

O-495-18

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3174036
BY DOMAIN CHANDON LLP
TO REGISTER

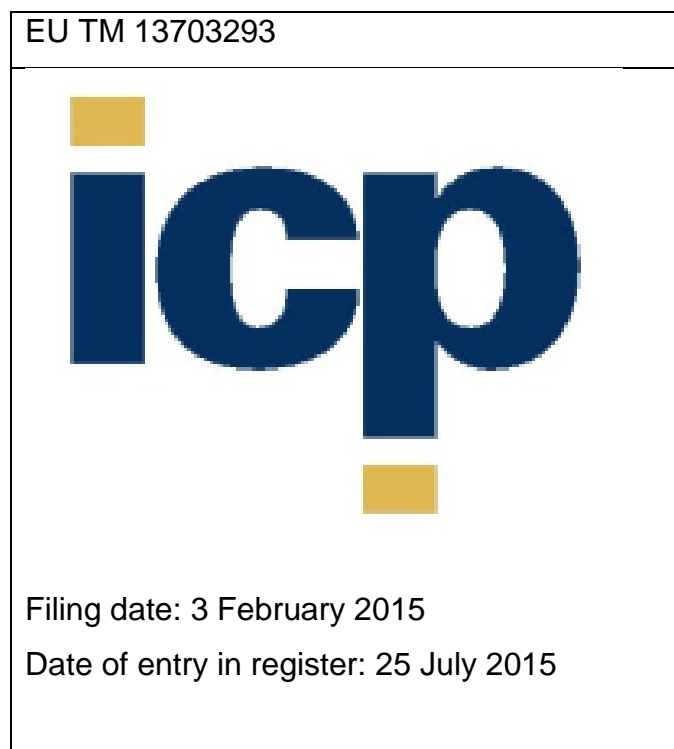


AS A TRADE MARK
IN CLASSES 9, 35, 37, 38, 42
AND OPPOSITION THERETO (UNDER NO. 407761)
BY
INFORMACION, CONTROL Y PLANIFICACION, S.A.

Background & Pleadings

1. Domain Chandon LLP ('the applicant') applied for the mark shown on the title page of this decision on 11 July 2016. The mark was published on 29 July 2016 in classes 9, 35, 37, 38 and 42. The published specifications are set out in full in paragraph 17.

2. Informacion, Control Y Planificacion, S.A. ('the opponent') opposes the mark under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') based on its earlier EU trade mark set out below which is registered in classes 9, 35, 37, 39 and 42. I will set out the registered goods and services later in this decision.



3. The applicant filed a counterstatement in which it denied the ground of opposition.

4. The opponent's EU trade mark is an earlier mark, in accordance with section 6 of the Act, but had not been registered for five years or more at the publication date of the applicant's mark, so it is not subject to the proof of use requirements, as per section 6A of the Act.

5. Only the applicant filed evidence. Neither party requested a hearing and the opponent filed written submissions in lieu. I make this decision based on the papers before me.

6. The applicant is represented by Trademark Eagle Limited in these proceedings and the opponent by Wynne-Jones IP Ltd.

Applicant's evidence

7. The applicant filed considerable evidence demonstrating use of the mark prior to making its application in 2016. As was pointed out in the Tribunal letter dated 3 January 2018, it is unclear why the applicant considered this evidence relevant. It is of no relevance to the notional and objective assessment I have to make of the likelihood of confusion between the respective marks and in the light of their corresponding goods and services as filed and I have therefore, not taken it into account.

Section 5(2)(b)

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

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10. The case law relating to the comparison of goods and services is set out below. In *Canon*, the CJEU 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:

The respective users of the respective goods or services;

- a) The physical nature of the goods or acts of services
- b) The respective trade channels through which the goods or services reach the market
- c) 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;
- d) 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. In relation to the assessment of the respective specifications, I note that in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

13. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, 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."

14. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, the General Court ('GC') held:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359,

paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

15. In *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 goods and services to be compared are set out below. I can see no similarity between the opponent's class 39 services and any of the applicant's goods and services, nor has the opponent made any submission to that effect. Where there is no similarity at all, there is no likelihood of confusion to be considered. There is therefore no need to include class 39 in my comparison below.

Opponent's goods and services	Applicant's goods and services
<p>Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus; Computers and computer peripheral devices; Computer programs recorded or stored on magnetic data carriers, recording or optical discs, computer software and software packages; Printers; Modems; Calculating machines; Magnetic, optical or other kinds of carriers for storing data, sound or images; Apparatus for recording, transmission, reproduction or processing of sound, images or data.</p>	<p>Class 9: Computer hardware; computer networking and data communications equipment; computer networking hardware; communications servers [computer hardware]; network access server hardware; network communication apparatus; network controlling apparatus; network management apparatus; network management software; communications servers [computer hardware]; telecommunication switches; computer network switches; routers; network routers; wireless routers; adapters for wireless network access; internet phones; VOIP phones; data storage apparatus; NAS (Network attached Storage); antennas and aerials as communications apparatus; electronic security systems for home network; software; computer firewall software; computer software for wireless network communications; signal cables for IT; AV and telecommunication; memory apparatus; computer modules; power adapters; audio conference apparatus; visual display units; wireless</p>

	communication apparatus; parts and fittings to all the aforesaid goods.
<p>Class 35: Advertising; Advertising, marketing and commercial promotions; Import-export services; Advertising; Advertising, marketing and publicity promotions; Advertising statements or announcements to the public, by any means of dissemination, advertising information and dissemination; Import-export services; Wholesaling and retailing in shops, via sales catalogues, via mail order or via electronic media, including via websites, of electronic and electrical articles for fixed and mobile telephony, portable devices, computer hardware and peripherals and accessories therefor, electronic and electrical household appliances, image and sound equipment, telecommunications and computer equipment, computer software, vehicles and parts therefor, electronic or electrical playthings and tools.</p>	<p>Class 35: Advertising; retail and wholesale services connected with the sale of computer hardware, computer networking and data communications equipment, computer networking hardware, communications servers [computer hardware], network access server hardware, network communication apparatus, network controlling apparatus, network management apparatus, network management software, communications servers [computer hardware], telecommunication switches, computer network switches, routers, network routers, wireless routers, adapters for wireless network access, internet phones, VOIP phones, data storage apparatus, NAS (Network attached Storage), antennas and aerials as communications apparatus, electronic security systems for home network, software, computer firewall software, computer software for wireless network communications, signal cables for IT, AV and telecommunication, memory apparatus, computer modules, power adapters, audio conference apparatus, visual display units, wireless communication apparatus, parts and fittings to all the aforesaid goods;</p>

	consultancy, information and advisory services to all the aforesaid services.
Class 37: Installation, repair and maintenance of electrical or electronic apparatus for fixed and mobile telephony, portable devices, computer hardware and peripherals and accessories therefor, electronic household appliances, image and sound equipment, telecommunications and computer equipment; Repair and maintenance of all kinds of vehicles and parts therefor, and of telecommunications and computer equipment; Repair and maintenance of all kinds of vehicles and parts therefor.	Class 37: Computer hardware and telecommunication apparatus installation, maintenance and repair; installation, maintenance and repair of computer hardware; installation of hardware for computer systems; installation of hardware for internet access; consultancy, information and advisory services to all the aforesaid services.
	Class 38: Rental of telecommunications equipment; rental of telecommunications apparatus and installations; information about telecommunications; consultancy, information and advisory services to all the aforesaid services.
Class 42: Industrial analysis and research services; Design and development of computers and computer programs (software); Computer programming services; Design, maintenance and up-dating of computer software; Design, installation, interconnection, verification and maintenance of computer programs; Technical project studies in the field of	Class 42: Testing of computer hardware; rental of computer hardware and software; consultancy, information and advisory services to all the aforesaid services.

<p>computer hardware and software; Computer software and hardware consultancy; Computer system analysis; Rental of computers and computer software; Scientific and industrial research; Design and creation of webpages; Provision of search engines for the Internet; Hosting computer sites and web sites</p>	
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18. Regarding class 9, the opponent submits that *software; computer firewall software; computer software for wireless network communications* are identical goods as they fall within the scope of its *computer software and software packages* on the *Meric* principle outlined in paragraph 14. I agree with this submission and would add that *network management software* also falls within the scope of *Computer software* at large. As for the remainder of the applicant's goods in class 9, namely *Computer hardware; computer networking and data communications equipment; computer networking hardware; communications servers [computer hardware]; network access server hardware; network communication apparatus; network controlling apparatus; network management apparatus; communications servers [computer hardware]; telecommunication switches; computer network switches; routers; network routers; wireless routers; adapters for wireless network access; internet phones; VOIP phones; data storage apparatus; NAS (Network attached Storage); antennas and aerials as communications apparatus; electronic security systems for home network; signal cables for IT; AV and telecommunication; memory apparatus; computer modules; power adapters; audio conference apparatus; visual display units; wireless communication apparatus; parts and fittings to all the aforesaid goods*, these are considered identical to *Apparatus for recording, transmission, reproduction or processing of sound, images or data* in the opponent's specification on the *Meric* principle.

19. Regarding class 35, I find that the opponent's *advertising* service is self-evidently identical to *advertising* in the applicant's specification. As for the following services in the applicant's specification, i.e. *retail and wholesale services connected with the*

sale of computer hardware, computer networking and data communications equipment, computer networking hardware, communications servers [computer hardware], network access server hardware, network communication apparatus, network controlling apparatus, network management apparatus, network management software, communications servers [computer hardware], telecommunication switches, computer network switches, routers, network routers, wireless routers, adapters for wireless network access, internet phones, VOIP phones, data storage apparatus, NAS (Network attached Storage), antennas and aerials as communications apparatus, electronic security systems for home network, software, computer firewall software, computer software for wireless network communications, signal cables for IT, AV and telecommunication, memory apparatus, computer modules, power adapters, audio conference apparatus, visual display units, wireless communication apparatus, parts and fittings to all the aforesaid goods, I find these to be identical to Wholesaling and retailing in shops, via sales catalogues, via mail order or via electronic media, including via websites, of electronic and electrical articles for fixed and mobile telephony, portable devices, computer hardware and peripherals and accessories therefor, image and sound equipment, telecommunications and computer equipment, computer software in the opponent's specification on the Meric principle.

20. In its submissions, the opponent contends that the applicant's class 35 services for *consultancy, information and advisory services to all the aforesaid services,*

“are all complementary to the services themselves. Additionally, it would be expected that the consultancy information and advisory for these services would derive from the same commercial origin as the services themselves”.

I agree with the opponent on this point and find these services to be complementary and as such similar to at least a medium degree.

21. Regarding class 37, I find that *Computer hardware and telecommunication apparatus installation, maintenance and repair; installation, maintenance and repair of computer hardware; installation of hardware for computer systems; installation of hardware for internet access* in the applicant's specification to be identical to the opponent's services for *Installation, repair and maintenance of electrical or electronic apparatus for fixed and mobile telephony, portable devices, computer hardware and*

peripherals and accessories therefor, image and sound equipment, telecommunications and computer equipment.

22. The opponent makes the same point that *consultancy, information and advisory services to all the aforesaid services* in the applicant's class 37 specification should be treated as complementary to the services themselves, with which I agree. As such I find the services similar to at least a medium degree.

23. With regard to class 38, as there is no equivalent class in the earlier mark, the opponent submits that the applicant's services in class 38, namely *Rental of telecommunications equipment; rental of telecommunications apparatus and installations; information about telecommunications; consultancy, information and advisory services to all the aforesaid services* are similar to the opponent's goods in class 9 on the basis that,

“The earlier registration covers goods in class nine which cover ‘telecommunication equipment, installations, and apparatus’. The rental of this equipment is highly similar to offering the goods themselves. It is both complementary and in direct competition with the goods offered in class 9. The rental of these goods cannot be done without the goods themselves. Additionally, potential consumers of the opponent's could end up opting to rent these goods rather than purchasing...”.

24. I agree with the opponent's submission on this matter. My own experience (as a member of the general public) confirms that it is not unusual for companies to offer rental services for apparatus or equipment as an alternative to purchase so there is likely to be a generally held view that a rental service for telecommunications products and the products themselves come from the same commercial undertaking. I find these services and goods to be similar. Services such as *consultancy, information and advisory services* are closely tied to the service itself and can therefore be considered as complementary. As such I find these services similar to at least a medium degree.

25. Regarding class 42, I find that the opponent's and applicant's services *rental of computer software* are obviously identical. Further I consider that *rental of computer hardware* is similar to a medium degree because hardware is necessary to the function of software making them complementary and I consider it likely that they will

be available for rental from the same undertaking. The opponent submits that *testing of computer hardware* is similar to *Design, maintenance and up-dating of computer software; Design, installation, interconnection, verification and maintenance of computer programs* in its specification on the basis that,

“... it would be again assumed by the average consumer that all of these services would be offered under the same roof and a single commercial undertaking”.

I agree with this submission. As outlined above, I find there is a complementary relationship between hardware and software so there is at least a medium degree of similarity between the testing of hardware and the design, maintenance and updating of software. The nature of the services are the same in that both are checking functionality of the products and the users are likely to be in the same technology field.

Average consumer and the purchasing act

26. I now consider who the average consumer is for the contested goods and services and how they are purchased. 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*.

27. 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.”

28. In this case the specifications are broad and cover a range of goods and services, and could be purchased by both the general public and businesses. Some of the contested goods and services could be very expensive purchases such as installation of computer systems whilst other goods and services are lower in price. Ordinarily I would expect a normal to high level of attention being paid by the consumer during selection. The purchasing act will be primarily visual as both the goods and services can be selected in traditional bricks and mortar retail premises, or from perusal of Internet websites or advertising materials. However, I do not discount aural considerations such as advice sought from a sales team or from a technical specialist prior to purchase.



Comparison of the marks

29. 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 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.”

30. 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.

31. The marks to be compared are:

Opponent's mark	Applicant's mark
	

32. The opponent's mark is a composite arrangement of the letters **icp** in lower case and coloured dark blue, with two yellow rectangular devices. One rectangular device is positioned above the letter **i** and the other is positioned below the descending tail of the letter **p**. It is a rule of thumb that generally words speak louder than devices. I consider that rule to be applicable here and it is the letters **ICP** which form the overall impression of the mark.

33. The applicant's mark is also a composite arrangement of the capital letters **ICP**, surmounting a device (which the applicant describes as a 'node') and the word **networks**. All three elements are coloured white and contained within a blue parallelogram shaped background. The device and **networks** word element are smaller in scale and size than the letters **ICP** above but they are not negligible. The opponent submits that,

“the word ‘network’ [sic] within the applied for mark will be disregarded, as it is purely descriptive and lacks distinctive character in respect of the goods and services filed”

I note the opponent's submissions and agree that **networks** is a descriptive term in relation to the contested goods and services and as such is lower in distinctiveness than the letters **ICP**, which I find to be the dominant and distinctive element of the mark.

34. When making a visual comparison, the point of similarity is the letter combination **ICP** which appears in both marks. There are points of difference in that the opponent's mark has a rectangle shape above the letter **i** and below the letter **p** although the shape above the **i** does reinforce the notion of it being seen as a letter **i**. The applicant's mark has the additional node device and word **networks**, although I

have already found that this word carries less weight overall within the mark. Taking all these factors into account, I find there is a medium level of similarity.

35. In an aural comparison, the shared letters I, C and P will be pronounced identically as EYE-CEE-PEE. The opponent's additional device element will not be verbalised as is the case with the applicant's device. The applicant's other word element **networks** is likely to be verbalised so taking this into account, I find there is a medium level of aural similarity.

36. In a conceptual comparison of the marks, the letters ICP have themselves no immediately graspable concept¹. The applicant's additional word **networks** will bring to mind its usual dictionary definition which is descriptive of the contested goods and services. Given that, the conceptual hook for the average consumer will be computer or telecommunications networks and the letters ICP. On that basis I find that the marks are conceptually neutral.

Distinctive character of the earlier mark

37. I now consider the distinctive character of the earlier mark. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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

¹ It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

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).”

38. There is no evidence showing use of the earlier mark before me in this case so I can only consider the inherent distinctiveness of the earlier mark.

39. Although the letters **ICP** do not describe or allude to the relevant goods and services, there is nothing especially striking or inventive about three random letters of the alphabet. The device elements are relatively banal. On that basis, I find that there is an average level of inherent distinctiveness.

Likelihood of confusion

40. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

41. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

42. Furthermore I note in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

43. So far, I have found that some of the contested goods and services are identical and some are similar on the basis of complementarity and other factors and the average consumer will pay a normal to high level of attention during the purchasing process. In addition, I have found that the earlier mark has an average level of inherent distinctiveness. In the comparison of the marks I found they were visually and aurally similar to a medium degree and conceptually neutral.

44. Based on the marks and the goods and services before me and taking into account the assessments I have made, in addition to the comments made by Mr Purvis outlined above in *Kurt Geiger*, I have found that the word **networks** is the weakest element of the applicant’s mark leaving the device and the letters **ICP** which I found to be the dominant and distinctive element. Obviously, the letters **ICP** are identical to the earlier mark. Given this identical **ICP** element in both marks and the weak distinctiveness of the word **networks** in the applicant’s mark, I believe that

even in the case of business consumers giving a high level of attention to purchasing expensive goods and services, the effect of imperfect recollection will be such that a significant proportion of the relevant public will directly confuse the two marks where the goods and services are identical or similar.

Conclusion

45. The opposition succeeds under section 5(2)(b) of the Act for all the goods and services claimed.

Costs

46. As the Opponent has been successful, it is entitled to a contribution of towards its costs incurred in these proceedings. The opponent has also asked that the applicant's provision of unnecessary evidence should be taken into account. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£100 official fees for filing Notice of Opposition

£400 considering the defence and counterstatement and preparing written submissions

£100 considering applicant's evidence

£600 total

47. I order Domain Chandon LLP to pay Informacion, Control Y Planificacion, S.A the sum of £600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of August 2018

June Ralph

For the Registrar,

The Comptroller General