In both scenarios, the selection process is predominantly a visual one, with the mark being encountered online or in brochures etc, although, the aural aspects of the marks will not be ignored completely.

9) The opponent's social networking services are something aimed at the general public. A reasonable (but no higher than the norm) degree of care and attention will be used in another mainly visual selection process. The same applies, in my view, to the other services covered by the earlier mark.

The distinctiveness of the earlier mark

10) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been presented, so I have only the inherent qualities of the mark to consider.

11) The earlier mark is far from a fanciful one. It makes a clear allusion to the services as the "I NEED" element will be perceived as a reference to what the user ("I") of the service requires ("NEED[S]") in terms of what they require from their social networking experience. The stylisation is modest and adds little by way of distinctive character, similar observations apply to the strap line. **The level of distinctiveness is of a modest level at best.**

Comparison of the marks

12) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

iNeed

v

ineed
the UK's gateway to people who care.

13) Both marks contain the letters and words “i” and “N/need” conjoined. However, in both marks that element will clearly be broken down as I (as in the first person) NEED (as in “to need something”). The opponent’s mark also has additional wording which forms a separate element. In his evidence Mr Grice (for the applicant) referred to this as the distinctive element. I reject his argument. The dominant and distinctive element of the opponent’s mark is the “i/need” aspect. The additional wording is less prominent visually and is largely descriptive, although it would be wrong to exclude it from the comparison altogether.

14) Visually, there is a high degree of similarity given the presence in both marks of iNeed/ineed. The stylisation in the applicant’s mark does not greatly assist in distinguishing these aspects. The rest of the opponent’s mark is borne in mind but given the less prominent role those words play, together with its descriptive connotation (meaning less significance will be given to it), the similarity between the marks as a whole is not greatly reduced. A similar analysis runs through the aural comparison. Indeed, it is likely that an average consumer will refer to the opponent’s mark simply as I NEED (not articulating the rest of the wording) which means that from this perspective the marks are aurally identical. However, even if this were not so, the comment already made about the additional wording also applies here and I still consider the marks to be highly similar. The concept of both marks that will be perceived and stored away by the average consumer will be based upon the I NEED element, an element which is suggestive of something a person needs. The concepts are effectively identical. Overall, there is a high degree of similarity between the marks.

Comparison of services

15) When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

16) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

17) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“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).”

18) In relation to complementarity, I 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 to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory

approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

19) In relation to understanding what terms used in specifications mean/cover, 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”² and that I must also 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 meaning³. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he 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) (IPTRANSLATOR)* [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.”

20) The services for which the applicant seeks registration are varied. They must all be considered even though it is clear that the primary service it offers is some form of tradesperson network/directory. I will go through the terms the applicant has applied for below, in each case comparing them to the services registered under the opponent’s mark which read:

Class 38: Arranging access to data bases on the Internet for licence holders and members.

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

Class 42: Development and design of data bases for collecting user input for the voluntary and public sector.

Class 45: On-line social networking services.

21) All of the applicant's services are in class 35. I will now discuss the terms in turn.

Local community services directory; Online business & trades people directory & networking services

22) These services enable a person to locate and find a tradesperson. Often such services are provided with an element of recommendation by previous users. The closest service seems to be the social networking covered by the earlier mark. It is possible for social networkers to ask each other for a recommendation for a trades person when the need arises. However, even though it is possible for both services to be offered on line, the core purpose of each is quite different. One for people to engage in social interaction, the other for people to locate trades people. The services do not really compete in the true sense of the word, they are certainly not complementary. Social networking could potentially be used for anything including giving advice to fellow social networkers on medical issues, this does not mean a social network service would be regarded as similar to a medical service. The same applies here. **The services are not similar.**

Advertising; advertising services provided via the Internet

23) By parity of reasoning with the above, the services are not similar. Merely because some businesses use social media platforms to advertise on, does not make advertising a similar service to a social networking service. The opponent is in no better position with regard to its other services. **The services are not similar.**

Production of television and radio advertisements

24) The production of radio and television advertisements is a specific niche service performed by an advertising agency or similar organisation. I can see no real similarity with social networking. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Business management; business administration; office functions; provision of business information

25) These are all services provided to businesses to assist them in the running and administration of a business. I see no reason whatsoever to consider them as similar to a social networking service – the purposes are different as is the nature, method of use etc. There is no aspect of competition and no obvious form of complementarity. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Electronic data storage

26) The storage of electronic data is a service facilitating the (normally) off-site safe storage of electronic documents and other data. The closest service of the earlier mark is likely to be the provision of access to databases. The access service is providing the telecommunication means to access a database (for members of an organisation or some other body, according to the specification) whereas the other is simply the storage itself. However, storage and access can go hand in hand in some scenarios. The differentiating factor here, though, is what is being accessed/stored. On the one hand the users own electronic data. On the other is a database, most likely to be database of information, that a user (or the specified member) can make use of upon access. In reality there is no meaningful similarity. **The services are not similar and the opponent is in no better position with regard to its other services.**

Data processing

27) The processing of data is akin (in terms of my reasoning and findings) to business administration/office function etc. **I conclude that these services are not similar to those of the opponent.**

Organisation, operation and supervision of loyalty and incentive schemes

28) These are services provided to businesses so as to facilitate a loyalty or incentive scheme. They are specialist services provided by specialist undertakings. I see no reason whatsoever to consider them as similar to a social networking service – the purposes are different as is the nature, method of use etc. There is no aspect of competition and no obvious form of complementarity. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Accountancy

29) These services are provided to businesses or individuals to assist with tax returns, management of cash flows and similar tasks. I see no reason whatsoever to consider them as similar to a social networking service – the purposes are completely different as are the natures, method of use etc of the services. There is no aspect of competition and no obvious form of complementarity. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Auctioneering

30) Auctioneering or the running of an auction has no real similarity with social networking that I can see. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Trade fairs

31) Such a term relates to the running or organisation of trade fairs. I can see no real similarity with social networking. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Opinion polling

32) The running of a true opinion poll is a specialised service provided by specialist undertakings. I can see no real similarity with social networking, with its core purpose being quite different and being provided by completely different undertakings. This is so even though it is possible to gather people's opinions via a social networking service; I do not consider them to be complementary in the sense described by the case-law. I see no greater link with database design/development/access and no real argument or evidence has been put forward by the opponent. **I conclude that these services are not similar to those of the opponent.**

Likelihood of confusion

33) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). 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 they are likely to be confused.

34) I have held that none of the applicant's service should be considered similar to any of the services covered by the earlier mark. Accordingly, there can be no finding of a likelihood of confusion as per the judgment of the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07. However, even if there was some similarity then any similarity must be of a very low degree. Although the marks are highly similar, the low degree of similarity between the services would not have resulted in a likelihood of confusion, particularly bearing in mind the only moderate level of distinctive character of the earlier mark. In other words, the use of the type of marks in issue, given their suggestive meanings, would result in the similarity being put down simply to co-incidence rather than economic connection. **There is no likelihood of confusion and the opposition fails.**

Costs

35) The applicant has succeeded and is entitled to a contribution towards its costs. However, as it was not professionally represented, I have reduced what I may otherwise awarded as it would not have incurred any legal fees in this regard. My assessment is as follows:

Preparing a statement and considering the other side's statement - £100

Filing evidence - £100

Total - £200

36) I hereby order Ineed Networking Together Limited to pay ideas.org Limited the sum of £200 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 26th day of June 2014

Oliver Morris
For the Registrar,
The Comptroller-General

ⁱ The leading judgments are: *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, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).