

O-355-21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3305581

IN THE NAME OF BOON ONLINE LIMITED IN RESPECT OF THE TRADE MARK

BOON

IN CLASSES 9, 35 and 42

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 503149

By Wirecard AG

1. Registration 3305581 stands in the name BOON ONLINE LIMITED (“the proprietor”). The relevant details of this registration are:

Mark:



Filing date: 22 April 2018

Registration date: 17 August 2018

Classes:

Class 9: Computer programs for accessing, browsing and searching online databases; Computer software to enable searching and retrieval of data; Computer search engine software; Computer software to enable the searching of data; Computer programs for searching remotely for content on computers and computer networks; Software for searching and retrieving information across a computer network; Software for embedding online advertising on websites; Software for evaluating customer behaviour in online shops; Software for operating an online shop; Software for processing images, graphics and text.

Class 35: Retail purposes (Presentation of goods on communication media, for -); Communication media (Presentation of goods on -), for retail purposes; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Advice for consumers (Commercial information and -) [consumer advice shop]; Commercial information and advice for consumers [consumer advice shop]; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Consumers (Commercial information and advice for -) [consumer advice shop]; Providing consumer product advice; Providing consumer product advice

relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product advice relating to software; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Comparison services (Price -); Price comparison services; Provision of online price comparison services; Services with regard to product presentation to the public; Presentation of companies and their goods and services on the Internet; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Advertising and advertisement services; Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising for others; Advertising material (Dissemination of -); Advertising material (Updating of -); Advertising of business web sites; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services for the promotion of e-commerce; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to clothing; Advertising services relating to cosmetics; Advertising services relating to hotels; Advertising services relating to jewelry; Advertising services relating to perfumery; Advertising; Advertising services relating to the commercialization of new products; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of goods; Advertising services to promote the sale of beverages; Advertising the goods and services of online vendors via a searchable online guide; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Marketing; Marketing services;

Affiliate marketing; Promotion of goods and services for others; Promotion of goods and services through sponsorship; Promotional advertising services; Promotional and advertising services; Sales promotion for third parties; Sales promotion services; Sales promotion services for third parties; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes.

Class 42: Providing search engines for obtaining data on a global computer network; Search engines (Providing -) for the internet; Providing Internet search engines with specific search options; Providing search engines for obtaining data on a global computer network; Provision of Internet search engines; Provision of search engines for the Internet.

2. On 20 May 2020, Wirecard AG (“the applicant”) filed an application for invalidation against all of the goods and services under this mark under Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of the following marks and goods/services.

EUTM 12795464

Mark: boon

Filing date: 15 April 2014

Registration date: 16 December 2014

Classes:

Class 09: Databases (electronic); Recorded and downloadable computer software; Electronic apparatus for verifying the authenticity of pre-paid, debit, credit and other payment cards; Digital transmitters and receivers, in particular mobile telephones, for stationary and mobile payment systems, electric, electronic and optical devices and instruments, and parts therefor, for the recording, processing, receiving, transmission, sending, storage, exchange and output of messages, images, speech and data, included in class 9; Data carriers with computer software recorded thereon, in particular magnetic and optical data carriers containing computer software, In particular application software, Operating-systems software, Database software, Data encryption software, data decryption software and software for processing digital signatures; Calculating machines, data processing equipment and

computers and parts therefor; Active or passive electronic components, In particular integrated and non-integrated semiconductor component parts; Printed circuit boards, with and without electronic component parts.

Class 35: Computerised file management.

Class 42: Creation and maintenance of computer databases; Consultancy in relation to information systems using online electronic online communications networks; Enabling temporary use of non-downloadable computer software for verifying credit card and bank card payments, processing of credit card and bank card transactions, investigation of fraud in relation to credit cards and bank cards, processing of electronic payment transactions, processing of automated clearance payments, automatic database management; Technical support, Namely troubleshooting and debugging in relation to computer software problems and integration of computer systems and networks; Management and Advisory services, Namely technical assistance for businesses in relation to the use of electronic online communications networks; Services of an electronic exchange between data processing networks (clearing centres), namely adding data, converting data into a receiver-dependent form/structure and/or data matching (business computer science); Analysis of information for validation and verification (services of economists); Confirmation of electronic certifications.

EUTM 14672562

Mark:



Filing Date: 13 October 2015

Registration Date: 11 February 2019

Classes:

Class 09: Databases (electronic); Stored and downloadable computer-software; Electronic apparatus for verifying the authenticity of pre-paid, debit, credit and other payment cards; Digital transmitters and receivers, in particular mobile telephones,

for stationary and mobile payment systems, electric, electronic and optical devices and instruments, and parts therefor, for the recording, processing, receiving, transmission, sending, storage, exchange and output of messages, images, speech and data (included in class 9); Data carriers containing recorded computer software, in particular magnetic and optical data carriers containing computer software, in particular applications software, operating systems software, database software, data encoding software, data decoding software and software for processing digital signatures; Calculating machines, data processing equipment and computers and parts therefor; Active and passive electronic components, in particular integrated and non-integrated semiconductor components; Printed circuit boards with and without electronic components; Application software for mobile phones; Application software for mobile telephones, namely for applying for and operating a bank account; Application software for mobile telephones, namely for performing transactions between customers without requiring third party interposition; Computer communication software to allow customers to access bank account information and transact bank business.

Class 35: Computerised file management; Computer services, namely providing of an interactive computer database in the field of payment information and payment behaviour.

Class 42: Creation and maintenance of computer databases; Consultancy in relation to information systems using online electronic communications networks; Enabling temporary use of non-downloadable computer software for verifying credit card and bank card payments, processing of credit card and bank card transactions, investigation of fraud in relation to credit cards and bank cards, processing of electronic payment transactions, processing of automated clearance payments, automatic database management; Technical support services, namely, troubleshooting of computer software problems, and integration of computer systems and networks; Management and Advisory services, Namely technical assistance for businesses in relation to the use of electronic online communications networks; Services of an electronic exchange between computer networks (clearing centre), namely adding and converting data into a receiver-dependent

form/structure and/or data matching (computer-aided economic services); Analysis (validation and verification) of information (economic services).

IR 953611

Mark: boon

Filing date: 28 December 2007

Registration date: 26 January 2009

Classes:

Class 35: Advertising; business management, business administration.

Class 42: Design of computer hard and software.

3. In its statement of grounds, the applicant argues that the respective goods/services are either identical or at least similar and that the marks are also either identical or similar.
4. The proprietor filed a counterstatement denying the claims made. It states that there is a significant difference in design, typography and usage of the respective marks. It also claims that the services offered by each party are substantially different in industry and functionality.
5. Only the proprietor provided evidence in these proceedings, neither party filed written submissions, and a hearing was not requested. This decision is therefore taken following a careful perusal of the papers before me.
6. The proprietor is unrepresented. The applicant is represented by Pinsent Masons
7. The applicant's above mentioned trade marks are earlier marks, in accordance with Section 6 of the Act. The earlier EUTMs are not subject to proof of use requirements as they have not been registered for five years or more before the filing date of the proprietor's mark, as per section 6A of the Act. The earlier IR was subject to the proof of use however the proprietor did not request this. Therefore, the applicant may rely on all of the goods and services set out above.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Evidence

9. The proprietor filed a witness statement from the company director, Mr Dylan Grey together with nine supporting exhibits, DJG1-DJG9.

10. In his witness statement, Mr Grey states that his company sells technology to online retailers including personalised product recommendations to their consumers. He says that the company's website targets corporate clients exclusively. He contrasts this by saying that the applicant's customers are solely consumers, in particular in relation to financial services.

11. Mr Grey explains that the scope of his registration has been limited (as per the Form TM23 shown in DJG5) limiting the goods in class 09, following a review by Hybrid Legal (shown in the letter addressed to the applicant's legal representatives dated 11 February 2020 in DJG4) as they were deemed to overlap with the goods covered by the applicant's marks.

12. Mr Grey claims that the word 'boon' is always written in uppercase letters and that their usage is consistent across their websites, this is supported by the information provided under exhibit DJG7.

13. Mr Grey has provided several screenshots of the proprietor's website and social media accounts and an article from a third-party website to show evidence of his assertion that their services are aimed at businesses rather than consumers.

14. He has also provided screenshots from the applicant's website stating their services are for consumers together with screenshots from a third-party website of an article dated 29 October 2019 which gives details of one of the applicant's products.

15. Whilst I have given full consideration to Mr Grey's evidence, I must consider all of the possible uses for the trademarks in the classes that have been registered. Neither party's goods or services are expressly limited to one particular group of consumers

16. Mr Grey also provides a screenshot from the applicant's website that says they are closing their 'boon' services to consumers and claims that they do not appear to be using the trademark going forward. For the purposes of these proceedings the applicant's earlier registered marks are valid rights and any question as to non-use of them will not form part of this decision.

DECISION

17. The relevant legislation is as follows:

18. Section 47 of the Act states as follows:

"47. –

(1) [...]

(2) Subject to subsections (2A) and (2G) the registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

(2A) The registration of a trade mark may not be declared invalid on the

ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor),
and

(b) use in the United Kingdom includes affixing the trade mark to goods
or to the packaging of goods in the United Kingdom solely for export
purposes.

(2D) In relation to a European Union trade mark or international trade mark
(EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be
construed as a reference to the European Community.

(2DA)...

(2E) Where an earlier trade mark satisfies the use conditions in respect of
some only of the goods or services for which it is registered, it shall be treated
for the purposes of this section as if it were registered only in respect of those
goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade
mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade
mark must be refused if it would have been refused, for any of the reasons set
out in subsection (2H), had the application for the declaration been made on
the date of filing of the application for registration of the later trade mark or
(where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared
invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a
distinctive character as mentioned in the words after paragraph (d) in section
3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c)...

(3)...

(4)...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

19. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

20. Section 5(2)(a) of the Act is as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Case law

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

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

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods and services

23. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

24. 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”.

25. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), Case T-133/05, the General Court ("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".

27. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

28. The Parties respective specifications are:

	Applicant's Registrations	Proprietor's Registration
Class 9	<p><i>EU trade mark registration no. 012795464)</i></p> <p>Databases (electronic); Recorded and downloadable computer software; Electronic apparatus for verifying the authenticity of pre-paid, debit, credit and other payment cards; Digital transmitters and receivers, in particular mobile telephones, for stationary and mobile payment systems, electric, electronic and optical devices and instruments, and parts therefor, for the recording, processing, receiving, transmission, sending, storage, exchange and output of messages, images, speech and data, included in class 9; Data carriers with computer software recorded thereon, in particular magnetic and optical data carriers containing computer software, In particular application software, Operating-systems software, Database software, Data encryption software, data decryption software and software for processing digital signatures; Calculating machines, data processing equipment and computers and parts therefor; Active or passive electronic components, In particular integrated and non-</p>	<p>Computer programs for accessing, browsing and searching online databases; Computer software to enable searching and retrieval of data; Computer search engine software; Computer software to enable the searching of data; Computer programs for searching remotely for content on computers and computer networks; Software for searching and retrieving information across a computer network; Software for embedding online advertising on websites; Software for evaluating customer behaviour in online shops; Software for operating an online shop; Software for processing images, graphics and text.</p>

	<p>integrated semiconductor component parts; Printed circuit boards, with and without electronic component parts</p>	
	<p><i>EUTM 014672562</i></p> <p>Databases (electronic); Stored and downloadable computer-software; Electronic apparatus for verifying the authenticity of pre-paid, debit, credit and other payment cards; Digital transmitters and receivers, in particular mobile telephones, for stationary and mobile payment systems, electric, electronic and optical devices and instruments, and parts therefor, for the recording, processing, receiving, transmission, sending, storage, exchange and output of messages, images, speech and data (included in class 9); Data carriers containing recorded computer software, in particular magnetic and optical data carriers containing computer software, in particular applications software, operating systems software, database software, data encoding software, data decoding software and software for processing digital signatures; Calculating machines, data processing equipment and</p>	

	<p>computers and parts therefor; Active and passive electronic components, in particular integrated and non-integrated semiconductor components; Printed circuit boards with and without electronic components; Application software for mobile phones; Application software for mobile telephones, namely for applying for and operating a bank account; Application software for mobile telephones, namely for performing transactions between customers without requiring third party interposition; Computer communication software to allow customers to access bank account information and transact bank business.</p>	
Class 35	<p><i>EUTM012795464</i> Computerised file management.</p>	<p>Retail purposes (Presentation of goods on communication media, for -); Communication media (Presentation of goods on -), for retail purposes; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Advice for</p>
	<p><i>EUTM 014672562</i> Computerised file management; Computer services, namely providing of an interactive computer database in the field of payment information and payment behaviour.</p>	
	<p><i>WE00000953611</i></p>	

	<p>Advertising; business management, business administration.</p>	<p>consumers (Commercial information and -) [consumer advice shop]; Commercial information and advice for consumers [consumer advice shop]; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Consumers (Commercial information and advice for -) [consumer advice shop]; Providing consumer product advice; Providing consumer product advice relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product advice relating to software; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Comparison services (Price -); Price comparison services; Provision of online price comparison services;</p>
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		<p>Services with regard to product presentation to the public;</p> <p>Presentation of companies and their goods and services on the Internet; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Advertising and advertisement services;</p> <p>Advertising and marketing;</p> <p>Advertising and marketing services; Advertising and marketing services provided via communications channels;</p> <p>Advertising and promotion services; Advertising and promotional services; Advertising by transmission of on-line publicity for third parties through electronic communications networks;</p> <p>Advertising for others; Advertising material (Dissemination of -);Advertising material (Updating of -);Advertising of business web sites; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors;</p> <p>Advertising of the services of other vendors, enabling customers to conveniently view and compare the</p>
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		<p>services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services for the promotion of e-commerce; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to clothing; Advertising services relating to cosmetics; Advertising services relating to hotels; Advertising services relating to jewelry; Advertising services relating to perfumery; Advertising; Advertising services relating to the commercialization of new products; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of goods; Advertising services to promote the sale of beverages; Advertising the goods and services of online vendors via a searchable online guide; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional</p>
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		<p>services; Advertising, promotional and marketing services;</p> <p>Advertising, promotional and public relations services; Marketing;</p> <p>Marketing services; Affiliate marketing; Promotion of goods and services for others; Promotion of goods and services through sponsorship; Promotional advertising services; Promotional and advertising services; Sales promotion for third parties; Sales promotion services; Sales promotion services for third parties; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes.</p>
Class 42	<p><i>EUTM012795464</i></p> <p>Creation and maintenance of computer databases; Consultancy in relation to information systems using online electronic online communications networks; Enabling temporary use of non-downloadable computer software for verifying credit card and bank card payments, processing of credit card and bank card transactions, investigation of fraud in relation to credit cards and bank cards, processing of electronic payment transactions, processing of</p>	<p>Providing search engines for obtaining data on a global computer network; Search engines (Providing -) for the internet;</p> <p>Providing Internet search engines with specific search options;</p> <p>Providing search engines for obtaining data on a global computer network; Provision of Internet search engines; Provision of search engines for the Internet.</p>

	<p>automated clearance payments, automatic database management; Technical support, Namely troubleshooting and debugging in relation to computer software problems and integration of computer systems and networks; Management and Advisory services, Namely technical assistance for businesses in relation to the use of electronic online communications networks; Services of an electronic exchange between data processing networks (clearing centres), namely adding data, converting data into a receiver-dependent form/structure and/or data matching (business computer science); Analysis of information for validation and verification (services of economists); Confirmation of electronic certifications.</p>	
	<p><i>EUTM 014672562</i> Creation and maintenance of computer databases; Consultancy in relation to information systems using online electronic communications networks; Enabling temporary use of non-downloadable computer software for verifying credit card and bank card payments, processing of credit card and bank</p>	

	<p>card transactions, investigation of fraud in relation to credit cards and bank cards, processing of electronic payment transactions, processing of automated clearance payments, automatic database management; Technical support services, namely, troubleshooting of computer software problems, and integration of computer systems and networks; Management and Advisory services, Namely technical assistance for businesses in relation to the use of electronic online communications networks; Services of an electronic exchange between computer networks (clearing centre), namely adding and converting data into a receiver-dependent form/structure and/or data matching (computer-aided economic services); Analysis (validation and verification) of information (economic services).</p>	
	<p><i>WE00000953611</i></p> <p>Design of computer hard and software.</p>	

29. The proprietor's mark is registered for various forms of computer software under class 9. The applicant's two EUTM's are registered for "Recorded and downloadable computer software". I therefore find that this encompasses the entirety of the class 9 goods of the proprietor's mark. Applying the *Meric* principle, I consider the goods in class 9 to be identical. In addition, the applicant's mark WE953611 is registered under class 42 for "design of computer hard and software". I believe that most

designers of computer software would then sell that software on to consumers, be those professional or to the public at large. Therefore, I would say these goods and services are complementary and thereby similar to a low degree

30. The following services from the class 35 element of the proprietor's registration: "Retail purposes (Presentation of goods on communication media, for); Communication media (Presentation of goods on -), for retail purposes; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Services with regard to product presentation to the public; Presentation of companies and their goods and services on the Internet; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Advertising and advertisement services; Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising for others; Advertising material (Dissemination of -);Advertising material (Updating of -);Advertising of business web sites; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services for the promotion of e-commerce; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to clothing; Advertising services relating to cosmetics; Advertising services relating to hotels; Advertising services relating to jewelry; Advertising services relating to perfumery; Advertising; Advertising services relating to the commercialization of new products; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of goods; Advertising services to promote the sale of beverages; Advertising the goods and services of online vendors via a searchable online guide; Advertising via the Internet; Advertising, including on-line advertising

on a computer network; Advertising, services; Advertising services; Advertising services; Advertising services; Promotional advertising services; advertising services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Marketing; Marketing services; Affiliate marketing; Promotion of goods and services for others; Promotion of goods and services through sponsorship; Sales promotion for third parties; Sales promotion services; Sales promotion services for third parties; marketing and promotion services, marketing and promotional services, promotional and marketing services, promotional and public relations, Promotional services”, all involve the advertising, marketing, promoting and/or presenting of goods in various manners. The applicant’s earlier mark IR953611 is registered under Class 35 for “advertising”. Advertising is “the promotion of goods or services for sale”.¹ Marketing refers to activities a company undertakes to promote the buying or selling of a product or service.² Therefore, applying the *Merix* principle, I find these services to be identical.

31. The following class 35 services registered under the proprietors mark: “Advice for consumers (Commercial information and -) [consumer advice shop]; Commercial information and advice for consumers [consumer advice shop]; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Consumers (Commercial information and advice for -) [consumer advice shop]; Providing consumer product advice; Providing consumer product advice relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product advice relating to software; Provision of information and advice to consumers regarding the selection of products and items to be purchased;” are all focused around advice and information about products provided to consumers.

¹ <https://www.collinsdictionary.com/dictionary/english/advertising>

² <https://www.investopedia.com/terms/m/marketing.asp>

32. In comparing these services with the goods and services of the applicant's marks, I rely on the guidance coming from the *Treat* decision. I conclude that although the proprietor's services are fairly broad in terms of who the respective users may be, I find no overlaps in the respective uses of the services at issue, nor the nature of the services or trade channels. These services are therefore dissimilar.

33. Turning to the proprietor's class 35 services: "Comparison services (Price -); Price comparison services; Provision of online price comparison services;" for the same reasons as set out in the previous paragraph, I do not find any similarity between these services and the goods and services of the applicant's marks. I find that services relating to price comparison do not share uses, trade channels or nature with any of the goods or services under the applicant marks. These services are dissimilar.

34. Turning to the proprietor's services under Class 42: "Providing search engines for obtaining data on a global computer network; Search engines (Providing -) for the internet; Providing Internet search engines with specific search options; Providing search engines for obtaining data on a global computer network; Provision of Internet search engines; Provision of search engines for the Internet."

35. A search engine is a computer program that searches for documents containing a particular word or words on the internet.³ Computer programs are referred to as software.⁴ Given this, I find the earlier 'stored/recorded and downloadable computer software' contained under the applicant's earlier EUTMs to be similar to at least a low degree to the proprietor's class 42 services, notwithstanding the fact that one is a good and the other a service. The downloadable nature of the applicant's products serves to provide a direct link to the provision of a software product provided through the proprietor's services. The nature, intended purpose, users and channels of trade may be the same.

36. I find that the provision of search engine services is similar to at least a medium degree to the class 42 services under the applicant's earlier IR953611 "Design of

³ <https://www.collinsdictionary.com/dictionary/english/search-engine>

⁴ <https://www.collinsdictionary.com/dictionary/english/software>

computer hard and software". As established above, a search engine is a computer program and the applicant's class 42 services under IR953611 encompass the design of computer software *per se*, the purpose of which may be to provide a search engine or search engine services.

37. In conclusion, I find all of the proprietor's class 09 goods to be identical to the applicants goods. I also find the following services under the proprietor's mark to be identical under *Meric*:

Class 35: Retail purposes (Presentation of goods on communication media, for); Communication media (Presentation of goods on -), for retail purposes; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Services with regard to product presentation to the public; Presentation of companies and their goods and services on the Internet; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Advertising and advertisement services; Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising for others; Advertising material (Dissemination of -);Advertising material (Updating of -);Advertising of business web sites; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services for the promotion of e-commerce; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to clothing; Advertising services relating to cosmetics; Advertising services relating to hotels; Advertising services relating to jewelry; Advertising services

relating to perfumery; Advertising; Advertising services relating to the commercialization of new products; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of goods; Advertising services to promote the sale of beverages; Advertising the goods and services of online vendors via a searchable online guide; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, services; Advertising services; Advertising services; Advertising services; Promotional advertising services; advertising services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Marketing; Marketing services; Affiliate marketing; Promotion of goods and services for others; Promotion of goods and services through sponsorship; Sales promotion for third parties; Sales promotion services; Sales promotion services for third parties; marketing and promotion services, marketing and promotional services, promotional and marketing services, promotional and public relations, Promotional services.

38. I have found the proprietor's services under Class 42: "Providing search engines for obtaining data on a global computer network; Search engines (Providing -) for the internet; Providing Internet search engines with specific search options; Providing search engines for obtaining data on a global computer network; Provision of Internet search engines; Provision of search engines for the Internet." To be similar to either at least a low degree, or at least a medium degree respectively, to the applicant's goods in class 09 and services in class 42.

39. Finally, I have found "Advice for consumers (Commercial information and -) [consumer advice shop]; Commercial information and advice for consumers [consumer advice shop]; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Consumers (Commercial information and advice for -) [consumer advice shop]; Providing consumer product advice; Providing consumer product advice relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product

advice relating to software; Provision of information and advice to consumers regarding the selection of products and items to be purchased;” and “Comparison services (Price -); Price comparison services; Provision of online price comparison services;” to be dissimilar to the applicant’s goods and services.

40. Therefore, the Cancellation Application is dismissed in relation to the following class 35 services of the proprietor: “Advice for consumers (Commercial information and -) [consumer advice shop]; Commercial information and advice for consumers [consumer advice shop]; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Consumers (Commercial information and advice for -) [consumer advice shop]; Providing consumer product advice; Providing consumer product advice relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product advice relating to software; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Comparison services (Price -); Price comparison services; Provision of online price comparison services;”.

41. My assessment will continue only in respect of the proprietor’s Class 9 and 42 goods and services, and the following services in Class 35: “Retail purposes (Presentation of goods on communication media, for); Communication media (Presentation of goods on -), for retail purposes; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Services with regard to product presentation to the public; Presentation of companies and their goods and services on the Internet; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Advertising and advertisement services; Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising by transmission of on-line publicity for third parties

through electronic communications networks; Advertising for others; Advertising material (Dissemination of -);Advertising material (Updating of -);Advertising of business web sites; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services for the promotion of e-commerce; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to clothing; Advertising services relating to cosmetics; Advertising services relating to hotels; Advertising services relating to jewelry; Advertising services relating to perfumery; Advertising; Advertising services relating to the commercialization of new products; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of goods; Advertising services to promote the sale of beverages; Advertising the goods and services of online vendors via a searchable online guide; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services;” “Promotional advertising services; Promotional and advertising services;” and “Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Marketing; Marketing services; Affiliate marketing; Promotion of goods and services for others; Promotion of goods and services through sponsorship; Sales promotion for third parties; Sales promotion services; Sales promotion services for third parties;”.

Average consumer and the purchasing act

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

43. 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.”

44. The proprietor has claimed that their goods and services are offered directly to corporate clients and businesses, whereas the goods and services offered by the applicant are sold directly to consumers.

45. The goods and services in question cover a very broad range. Firstly, I will consider the software goods, which I believe may be purchased by the general public for personal use, or by businesses for use in a professional environment. However, the purchase of software is not likely to be a regular one and perhaps may even be a one-off event. I appreciate that there are some specific types of software within the proprietor’s registration which would fit their suggestion that those types of software are aimed towards corporate entities however, it is entirely possible that some of the software listed could be for non-professional consumers directly.

46. The selection of such goods will largely be a visual process mainly from websites online and possibly within retail establishments. However, I do not dismiss the potential for the marks to be expressed aurally in conversation with salespersons, on the phone, or when visiting retail outlets.

47. The purchase process will likely require more attention than casual inexpensive purchases (e.g. daily consumables) as this is more likely to be a less frequent and more expensive purchase and the software is likely to be used on an ongoing basis.

The cost of these goods is likely to vary depending on the type of software and the needs of the user.

48. Depending on the value and purpose of the software in question, I consider the average consumer would pay at least a medium degree of attention in its purchase.

49. The services at issue in Class 35 comprise a range of advertising, promotional and marketing services, as well as business management and administration services; file management and database services, and consumer advice and price comparison services. I find that the average consumer for these services would most likely be a professional. The selection of such services is most likely to be a visual process, either online, via websites or through the traditional bricks and mortar high street establishments, with the possibility of aural conversations with salespersons and word of mouth recommendations.

50. All of the class 35 services at issue are likely to be a fairly regular consideration for a professional consumer or business, but I feel such selections will generally invite a higher level of attention than casual purchases, due to the higher cost of such services and their reasonably technical and complex nature. I therefore consider the average consumer will pay at least a medium degree of attention in the selection and purchase of these services.

51. Finally, turning to the contested services under Class 42 and the provision of search engines. As determined above, a search engine can be said to be a form of computer software. In this instance I do believe it is more likely that the average consumer of these services would be a professional rather a member of the general public. As I have found previously regarding software, the purchase process will likely require more attention than casual inexpensive purchases (e.g. daily consumables) as this is more likely to be a less frequent and more expensive purchase and the software is likely to be used on an ongoing basis. I therefore believe the average consumer, professional or otherwise, would be paying at least a medium degree of attention during the purchase process.


Comparison of marks


52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

54. The respective trade marks are shown below:

<p><i>EU012795464 & WE00000953611</i></p> <p>boon</p>	
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<p>EU014672562</p> 	
Applicant's trade marks	Proprietor's Mark

55. As all of the marks at issue are comprised of the same single word, the overall impression of the marks is the same and lies in that word.

56. The marks share the same four letters presented in the same order. The figurative mark registered by the proprietor is in a teal colour and is presented in capital letters. The applicant's marks *EU012795464* & *WE00000953611* are both registered for the word itself. I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* case BL O/281/14 who found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

57. I therefore acknowledge that those earlier marks may be presented in any font, sizing or combination of upper and lower-case fonts. When considering notional and fair use, it is also true that the applicant's earlier marks may be used in the same or a similar colour to that shown in the proprietor's mark. I therefore find that these marks are identical.

58. Mark EU014672562 is a figurative mark registered by the applicant. This is registered in lower case letters and also has a full stop at the end of the word. Given

the word itself is still essentially the same as the proprietor's mark, I do not believe the full stop provides anything further in terms of distinctiveness. I find these marks to be highly visually similar.

59. Aurally the marks will be articulated in precisely the same way and are therefore identical.

60. Conceptually the word Boon has a dictionary definition of something extremely useful, helpful, or beneficial; a blessing or benefit.⁵ As all of the marks are comprised solely of this term, they are conceptually identical.

61. In conclusion, I find the marks to be visually, aurally and conceptually identical with the exception of the applicant's mark EU014672562 which is aurally and conceptually identical, and visually highly similar to the proprietor's mark.

Distinctive character of the earlier trade mark

62. 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

⁵ <https://www.collinsdictionary.com/dictionary/english/boon>

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).”

63. 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.”

64. The applicant did not file any evidence and has made no claim of an enhanced level of distinctiveness in its earlier marks. I must therefore consider the position based on the inherent distinctiveness of the marks.

65. The applicant’s marks consist of the word ‘boon’ which can be said to be an ordinary dictionary term that will be readily understood. The word does not directly describe the services being provided and does not appear allusive or suggestive. Therefore, the opponent’s earlier mark can be said to be inherently distinctive to a medium degree.

Likelihood of Confusion

66. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

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

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

68. To determine whether there is a likelihood of confusion, I must bear in mind a number of factors. I have found the marks to be visually identical or highly similar and aurally and conceptually identical. The goods and services at issue are identical, similar to at least a medium degree, or similar to at least a low degree. I have also found the earlier mark to be inherently distinctive to a medium degree.

69. I am satisfied that although I have found that the average consumer, be that a professional or a member of the general public, would be paying at least a medium degree of attention when selecting the goods and services at issue, the similarities between the marks and the goods and services are sufficiently high so as to counteract that attention level. I therefore find that the average consumer will

mistake one of these marks for the other and consequently there is a direct likelihood of confusion between these marks.

70. In making my assessment, I have kept in mind 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.

Conclusion

71. The applicant has succeeded in respect of all of the contested goods and services in classes 9 and 42. It has also succeeded in respect of the following services in Class 35: "Retail purposes (Presentation of goods on communication media, for); Communication media (Presentation of goods on -), for retail purposes; Providing a searchable online advertising guide featuring the goods and services of online vendors; Providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; Services with regard to product presentation to the public; Presentation of companies and their goods and services on the Internet; Presentation of goods and services; Presentation of goods on communication media, for retail purposes; Presentation of goods on communications media, for retail purposes; Advertising and advertisement services; Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising for others; Advertising material (Dissemination of -);Advertising material (Updating of -);Advertising of business web sites; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services for the promotion of e-commerce; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to clothing; Advertising services relating to cosmetics; Advertising services relating to

hotels; Advertising services relating to jewelry; Advertising services relating to perfumery; Advertising; Advertising services relating to the commercialization of new products; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of goods; Advertising services to promote the sale of beverages; Advertising the goods and services of online vendors via a searchable online guide; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Promotional advertising services; Promotional and advertising services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Marketing; Marketing services; Affiliate marketing; Promotion of goods and services for others; Promotion of goods and services through sponsorship; Sales promotion for third parties; Sales promotion services; Sales promotion services for third parties;”.

72. The applicant has failed in respect of the following contested services in class 35: “Advice for consumers (Commercial information and -) [consumer advice shop]; Commercial information and advice for consumers [consumer advice shop]; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Consumers (Commercial information and advice for -) [consumer advice shop]; Providing consumer product advice; Providing consumer product advice relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product advice relating to software; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Comparison services (Price -); Price comparison services; Provision of online price comparison services;”.

73. The proprietor’s registration is invalidated for all of the class 09 and class 42 goods and services, and all of the class 35 services listed in paragraph 71. The registration remains valid for those class 35 services listed in paragraph 72.

COSTS

74. The applicant has been largely successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale set out in Tribunal Practice Notice (TPN) 2/2016. After due consideration, I believe that an award of costs to the applicant is appropriate as follows:

Official fee	£200
Preparing the Application for Invalidation and considering the Counter Statement	£300
TOTAL	£500

75. I therefore order BOON ONLINE LIMITED to pay Wirecard AG the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 11th day of May 2021

**L Nicholas
For the Registrar**