

**O-438-15**

TRADE MARKS ACT 1994  
IN THE MATTER OF TRADE MARK APPLICATION NUMBER  
3 063 806 IN THE NAME OF RED PIXIE LIMITED TO  
REGISTER THE TRADE MARK uDo IN CLASS 09

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO  
402 963 BY INFORMATION TECHNOLOGY JUNCTION  
LIMITED

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### Background and pleadings

1. Red Pixie Limited (the applicant) applied to register the trade mark uDo in the UK on 11 July 2014. It was accepted and published in the Trade Marks Journal on 29 August 2014 in respect of the following goods in Class 09:

*Business software allowing users to access and control standard commodity services and items in particular desktop applications, licenses, access controls and organisational hierarchy data; interfacing business software supporting end-user computing systems and processes.*

2. Information Technology Junction Limited (the opponent) oppose the trade mark on the basis of Section 5(2) (a) and/or (b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark 2 563 485 in respect of the mark UDO. The following services are relied upon in this opposition:

Class 35:

*Business management; business administration; office functions; business information*

Class 42:

*Providing customized on-line web pages and data feeds featuring user-defined information, which includes blog posts, new media content, other on-line content, and on-line web links to other websites; developing and hosting a server on a global computer network for the purpose of facilitating e-commerce via such a server; designing, creating, maintaining and hosting online retail and electronic commerce websites; computer services, namely, providing a web-based system and online portal for e-commerce purposes; providing a web site featuring temporary use of non-downloadable software allowing web site users to upload, post and display online information, posts, comments, videos for sharing with others; advice, consultancy and information relating to the aforesaid services.*

3. The opponent argues that the respective goods and services are identical or similar in that there is a complementary relationship between them and that the marks are also identical or similar.
4. The applicant filed a counterstatement denying the claims made.
5. Only the applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
6. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

### **Applicant's Evidence**

7. This is witness statement from Mr Victor Caddy, a trade mark attorney representing the applicant in these proceedings. He describes a number of exhibits (VIC.1 – VIC.4) which is a collection of pages from the applicant's website outlining the services provided by the applicant. He asserts that this material demonstrates the mark in use and its intended purpose. By and large this appears to show a self service IT system for the business user. The applicant also describes itself as providing services and technology. Notably, it explains that its company is instrumental in evolving, managing and transforming IT departments to ensure business success.

### **DECISION**

8. For reasons of procedural economy, the opposition based upon Section 5(2) (b) of the Act will be considered first.

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

9. Sections 5(2)(b) of the Act is 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”.

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

10. In the judgment of the Court of Justice of the European Union 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”.

11. 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;

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- 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.

12. The following guidance is also helpful:

13. 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."

14. 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."

15. 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

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core of the possible meanings attributable to the rather general phrase.”

16. Further, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

17. In *Sanco SA v OHIM*, Case T-249/11, the General Court 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.

18. For reasons of procedural economy, this comparison will focus upon the earlier Class 35 services relied upon which are:

*Business management; business administration; office functions; business information*

The contested goods are:

Class 9:

*Business software allowing users to access and control standard commodity services and items in particular desktop applications, licenses, access controls and organisational hierarchy data; interfacing business software supporting end-user computing systems and processes.*

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19. The earlier business management is a service that functions to coordinate the efforts of people to accomplish goals and objectives. This is usually achieved by using available resources efficiently and effectively. This would include the deployment and manipulation of all kinds of resources including human resources, financial resources, technological resources and natural resources.
20. The respective specifications clearly differ in nature as the earlier are services and the later are goods. The method of use also differs. The contested goods are tools that can be utilized by a business to achieve its goals and objectives. They also aim to enable greater efficiency as tasks can be carried out more quickly and with greater ease. It is considered that there is therefore a degree of similarity between the purpose of the goods and that of the earlier services. The end user, namely businesses, will also likely coincide.
21. Further, business management appears, by its very nature, to include the deployment and manipulation of technological resources. While this will likely include people with specialist skills, it will also include particular types of software. It is therefore difficult to see how, in a technological age a business management service could be delivered without the kinds of software tools that the later goods include. Finally, it is noted that according to the applicant's own evidence, it describes itself as being instrumental to the evolving, managing and transforming of IT departments for business success. This "business" angle is important as the services provided can include project management and change management services which fall within the wider umbrella of business management. It is therefore considered to be perfectly reasonable to find that the same or a linked undertaking could offer services such as business management and also produce the related goods bearing in mind that these goods are business software. They are therefore considered to also be complementary.
22. Bearing in mind all of the aforesaid, it is considered that the goods and services are similar, to a low to moderate degree.

## Comparison of marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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

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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.”

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

25. The respective trade marks are shown below:

UDO	uDo
Earlier trade mark	Contested trade mark

26. As regards distinctive and dominant components, the earlier mark will be appreciated instantly as a whole and so the answer is straightforward. In respect of the contested mark, the applicant argues that there are two separate components with the letter “u” being used to mean “you”. However, there is no stand out distinctive or dominant component present; even in event of separation, the mark is appreciated instantly as a whole and so the correct comparison to be made is as between the marks as wholes.

27. Visually it is noted that the marks coincide entirely in respect of the letters present – U, D and O. There is a difference in presentation with the earlier mark presented in capital letters and the contested mark with only the letter D appearing in capital. The applicant asserts that this has the effect of carving up the mark and it is accepted that this does have a visual impact. However, despite this there is considered to be a high degree of visual similarity.

28. Aurally, the earlier mark is likely to be pronounced as “OO-DOO”, “OO-DOH” or as the letter string “U D O”. The contested mark is most likely to be articulated as “YOU-DOO”. There is therefore potential for aural difference but also potential for similarity dependent on the articulation chosen. The worst case scenario for the opponent is “YOU-DOH” versus “U D O”, but the best case would be “OO-DOO” and “YOU-DOO”. In conclusion, there is likely to be aural similarity between the marks and in the best case for the opponent this could be to a high degree.

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29. Conceptually, the applicant asserts that its mark will be understood as “you can do” and I accept that this is the most likely scenario, though this may involve some thought on the part of the consumer (as opposed to, for example, an ordinary dictionary word whose meaning will be immediately grasped). It is unlikely that the earlier trade mark will be understood in the same manner. Rather, it is likely to be seen as an invented term or as a random three letter string. The marks are therefore likely to be viewed as different in concept and so are not similar in this regard.

### **Average consumer and the purchasing act**

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

31. 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.”

32. In respect of both the applicant's goods and the opponent's services the relevant public is likely to be the business sector. The nature of the processing purchase could involve an official procurement process and possibly also invitations to tender. In any case, there is likely to be research of some description involved prior to a particular undertaking (and the services and products thereof) being chosen. The nature of the goods and services and their relative importance (to increase efficiency and performance) and also their cost which is likely to be relatively expensive, lead to the conclusion that this will be a considered purchase and therefore that the level of attention that will be displayed during the purchasing process will be fairly high.

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

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



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“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

34. The opponent has not claimed that its mark has achieved an enhanced degree of distinctiveness through use made of it and there is no evidence to this effect. In any case, the earlier trade mark is likely to be viewed as a three letter string UDO and has the look and feel of an invented word. Though it is comprised of only three letters, it is considered to have a higher than average degree of distinctiveness.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be

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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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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36. The goods and services have been found to be similar to a low to moderate degree. The marks are visually highly similar and the same may be true aurally, depending on the articulation chosen. This is important as a lower degree of similarity between the goods and services can be offset against a higher degree of similarity between the marks. In this respect, it is true that there is no conceptual similarity and that this can counteract visual and aural similarities<sup>1</sup>. However, this is not always the case<sup>2</sup> and in this case only one of the marks will be perceived as having a meaning (thus lessening the prospects of counteraction). Further, this meaning may not be immediately grasped, i.e. there may be a moment of thought required beforehand. Finally, as already stated, the degree of visual (and potentially aural) similarity here is so high that any counteractive effect is unlikely.

37. It is also true that a high degree of attention is likely to be displayed during the purchasing process which can negate against imperfect recollection occurring. However, the earlier mark is considered to have a higher than average degree of distinctiveness and the letters present – UDO - are identical to those in the later mark<sup>3</sup>. Though the later mark uses lower case letters, this does not detract from the high degree of visual similarity between the marks. As already stated they could also be aurally close. Bearing in mind all of the aforesaid it is considered that confusion between the two is likely.

38. As such, the opposition succeeds in its entirety.

### Final Remarks

39. As the opposition has succeeded under Section 5(2) (b) of the Act, there is no need to consider the remaining ground of opposition.

### COSTS

40. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition Fee - £100  
Preparing a statement and considering the other side's statement: -  
£200  
Preparing written submissions in lieu of a Hearing - £200  
TOTAL: £500

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<sup>1</sup> *The Picasso Estate v OHIM*, Case C-361/04 P,

<sup>2</sup> *Nokia Oyj v OHIM*, Case T-460/07

<sup>3</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

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41. I therefore order RedPixie Limited to pay Information Technology Junction Ltd the sum of £500. The above sum should 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 16th day of September 2015**

**Louise White**

**For the Registrar,**