

O-358-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3168791
BY UBERFONE LIMITED
TO REGISTER IN CLASSES 9, 35 & 38
THE TRADE MARK**



AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER Nos. 408483
BY
UBER TECHNOLOGIES INC.**

BACKGROUND

1) On 9 June 2016, Uberfone Ltd (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following goods and services, subsequently amended:

In Class 9: Mobile phones and accessories; batteries; battery charges; media for storing information, data, signals, images and/or sounds; photographic apparatus and instruments; parts and fittings for the aforesaid goods.

In Class 35: Retail services connected with the sale of mobile phones and accessories; batteries; battery charges; media for storing information, data, signals, images and/or sounds; photographic apparatus and instruments; parts and fittings for the aforesaid goods”.

In Class 38: Advisory and consultancy services relating to communications apparatus, equipment and accessories; rental and hire of communications apparatus, equipment and accessories; provision of information relating to communications apparatus, equipment and accessories”.

2) The application was examined and accepted, and subsequently published for opposition purposes on 4 November 2016 in Trade Marks Journal No.2016/045.

3) On 6 February 2017 Uber Technologies Inc. (hereinafter the opponent) filed notice of opposition. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
UBER	EU 10460442	01.12.11 24.04.12	9	Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; Computer software; Computer peripherals; 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; Automatic vending machines and mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus.
			38	Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators in the vicinity of the caller using mobile phones; Telecommunications.
UBERX		17.06.14	9	Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; Computer software; Scientific, nautical,

	EU 13004809	16.10.14 Priority date 20.02.14 Priority country United States of America		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; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Fire-extinguishing apparatus.
			38	Telecommunications services, namely, routing calls, SMS messages, and push notifications to local third-party motorized vehicle operators in the vicinity of the caller using mobile phones; Telecommunications.
UBERPOP	EU 13009171	18.06.14 22.01.15	9	Computer software for coordinating transportation and delivery services; Computer software for providing information on transportation and delivery services; Computer software for the scheduling and dispatch of motorized vehicles, couriers, and messengers; Computer software for planning, scheduling, controlling, monitoring, and providing information on transportation of passengers, assets, and goods; Computer software for providing information concerning pick-up and delivery of passengers, assets, and goods in transit; Computer software that enables customers to communicate with motorized vehicle operators, couriers, and messengers; Computer software that enables customers to manage and track pickup and delivery of passengers, assets, and goods; Transportation software; Computer software for coordinating and matching drivers and passengers for potential ridesharing; 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; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Fire-extinguishing apparatus.
			38	Telecommunications services, namely, routing calls, text messages, and push-notifications to local third-party motorized vehicle operators, couriers, and messengers in the vicinity of the caller using mobile phones; Telecommunications services, namely, routing calls, text messages, and push-notifications to customers; Telecommunications; Online document delivery via a global computer network.
UBEREATS	EU 13759394	20.0215 23.0615	9	Computer software; computer software for engaging and coordinating transportation services; computer software for engaging and coordinating delivery services.
			35	Advertising and promotional services; business management; business administration; business administration in the field of transport and delivery; business management services in the field of transport and delivery; ordering services; food and grocery ordering services; product ordering and delivery services; computerized ordering service; on-line ordering service; office functions; on-line retail store services; on-line grocery store services; comparison shopping services; monitoring, managing and tracking of package shipments; monitoring and tracking of package shipments to ensure on-time delivery for business purposes; business management consulting services in the field of transportation and delivery; providing information and tracking information to third parties regarding pickup and delivery status via Internet access and telephone; follow-up services, namely, providing electronic tracking of packages and documents to others; providing a web-based system and online portals in the field of consumer-to-business commerce for consumers to enter, manage and modify their consumer preference information for use by merchants to create and manage offers for delivery to consumers.
			38	Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators and food and grocery delivery agents in the vicinity of the caller using mobile phones; telecommunication

				services, namely, routing calls, SMS messages and push-notifications to retail and delivery services; telecommunications.
UBERPOOL	EU 14414221	27.07.15	9	Computer software for coordinating transportation services, namely, software for the automated scheduling and dispatch of motorized vehicles; computer software for use by motorized vehicle operators and passengers and potential passengers for ridesharing; computer software.
		25.11.15 Priority date 29.05.15 Priority country United States of America	38	Telecommunications services, namely, routing calls, SMS messages, and push-notifications to local third-party motorized vehicle operators in the vicinity of the caller using mobile phones; telecommunications.
UBERRUSH	EU 15099278	11.02.16	9	Computer software for coordinating transportation and delivery services; computer software for obtaining, arranging and booking transportation and delivery services; computer software for providing information on transportation and delivery services; computer software for the scheduling and dispatch of motorized vehicles, couriers, and messengers; computer software for planning, scheduling, controlling, monitoring, and providing information on transportation of assets and goods; computer software for providing information concerning pick-up and delivery of assets and goods in transit; computer software that enables customers to communicate with motorized vehicle operators, couriers, and messengers; computer software that enables customers to manage and track pickup and delivery of assets and goods; computer software for use by others to provide transportation and delivery services; mobile application software for coordinating transportation and delivery services; mobile application software for obtaining, arranging and booking transportation and delivery services; mobile application software for providing information on transportation and delivery services; mobile application software for the scheduling and dispatch of motorized vehicles, couriers, and messengers; mobile application software for planning, scheduling, controlling, monitoring, and providing information on transportation of assets and goods; mobile application software for providing information concerning pick-up and delivery of assets and goods in transit; mobile application software that enables customers to communicate with motorized vehicle operators, couriers, and messengers; mobile application software that enables customers to manage and track pickup and delivery of assets and goods; mobile application software for use by others to provide transportation and delivery services; computer software; downloadable software; telephones; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; cash registers, calculating machines, data processing equipment and computers.
		14.07.16	35	Advertising and promotional services; marketing services; business management; business administration; business administration in the field of transport and delivery; business management services in the field of transport and delivery; ordering services; food and grocery ordering services; product ordering services; computerized ordering service; online ordering service; office functions; online grocery store services; comparison shopping services; business management consulting services in the field of transportation and delivery; providing incentive reward programs for customers and partners for commercial, promotional or advertising purposes; customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; providing an online marketplace for users to buy, sell and exchange goods and services with other users.
			38	Telecommunications services, namely, routing calls, text messages, and push-notifications to local third-party motorized vehicle operators, couriers, and messengers in the vicinity of the caller using mobile phones; telecommunications services, namely, routing calls, text messages, and push-notifications to

				customers; electronic transmission of data; telecommunications.
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- a) The opponent relies upon all of the goods and services for which its six marks above are registered and also claims that it has reputation in all the goods and services for which its marks are registered. The opponent contends that its marks and the mark applied for are very similar and that the goods and services applied for are identical and/or similar to the goods and services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent relies only upon its earlier mark 10460442 for its claim under 5(3) of the Act. It says that use of the mark in suit would take unfair advantage of its earlier mark as the marks/goods and services are identical/ similar. Use of the mark in suit would also dilute the distinctiveness of its mark. As such the mark in suit offends against section 5(3) of the Act.
- c) The opponent claims to have used the sign UBER in the UK since 1 December 2011 in respect of the following goods: Computer software; computer hardware; online retail store services; Insurance; telecommunications; transportation services; travel arrangement; Providing temporary use or online non-downloadable software for providing transportation services, booking for transportation services and for dispatching motorized vehicles to customers; Scientific and technological services and research and design relating thereto; industrial analysis and research services; Design and development of computer hardware and software. As such it has achieved goodwill in these services throughout the UK. Use of the mark in suit will cause misrepresentation and damage and therefore offends against section 5(4)(a) of the Trade Marks Act.
- 4) On 20 August 2018 the applicant filed a counterstatement basically denying all the grounds of opposition.
- 5) Only the opponent filed evidence, and both also seek an award of costs in their favour. The matter came to be heard on 6 June 2019 when Mr Kelly of Messrs FR Kelly represented the applicant; the opponent was represented by Mr Harris of Counsel instructed by Messrs Lane IP.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 16 November 2018, by Raphael Gutierrez the Director of Intellectual Property at the opponent company. The company was originally called UBERCAB but changed its name to UBER in 2011. He states that the opponent began offering its mobile phone software application (app) in the UK in June 2012. The app allows users to obtain, and Uber partners to provide, on-demand, location-based transportation, delivery and other services. Prior to the date of the application (9 June 2016) these services were available in most major cities in the UK (Birmingham, Bristol, Cardiff, Edinburgh, Glasgow, Leeds, London, Manchester, Newcastle and Sheffield). He states that in London alone in 2015 there were more than 3million Uber trips per month. He states that in the UK the mark UBER has also been used as a prefix to describe the type of vehicle used e.g. UberX for a standard vehicle; UberXL for a larger vehicle; UberExec for executive vehicles; UberLux for luxury vehicles and UberPool for standard vehicles used for shared journeys.

7) Mr Gutierrez states that in the UK the Uber Twitter page has 38,000 followers. He provides global figures for other types of social media, which are much higher but not relevant as there is no specific UK figure. The company has participated in a number of UK exhibitions, conventions and conferences and has won a number of awards in the UK. The opponent provides the following turnover figures for its wholly owned UK subsidiary company which shows UK turnover under Uber increasing from £11.3m in 2014 to £36.9million in 2016. He provides the following exhibits:

- RG1: A history of the opponent company.
- RG2: A number of press articles dated prior to the application date (9 June 2016) which show the Uber cab service being used in various cities and towns throughout the UK. They show use of the terms UBER and UBERX, prior to the relevant date. Use of the other marks shown above are included at pages 34, 39, 41, 43, 45, 50, 55, 59, 71, 74, 81, 86, 90, 93, 96, 99, 103, but these (and a large number of the other pages) are not dated.
- RG6: This is said to be examples from the Uber website of Uber sub brands being used. However, those that relate to the UK and are dated prior to the relevant date only show use of the mark UBER.

- RG7: Details of the iTunes app store and Google Play store regarding the Uber app. These show that globally it has been downloaded over 100 million times.
- RG8: This is said to contain newspaper articles regarding use of the sub-brands referred to in paragraph 6 above. However, it also has pages from the UBER and other websites. The following marks are mentioned:
 - UBERXL: page 164, dated 22 October 2014, from UBER website.
 - UBEREXEC: page 167, dated 9 April 2015, from the Yorkshire Evening post; also page 168 from a website thenextweb.com dated 22 November 2013.
 - UBER LUX: page 169, from a website thenextweb.com, dated 22 November 2013.
 - UBERPOOL: page 170, the Daily Telegraph, dated 31 May 2016.
- RG9: Use of Uberpop (drivers have no professional taxi or chauffeur licences) in Paris in 2014 and UberEats (a fast food delivery service) in London in March 2017. It also shows other uses of Uber as a prefix such as UberAdvent, Ubercheeky and Ubergiving. However, these appear to one off marketing gimmicks, with Ubercheeky being used in connection with delivering underwear for Valentines day 2014, and Ubergiving (donating to charity) and Uberadvent (Christmas competitions) connected with Christmas 2014. It also shows Uberlive in connection with live shows in June 2015; Uberpitch where business start-ups could pitch their ideas to potential investors in May 2016. It also shows Uber selling a phone holder for use in cars in the USA.
- RG10 More press articles, dated prior to the application date which shows that Uber has 20,000 drivers in London.
- RG11: Articles showing that the opponent took part in a number of UK based exhibitions and conferences.
- RG12-15: Press articles showing the opponent (UBER) winning awards in the UK in 2014, 2015 and 2016.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The mark in suit was published on 4 November 2016 at which point none of the opponent’s marks had been registered for over five years. Therefore, the proof of use requirements do not bite.

12) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

The average consumer and the nature of the purchasing decision

13) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

14) The goods and services in this case relate, broadly speaking, to mobile phones and retail and advisory services for same. Such items are typically purchased by the public at large (including businesses). Such goods and services will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that such goods and services may be researched or discussed with a member of staff. Therefore, aural considerations must also be taken into account. Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items for a computer such as a cable or standard off

the shelf software the average consumer will pay attention to considerations such as whether the item is compatible with their existing equipment, precisely what it will deliver and also the cost. **Overall the average consumer for these types of goods and services is likely to pay at least a medium degree of attention to the selection of such goods and services. I believe that this also holds true for all of the goods and services covered by the application.**

15) As stated earlier a number of these goods and services will also be purchased by businesses. It is normal to assume that businesses take slightly more care in making decisions regarding the purchase of goods and services as their survival may depend upon making the correct choice both economically and for the image of the business. **To my mind, the average business consumer for these types of goods and services is likely to pay a medium to high degree of attention to the selection of the goods and services covered by the application.**

Comparison of goods and services

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

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

17) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC 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”.

18) 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."

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

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

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

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

21) 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".

22) 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.”

23) I also note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

24) Thus, where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. I will first compare the goods and services of the opponent’s mark EU 10460442 which, to my mind, offers the opponent its strongest case in terms of its mark and goods and services. At the hearing Mr Harris accepted that this mark did indeed provide his client’s strongest case.

25) I shall first consider the two parties goods in class 9. In my opinion, the opponent's specification of "Apparatus for recording, transmission or reproduction of sound or images; Computer software; Computer peripherals; Magnetic data carriers, recording discs" encompasses the terms "Mobile phones and accessories; media for storing information, data, signals, images and/or sounds; parts and fittings for the aforesaid goods" in the applicant's specification. They are therefore identical.

26) The opponent's specification of "photographic apparatus and instruments; Computer software; Computer peripherals; Magnetic data carriers, recording discs", to my mind, encompasses to the terms "media for storing information, data, signals, images and/or sounds; photographic apparatus and instruments; parts and fittings for the aforesaid good". They are therefore identical.

27) In my view, the opponent's specification of "Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity;" encompasses the terms "batteries; battery charges; parts and fittings for the aforesaid goods". They are therefore identical.

28) I next turn to consider the services of the two parties in class 38. The last word in the opponent's specification is simply "telecommunications" which, in my view, must encapsulate all of the applicant's specification in the same class. The class 38 services of the two parties are identical.

29) At the hearing I set out my views expressed in paragraphs 25-28 above to Mr Kelly. Although he did not accept my findings he stated that he would not contest the matter and so did not provide submissions.

30) The applicant's remaining services are simply retail services relating to mobile phones in class 35. None of the opponent's services under the mark EU 10460442 are in any way similar to these services of the applicant. The nearest the opponent gets is the goods which are listed in the applicant's retail services are similar to the opponent's goods in class 9. In deciding if the opponent's goods can be considered similar to the retailing of said goods I take into account the views expressed in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, where the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

31) I also look to the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, where Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

32) However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

33) Whilst in *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

34) At the hearing Mr Harris referred me to the subsequent decision of the Hearing Officer in the above case O-454-14 (*Wasabi*) after Mr Hobbs had commented in the manner he did and remitted it to the Registry. The Hearing Officer in the remitted case stated:

"14. I find that *travelling bags, shopping bags and beach bags* are types of handbags and are therefore covered by that term. If that is right, then on the same basis as *Oakley* I find that *the bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags* is a complementary service to *handbags*. If that is not right, the goods to which these retail services relate are highly similar to handbags. They are likely to be sold alongside, and as alternatives to, some kinds of handbags. They are therefore likely to be the subject of the same retail services as handbags. In these circumstances the applicant's retail services may be important for the sale of the opponent's goods. It is therefore plausible that the relevant public might believe that the undertaking which sells *handbags* under a particular trade mark is the same undertaking, or a connected undertaking, to one that provides (under the same or a similar mark) the service of *bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags*'. There is therefore a degree of complementarity between the applicant's retail services and the opponent's *handbags*.

15. Nevertheless, the nature, purpose and method of use of these goods are different to retail services. Further, the respective goods and services are not in competition. Therefore there is only a low degree of similarity between, on the one hand, *the bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags*' and on the other hand, *handbags*."

35) Earlier in this decision (at paragraph 25) I determined that aspects of the opponent's class 9 specification were identical to the applicant's class 9 goods "Mobile phones and accessories; media for storing information, data, signals, images and/or sounds; parts and fittings for the aforesaid goods". The class 35 services of the applicant relate simply to the retailing of these goods. In my experience, the type of goods covered by the class 9 registration and included in the applicant's class 35 retail services are not usually sold by the manufacturer in retail outlets. With certain exceptions computer hardware and software, telecommunications equipment, audio and visual equipment and their peripheral items are usually sold in retail stores specialising in such items (PC World, Richer Sounds) or general electrical stores (Currys, Argos), and also through on-line sites (Amazon, eBay). I accept that some manufacturers do retail their own products (Apple) but these are, in my experience, the exception. Taking into account the comments in the above authorities I conclude that the services of the applicant in class 35 must be regarded as complementary to the opponent's goods in class 9 and similar to a low degree.

36) I also have to consider the goods and services for which the opponent's other marks are registered and compare these to the class 35 services of the applicant. The trade mark EU 13759394 (UNBEREATS) has services in class 35, part of which states "on-line retail store services", however, it does not specify what goods are intended to be sold and in accordance with paragraph 33 above this is too vague to find any similarity or complementarity. Trade mark EU 15099278 also has some class 35 services including "on-line grocery store services" which to my mind is another way of saying "retail of groceries". In this instance the goods are specified and are utterly different to the goods being retailed by the applicant. I therefore find that the applicant's services in classes 35 are not similar or complementary to any of the goods or services for which the opponent's marks are registered.

37) My conclusions regarding the goods and services of the two parties are:



- the class 9 goods are identical.
- the services of the applicant in class 35 are complementary to the opponent's goods in class 9 and so are similar to a low degree.
- the class 38 services of the two parties are identical.

Comparison of trade marks

38) As stated earlier in this decision I believe that the opponent’s mark EU 10460442 provides the opponent with its strongest case. 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 them, 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.”

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

Opponent’s trade mark	Applicant’s trade mark
	

40) The applicant points out the obvious differences visually and phonetically, but also contends that the average consumer would understand that the UBER element means outstanding or superb. It states:

“The comparison in relation to this Trade Mark is between a trade mark consisting of four letters and a trade mark consisting of five words consisting of a total of twenty five letters. Furthermore, the trade mark of the Applicant contains at the beginning of the trade mark, the letter U (in stylised font) with an umlaut appearing above the U which has the appearance of a smiley face. The trade

mark for which the Applicant seeks registration is, as a result of the clear differences in the trade mark, visually, phonetically and conceptually easily distinguishable from his prior right.”

41) When comparing the marks I take into account the views expressed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word 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.

42) I note that in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the Court of Justice of the European Union found 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)".

43) When considering the use of a foreign word in a mark I look to the views expressed in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, where in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought. The same must apply to the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them: see *Matratzen Concord AG v OHIM*, Case T-6/01.

44) Visually it is obvious that both marks have the word UBER at their starts. Most UK consumers will recognise that the term is German, but probably not be aware of its meaning. Those who do know that it denotes an outstanding or supreme example of a particular kind of person or thing will see it as laudatory and less distinctive. Given the reputation of the UK population as being monoglots the number who will know of the meaning will, I believe, be relatively low. I accept that the applicant's mark has a more rounded letter "u" with what could be an umlaut, which given that the word "UBER" will be seen to be of German origin, would be unsurprising. It undoubtedly also makes a "smiley face".

45) To my mind, the average consumer will immediately see the "smiley face" and assume that the word UBER is usually spelt with an umlaut but that it has been slightly adapted to give the impression of a "friendly" company. The rest of the applicant's mark will obviously be seen but the term "fone" will immediately be understood to refer to phones and telecommunications (as per Vodafone) as it is a commonly used spelling of phone. When used on phones and telecommunications goods or services

it would be seen as descriptive or allusive and therefore lacks distinctiveness. The second line of the applicant's mark "We've got you covered" will be seen as a typically marketing strapline of little or no distinctiveness and certainly not an indication of origin. When used in relation to phones and telecommunications it will probably be seen as an indication of the network coverage, an aspect of particular importance to mobile phone users who can find themselves in areas where they cannot get a signal. There are obvious visual differences, but the majority of the differences are in relation to descriptive or marketing matter. To my mind, there is a low to medium degree of visual similarity.

46) Aurally, the marks would begin in identical fashion and then, after the first two syllables (U-BER) are completely different. The marks are at least similar to a low degree.

47) Conceptually, I do not believe that most UK consumers will be aware of what the term UBER means, as such it will simply be viewed as a foreign word with the equivalent of phone tagged on and a strapline or slogan underneath. I believe that the conceptually the marks are conceptually neutral

48) Overall. I believe that the marks have a low to medium degree of similarity.

Distinctive character of the earlier trade mark

49) 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).”

50) The opponent’s mark consists of a single word UBER. Earlier in this decision I determined that the average UK consumer would view the word as a foreign word but not be aware of what it means. As such **it has at least an average degree of inherent distinctiveness**. The opponent has shown that it has made extensive use of its mark in the UK in relation to cab services and the telephone application that has to be downloaded and used to access the service. The service has been controversial and has engendered many headlines as conventional cab/mini cab companies sought to prevent the company being granted licenses to work in the UK. **As such it has an enhanced degree of distinctives through use, although not in respect of the goods I have found to be identical.**

Likelihood of confusion

51) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay at least a medium (medium to high in the case of businesses) degree of attention to the selection of said goods and services.
- the marks of the two parties have a low to medium degree of similarity.

- the opponent's mark has at least an average degree of inherent distinctiveness but can benefit from an enhanced distinctiveness through use, but not in respect of those goods and services deemed to be identical.
- in respect of the goods and services I found the following:

the class 9 goods are identical.

the services of the applicant in class 35 are complementary to the opponent's goods in class 9 and so are similar to a low degree.

the class 38 services of the two parties are identical.

52) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. 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."

53) 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.

54) I also consider the issue of indirect confusion, and take into account the case of *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.

55) I also note that 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.

56) In view of all of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused, directly or indirectly, into believing that the goods and services identified above as being identical applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it, even though the opponent’s mark has no enhanced distinctiveness through use on the good and services. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods and services in classes 9 & 38.**

57) In view of all of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused, directly or indirectly, into believing that the goods and services identified above as being similar to a low degree and applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the services in Class 35.**

58) I note that the opponent contended that it had a family of marks. When considering this claim I take into account the views expressed in *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, where the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

59) To my mind the opponent's evidence of use of its other registered marks is such that it does not meet the standard as set out above that the average consumer will be aware of the other marks relied upon and so unaware of a family of UBER marks being used by the opponent. Even if I am wrong in this, if the opponent has a family of marks it is in relation to its taxi services and therefore takes the opposition no further than its case based on UBER alone for identical and similar goods/services.

60) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

61) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Saloman*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those

goods/services, and the strength of the earlier mark's reputation and distinctiveness;
Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation

(Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

62) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade marks enjoy a reputation or public recognition. Earlier in this decision I found that the opponent had provided evidence that it had a reputation in its UBER mark in respect of cab services and the telephone application that has to be downloaded and used to access the service. As such it gets over the first hurdle of reputation in respect of mark EU10460442. I am willing to accept that the opponent also has reputation in its mark UBERX in respect of cab services solus.

63) I next consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

64) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of

Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

65) In C-252/07 *Intel Corp* [2008] ECR I-8823 at paragraph 42 the court set out the factors used to assess a link. Those factors include:

the degree of similarity between the conflicting marks;

the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

the strength of the earlier mark’s reputation;

the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

the existence of the likelihood of confusion on the part of the public.

66) First I shall consider the applicant’s goods and services in classes 9 and 38. Earlier in this decision I found that the opponent’s mark UBER is similar to the mark sought to be registered by the applicant a low to medium degree. I also found that the applicant’s goods and services in classes 9 & 38 were identical to the goods and services of the opponent in the same classes. The opponent’s mark UBER has an average degree of inherent distinctive character but can benefit from an enhanced distinctiveness through use only in respect of cab services and telephone apps. To my mind, the fact that the users and goods and services are the same means that if a member of the public or business user saw the applicant’s mark they would make the link to the opponent. Because

the relevant public would make the link between the use of the mark in suit upon the goods and services for which it is sought to be registered, there will inevitably be dilution of the opponent's mark, and, depending on the quality of the applicant's services, detriment.

67) I must now turn to consider whether the services in class 35 which I found to be similar to a low degree to the opponent's class 9 goods would also be linked to the opponent if the mark in suit were used upon them. For ease of reference these services in Class 35 are: Retail services connected with the sale of mobile phones and accessories; batteries; battery charges; media for storing information, data, signals, images and/or sounds; photographic apparatus and instruments; parts and fittings for the aforesaid goods".

68) To my mind, the opponent's reputation is inextricably linked to the telephone application (app) as much as the cab service. Therefore, to my mind the average consumer would immediately link services connected with the sale of mobile phones (and accessories) with the opponent. Mobile phones are capable of taking photographs and videos which include sound and so I regard all the services set out in the paragraph above to relate to mobile phones.

69) Because the relevant public would make the link between the use of the mark in suit upon the goods and services for which it is sought to be registered, there will inevitably be dilution of the opponent's mark, and, depending on the quality of the applicant's services, detriment. **The ground of opposition under section 5(3) succeeds in respect of the applicant's specification in classes 9, 35 & 38.**

70) Turning to consider the ground of opposition under section 5(4)(a) I note that the one possible difference between the position under trade mark law and the position under passing off law is that in the Court of Appeal in Marks and Spencer PLC v Interflora, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. However, as both tests are intended to be partly qualitative measures intended to exclude those who are unusually careful or careless, it is doubtful whether the difference between the legal tests will often result in different outcomes.

71) For the same reasons I found that the use of trade mark EU 10460442 would create a likelihood of confusion, or create a link to the earlier mark and the goods and services for which it has a reputation, I find that it is likely that a substantial number of persons will believe that use of the mark 10460442 in relation to the goods and services for which it has goodwill and reputation, indicates a connection in the course of trade to the opponent's business. The ground of opposition under section 5(4)(a) therefore succeeds in respect of the goods in class 9 and the services in classes 35 and 38.

CONCLUSION

72) The opposition under sections 5(2)(b), 5(3) and 5(4)(a) succeeds in respect of the goods in class 9 and the services in classes 35 & 38.

COSTS

73) As the opponent has succeeded it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£800
Attendance at the hearing	£1200
TOTAL	£2,300

74) I order Uberfone Limited to pay Uber Technologies Inc. the sum of £2,300. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2019

George W Salthouse
For the Registrar,
the Comptroller-General