

**BL O-480-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF CONSOLIDATED PROCEEDINGS INVOLVING:**

**TRADE MARK APPLICATIONS 3225728; 3225741 and 3225762  
BY HYLINK DIGITAL SOLUTION CO., LTD.**

**TO REGISTER THE FOLLOWING TRADE MARKS:**

**HYLINK**



**AND**

**OPPOSITIONS THERETO (No.s 409893, 409894 and 409895)  
BY MILLWARD BROWN UK LIMITED**

## **Background and pleadings**

1. **Hylink Digital Solution Co., Ltd.** (the applicant) applied to register the trade marks:

a) **HYLINK** (application 3225728)

b)  (application 3225741)

c)  (application 3225762)

in the UK on 19 April 2017. They were accepted and published in the Trade Marks Journal on 28 April 2017, in respect of the following goods and services:

### **Application (a) 3225728:**

**Class 35:** Advertising; publicity; advertising agencies; publicity agencies; on-line advertising on a digital communication network; rental of advertising space; public relations; organization of exhibitions for commercial or advertising purposes; business management and organization consultancy; business management of performing artists; systemization of information into computer databases; sponsorship search.

### **Application (b) 3225741:**

**Class 35:** Public relations; advertising; publicity; advertising agencies; publicity agencies; rental of advertising space; systemization of information into computer databases; import-export agencies; business management and organization

consultancy; on-line advertising on a digital communication network; business management of performing artists; organization of exhibitions for commercial or advertising purposes.

**Class 42:** Conversion of data or documents from physical to electronic media; computer programming; duplication of computer programs; rental of computer software; computer software consultancy; computer system analysis; providing search engines for the internet; computer software design; creating and maintaining web sites for others; hosting computer sites.

**Application (c) 3225762:**

**Class 09:** Electronic notice boards; electronic publications, downloadable; animated cartoons; enlarging apparatus [photography]; photocopiers [photographic, electrostatic, thermic]; computer software, recorded; neon signs; sound reproduction apparatus; network communication device; computer programs, recorded.

**Class 35:** Public relations; advertising; publicity; advertising agencies; publicity agencies; rental of advertising space; systemization of information into computer databases; import-export agencies; business management and organization consultancy; on-line advertising on a digital communication network; business management of performing artists; organization of exhibitions for commercial or advertising purposes.

**Class 42:** Conversion of data or documents from physical to electronic media; computer programming; duplication of computer programs; rental of computer software; computer software consultancy; computer system analysis; providing search engines for the internet; computer software design; creating and maintaining web sites for others; hosting computer sites.

2. **Millward Brown UK Limited** (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier European Union (formerly Community) Trade Mark 013536495

for the plain word mark **LINK**. The following services are relied upon in this opposition:

**Class 16:** Paper; cardboard; printed matter; publications; newspapers and periodicals; books; publicity material; photographs; posters; calendars; stationery; plastic materials for packaging.

**Class 35:** Media research and consultation; planning, buying and negotiating advertising and media space and time; advertising, promotional and marketing services; business and business management services; advisory and consultation services in the field of advertising and business and providing advertising for others online over a global computer information network; publicity services; production of advertising matter and commercials; public relations services; market research and market analysis; research and information services relating to business, advertising and marketing; statistical analysis and compilation; opinion polling services; business administration; provision of information relating to the aforesaid; provision of the aforesaid services on-line from a computer database or a global computer network; compilation of advertisements for use as web pages on a global computer network; and providing media services in the field of one-to-one advertising and marketing, namely, the planning and purchase of media time and space for direct marketing advertising; digital and online advertising; the placement of advertising in the media; organization of promotional campaigns and related consultancy services; data processing; analysis and study of information collected on consumer opinions and behavior through market research and advertising studies.

**Class 42:** Design services; computer services; product design and development; editing services for computer programs; art studio services; industrial design services; design of packaging; styling agencies (industrial design); graphic arts designing; interior design services; fashion design; architectural services; technical project studies; research and development of new products for others (product development); development of computer systems in the field of graphic arts; design (creation) and development of market research tools; creation of virtual and interactive images; software design and development, computer

programming, computer programming services, hosting of computer sites (web sites); information, research and consultancy services relating to the aforesaid; information services relating to the Internet; provision of information relating to the aforesaid; design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs; development of systems for the storage of data; computer programming; rental of computer software; hosting websites; services of an application service provider, namely, installation, electronic storage, rental, and maintenance of application software that allows users to play and program music and entertainment-related audio, video, text and other multimedia content; computerised data storage services.

3. Initially the opposition was based on the earlier European Union trade mark referred to above and the opponent's earlier UK mark 2447494. Additionally, the opponent invoked Section 5(3) and Section 5(4)(a) as well as Section 5(2)(b). However, later in proceedings, the opponent requested a case management conference (CMC), to contest the registry's preliminary view refusing the opponent's extension of time request. The CMC was taken by a different hearing officer on 18 January 2018.
4. The hearing officer set out her reasons why the request for an extension of time had been refused as follows:

“The examples of evidence which were given on the extension of time request are unremarkable: turnover, advertising figures, and promotional material. These are the bread and butter of evidence in cases with grounds under section 5(2)(b), 5(3) and 5(4)(a). There were no surprises in the counterstatement. Having taken into consideration these factors, together with the length of time during which the opponent has been aware that the proceedings might be defended, it appeared remiss of the opponent a) not to have mentioned jurisdictional difficulties in the extension request and b) not to have made some preparations for evidence in the period since filing the opposition (6 months ago) in the light of those difficulties, which it must have anticipated.

The opponent relies upon two earlier marks, one of which is subject to proof of use. I was told that one of the reasons why no preparations were made prior to the period set was that the opponent was waiting to see whether it was put to proof. That may be so, but evidence is still required for reputation under section 5(3) and for goodwill under 5(4)(a).

Further, the opponent's representative was unable to tell me what evidence has been gathered thus far, it now being over two weeks after the due date. I should point out that, contrary to a submission made by the opponent's representative, it is not 'usual' to grant a first extension request. Each request must be fully supported, whether it is the first or a subsequent request. Tribunal Practice Notice 2/2011 refers.

In the circumstances, I declined to exercise my discretion and permit the extra time for filing evidence. I upheld the preliminary view to refuse the request. The consequence of this is that I have struck out the grounds under section 5(3) and 5(4)(a) and also the reliance upon UK trade mark 2447494. The opposition will proceed under section 5(2)(b) on the basis of earlier mark EUTM 13536495, which, in any event, is the stronger of the two earlier marks in terms of similarity of marks, goods and services."

5. Subsequently the opposition is now based solely on the opponent's earlier European trade mark and on the ground of section 5(2)(b).
6. The opponent claims in its statement of grounds (TM7), that all of the applied for goods and services are identical or similar to the goods and services protected under its earlier mark, and that the marks are similar. It states that the applicant's marks all contain the whole word 'LINK' and that these similarities will create a likelihood of confusion and association between its earlier mark and the applicant's marks.
7. The applicant claims in its counter statement (TM8), that the marks in issue differ conceptually, visually and aurally, as well as when considered as a whole.

8. 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.
9. The applicant has been professionally represented throughout the proceedings by Albright IP Limited whilst the opponent has been professionally represented by Bristows LLP.

## **Decision**

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

10. Section 5(2)(b) of the Act is as follows:

“(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.”

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 might 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**

12 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”.

13. 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 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.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. 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”.

16. 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.

17. The parties’ respective specifications are:

Earlier mark	Application 3225728 (a)
<p><b>Class 16:</b> Paper; cardboard; printed matter; publications; newspapers and periodicals; books; publicity material; photographs; posters; calendars; stationery; plastic materials for packaging.</p> <p><b>Class 35:</b> Media research and consultation; planning, buying and</p>	<p><b>Class 35:</b> Advertising; publicity; advertising agencies; publicity agencies; on-line advertising on a digital communication network; rental of advertising space; public relations; organization of exhibitions for commercial or advertising purposes; business management and organization consultancy; business</p>

<p>negotiating advertising and media space and time; advertising, promotional and marketing services; business and business management services; advisory and consultation services in the field of advertising and business and providing advertising for others online over a global computer information network; publicity services; production of advertising matter and commercials; public relations services; market research and market analysis; research and information services relating to business, advertising and marketing; statistical analysis and compilation; opinion polling services; business administration; provision of information relating to the aforesaid; provision of the aforesaid services on-line from a computer database or a global computer network; compilation of advertisements for use as web pages on a global computer network; and providing media services in the field of one-to-one advertising and marketing, namely, the planning and purchase of media time and space for direct marketing advertising; digital and online advertising; the placement of advertising in the media; organization of promotional campaigns and related consultancy services; data processing; analysis and study of information</p>	<p>management of performing artists; systemization of information into computer databases; sponsorship search.</p>
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collected on consumer opinions and behavior through market research and advertising studies.

**Class 42:** Design services; computer services; product design and development; editing services for computer programs; art studio services; industrial design services; design of packaging; styling agencies (industrial design); graphic arts designing; interior design services; fashion design; architectural services; technical project studies; research and development of new products for others (product development); development of computer systems in the field of graphic arts; design (creation) and development of market research tools; creation of virtual and interactive images; software design and development, computer programming, computer programming services, hosting of computer sites (web sites); information, research and consultancy services relating to the aforesaid; information services relating to the Internet; provision of information relating to the aforesaid; design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs;

<p>development of systems for the storage of data; computer programming; rental of computer software; hosting websites; services of an application service provider, namely, installation, electronic storage, rental, and maintenance of application software that allows users to play and program music and entertainment-related audio, video, text and other multimedia content; computerised data storage services.</p>	
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18. **Class 35:** The opponent's earlier services in class 35 include specifically the terms 'advertising services', 'publicity services', 'public relations services' and 'business and business management services', amongst others. The applicant's services 'advertising; publicity; advertising agencies; publicity agencies; on-line advertising on a digital communication network; rental of advertising space; public relations; business management and organization consultancy; business management of performing artists' are encompassed within the opponent's class 35 services mentioned above and are therefore found to be identical.

19. The applicant's services 'systemization of information into computer databases' involve a process that combines data processing of information alongside the technical manipulation of computer databases. As such, the opponent's earlier services 'data processing' in class 35 wholly encompass the applicant's services in this regard. These services are considered to be identical.

20. The applicant's services 'sponsorship search' are services whereby the consumer requires the service provider to assist in finding a sponsor for a particular activity or event. The applicant will use its resources to search for and locate a suitable sponsor depending on the consumer's requirements. This service takes the form of a business transaction or service, provided by the applicant to the consumer. As such it falls under the broader heading in the opponent's earlier 'business services' and is considered to be identical.

21. The applicant's services 'organization of exhibitions for commercial or advertising purposes' comprise a professional service in the field of event organisation. These services involve liaising with the client, to agree on the details around issues such as booking venues, catering, lighting, floor layout, marketing of the event, demonstrations, booking public speakers, amongst others. Much of the work involved can be said to be administration and project management in nature, essential in ensuring that many different strands and work flows are pulled together in a timely and effective manner to ensure a successful exhibition.
22. The opponent's services in class 35 include 'business services' and 'business administration' which are broad in nature. The provision of business services *per se* will include liaising with consumers to agree on detail around specific services required. The term 'business services' will include acting on behalf of third parties in a business transaction, to ensure that a successful result is realised. The opponent's services 'business administration' are services provided to the consumer intended to ensure that a business, or transaction, is organised, arranged and carried out efficiently and effectively, with a successful result. These services may include the secretarial aspect of running a business and they may also cover personnel and facilities management of a site on behalf of others.
23. In that respect the applicant's services 'organization of exhibitions for commercial or advertising purposes' can be seen to share nature, users and channels of trade with the opponent's broader terms 'business services' and 'business administration'. These services are therefore considered to share a good degree of similarity.
24. In conclusion, all of the applicant's services applied for under 3225728, have been found to be identical or similar to some of the opponent's services.

Earlier mark	Application 3225741 (b)
Class 16: Paper; cardboard; printed	Class 35: Public relations; advertising;

matter; publications; newspapers and periodicals; books; publicity material; photographs; posters; calendars; stationery; plastic materials for packaging.

**Class 35:** Media research and consultation; planning, buying and negotiating advertising and media space and time; advertising, promotional and marketing services; business and business management services; advisory and consultation services in the field of advertising and business and providing advertising for others online over a global computer information network; publicity services; production of advertising matter and commercials; public relations services; market research and market analysis; research and information services relating to business, advertising and marketing; statistical analysis and compilation; opinion polling services; business administration; provision of information relating to the aforesaid; provision of the aforesaid services on-line from a computer database or a global computer network; compilation of advertisements for use as web pages on a global computer network; and providing media services in the field of one-to-one advertising and

publicity; advertising agencies; publicity agencies; rental of advertising space; systemization of information into computer databases; import-export agencies; business management and organization consultancy; on-line advertising on a digital communication network; business management of performing artists; organization of exhibitions for commercial or advertising purposes.

**Class 42:** Conversion of data or documents from physical to electronic media; computer programming; duplication of computer programs; rental of computer software; computer software consultancy; computer system analysis; providing search engines for the internet; computer software design; creating and maintaining web sites for others; hosting computer sites.



marketing, namely, the planning and purchase of media time and space for direct marketing advertising; digital and online advertising; the placement of advertising in the media; organization of promotional campaigns and related consultancy services; data processing; analysis and study of information collected on consumer opinions and behavior through market research and advertising studies.

**Class 42:** Design services; computer services; product design and development; editing services for computer programs; art studio services; industrial design services; design of packaging; styling agencies (industrial design); graphic arts designing; interior design services; fashion design; architectural services; technical project studies; research and development of new products for others (product development); development of computer systems in the field of graphic arts; design (creation) and development of market research tools; creation of virtual and interactive images; software design and development, computer programming, computer programming services, hosting of computer sites

<p>(web sites); information, research and consultancy services relating to the aforesaid; information services relating to the Internet; provision of information relating to the aforesaid; design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs; development of systems for the storage of data; computer programming; rental of computer software; hosting websites; services of an application service provider, namely, installation, electronic storage, rental, and maintenance of application software that allows users to play and program music and entertainment-related audio, video, text and other multimedia content; computerised data storage services.</p>	
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25. **Class 35:** The opponent's earlier services in class 35 include specifically the terms 'advertising services', 'publicity services', 'public relations services' and 'business and business management services' amongst others. The applicant's services 'public relations; advertising; publicity; advertising agencies; publicity agencies; rental of advertising space; business management and organization consultancy; on-line advertising on a digital communication network; business management of performing artists' are encompassed within the opponent's class 35 services mentioned above and are therefore found to be identical.

26. The applicant's services 'systemization of information into computer databases' involve a process that combines data processing of information alongside the technical manipulation of computer databases. As such, the opponent's earlier

services 'data processing' in class 35 wholly encompass the applicant's services in this regard. These services are considered to be identical.

27. The applicant's services 'import-export agencies' are a business service, arranging the import of goods and the export of goods on behalf of others. This service is wholly encompassed within the terms 'business services' and 'business administration' of the opponent's class 35 specification and these services are therefore considered to be identical.

28. The applicant's services 'organization of exhibitions for commercial or advertising purposes' comprise a professional service in the field of event organisation. These services involve liaising with the client, to agree on the details around issues such as booking venues, catering, lighting, floor layout, marketing of the event, demonstrations, booking public speakers, amongst others. Much of the work involved can be said to be administration and project management in nature, essential in ensuring that many different strands and work flows are pulled together in a timely and effective manner to ensure a successful exhibition.

29. The opponent's services in class 35 include 'business services' and 'business administration' which are broad in nature. The provision of business services *per se* will include liaising with consumers to agree on detail around specific services required. The term 'business services' will include acting on behalf of third parties in a business transaction, to ensure that a successful result is realised. The opponent's services 'business administration' are services provided to the consumer intended to ensure that a business or single transaction is organised, arranged and carried out efficiently and effectively, with a successful result. These services may include the secretarial aspect of running a business and they may also cover personnel and facilities management of a site on behalf of others.

30. In that respect the applicant's services 'organization of exhibitions for commercial or advertising purposes' can be seen to share nature, users and channels of trade with the opponent's broader terms 'business services' and 'business administration'. These services are therefore considered to share a good degree of similarity.

31. **Class 42:** The opponent's earlier class 42 service 'computer services' is an extremely wide-ranging term in the field of information technology. The applicant's services 'computer system analysis' are a specialist service provided by either a person or a piece of software, intended to analyse computer systems in order to monitor functionality, effectiveness and look for faults etc. These services fall under the opponent's broader term 'computer services' and are therefore identical.
32. The applicant's services 'conversion of data or documents from physical to electronic media' is a service providing the conversion of data to an electronic media. This is a computer-centric service and is wholly encompassed within the opponent's 'computer services'. These services are therefore considered to be identical.
33. The opponent's services 'hosting of computer sites (web sites)' are identical to the applicant's 'hosting computer sites'.
34. The applicant's services 'computer programming; duplication of computer programs; rental of computer software; computer software consultancy; computer software design' are covered by the opponent's 'computer services' and are therefore identical.
35. The applicant's services 'creating and maintaining web sites for others; providing search engines for the internet' are services specifically involved in the creation, provision and maintenance of internet websites for others. These services are considered to be niche computer services and as such are considered to fall within the opponent's services 'computer services' and are therefore identical.
36. In conclusion, all of the applicant's services applied for under 3225741 in class 42 have been found to be identical, and all of the services in class 35 have been found to be identical or similar to some of the opponent's services.

Earlier mark	Application 3225762 (c)
<p><b>Class 16:</b> Paper; cardboard; printed matter; publications; newspapers and periodicals; books; publicity material; photographs; posters; calendars; stationery; plastic materials for packaging.</p> <p><b>Class 35:</b> Media research and consultation; planning, buying and negotiating advertising and media space and time; advertising, promotional and marketing services; business and business management services; advisory and consultation services in the field of advertising and business and providing advertising for others online over a global computer information network; publicity services; production of advertising matter and commercials; public relations services; market research and market analysis; research and information services relating to business, advertising and marketing; statistical analysis and compilation; opinion polling services; business administration; provision of information relating to the aforesaid; provision of the aforesaid services on-line from a computer database or a global computer network; compilation of advertisements for use as web</p>	<p><b>Class 09:</b> Electronic notice boards; electronic publications, downloadable; animated cartoons; enlarging apparatus [photography]; photocopiers [photographic, electrostatic, thermic]; computer software, recorded; neon signs; sound reproduction apparatus; network communication device; computer programs, recorded.</p> <p><b>Class 35:</b> Public relations; advertising; publicity; advertising agencies; publicity agencies; rental of advertising space; systemization of information into computer databases; import-export agencies; business management and organization consultancy; on-line advertising on a digital communication network; business management of performing artists; organization of exhibitions for commercial or advertising purposes.</p> <p><b>Class 42:</b> Conversion of data or documents from physical to electronic media; computer programming; duplication of computer programs; rental of computer software; computer software consultancy; computer system analysis; providing search engines for the internet; computer</p>

<p>pages on a global computer network; and providing media services in the field of one-to-one advertising and marketing, namely, the planning and purchase of media time and space for direct marketing advertising; digital and online advertising; the placement of advertising in the media; organization of promotional campaigns and related consultancy services; data processing; analysis and study of information collected on consumer opinions and behavior through market research and advertising studies.</p> <p><b>Class 42:</b> Design services; computer services; product design and development; editing services for computer programs; art studio services; industrial design services; design of packaging; styling agencies (industrial design); graphic arts designing; interior design services; fashion design; architectural services; technical project studies; research and development of new products for others (product development); development of computer systems in the field of graphic arts; design (creation) and development of market research tools; creation of virtual and interactive images; software design</p>	<p>software design; creating and maintaining web sites for others; hosting computer sites.</p>
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<p>and development, computer programming, computer programming services, hosting of computer sites (web sites); information, research and consultancy services relating to the aforesaid; information services relating to the Internet; provision of information relating to the aforesaid; design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs; development of systems for the storage of data; computer programming; rental of computer software; hosting websites; services of an application service provider, namely, installation, electronic storage, rental, and maintenance of application software that allows users to play and program music and entertainment-related audio, video, text and other multimedia content; computerised data storage services.</p>	
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37. **Class 09:** The opponent's earlier goods in class 16 'printed matter; publications; newspapers and periodicals; books' are goods which are intended to be read and to inform the consumer on a certain topic. The applicant's class 09 goods 'electronic publications' share the same intended purpose, respective use and respective users as the opponent's goods above, albeit they are provided in electronic format. They are goods intended to be read by the consumer with the purpose of conveying a message to that audience. These goods are therefore considered to be similar to a medium degree.

38. The applicant's class 09 goods 'electronic notice boards' and 'neon signs' are products intended for use in the conveying of information and messages to an audience. The opponent's earlier goods in class 16 'publicity material' include publicity items produced in physical materials such as plastic, cardboard or paper, and which are intended to convey a message or information. These goods share the same purpose, likely channels of trade, respective users and potentially nature, inasmuch as they will all be physical items displaying a message or information to a certain target group. These goods are therefore considered to be similar to a medium degree.
39. The applicant's class 09 goods 'computer software, recorded', 'computer programs, recorded' and 'downloadable animated cartoons' all share commonality with the opponent's earlier services 'software design and development, computer programming, computer programming services; information, research and consultancy services relating to the aforesaid; design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs; computer programming; rental of computer software'. These goods and services are used by the same public and are produced by the same undertakings. It is not uncommon, particularly in the business or entertainment field, for an undertaking providing computer programming services, for example, to also be acting as the retailer of the software or programs they have designed. These goods and services are also complementary to each other and share the same trade channels, however they do not share nature or intended purpose, as they are tangible goods on the one hand, and intangible services on the other. Therefore, these goods and services are similar to a medium degree.
40. The applicant's class 09 goods 'network communication device', 'enlarging apparatus [photography]', 'photocopiers [photographic, electrostatic, thermic]' and 'sound reproduction apparatus' are electronic goods which have no counterpart or link to any of the opponent's earlier goods or services and are subsequently considered to be dissimilar.



41. **Class 35:** The opponent's earlier services in class 35 include specifically the terms 'advertising services', 'publicity services', 'public relations services' and 'business and business management services' amongst others. The applicant's services 'public relations; advertising; publicity; advertising agencies; publicity agencies; rental of advertising space; business management and organization consultancy; on-line advertising on a digital communication network; business management of performing artists' are encompassed within the opponent's class 35 services mentioned above and are therefore found to be identical.
42. The applicant's services 'systemization of information into computer databases' involve a process that combines data processing of information alongside the technical manipulation of computer databases. As such, the opponent's earlier services 'data processing' in class 35 wholly encompass the applicant's services in this regard. These services are considered to be identical.
43. The applicant's services 'import-export agencies' are a business service, arranging the import of goods and the export of goods on behalf of others. This service is wholly encompassed within the terms 'business services' and 'business administration' of the opponent's class 35 specification and these services are therefore considered to be identical.
44. The applicant's services 'organization of exhibitions for commercial or advertising purposes' comprise a professional service in the field of event organisation. These services involve liaising with the client, to agree on the details around issues such as booking venues, catering, lighting, floor layout, marketing of the event, demonstrations, booking public speakers, amongst others. Much of the work involved can be said to be administration and project management in nature, essential in ensuring that many different strands and work flows are pulled together in a timely and effective manner to ensure a successful exhibition.
45. The opponent's services in class 35 include 'business services' and 'business administration' which are broad in nature. The provision of business services *per se* will include liaising with consumers to agree on detail around specific services required. The term 'business services' will include acting on behalf of third parties

in a business transaction, to ensure that a successful result is realised. The opponent's services 'business administration' are services provided to the consumer intended to ensure that a business or single transaction is organised, arranged and carried out efficiently and effectively, with a successful result. These services may include the secretarial aspect of running a business and they may also cover personnel and facilities management of a site on behalf of others.

46. In that respect the applicant's services 'organization of exhibitions for commercial or advertising purposes' can be seen to share nature, users and channels of trade with the opponent's broader terms 'business services' and 'business administration'. These services are therefore considered to share a good degree of similarity.

47. **Class 42:** The opponent's earlier class 42 service 'computer services' is an extremely wide-ranging term in the field of information technology. The applicant's services 'computer system analysis' are a specialist service provided by either a person or a piece of software, intended to analyse computer systems in order to monitor functionality, effectiveness and look for faults etc. These services fall under the opponent's broader term 'computer services' and are therefore identical.

48. The applicant's services 'conversion of data or documents from physical to electronic media' is a service providing the conversion of data to an electronic media. This is a computer-centric service and is wholly encompassed within the opponent's 'computer services'. These services are therefore considered to be identical.

49. The opponent's services 'hosting of computer sites (web sites)' are identical to the applicant's 'hosting computer sites'.

50. The applicant's services 'computer programming; duplication of computer programs; rental of computer software; computer software consultancy; computer software design' are covered by the opponent's 'computer services' and are therefore identical.

51. The applicant's services 'creating and maintaining web sites for others; providing search engines for the internet' are services specifically involved in the creation, provision and maintenance of internet websites for others. These services are considered to be niche computer services and as such are considered to fall within the opponent's services 'computer services' and are therefore identical.

52. In conclusion, all of the applicant's services applied for under 3225762 in class 42 have been found to be identical, and all of the services in class 35 have been found to be identical or similar to some of the opponent's services.

53. Some of the applicant's goods applied for in class 09 under 3225762 have been found to be similar to the opponent's goods and services, namely:

Electronic notice boards; electronic publications, downloadable; animated cartoons; computer software, recorded; neon signs; computer programs, recorded.

54. Some of the applicant's class 09 goods are considered to be dissimilar to the opponent's goods and services.

As I have found some of the applicant's class 09 goods to be dissimilar, there can be no likelihood of confusion and the opposition under section 5(2)(b) of the Act fails in respect of those goods, namely:

'Enlarging apparatus [photography]; photocopiers [photographic, electrostatic, thermic]; sound reproduction apparatus; Network communication device',

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

55. 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*.

56. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

57. The average consumer of many of the technical or specialist goods and services at issue, for example, ‘electronic notice boards; computer programming; computer software design services; advertising; publicity; business services; business administration;’ will be a professional consumer. For other goods and services at issue, for example, printed matter; books; newspapers; periodicals; posters and calendars; the average consumer will be, for the most part, the general public, but may also be a professional consumer.

58. The selection of technical and specialist goods and services such as business administration or software design services, will be made carefully as these are services that are unlikely to be low cost. The choice of, for example, an advertising agency or public relations firm, is not a casual selection. The average consumer of such services will display a higher level of attentiveness, however the selection process for less technical, day to day products such as a newspaper or periodical, will be made more casually and the consumer of those goods will pay no more than a medium degree of attention to their selection.

59. The selection of the services at issue will be made primarily via websites, high street outlets and through word of mouth recommendations. These services may

also be selected following discussion over the telephone. The selection process can be said to be primarily a visual one, however an aural selection cannot be ruled out. The selection of many of the goods at issue will also be a visual process, combined with technical discussion over the specification and technological capabilities of goods such as electronic notice boards and computer software for example. In the selection of day to day items such as newspapers and periodicals, the choice is likely to be made visually.

### **Comparison of marks**

60. 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 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.”

61. 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.

62. The marks to be compared are:

**(a) 3225728**

Earlier trade mark	Contested trade mark
<b>LINK</b>	<b>HYLINK</b>

63. The opponent's mark consists solely of the plain word 'LINK'. The overall impression given by the opponent's mark lies purely in the perception of the basic English word as a whole.

64. The applicant's mark is comprised of the plain typeface word 'HYLINK' presented in capital letters. Whilst the word 'LINK' is a common word in the English language, the prefix 'HY' is meaningless (although phonetically it may be perceived to be a misspelling of the word 'HIGH'). The overall impression given by the applicant's mark will be that of a single verbal element 'HYLINK'.

**Visual similarity**

65. The marks are visually similar inasmuch as they both contain the word 'LINK', presented in plain type face capital lettering.

66. The marks are visually different in respect of the letters 'HY' which form the beginning of the applicant's mark.

67. Weighing the similarities and differences, and bearing in mind my assessment of the overall impression, I find the marks to be visually similar to a low to medium degree.

**Aural similarity**

68. The opponent's mark is comprised solely of the verbal element 'LINK' which will be enunciated as the single syllable *LINK*. The applicant's mark comprises the letters 'HYLINK'. The mark will be articulated as *HI/LINK*.

69. The marks are aurally similar to a medium degree.

**Conceptual similarity**

70. A conceptual impression of the opponent's mark can only be found in the word 'LINK' as a whole, which is a basic English word that describes a connection between two or more things.

71. The applicant's mark comprises essentially an invented word, although the additional element 'HY' at the beginning of that mark, may be perceived as a misspelling of the word 'HIGH', being phonetically identical. The conceptual impact of the term as a whole, might be that of a link or connection provided in a high place. However, bearing in mind the vagueness of the expression 'HIGH LINK', no meaningful conceptual message will be relayed. For the average consumer that perceives the mark purely as an invented word 'HYLINK', the mark is meaningless and lacks a concept.

72. Therefore, I find that the marks are conceptually neutral, or, alternatively, are similar to a lower than average degree if the vague expression 'high link' is perceived.

**(b) 3225741**

Earlier trade mark	Contested trade marks
<b>LINK</b>	

73. The opponent's mark consists solely of the plain word 'LINK'. The overall impression given by the opponent's mark lies purely in the perception of the basic English word as a whole.

74. The applicant's mark is a figurative mark comprised of an orange logo element; the word 'link' in grey, lower case lettering, and the word 'ADVERTISING' in smaller, capital grey lettering. The orange logo element may be perceived by the average consumer as the letters 'HY' in a stylised design, however it is possible that this element may be appreciated merely as an abstract curved line creating a link between one vertical line and another. The word 'ADVERTISING' will be understood to describe the services offered by the applicant and is therefore non-distinctive and will carry little weight in the overall impression of the mark. Due to their size and placement, the overall impression of the mark is of the word 'link' and the abstract figurative element, which make a roughly equal contribution to that impression.

### **Visual similarity**

75. The marks are visually similar inasmuch as they both contain the word 'LINK'.

76. The marks are visually different in respect of the orange logo element that forms the first part of the applicant's mark, and in the word 'ADVERTISING', also in the applicant's mark, presented in small grey lettering and placed directly below the larger verbal element 'link'. The marks also differ in the fact that the word 'LINK' in the marks is presented in different size, colour and font.

77. Weighing the similarities and differences, and bearing in mind my assessment of the overall impression, I find the marks to be visually similar to a medium degree.

### **Aural similarity**

78. The opponent's mark is comprised solely of the verbal element 'LINK' which will be enunciated as the single syllable *LINK*. The applicant's mark comprises the



words 'LINK' and 'ADVERTISING' and will be articulated as *LINK/AD/VUR/TY/ZING*. For the consumer that perceives the orange figurative element as the letters 'HY', the mark will be articulated as *HI/LINK/AD/VUR/TY/ZING*.

79. Regarding the non-distinctive word 'ADVERTISING', it could be argued that this element may not be articulated at all, which would, if the logo element is not perceived to be the letters 'HY', suggest a finding of aural identity purely in respect of the common element 'LINK'. For those consumers who would articulate HY and ADVERTISING, the marks can be said to be aurally similar to a medium degree.

### **Conceptual similarity**

80. Conceptually, the primary focus in each mark will be of the word 'LINK', which is a common word that suggests a connection between two or more things.

81. The figurative element in the applicant's mark is an orange logo element which conveys no conceptual message for that part of the relevant public which perceives it as merely figurative rather than the stylised letters 'HY'. The other element in the applicant's mark is the word 'ADVERTISING'. For the goods and services in the applied for mark that have a connection to advertising services, this element is non-distinctive and descriptive but will nevertheless carry a conceptual message to the consumer. For goods and services that have no link to advertising services, the term will still bring forward a concept relating to the notion of advertising *per se*. The figurative element may be perceived to be the letters 'HY', and thereby treated as a misspelling of the word 'HIGH', in which case the conceptual message of the term as a whole, might be that of a link or connection to advertising services, provided in a high place. However, bearing in mind the vagueness of the expression 'HIGH LINK', no meaningful conceptual message will be relayed. For the average consumer that perceives the mark purely as an invented word 'HYLINK', the mark is meaningless and lacks a concept.

82. Therefore, in respect of the consumer that considers the logo element to be purely figurative, I find that the marks are conceptually similar to a high degree. For the consumer who perceives the letters 'HY' in the mark and considers this element to be a misspelling of the word 'HIGH', I find the marks to be conceptually similar to a lower than average degree.

**(c) 3225762**

Earlier trade mark	Contested trade marks
<p><b>LINK</b></p>	

83. The opponent's mark consists solely of the plain word 'LINK'. The overall impression given by the opponent's mark lies purely in the perception of the basic English word as a whole.

84. The applicant's mark is a figurative mark comprised of an abstract logo element which may be perceived as the letters 'HY' in a stylised design by the average consumer, however, equally, this element may be appreciated merely as an abstract curved line creating a link between one vertical line and another. The applicant's mark also contains the word 'link' in black and white, lower case lettering, and the word 'ADVERTISING' in smaller, capital type, black and white lettering. The applicant's mark also contains four Asian characters placed on the right-hand side of the mark. The word 'ADVERTISING' will be understood to describe the services offered by the applicant and is therefore non-distinctive and will carry little weight in the overall impression of the mark. Due to their size and placement, the overall impression of the mark is of the word 'link', the abstract figurative element, and the Asian characters, which make a roughly equal contribution to that impression.

### **Visual similarity**

85. The marks are visually similar inasmuch as they both contain the word 'LINK'.

86. The marks are visually different in respect of the logo element which forms the first part of the applicant's mark and in the word 'ADVERTISING', also in the applicant's mark, presented in small grey lettering and placed directly below the larger verbal element 'link'. The marks also differ in respect of the Asian characters in the applicant's mark, which have no counterpart in the opponent's earlier mark and in the fact that the word 'LINK' in the marks is presented in different size, colour and font.

87. Weighing the similarities and differences, and bearing in mind my assessment of the overall impression, I find the marks to be visually similar to a medium degree.

### **Aural similarity**

88. The opponent's mark is comprised solely of the verbal element 'LINK' which will be enunciated as the single syllable *LINK*. The applicant's mark comprises the words 'LINK' and 'ADVERTISING' and will be articulated as *LINK/AD/VUR/TY/ZING*. For the consumer that perceives the figurative element as the letters 'HY' the mark will be articulated as *HI/LINK/AD/VUR/TY/ZING*. The Asian characters in the applicant's mark will not be articulated by the average consumer and therefore add nothing to the aural comparison of these marks.

89. Regarding the word 'ADVERTISING', it could be argued that this element may not be articulated at all, which might, if the logo element was not perceived to be the letters 'HY', suggest a finding of aural identity purely in respect of the common element 'LINK'. For those consumers who would articulate HY and ADVERTISING, the marks can be said to be aurally similar to a medium degree.

## **Conceptual similarity**

90. Conceptually, the assessment of the opponent's mark can only be in the word 'LINK', which is a common word that suggests a connection between two or more things. This verbal element also forms a significant part of the conceptual message relayed by the later mark.
91. The figurative element in the applicant's mark is an abstract logo element which conveys no conceptual message for that part of the relevant public which perceives it as merely figurative rather than the stylised letters 'HY'. For any goods or services in the applied for mark that have a connection to advertising services, the word 'ADVERTISING' in the mark will be considered to be non-distinctive and descriptive, but will nevertheless carry a conceptual message to the consumer. For goods and services that have no link to advertising services, the term will still bring forward a concept relating to the notion of advertising *per se*. The figurative element may be perceived to be the letters 'HY', and thereby treated as a misspelling of the word 'HIGH', in which case the conceptual message of the term as a whole, might be that of a link or connection to advertising services, provided in a high place. However, bearing in mind the vagueness of the expression 'HIGH LINK', no meaningful conceptual message will be relayed. For the average consumer that perceives the mark purely as an invented word 'HYLINK', the mark is meaningless and lacks a concept.
92. The Asian characters, whilst meaningless to the average consumer, form an obvious part of the mark and will convey the concept of an Asian connection with the applicant or the applicant's goods and services.
93. Therefore, in respect of the consumer that considers the logo element to be purely figurative, I find that the marks are conceptually similar to a higher than normal degree. For the consumer that perceives the letters 'HY' in the mark and appreciates that element as a misspelling of the word 'HIGH', I find the marks to be conceptually similar to a lower than average degree.

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

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

“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).”

95. The opponent has not claimed that its earlier mark has an enhanced distinctive character through use. I therefore have only the inherent position to consider.

96. The opponent's mark is comprised solely of the word 'LINK'. The word 'LINK' has little or no connection with the goods and services covered by the opponent's earlier mark. Even for goods and services for which there is no obvious connection with the word 'LINK', it remains a fairly common and basic word in the English language and can therefore be said to have no more than a normal degree of inherent distinctiveness.

## **Likelihood of Confusion**

97. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 11).

98. 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods the nature of the purchasing process and the fact 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.

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

100. The applicant's marks are all different to some degree, and the goods and services listed under each application differ slightly from each other. Taking note of the applicant's comments in its written submissions dated 12 April 2018 (reflecting on the importance of recognising the differences between the marks and the differences in the lists of goods and services at issue), I feel that it is appropriate to consider the matter of confusion between these marks and the opponent's earlier mark, independently, as I have done earlier, in the comparisons of goods/services and marks.

101. I begin therefore, with the applicant's plain word mark 'HYLINK' filed under application 3225728 in class 35.

102. I have found the marks at issue to be visually similar to a low to medium degree; aurally similar to a medium degree and conceptually neutral or similar to a lower than average degree. The earlier mark enjoys a normal level of distinctive character and the average consumer will be a professional, displaying a higher than normal level of attentiveness during the selection process of the services involved. I have found the services at issue to be identical or similar to a good degree.

103. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

104. Whilst the marks at issue 'LINK' and 'HYLINK' share the letters 'LINK', the visual difference between the two marks is clear and obvious, occurring at the beginning of the applicant's mark. It is also the case that the aural similarities are to be found in the ending of the marks and that the phonetic difference between the two marks will be immediately perceived. Conceptually, whilst the word 'LINK' conveys a message to the average consumer, the applicant's mark, when considered in its entirety, is an invented expression with no obvious meaning. Where the consumer might perceive the applicant's mark to be the words 'HIGH LINK' it is the case that conceptually, this expression is vague and allusive at best, and provides no clear message as such.

105. In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union 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."


106. As the average consumer in this matter will be a professional, more time and care will be taken in the selection of the services at issue, and the level of attention paid will be higher than normal. The services involved have been found to be of a kind that can be said to be technical and specialised and therefore unlikely to be low cost.

107. Having considered all of this, I find there to be no likelihood of confusion, direct or indirect, even having found some of the services to be identical, as the differences between the marks, the earlier of which is of no more than average



distinctiveness, are sufficient to ensure that the average consumer, paying particular attention, will readily distinguish between them in the market place.



108. I turn now to the applicant's mark  filed under application 3225741 in classes 35 and 42.

109. I have found the marks at issue to be visually similar to a medium degree.

110. I have found the marks to be aurally identical where the consumer does not perceive the letters 'HY' in the logo, and does not articulate the word 'ADVERTISING' due to its non-distinctive nature, or aurally similar to a medium degree where the logo element is perceived to be the letters 'HY' and where the word 'ADVERTISING' is enunciated.

111. Conceptually I have found the marks to be similar to a higher than average degree for those consumers who do not perceive the logo to be the letters 'HY', and bearing in mind the non-distinctive nature of the word 'ADVERTISING', or similar to a lower than average degree where the consumer does consider the logo element to be the letters 'HY'.

112. The earlier mark enjoys a normal level of distinctive character. The average consumer will be a professional, displaying a higher than normal level of attentiveness during the selection process of the services involved. I have found the services at issue to be identical or similar to a good degree.

113. The logo element at the beginning of the applicant's mark may be perceived by the average consumer to be the letters 'HY' in a heavily stylised design. However, it is also quite likely that a significant proportion of the relevant class of public will not perceive this element in the mark as anything other than an abstract figurative pattern. It is also the case that the word 'ADVERTISING' in the applicant's mark, presented in much smaller lettering than the word 'LINK' and comprising the smallest element in the mark, will also be considered to be nothing more than a non-distinctive, descriptive element in that mark.

114. The common element between the marks at issue is the word 'LINK'. In *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16, the General Court held that the mark shown below was not identical to the word mark CREMESPRESSO.

**CR***e***M**ESPRESSO


The court stated that:

“According to the case law, word marks are marks consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element (see, to that effect, judgment of 7 October 2010, *Accenture Global Services v OHIM - Silver Creek Properties (acsensa)* (T-244/09) not published, EU:T:2010:430 , at [28] and the case-law cited). Therefore, the applicant’s claim that the protection of the earlier mark held by it would also apply with respect to the variations of stylisation **CR**e**M**ESSO and **CR**e**M** ESSO must be rejected.”

Therefore, a word mark registered in standard characters may be considered to cover the use of the same word(s) presented in any normal font. This is so irrespective of the use of upper and lower case letters, or any customary combination of the two. However, normal and fair use of word-only marks, in this case CREMESSO, should not be taken to include stylisation that goes beyond normal and fair use of the word mark, such as in the CReMESPRESSO example shown above.

115. Based on the findings set out above in 'CReMESPRESSO', I find the differences between the size, colour and fonts used in the word 'LINK' in the marks at issue, to be irrelevant in the consumer’s consideration of these marks. They are, for all intents and purposes, identical.

116. In this matter, I conclude that there is no likelihood of direct confusion

between the marks 'LINK' and  as the consumer will readily appreciate the differences between the plain word mark of the opponent and the figurative mark of the applicant.

117. I must however, consider the potential for indirect confusion between the marks.

118. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

119. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion<sup>1</sup>.

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<sup>1</sup> See, for example, the decision of Mr James Mellor QC sitting as the Appointed Person in *Duebros Ltd v Heirler Cenovis GmbH* (BL O/547/17; 27 October 2017).

120. I believe that the visual, aural and conceptual similarities created by the common word 'LINK' will lead to indirect confusion on the part of the average consumer, who will believe the marks to be brand variants of each other and originating from the same or a related undertaking. Whilst I accept that indirect confusion should not be reached merely because the marks share a common element, and that what is required by the average consumer is an instinctive reaction that leads them to the conclusion that the identical services come from the same (or related) trade origin, that instinctive reaction is present in this case.

121. A significant proportion of the relevant public, that part of the consumer base that does not recognise the orange logo element as representing the letters 'HY' and which dismisses the word 'ADVERTISING' as purely non-distinctive and descriptive, will consider the later mark to be a 'LINK' mark. As both parties are involved in the advertising field of business, the average consumer who may be aware of the earlier mark will, when faced with the applicant's figurative mark, simply assume that the accompanying logo in the later mark is an evolution of the existing brand and will understand the inclusion of the word 'LINK' to signify a same stable service.

122. It is also well established that when trade marks consist of a combination of words and figurative components, it is by the word component(s) that the trade mark is most likely to be referred.

123. There is therefore a likelihood of indirect confusion between these marks for all of the services found to be similar or identical.

124. Finally, I turn to the applicant's third mark  
filed under application 3225762 in classes 09, 35 and 42.



125. I have found the marks at issue to be visually similar to a medium degree.

126. I have found the marks to be aurally identical where the consumer does not perceive the letters 'HY' in the logo, and does not articulate the word 'ADVERTISING' due to its non-distinctive nature. The marks are aurally similar to

a medium degree if the logo element is perceived to be the letters 'HY' and where the word 'ADVERTISING' is enunciated. The Asian characters in the mark will not be articulated by the average consumer.

127. Conceptually I have found the marks to be similar to a higher than average degree for those consumers who do not perceive the logo to be the letters 'HY', and bearing in mind the non-distinctive nature of the word 'ADVERTISING', or similar to a low degree where the consumer does consider the logo element to be the letters 'HY'. The addition of the Asian characters, whilst creating a conceptual link between Asia and the applicant company or the goods and services provided by the applicant, adds nothing further to the overall conceptual impact of the mark as a whole.

128. The earlier mark enjoys a normal level of distinctive character. The average consumer will be a professional, displaying a higher than normal level of attentiveness during the selection process of the services involved and, in respect of some of the goods at issue, the general public, whose attention will be normal.

129. I have found all of the services at issue to be identical or similar to a good degree, and some of the goods to be identical or similar to a medium degree. Some of the goods applied for in class 09 are considered to be dissimilar and subsequently no longer form part of this process.

130. The logo element at the beginning of the applicant's mark may be perceived by the average consumer to be the letters 'HY' in a heavily stylised design. However, it is also quite likely that a significant proportion of the relevant class of public will not perceive this element in the mark as anything other than an abstract figurative pattern. It is also the case that the word 'ADVERTISING' in the applicant's mark, presented in much smaller lettering than the word 'LINK' and comprising the smallest element in the mark, will also be considered to be nothing more than a non-distinctive, descriptive element in that mark. The Asian characters placed at the right-hand side of the applicant's mark will not be readily understood by the average consumer. They affect the visual identity of the mark but not the aural impression as they will not be articulated by the average

consumer. Whilst these characters will convey the concept of an Asian connection, either to the applicant company or to the goods and services on offer, this message does nothing to detract from the fact that the word 'LINK' in the later mark forms the predominant verbal element in that mark and also the central element of the mark visually.

131. The common element between the marks at issue is the word 'LINK'. In this regard I refer to my comments earlier (paragraph 114) in respect of *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16, which are relevant in this application as well. Based on the findings set out in 'CREMESPRESSO', I find the differences between the size, colour and fonts used in the word 'LINK' in the marks at issue, to be irrelevant in the consumer's consideration of these marks. They are, for all intents and purposes, identical.

132. In this matter, I conclude that there is no likelihood of direct confusion

between the marks 'LINK' and  as the consumer will readily appreciate the differences between the plain word mark of the opponent and the figurative mark of the applicant.

133. I must however, consider the potential for indirect confusion between the marks. In this regard, I refer again to the findings in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 and *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, set out above in paragraphs 116-117.

134. I have found all of the parties' services in class 42 to be identical and all of the services in class 35 to be identical or similar. The average consumer of these services will be a professional consumer, who will be paying a higher than normal level of attention during the purchasing process. I have found some of the applicant's goods in class 09 to be similar to a medium degree and some to be dissimilar. Some of those goods are technical in nature, such as electronic notice boards, and will likely attract a professional consumer, others are less complex in nature, for example, electronic publications, and will be of interest to both the general public and a professional consumer.

135. Whilst I find that direct confusion between these marks is unlikely, I believe that the visual, aural and conceptual similarities created by the common word 'LINK' will lead to indirect confusion on the part of the average consumer, who will believe the marks to be brand variants of each other and originating from the same or related undertaking. I make this finding in respect of all of the goods and services found to be identical and similar. I believe that the professional consumer, paying more attention during the selection process, and equally the general public when choosing a newspaper or periodical, will consider the applicant's mark to be a brand evolution or new variant of the opponent's mark.

136. It is also well established, that when trade marks consist of a combination of words and figurative components, it is by the word component(s) that the trade mark is most likely to be referred.

137. Whilst I accept that indirect confusion should not be reached merely because the marks share a common element, and that what is required by the average consumer is an instinctive reaction that leads them to the conclusion that the identical services come from the same (or related) trade origin, that instinctive reaction is present in this case. The average consumer will simply assume that the opponent's earlier mark has been changed for some reason or another and will understand the inclusion of the word 'LINK' in the later mark to signify same stable goods and services.

## **Conclusion**

138. The opposition in respect of application 3225728 is dismissed entirely. The opposition in respect of application 3225741 is entirely successful. The opposition in respect of application 3225762 is successful for all of the goods and services found to be identical or similar. This opposition fails however, for those goods in class 09 that have been found to be dissimilar.

139. Application 3225762 may proceed to registration in class 09 for:

Enlarging apparatus [photography]; photocopiers [photographic, electrostatic, thermic]; sound reproduction apparatus; Network communication device.

**Costs**

140. The opponent has had the greater share of success and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee	£100
Preparing the statement of case and considering the counterstatement	£200
Total	£300

141. I therefore order Hylink Digital Solution Co., Ltd. to pay Millward Brown UK Limited the sum of £300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 2<sup>nd</sup> day of August 2018**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**