

O-268-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3013808
IN THE NAME OF GERRY DONALDSON
IN RESPECT OF THE TRADE MARK:**

iPulse

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500420 BY IMPULS AG**

Background and pleadings

1. The trade mark **iPulse** is registered under no. 3013808. It stands registered in the name of Gerry Donaldson. It was applied for on 12 July 2013 and completed its registration procedure on 18 October 2013. It is registered for the following goods and services:

Class 9 - Software; apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software; all the aforesaid goods relating to performance management and the Value Metrics Profiling (Psychometric Profiling).

Class 35 - Management services, Electronic data storage services; business management; business administration; electronic data storage; business organisation, data processing services; provision of business information; all the aforesaid services relating to performance management and the Value Metrics Profiling (Psychometric Profiling).

2. On 22 May 2014, ImPuls AG (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

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

(a)....

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

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

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.”

3. The applicant directs its application against all of the goods and services in Mr Donaldson’s registration. It relies upon all the goods and services (shown below) in International Registration (“IR”) no. 1017124 for the trade mark shown below which claims the colour blue:

Impuls

The IR designated the EU on 5 September 2009 and the registration process was completed on 30 August 2011:

Class 9 - Data processing equipment and computers; software, with programs provided data mediums.

Class 35 - Organizational consultancy in the area (fields) of data processing.

Class 41 - Education and providing of training.

Goods and services limited to:

Education and providing of training in the field of data processing and software programming.

Goods and services limited to:

Education and providing of training with regard to electronic data processing including software and hardware.

Class 42 - Design and development of computers and computer programs; renting of data processing equipment.

The applicant states:

“The goods and services covered by the later mark are identical or similar to the goods and services covered by the earlier trade mark.”

4. The trade mark shown above qualifies as an earlier trade mark under the above provisions. As the applicant’s earlier trade mark had not been registered for more

than five years when the application for invalidation was filed, it is not subject to proof of use, as per section 47(2)(2A) of the Act. As a consequence, the applicant is entitled to rely upon all of the goods and services it claims.

5. Mr Donaldson filed a counterstatement in which the basis of the invalidation is denied. He states:

“The word ImPuls bears no connection or grammatical comparison to my trade mark. In Germany alone, there are many companies, including multi-national insurance companies that use “impuls” in their company name and branding. Yet their products and meaning bears no relation what so ever to this ImPuls AG brand. So it’s preposterous to suggest that they have exclusivity of these letters.”

Having identified two Community Trade Marks (“CTM”) for the word Impuls registered in the name of two different undertakings for goods in class 7 and services in classes 35, 36 and 42 respectively, Mr Donaldson explains that the “i” in iPulse stands for intelligence and the word “Pulse” represents “...the pulse of a person from a psychometric profile perspective.” In view of the results of a range of Internet searches conducted on his behalf, Mr Donaldson concludes that the parties “operate in a completely different world”. He states:

“iPulse does not look similar to Impuls. This is not a translation thing here. Is simple language.”

He adds:

“In English, the word impulse is to react upon a gut feeling, a sensation an internal value, so even if people the world over were to look at the brand Impuls, they would trend firstly to an emotional meaning instead of a fashion company supplying ERP software solutions. That’s not what iPulse represents. iPulse is all about psychology.”

6. Although neither party filed evidence, both filed written submissions during the course of the evidence rounds; I will refer to these written submissions, as necessary, below. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

Section 5(2)(b) – case law

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

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 be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

8. The competing goods and services are as follows:

| Applicant's goods and services | Mr Donaldson's goods and services |
|--|--|
| <p>Class 9 - Data processing equipment and computers; software, with programs provided data mediums.</p> <p>Class 35 - Organizational consultancy in the area (fields) of data processing.</p> <p>Class 41 - Education and providing of training with regard to electronic data processing including software and hardware.</p> <p>Class 42 - Design and development of computers and computer programs; renting of data processing equipment.</p> | <p>Class 9 - Software; apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software; all the aforesaid goods relating to performance management and the Value Metrics Profiling (Psychometric Profiling).</p> <p>Class 35 - Management services, Electronic data storage services; business management; business administration; electronic data storage; business organisation, data processing services; provision of business information; all the aforesaid services relating to performance management and the Value Metrics Profiling (Psychometric Profiling).</p> |

9. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

10. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;

- e) 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.

11. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

12. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

13. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

14. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“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).”

15. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

16. In its submissions, the applicant states:

“All goods and services covered by the later mark are identical or highly similar to those covered by the earlier trade mark, since they would be made available through the same sales channels.”

The correct approach to the comparison of goods and services

17. Although in his submissions Mr Donaldson refers to the goods and services upon which his trade mark has been used, and contrasts this with what he considers to be the area of trade of interest to the applicant, that is not the correct approach. As the applicant’s earlier trade mark is not subject to proof of use, what I am required to do is to make a notional comparison of the goods and services in Mr Donaldson’s registration with the goods and services in the applicant’s earlier trade mark.

Class 9

18. Although Mr Donaldson's goods in this class all relate to "performance management and the Value Metrics Profiling (Psychometric Profiling)", as the applicant's specification in this class is unlimited, it would include goods for the purpose mentioned in Mr Donaldson's specification. As "software", "data processing equipment, computers" and "computer software" in Mr Donaldson's specification find counterparts in the applicant's specification in this class, the goods are clearly identical. As to the goods which remain in Mr Donaldson's specification in this class i.e. "apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs, DVDs and other digital recording media", these are all, in my view, likely to be encompassed by the broad term "data processing equipment and computers" included in the applicant's specification in this class and, as a consequence, identical on the principles outlined in *Meric*. However, even if the competing goods are not to be regarded as identical, if one considers the respective nature, users, intended purpose, method of use, trade channels and the degree of complementarity that exists between them, they are, in my view, similar to a fairly high degree.

Class 35

19. Although Mr Donaldson's specification in this class includes the same limitation mentioned above, as his "management services", "business management", "business administration" and "business organisation" services would all encompass the applicant's "organisational consultancy in the area (fields) of data processing", the competing services are identical on the *Meric* principle. As to "electronic data storage services", "electronic data storage" and "data processing services" in Mr Donaldson's specification, having considered again the factors mentioned above including, inter alia, the respective users, intended purpose, channels of trade and complementarity, there is, in my view, at least a reasonable degree of similarity between these services and (at least) the following goods and services in the applicant's earlier trade mark: "data processing equipment and computers" in class 9, the services in class 35 and "renting of data processing equipment" in class 42. Finally, as the "provision of business information" in Mr Donaldson's specification all relates to "performance management and the Value Metrics Profiling (Psychometric Profiling)", it too is reasonably similar, in my view, to the applicant's services in classes 35 and 41, as these services may relate to consultancy/education in relation to the data processing of the type of data of interest to Mr Donaldson.

The average consumer and the nature of the purchasing process

20. 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; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

21. Although the average consumer of the applicant’s goods in class 9 and services in class 41 may be a member of the general public, the average consumer of all of Mr Donaldson’s goods and services and the applicant’s services in classes 35 and 42 is, in my view, more likely to be a business user.

22. As I have no evidence or submissions to assist me in determining how such goods and services are selected, I must reach my own conclusions. As the goods at issue are most likely to be the subject of self selection from a bricks and mortar retail/wholesale outlet or from the pages of a brochure, catalogue or website, visual considerations are likely to have an important part to play in the selection process. As the services at issue are likely to be selected in much the same way, visual considerations will once again be important. However, as the goods and services at issue may also be the subject of oral recommendations from, for example, one business to another, aural considerations are also likely to feature in the selection process, although, in my view, probably to a much lesser extent than visual considerations.

23. I now turn to consider the degree of care the average consumer will display when selecting the goods and services at issue. Insofar as the average consumer may be a member of the general public, whether selecting computer hardware and software in class 9 or educational services in class 41, given (i) the selection process I have identified above, (ii) the relatively infrequent nature of such selections and (iii) the importance of choosing the most appropriate/compatible hardware/software and the most relevant training, I would expect the average member of the public to pay an above average degree of attention during the selection process. Similarly, the importance to a commercial undertaking of selecting the most appropriate provider of data processing equipment and related goods and services (including those goods and services in the area of trade of particular interest to Mr Donaldson) is obvious. Such a selection process is likely to take place fairly infrequently and may involve, inter alia, reviewing various documentation before potential providers are identified and approached. As it may also include exploratory meetings, demonstrations etc. with a range of providers and as not insignificant sums are likely to be in play, I would also expect the average business user to display a degree of attention well above the norm.


Comparison of trade marks

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

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

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

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

| Applicant's trade mark | Mr Donaldson's trade mark |
|---|---------------------------|
|  | iPulse |

26. In its submissions, the applicant states:

“[The competing trade marks are similar] since the trade marks are phonetically very similar, conceptually easily confused, and visually very similar.”

27. In his submissions, Mr Donaldson states:

“Visually – the earlier mark is in colour, claims colour as a feature of the mark and is presented in a particular stylised font, which is not present in the contested registration.

It is settled case law that consumers tend to pay more attention to the beginning of a mark. The earlier mark begins with a capital letter “I” followed by a small letter “m” followed by a capital P. This creates an initial impression of a 2 syllable word with emphasis on the 1st syllable i.e. Im-Puls (which could also be seen as I’m Puls) whereas the later registration by contrast contains the prefix “i”, which is followed by a capital P as the start of the recognisable English word Pulse.

The prefix “i” is commonly used in commerce by several parties across a wide range of goods/services and therefore the public are used to paying attention to what follows the prefix “i” to determine the overall impression of a mark.

Conceptual – The average UK customer is familiar with the word PULSE which is the distinctive and memorable element part of the contested registration. The word “Pulse” creates an impression of a beat or vibration that is vitally important and crucial to existence. By contrast, ImPuls presented in

colour with stylised font and lettering creates no known clear conceptual message that would in any way relate or be seen as connected with iPulse.

Aural – The earlier mark would have no recognised aspect or meaning to a UK customer to immediately be familiar with the pronunciation. It would be seen and pronounced as Im-Pulz or I'm Pulz with the "s" at the end having a hard sound like a "z". By contrast the contested registration would be instantly recognised by UK customers to be pronounced as iPulse ("i-Pulse") with a soft "s" sound."

28. The applicant's trade mark consists of the word ImPuls presented in blue in an unremarkable script; the colour blue is claimed as an element of the trade mark. In *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated:

"A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

As it would be legitimate for Mr Donaldson to present his trade mark in the same colour as the applicant's trade mark, the fact that his trade mark is registered in black and white is not a point which assists him.

29. Although the applicant's trade mark contains the letters "I" and "P" in upper case, it will still, in my view, be seen as a single word. Notwithstanding its somewhat unusual presentation, as its spelling differs only to the extent that the final letter "e" is absent from it, the overall impression it conveys, will, as Mr Donaldson suggests, be of the well known English language word "Impulse" meaning, inter alia: "a sudden desire, whim, or inclination..." and "an instinctive drive; urge" (collinsdictionary.com refers). The applicant's trade mark has no distinctive or dominant components; the distinctiveness lying in the trade mark as a whole.

30. As to Mr Donaldson's trade mark, this consists of a lower case letter "i" and the well known English language word "Pulse" presented in title case, the latter of which, Mr Donaldson argues "creates an impression of a beat or vibration...". In his submissions, Mr Donaldson explains that the letter "i" in his trade mark stands for intelligence and states that the "i" prefix is commonly used by other traders across a wide range of goods and services. Although he has provided no evidence in support of this assertion, my own experience tells me that the use of the letter "i" is ubiquitous, although I am less certain as to what the letter "i" is actually intended to signify (perhaps as an abbreviation of Internet or interactive or, as Mr Donaldson suggests, intelligence). Based on this submission, he concludes that it is the word "Pulse" that is the "distinctive and memorable part" of his trade mark. Whilst I agree that the word "Pulse" makes a significant distinctive contribution towards the overall impression his trade mark conveys, the letter "i" appearing at the beginning of his trade mark will not go unnoticed. Although the letter "i" is likely to be lacking in distinctive character, it nonetheless contributes to the overall impression Mr Donaldson's trade mark conveys. Considered overall, like the applicant's trade mark, the distinctiveness of Mr Donaldson's trade mark lies, in my view, in its totality.

31. Considered from a visual perspective both trade marks consist of six letters. Both contain an upper case letter “P” (in the third and second letter positions respectively) and this letter “P” is followed by the letters “u-l-s” in lower case in both trade marks. The competing trade marks differ to the extent that the applicant’s trade mark contains an upper case letter “I” (whereas Mr Donaldson’s trade mark begins with a lower case letter “i”), the applicant’s trade mark contains a lower case letter “m” after the upper case letter “I” and Mr Donaldson’s trade mark contains a lower case letter “e” at the end. Notwithstanding the presence of the shared letters and the order in which they appear in the competing trade marks, the fact that, inter alia, the applicant’s trade mark contains the letter “I” and “P” in upper case separated by a lower case letter “m” whereas Mr Donaldson’s trade mark begins with a lower case letter “i” followed by an upper case letter “P”, results, in my view, in (at most) an average degree of visual similarity between them.

32. Given my conclusions above, the applicant’s trade mark is, in my view, most likely to be pronounced as the two word syllable word Im-Pulse (rather than Im-Pulz or I’m Pulz as Mr Donaldson suggests). As Mr Donaldson’s trade mark will be pronounced in the manner he suggests i.e. as the two syllable word i-Pulse, there is, in my view, an above average degree of aural similarity between the competing trade marks.

33. Considered from a conceptual standpoint, as the applicant’s trade mark is, in my view, most likely to be approximated to the word “Impulse” the concrete conceptual message it will convey will, as indicated above, relate to “a sudden desire, whim, or inclination...”, “an instinctive drive; urge”. As to Mr Donaldson’s trade mark, the conceptual message conveyed by the letter “i”, is, as indicated above, likely to relate to Internet, interactive or intelligence. As to the word “Pulse” in his trade mark, this is likely to convey a range of conceptual meanings relating to, inter alia, “ the rhythmic contraction and expansion of an artery at each beat of the heart, often discernible to the touch at points such as the wrists”, “bustle, vitality, or excitement - the pulse of a city” and “the feelings or thoughts of a group or society as they can be measured - the pulse of the voters” (collinsdictionary.com refers) and, as Mr Donaldson suggests, “a recurrent rhythmic series of beats, waves, vibrations, etc.

34. The various conceptual messages likely to be conveyed by the letter “i” in Mr Donaldson’s trade mark find no counterpart in the applicant’s trade mark. While the word “Pulse” in his trade mark may, given the reference to “excitement” mentioned above, evoke related conceptual imagery to the word Impulse, the presence in Mr Donaldson’s trade mark of the initial letter “i” means that when considered as a whole, any conceptual meaning it may convey is, if not impossible, extremely difficult to discern. Considered overall, the applicant’s trade mark will, in my view, convey a concrete conceptual message, whereas Mr Donaldson’s trade mark will not.

Distinctive character of the applicant’s earlier trade mark

35. I must now assess the distinctive character of the applicant’s trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and 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 applicant has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In his counterstatement, Mr Donaldson refers to two CTMs for the trade mark Impuls registered for a range of goods and services in the name of different undertakings based in Germany. There is, however, nothing to suggest that (even) the word Impulse (spelt correctly and presented in normal typeface) would be descriptive of or non-distinctive for the goods and services for which the applicant's trade mark stands registered. However, even if that were the case, given its somewhat unusual presentation and misspelling, the applicant's earlier trade mark is, in my view, possessed of at least an average degree of inherent distinctive character.

Likelihood of confusion

36. 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 applicant's 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. Earlier in this decision I concluded that:

- the competing goods and services are either identical or similar to at least a reasonable degree;
- the average consumer will select the goods and services by a mixture of visual and aural means (with the visual component dominating) and will pay a degree of attention above/well above the norm when doing so;
- neither parties' trade marks have any distinctive or dominant elements, the overall impressions they create and their distinctiveness lying in the totalities they create;
- the competing trade marks are visually similar to (at most) an average degree and aurally similar to an above average degree;
- whilst the applicant's trade mark will create a concrete conceptual picture in the average consumer's mind, Mr Donaldson's trade mark will not;
- the applicant's earlier trade mark is possessed of at least an average degree of inherent distinctive character.

37. In reaching a conclusion, I note that in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

38. However, in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

39. I have already concluded that the applicant’s trade mark will be understood as the word well known English language word *Impulse*. Given the well known nature of this word and its related meaning, I have also concluded that it will create a concrete conceptual picture in the mind of the average consumer. This clear conceptual message is, in my view, sufficient (given that Mr Donaldson’s trade mark will not convey any clear conceptual message) to counteract the degree of visual and aural similarities between the competing trade marks I have identified earlier in this decision.

40. However, even if that conclusion was to be regarded as arguable (and proceeding on the basis that all of Mr Donaldson’s goods and services are identical to those of the applicant and the applicant’s earlier trade mark is possessed of the highest degree of inherent distinctive character), I am still satisfied that there is no likelihood of either direct confusion (i.e. where one trade mark is mistaken for the other) or indirect confusion (i.e. where the average consumer assumes the goods and services at issue come from undertakings which are economically linked). I reach that conclusion having reminded myself of (i) the importance of the visual aspect of the competing trade marks to the selection process, (ii) the not insignificant visual differences that exist between the competing trade marks, and (iii) the degree of care the average consumer will take during the selection process.

Conclusion

41. The application for invalidity fails.

Costs

42. Mr Donaldson has been successful and is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that Mr Donaldson has not been professional represented, I award costs to him on the following basis:

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

Written submissions: £50

Total: £150

43. I order ImPuls AG to pay to Gerry Donaldson the sum of **£150**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of June 2015

**C J BOWEN
For the Registrar
The Comptroller-General**