

O-091-20

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3373737
BY GERALDINE WILLIAMS AND BRETT JAMES TO REGISTER:

Bubble Finance

IN CLASS 36

AND

THE OPPOSITION THERETO UNDER NO 416342 BY
O2 WORLDWIDE LIMITED

Background and pleadings

1. On 7 February 2019, Geraldine Williams and Brett James (the applicants) applied to register 'Bubble Finance' in class 36, as follows:¹

Class 36

Finance services.

2. The application was published on 15 February 2019, following which it was opposed by O2 Worldwide Limited (the opponent).

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act), because, it submits, there is a likelihood of confusion between the mark applied for and its own earlier mark when used for identical or similar services.

The opponent relies upon the following earlier EU Trade Mark (EUTM):

Mark details and relevant dates	Goods and services relied upon
EUTM: 15145279 BUBBLE Filed: 24 February 2016 Registered: 4 December 2016	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; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; computer games; computer game software; computer games programs; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; televisions; headphones; global positioning system [GPS] apparatus; satellite navigation devices; computer software recorded onto CD Rom; SD-Cards (secure digital cards); glasses; spectacle glasses; sunglasses; protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable electronic publications; downloadable image files; downloadable music files; mouse mats; magnets; mobile telephone covers; mobile telephone cases; hands free kits for phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; software for the processing of financial transactions; electronic notice boards; electric batteries; battery chargers; security alarms; security cameras; security warning apparatus; security control apparatus; security surveillance apparatus; computer software for security purposes; computer software for insurance purposes; SIM cards; aerials; alarms; electric</p>
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cables; chemistry apparatus and instruments; recorded computer operating programs; computer peripheral devices; data processing apparatus; diagnostic apparatus, not for medical purposes; distance measuring apparatus; distance recording apparatus; downloadable ring tones for mobile phones; electronic tags for goods; eyepieces; goggles for sports; magnetic identity cards; intercommunication apparatus; loudspeakers; magnetic data media; mathematical instruments; modems; electric monitoring apparatus; television apparatus; testing apparatus not for medical purposes; telecommunication transmitters; parts and fittings for all the aforesaid goods.

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs; financial information and advice relating to tariffs; information and advice relating to finance and insurance; financial payment services; payment processing services; electronic payment services; automated payment services; payment collection agencies; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment services; Internet banking; mobile phone banking services; issuing of vouchers and coupons; issuing of tokens of value in relation to customer loyalty schemes; sponsorship of sports, sports teams and sports events; insurance administration; insurance for telecommunication apparatus and instruments; insurance for mobile telecommunication apparatus and instruments; insurance for digital apparatus and instruments; insurance for digital tablets; insurance for computer software and hardware; travel insurance; vehicle insurance; home insurance; charitable fund raising; credit card services; debit card services; debt collection agencies; financial sponsorship; repair costs evaluation [financial appraisal]; information and advisory services relating to the aforesaid

	services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.
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4. The opponent's mark is an earlier mark which is not subject to proof of use. This is because, at the date of the contested application, it had not been registered for five years.²

5. The applicant filed a counterstatement in which it denied the ground raised by the opponent.

6. Neither party filed evidence or requested to be heard. The opponent filed submissions in lieu of a hearing. I make this decision based on careful consideration of the papers before me.

7. The applicants represent themselves. The opponent is represented by Stobbs.

Preliminary issues

The applicants' actual use of their mark

8. In its counterstatement the applicant has described the exact nature of its business conducted under the mark applied for. The nature of the applicant's actual use has no bearing on the outcome of this decision.

9. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*³, the Court of Justice of the European Union (CJEU) stated, at paragraph 66 of its judgment, that when assessing the likelihood of confusion in the context of registering a new trade

² See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

³ *Case C-533/06*

mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

10. In other words, the way in which the applicants are actually using their trade mark at this point is not a factor which is relevant to the decision. Rather I must consider all normal and fair uses of the applicants' mark for all of the services listed in the application. In this case, the applicants have applied for 'Finance services' and it is on that basis that the decision must be made. The same applies to the opponent's earlier mark, which is not subject to proof of use, which means that the opponent is entitled to rely on all of the services for which it is registered.⁴

The opposition

11. Section 5(2)(b) of the Act states:

"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,

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

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C -342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

⁴ It has elected to rely on the goods in class 9 and the services in class 36.

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

Comparison of services

13. The opponent relies on goods in class 9 and services in class 36. The class 9 specification includes numerous goods which are clearly not similar to the applicants' 'finance services', for example, 'sunglasses'. The opponent has only made one submission with regard to class 9 and that is that 'computer software' is similar to financial services. Given that the opponent has a registration which covers services in class 36, the same class as the only term in the application, I will begin with an assessment of that class. The services are as follows:

The opponent's services:	The applicants' services:
Class 36 Insurance; financial affairs; monetary affairs; real estate affairs; financial information and advice relating to tariffs; information and advice relating to finance and insurance; financial payment services; payment processing services; electronic payment services; automated payment services; payment collection agencies;	Class 36 Finance services.

processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment services; Internet banking; mobile phone banking services; issuing of vouchers and coupons; issuing of tokens of value in relation to customer loyalty schemes; sponsorship of sports, sports teams and sports events; insurance administration; insurance for telecommunication apparatus and instruments; insurance for mobile telecommunication apparatus and instruments; insurance for digital apparatus and instruments; insurance for digital tablets; insurance for computer software and hardware; travel insurance; vehicle insurance; home insurance; charitable fund raising; credit card services; debit card services; debt collection agencies; financial sponsorship; repair costs evaluation [financial appraisal]; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.	
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14. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁵ the General Court (“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,

⁵ Case T- 133/05

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

15. The application is made in respect of ‘finance services’. The opponent’s specification includes ‘financial affairs’. Both are broad terms and are identical. In addition, the opponent’s specification includes terms such as, inter alia, ‘internet banking’, ‘mobile phone banking services’, ‘money transfer services’ and a range of insurance services and ‘bill payment services’, all of which fall within the applicants’ wider term and in accordance with *Meric*, are identical. I will return to this issue later in the decision.

16. Having found the services in class 36 to be identical I do not intend to consider the opponent’s goods in class 9 as they do not put the opponent in any better position.

The average consumer and the nature of the purchasing act

17. In accordance with the above cited case law (paras. 12 and 14), I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

18. 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*⁶, 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.

⁶ [2014] EWHC 439 (Ch)

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

19. The opponent submits that the applied for services are common services, aimed at the public at large. With regard to business use it submits:

“Businesses may well also utilize these services. However, as has been established, the section of the public with the lowest level of attention must be taken into consideration (T-106/06 Demp v OHIM).”⁷

20. The opponent relies on *Wealthkernal v UBS Group*⁸ and *EUI Worldwide Diamond Corporation*⁹ to support its view that the average consumer’s level of attention paid to these services will be average or at most ‘slightly above average’.

21. The parties’ specifications cover a range of financial services that can be aimed at an ordinary member of the public and/or at a more specialised commercial customer or financial institution. There is a degree of overlap in the sense that a commercial consumer will still use, for example, a personal credit card or banking service. In the case of a consumer seeking, for example, a payment system to use for their business this will involve a fairly high level of attention and consideration prior to the purchasing act. In contrast a customer who simply wishes to withdraw money from a cash machine or make a credit card payment will be a member of the general public who will pay a much lower level of attention to the transaction. That said, the purchasing act for all of the respective services will be at least well considered as the average consumer, whether an individual or a commercial undertaking, will take note of, inter alia, charges, interest rates, price comparisons and accessibility of services, before entering into the purchasing act.

22. In all cases the purchase may be made visually from a website, brochure, prospectus, etc., or aurally such as in their local branch of a bank, over the telephone or via a broker, financial advisor or other intermediary.

⁷ See the opponent’s submissions dated 2 January 2020.

⁸ O-094/18

⁹ O-650/19

Comparison of marks

23. The marks to be compared are as follows:

Opponent's earlier mark	The application
BUBBLE	Bubble Finance

24. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components¹⁰, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

25. With regard to the application the opponent submits:

"The Applicant's mark can be described as the word BUBBLE along with the additional element FINANCE. As a general rule, the public will not consider a descriptive element forming part of a complex mark to be a distinctive, nor dominant element in the overall impression conveyed by that mark. On this basis, the average consumer is likely to be drawn to the 'BUBBLE' element of the contested mark, and will consider this to be the designation of origin. On its own, the verbal element BUBBLE is also distinctive for the services. For this reason, it is submitted that the verbal BUBBLE element is the only dominant and distinctive element of the contested mark, and it would be the part of the mark that consumers would remember, particularly in the context of the services applied for."

26. The opponent's mark is the word BUBBLE in plain black type with no additional stylisation. The overall impression of the mark rests in that word.

¹⁰ Sabel v Puma AG, para.23

27. The applicants' mark consists of the two words BUBBLE and FINANCE presented in block capitals with no additional stylisation. The overall impression of the mark is dominated by the initial word BUBBLE, the second word simply being seen by the average consumer as a description of the services provided.

Visual similarity

28. Visual similarity rests in the fact that both marks include the word 'BUBBLE'. It is the totality of the earlier mark and the first word in the application. The visual differences are that the opponent's mark is presented in upper case letters and the application in title case, a fact that will go largely unnoticed by the average consumer and would be covered by fair and notional use of the marks. In addition, the application includes the word FINANCE. Overall, I find these marks to be visually similar to a medium degree.

Aural similarity

29. With regard to aural similarity, both marks are made up of common English words, the pronunciation of which will be easily understood by the average consumer. The opponent's mark and the first word of the application is the word BUBBLE. The additional word 'FINANCE', which is the second word in the applicants' mark, adds the two syllables 'FY' – 'NANCE'. However, given the descriptive nature of 'FINANCE', it may not be pronounced. Where the second word in the application is not pronounced, the competing marks are aurally identical. Where 'FINANCE' is pronounced, the marks are aurally similar to a medium degree.

Conceptual similarity

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹¹ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.¹²

31. With regard to the conceptual similarity between the competing marks, the opponent submits:

“Conceptually, the marks are highly similar in that they both refer to a thin sphere of liquid enclosing air or another gas.

The additional descriptive element FINANCE, which would be understood to mean the management of large amounts of money, would alter the overall impression somewhat. However, given that this element is descriptive, it would not detract significantly from the conceptual identity of the BUBBLE elements.”

32. Both marks refer to the concept of a bubble. This may be taken to mean a thin sphere of liquid or may mean something separate from other things. The applicants’ mark includes the additional word ‘FINANCE’ after the word ‘BUBBLE’, so the first word will be seen in that context. The opponent’s mark may be given a wider concept of BUBBLE, though, in light of the opponent’s services in class 36, which are financial services, this meaning is again likely to be in the context of finance. In any case, whatever the meaning attributed to the word ‘BUBBLE’ by the average consumer, it will be the same for both marks and I find them to be conceptually, at least, highly similar.

Distinctive character of the earlier marks

33. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall

¹¹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

¹² See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee, BL O/048/08*, paragraphs 36 and 37.

assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.¹³

34. No evidence has been filed, so I have only the inherent distinctiveness of the earlier mark to consider. The opponent submits that its mark is highly distinctive, due to the fact that BUBBLE has no meaning for financial services. The word BUBBLE is a normal English word with which the average consumer will be familiar. It has no obvious meaning in the context of the services and as such is a normal trade mark, possessed of a medium degree of inherent distinctive character.

Likelihood of Confusion

35. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them they have kept in their mind.¹⁴ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 services and vice versa.

36. I have found:

- The applicants' services include the opponent's services in class 36, which means they are identical.
- The marks share a medium degree of visual and aural similarity and are conceptually, at least, highly similar.

¹³ Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

¹⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

- The average consumer, who is a member of the general public or a business/professional, will pay at least an average degree of attention during selection processes for the services which will be purchased primarily visually, but I do not discount an aural element.
- The opponent's mark has a medium degree of distinctive character for the services in class 36.

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁵ as follows:

“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”.

38. In *Duebros Limited v Heirler Cenovis GmbH*, the Appointed Person emphasised the importance of envisaging the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. Ultimately, the assessment is whether the average consumer will make a connection between the marks and assume that the goods or services in question are

¹⁵ BL O/375/10.

from the same or economically linked undertakings. He stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark as this is mere association not indirect confusion.

39. With regard to the 'common element', I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which 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."

40. 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.

41. 'BUBBLE' is the common element in the competing marks. It is the totality of the earlier mark and the only distinctive element in the application. As I have found above, 'BUBBLE' has a medium degree of inherent distinctiveness. When used for identical services I find that there will be a likelihood of confusion. This may be direct, where the average consumer gives no attention to the descriptive word 'FINANCE' in the application, or, where that element is noticed, as a point of difference between the

respective marks, the average consumer will assume that the services at issue in these proceedings come from undertakings which are economically linked.

Finance services

42. The applicants have applied for the broad term 'finance services' in their specification which, given that it includes the named financial services in the earlier specification, is bound to be identical.¹⁶

43. I do not propose to limit the specification for finance services as the term does not lend itself to suitable limitation which would avoid a likelihood of confusion. In accordance with my earlier conclusion, an average consumer familiar with one of the parties' marks, used for financial services, would, when encountering the other, on a different financial service, consider it to be part of the same 'BUBBLE' stable of financial service providers.

44. Such a conclusion is made in accordance with the Registry's practice with regard to the partial refusal of trade marks taken from Tribunal Practice Notice (TPN) 1 of 2012, paragraph 3.2.2(d), which reads:

"d) ...Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

CONCLUSION

45. The opposition succeeds *prima facie*, under section 5(2)(b) of the Act and the application will be refused. The opponent has succeeded in full based on its services

¹⁶ In accordance with the decision in *Meric*.

in class 36, therefore, I will not go on to consider the remainder of its specification, which puts it in no better position.

COSTS

46. The opposition having succeeded, the opponent is entitled to a contribution towards its costs which I award on the following basis, bearing in mind that no evidence was filed and the decision was made from the papers:¹⁷

Official fees:	£100
Preparing the notice of opposition and considering the counterstatement:	£400
Submissions in lieu of a hearing:	£200
TOTAL	£700

47. I order Geraldine Williams and Brett James to pay O2 Worldwide Limited the sum of £700. These costs should be paid within 21 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 13th day of February 2020

Al Skilton
For the Registrar,
The Comptroller-General

¹⁷ The scale of costs applicable to proceedings before the Comptroller can be found in Tribunal Practice Notice 2/2016.