

O/387/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 1478130
DESIGNATING THE UNITED KINGDOM
IN THE NAME OF FLOWBIRD:**



IN CLASSES 9, 35, 36, 37, 38, 39 & 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418262
BY APCOA PARKING HOLDINGS GMBH**

BACKGROUND AND PLEADINGS

1. On 26 October 2018, FLOWBIRD (“the holder”) registered the International trade mark displayed on the cover page of this decision, under number 1478130 (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 27 April 2018 from the National Institute of Industrial Property, France (“INPI”), under filing number 4449641.

2. The IR was accepted for protection in the UK and was published in the Trade Marks Journal on 2 August 2019 in respect of a range of goods and services in classes 9, 35, 36, 37, 38, 39 and 42. The goods and services designated under the IR are included in an annex to this decision.

3. On 30 October 2019, APCOA Parking Holdings GmbH (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 and is directed against all the goods and services of the IR.

4. The opponent relies upon its European Union trade mark number 17307596 (“the earlier mark”), which consists of the following sign:



5. The earlier mark was filed on 6 October 2017 and became registered on 19 March 2018 in relation to goods and services in classes 9, 35, 36, 37, 38, 39, 42 and 45. The goods and services of the earlier mark, all of which are relied upon for the purposes of the opposition, are also included in the annex to this decision.

6. The opponent's mark is an earlier mark, in accordance with Section 6 of the Act.¹ However, as it had not been registered for five years or more at the priority filing date claimed by the IR, it is not subject to the proof of use requirements specified within Section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier mark is registered.

7. The opponent contends that the competing trade marks are similar and that the respective goods and services are either identical or similar, giving rise to a likelihood of confusion, including a likelihood of association.

8. The holder filed a counterstatement denying the ground of opposition.

9. Both parties have been professionally represented throughout these proceedings; the opponent by Laytons LLP and the holder by Swindell & Pearson Ltd. Neither filed evidence in these proceedings. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Both parties filed written submissions, the opponent in lieu of a hearing and the holder during the evidence rounds. Whilst I do not intend to summarise these, I have taken them all into consideration and will refer to them below, as and where necessary. This decision is taken following a careful perusal of the papers before me.

10. 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 the EU courts.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

PRELIMINARY REMARKS

11. In its written submissions, the holder refers to decision number 2020-0248 of the INPI. I note that the proceedings concerned a prior dispute between the parties in which the opponent opposed the holder's French trade mark number 4593877. The holder says that the goods and services at issue in those proceedings were "fundamentally the same" as in the present case, and that the contested marks in both oppositions "are very similar". The holder highlights that the INPI found no likelihood of confusion between the marks in its decision and argues that this was correct.

12. I must clarify at this early stage that, while I note the contents and findings of the decision, it suffices to say that it is not relevant to the present proceedings. It is well established that previous decisions of other national trade mark offices are not binding on the Registry. Moreover, the trade marks at issue in the opposition before the INPI were not the same as those in the present proceedings. Each case must be assessed on its own merits and, as such, I do not consider it appropriate to derive my findings or conclusions from the decision to which the holder refers. For the avoidance of doubt, the determination of the opponent's claim must take into account the relevant factors, following an assessment of the papers before me.

13. Furthermore, in its counterstatement, the holder submits:

"4. APCOA has not filed any pleadings, beyond ticking the boxes of the Form TM7 and have not set out any arguments as to why the marks are similar and why the goods and services are identical or similar in fact they have not argued which goods and services are identical and which goods and services are similar and they have not filed any pleadings in relation to confusion. They have not argued for direct confusion or for indirect confusion.

5. As APCOA has full opportunity to file the Form TM7 how they wish and they have wished to do so without any additional arguments save boxes ticked on the Form TM7, APCOA have in fact decided to not include any explanation at all of their case, even where the Form TM7 specifically invites this at Question 5. As the Opposition is based on an earlier mark APCOA had an opportunity

(See Question 5 TM7) to set out the arguments on which the Opposition is based, but clearly decided that it was not appropriate to file any arguments.

6. The Registrar is requested to hold that the TM7 is the “high water mark” of APCOA’s arguments i.e. APCOA cannot launch any argument not set out in the Form TM7, and given that there are no arguments set out in the Form TM7 it is maintained that this must be the full extent of the opposition pleadings allowed to APCOA. This is entirely in line with the Woolf Reforms as there can be few instances that are more “cards on the table” than a notice of opposition. APCOA have had the advantage of their Attorneys who clearly took this course of action.”

14. Although it can be of great assistance for parties to fully substantiate their arguments at the earliest opportunity, I must point out that there is no requirement to file a statement of grounds; in other words, it is possible to make a fully pleaded claim under section 5(2)(b) of the Act based on the completion of the boxes on a Form TM7.² While it is true that, where certain things are alleged, a statement of grounds may be needed, but I do not consider that to be the case here.

15. The opponent filed a Form TM7 in which the necessary boxes were completed. By virtue of the wording of section 5(2)(b) and the questions on the form, it was, or ought to have been, clear that the opponent claimed the competing trade marks were similar and the respective goods and services were identical or similar, resulting in a likelihood of confusion, including a likelihood of association. However, it remained open to the opponent to further explain its case at a later stage by way of evidence or written submissions. Therefore, while claims that were not pleaded in the TM7 will not be factored into my assessment, this does not equate to denying the opponent the opportunity to elaborate upon its already pleaded case.

² *Ontro Limited v Delta Air Lines, Inc*, BL O/044/21, paragraph 22

DECISION

Section 5(2)(b): legislation and case law

16. Section 5(2)(b) of the Act reads 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.”

17. 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 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

18. Some of the holder's goods and services, e.g. *'magnetic or chip payment, credit or debit cards'*, *'financial services relating to bank cards, credit cards, debit cards and electronic payment cards'*, *'transmission and reception of information, messages, via mobile telephones'* and *'providing car parks'*, are clearly identical to the goods and services relied upon by the opponent. Therefore, I will proceed on the basis that all of the goods and services are identical. If the opposition fails, even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

The average consumer and the nature of the purchasing act

19. 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.”

20. 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.³

21. The parties appear to be in agreement that the average consumer of the goods and services at issue will include members of the general public and business users.

³ *Lloyd Schuhfabrik Meyer, Case C-342/97*

However, their respective positions as to the level of attention paid by those groups of consumers differs considerably. The opponent has maintained that a “low or average” level of attention will be paid during the purchasing process by both groups of consumers. Conversely, the holder has contended that business users will display a “very high degree” of attention as they will commit to a single provider for “months or years”, in a transaction potentially involving “lots of money”. The holder has also submitted that members of the general public pay “little to almost no attention to the owner/operator” of car parking services as they are selected based upon geographical location, above all other factors.

22. I agree that some of the goods and services, such as some of those in class 39, for instance, are available to both the general public and members of the business community. However, I am of the view that most of the goods and services are more likely to be purchased by business users alone.

23. In respect of business users, although the frequency at which the goods and services are purchased is likely to vary, overall, they will be purchased relatively frequently for the ongoing operational, administrative and technological needs of the business. The selection of the goods would be fairly important for business users as they will wish to ensure that they are choosing products that reflect their specification requirements and enable their business to operate successfully. To this end, business users may consider various factors including technological functionality when selecting the goods. The selection of the services would also be relatively important for business users as they will wish to ensure that they are provided to a professional standard and will be suitable for their needs; some, such as those in class 45, may also have legal ramifications. When selecting the services, business users may consider factors such as the service provider’s expertise and prior outcomes, as well as the range and quality of products offered under the services. In light of the above, I do not agree that business users will demonstrate an extremely high or particularly low level of attention. Instead, it is considered that these consumers will pay a higher than normal level of attention when purchasing the goods and services. The goods are likely to be purchased from the physical outlets of specialist suppliers, or their online equivalents, where they will be selected after viewing information on physical displays or on the internet. The services are likely to be purchased after viewing

information on the internet, in business prospectuses or brochures. Overall, I am of the view that the purchasing process would be predominantly visual in nature. However, I do not discount an aural component to the selection of the goods and services in the form of discussions with sales representatives about products of this nature or verbal consultations with prospective service providers.

24. As for the general public, the services are not likely to be particularly frequent nor infrequent purchases. The cost of the services is likely to vary considerably; for example, vehicle rental is likely to attract a higher cost, while utilising a short-term parking space is likely to be inexpensive. However, overall, I am of the view that the services will not require a considerable outlay. The purchasing of some of the services is likely to follow a measured thought process; for example, when selecting vehicle rental services, the general public will consider factors such as the range of vehicles offered under the services and cost. Other services, such as utilising a car park, for instance, are likely to be more casual purchases requiring less thought. I agree with the holder that the purchasing decision in these circumstances may largely depend upon the geographical location of the car park. That being said, it is still a factor that will be considered during the purchasing process, as would the duration and availability of parking spaces. Therefore, I do not accept that little to no attention will be paid. To my mind, the level of attention of the general public is likely to range between lower and higher than normal, depending on the service. Taken overall, I am of the view that the general public will demonstrate a medium level of attention during the purchasing act. The services are typically purchased by the general public at the physical premises of the service provider, or after viewing information on the internet. While I cannot discount an aural component to the selection of the services in the form of advice from salespersons or word of mouth recommendations, it is considered that the selection process would be, primarily, visual.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

26. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

27. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

28. The opponent has contended that the earlier mark, consisting of a letter 'F' and stylised background, does not directly describe any characteristics of the goods and services for which it is registered. For this reason, the opponent has argued that the earlier mark has a medium degree of distinctiveness. The holder has not commented on the level of distinctiveness possessed by the earlier mark.

29. The earlier mark is figurative and is comprised of two elements, namely, the letter 'F' and a roughly square, green device which serves as a background. The 'F' is presented in white and is stylised to such an extent that it is not, as the opponent has asserted, "clearly recognisable". Arguably, it no longer looks like the letter and I am not entirely convinced that consumers would immediately perceive it as such. That being said, I am prepared to accept that a significant proportion of consumers would identify the letter in the mark. In relation to this section of average consumers, I agree with the opponent that the letter has no descriptive or allusive qualities in respect of the goods and services of the earlier mark. However, to my mind, given that there is a propensity for many undertakings to adopt letters as indicators of trade origin, the letter 'F' is not particularly distinctive. In my view, it is equally likely that another significant proportion of consumers (probably the majority) would not immediately identify the letter and would, instead, regard it as a figurative element consisting of three parallelogram shapes. The arrangement and relative sizes of the shapes will appear arbitrary and, therefore, I acknowledge that there is a degree of originality. Nonetheless, they are still ordinary shapes. In light of the foregoing, I find that the earlier mark has a medium degree of inherent distinctive character for both sections of average consumers. In the case of those who identify the letter 'F', the distinctive character of the mark is attributable to its particular graphic representation and not in the letter per se.



Comparison of trade marks

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

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

31. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

32. The competing trade marks are as follows:

The earlier mark	The holder's mark
	

33. I have lengthy submissions from both parties on the similarity of the marks which I do not propose to reproduce in full here. However, I have taken them all into consideration in reaching my decision.

Overall impression

34. The earlier mark is figurative and consists of shapes resembling the letter 'F' and a roughly square, green device. As I have already found, it is arguable whether the letter 'F' would be identified by consumers due to its heavy stylisation. It is, however, clear that the stylisation is so striking that it plays an important role in the mark; the overall impression of the mark is dominated by this highly stylised component, which may or may not be perceived as the letter 'F'. The roughly square device will be perceived as a background, whereas the use of colour will be seen as decorative. Therefore, these latter two elements, while still contributing, will play lesser roles in the overall impression of the mark.

35. The contested mark is also figurative and consists of lighter and darker dots on a grey background. The holder has argued that the mark contains an image of a bird, though, to my mind, this is simply not apparent. At the centre of the mark, the darker dots coalesce to form a letter 'F' by contrast to the lighter background. The letter will be immediately identified by consumers. I am of the view that the letter 'F' and, more importantly, the way in which it is stylised dominate the overall impression of the mark. The lighter dots surrounding the central element will be perceived as a background and the use of colour will be seen as decorative. Accordingly, although these elements still provide a contribution, they will play a reduced role in the overall impression of the mark.

Visual comparison

36. In respect of consumers who do not immediately identify the letter 'F' in the earlier mark, I find that there is no point of visual similarity between the competing marks. As for consumers who see the letter 'F' in the earlier mark, the competing marks remain very different to look at. I accept that they will both be perceived to contain the letter 'F'. Nonetheless, just because two marks share representations of the same thing

does not automatically result in visual similarity between them.⁴ The distinctive character of the competing marks is not in the letter 'F' per se, but, rather, in their respective graphic representations. In this regard, I note that the marks are both highly stylised in drastically different ways. It is considered that there is no visual similarity between the marks.

Aural comparison

37. For consumers who do not identify the letter 'F' in the earlier mark, there is no aural similarity between the competing marks. This is because the contested mark will be pronounced as "EFF", whereas the figurative element of the earlier mark will not be articulated in any way. In contrast, for the section of average consumers who read the letter 'F' in the earlier mark, I agree with the opponent that the competing marks will be aurally identical.

Conceptual comparison

38. For a conceptual message to be relevant, it must be capable of immediate grasp.⁵ The letter 'F' does not convey any clear and obvious meaning which could be discerned by the average consumer. For this reason, I do not accept the opponent's contention that the competing marks are conceptually identical. Irrespective of whether the letter 'F' is identified in the earlier mark or is, instead, perceived as three shapes, the competing marks have no semantic content. Therefore, the position is, effectively, neutral.

Likelihood of confusion

39. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of

⁴ *The Royal Academy of Arts v Errea Sport S.P.A.*, BL O/010/16

⁵ *The Picasso Estate v OHIM*, Case C-361/04 P

similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

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

41. I also bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13. He 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, saying:

“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”.

42. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive

character of the earlier mark lie?'. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

43. Having proceeded on the basis that the holder's goods and services are identical to those of the opponent, I further concluded that:

- Average consumers of the goods and services at issue are likely to include members of the general public and business users, the former demonstrating a medium level of attention and the latter demonstrating a higher than normal level of attention during the purchasing act;
- The purchasing process for the goods and services would be predominantly visual in nature, though I have not discounted aural considerations;
- The earlier mark possesses a medium degree of inherent distinctive character;
- The overall impression of the earlier mark is dominated by the highly stylised central element, which may or may not be perceived as the letter 'F', while the background device and use of colour play lesser roles;
- The overall impression of the contested mark is dominated by the letter 'F' and the way in which it is presented, whereas the decorative background plays a reduced role;
- Whether or not the average consumer identifies the letter 'F' in the earlier mark, there is no visual similarity between the competing marks;
- Aural similarity factors upon whether the letter 'F' is identified, the competing marks being aurally identical where it is and aurally dissimilar where it is not;
- Irrespective of how the earlier mark is perceived, the competing marks are conceptually neutral.

44. In respect of the significant proportion of average consumers who do not identify the letter 'F' in the earlier mark, I have found that the competing marks are visually and aurally dissimilar, while being conceptually neutral. As the earlier mark will not be seen as containing an 'F', I can see no reason why the marks would be mistaken for one another, or why consumers would believe that they originate from economically linked undertakings. Accordingly, there is no likelihood of direct or indirect confusion.

45. Turning to the section of average consumers who identify the letter 'F' in the earlier mark, I remind myself that the competing marks are visually dissimilar, aurally identical and conceptually neutral. My finding that the competing marks are aurally identical is a factor which weighs in favour of the opponent. Nevertheless, I have found that the competing marks are visually dissimilar, a factor which weighs strongly in the holder's favour. Visual, aural and conceptual similarities do not always carry the same weight. For instance, where goods or services are purchased by primarily visual means, greater weight will be attributed to the visual similarities or differences.⁶ In this case, given that the purchasing act is likely to be predominantly visual in nature, the visual differences between the competing marks are of particular importance. Further, as the competing marks consist of a single letter, the differences between them have a significant impact on their respective overall impressions and are more likely to be noticed by consumers.⁷ In addition, while I have found that the earlier mark possesses a medium degree of inherent distinctive character, this resides in its particular graphic representation, rather than in the letter 'F' per se. Bearing this in mind, I note that the stylisation of the respective marks is strikingly different. The visual differences are compounded by the fact that the competing marks are conceptually neutral and, as such, have no meaning which could link them together in the mind of consumers. Finally, although the competing marks may both be verbalised as "EFF", as the purchasing process for the goods and services is likely to be a primarily visual one, consumers are unlikely to select the goods and services without sight of the marks. In these circumstances, there is only limited potential for aural confusion and, in any event, aural identity between the marks is insufficient alone in the context of the

⁶ *New Look v OHIM* T-117/03 to T-119/03 and T-171/03

⁷ Case T-274/09 *Deutsche Bahn v OHIM*, paragraph 78, and Case T-304/10 *dm-drogerie markt v OHIM*, paragraph 42

necessary global assessment for a finding of direct confusion.⁸ Taking all the above factors into account, I do not consider that the average consumer would mistake one mark for the other, even on goods and services that are identical. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

46. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., again sitting 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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

⁸ BL O/010/16

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

47. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach. I also recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.⁹ The common element between the competing marks is the letter ‘F’, which, without any stylisation, is relatively low in distinctive character. Consequently, I do not believe that consumers who identify the letter in the earlier mark will assume that the parties are economically linked undertakings on the basis of the competing trade marks; I am unconvinced that consumers would assume a commercial association or licensing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared letter ‘F’. The distinctive character of the earlier mark does not rest solely in the letter but, rather, its particular graphic representation. To my mind, this section of average consumers is likely to assume that the use of the letter is a coincidence due to the propensity for many undertakings to adopt letters as indicators of trade origin and not an indication that there is a connection between the undertakings responsible for the marks. Further, the differences between the marks are not conducive to being a logical sub-brand or brand extension. I can see no reason why the average consumer, having recognised the significant differences in the stylisation of the marks, would assume that the opponent had redesigned its mark with a completely different look and feel, resulting in the holder’s mark. In light of the above,

⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

I find that there is no likelihood of indirect confusion between the competing marks, even in relation to goods and services that are identical.

CONCLUSION

48. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal against my decision, protection for the IR will be granted in the UK in respect of the full range of designated goods and services.

COSTS

49. As the holder has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of **£750** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£250
Preparing written submissions	£500
Total	£750

50. I therefore order APCOA Parking Holdings GmbH to pay FLOWBIRD the sum of **£750**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 24th day of May 2021

James Hopkins
For the Registrar,
The Comptroller-General

ANNEX

Goods and services of the IR

Class 9: Electronic terminals of information, of sale of goods and/or services; remote recognition terminals enabling the debiting of services sold; interactive information terminals; electronic machines for dispensing parcels and/or goods; electronic parking terminals including electronic terminals of car parks; memory cards intended for use with parking pay points; parking meters including electronic memory parking meters; parking meters operated by a magnetic card, coins or tokens; parking meters operated by electronic memory cards; parking meters for multi-media communication; parking meters operated by cards with microprocessors; time and date stamping machines including on-street time and date stamping machines; electronic parking tickets; electronic apparatus for vehicle parking management, especially on-street or in a closed park, especially automatic pay stations; electronic apparatus for access security apparatus for vehicle parking management; electronic apparatus for control of access for car parks; software, servers, computers and communication terminals for the management of car parks; electronic apparatus for communication between time and date stamping machines and a central computer; electronic apparatus for communication (sub-assemblies in communication) to be located in the time and date stamping machines; electronic apparatus for issuance of public transport tickets; software for use in issuance of public transport tickets; public transport tickets consisting of an electronic memory card; software, servers, computers and communication terminals for the management of electronic apparatus for issuance of public transport tickets; software, servers, computers and communication terminals for monitoring, management and delivery of parcels and goods; electronic reading and writing apparatus for memory cards for use in parking pay points, parking meters, time and date stamping machines, electronic apparatus for issuance of public transport tickets; Apparatus for transmitting data concerning vehicle parking, data in connection with the recharging of electric vehicles and e-ticketing data; electronic and/or computer apparatus for navigation, orientation, location and positioning of available parking spaces, vehicle recharging points, particularly by means of satellite geolocation; interfaces (computing) and software (recorded programs) for electronic payment transactions; computer software for document management; electronic payment

instruments and apparatus; cash or ticket dispensers; magnetic or chip payment, credit or debit cards; software for accessing databases, telecommunication services, computer networks and electronic bulletin boards; downloadable software for the supply and monitoring of information relating to the distribution and delivery of coin-operated apparatus.

Class 35: Business management assistance, efficiency experts in the field of parking, electric vehicle recharging points and e-ticketing; providing marketing and commercial information in the field of parking vehicles, recharging electric vehicles or e-ticketing; subscription services for third parties, namely, for subscription to a telephone service, subscription to a database, subscription to a database server; collection and systematization of data in a central file; computer file management; computer file management, in particular via the Internet, extranets or intranets; retail sale of gas cylinders, particularly via the Internet, intranets or extranets; promoting the goods and services of others by means of discount card schemes, discount vouchers; management of a discount program enabling participants to obtain discounts on goods and services; loyalty programs.

Class 36: Payment services by mobile telephone or Internet for parking spaces, electric vehicle recharging, transportation tickets; Provision of electronic funds transfer services; information and consultation in relation to payment; on-line payment services on an electronic communication network; financial services relating to bank cards, credit cards, debit cards and electronic payment cards.

Class 37: Maintenance services (servicing, repair) for electronic information terminals and/or sale of goods/services, remote recognition terminals allowing the debiting of services sold, interactive information terminals, electronic machines for dispensing parcels and/or goods, parking terminals, parking meters, time and date stamping machines, electronic apparatus for vehicle parking management, electronic apparatus for access security to apparatus for vehicle parking management, electronic apparatus for control of access for car parks, electronic apparatus for communication between time and date stamping machines and a central computer, electronic communication apparatus (communication sub-assemblies) to be located in time and date stamping machines, electronic apparatus for issuance of public transport tickets, electronic

apparatus for writing/reading for memory cards used in parking terminals, parking meters, time and date stamping machines, electronic apparatus for issuance of public transport tickets.

Class 38: Transmission of data from parking pay points, parking meters, time recorders, automatic parking lot pay terminals, vehicle recharge points and electronic apparatus for issuing transportation tickets to a computer center (one or more computers), for real-time management of parking lots, electric vehicle recharging points and seats on public transportation; transmission and reception of information, messages, via mobile telephones; information transmission from a computer data bank; information transmission services concerning news via mobile telephone; call center services [electronic communications]; telecommunication services in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; information relating to telecommunications in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; electronic display services (telecommunications) in relation to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental; transmission services relating to vehicle parking, rental of car parking spaces, public transport, carpooling, car-sharing, car rental.

Class 39: Providing car parks; services for reserving public transport tickets by public automatic electronic apparatus; vehicle parking services; services for reserving parking spaces provided online via the Internet or mobile telephone; providing information relating to available parking spaces; navigation (guiding) of vehicles to available parking spaces, parking pay points, electric vehicle recharging points; information relating to transport, travel or vehicle rental; rental of vehicle parking spaces; information services relating to vehicle parking, road traffic; information services relating to mobility, namely, car-sharing, carpooling, vehicle rental, recharge terminals for electric cars; vehicle rental; rental of bicycles; information services relating to the rental of vehicles and bicycles; vehicle equipment rental services; retail sale of transportation tickets, vehicle booking tickets particularly via the Internet, intranets or extranets; rental of parking spaces, namely, providing temporary use of parking spaces.

Class 42: Software and database development (design) intended for operating or controlling apparatus for vehicle parking management, apparatus for issuance of public transport tickets, interactive terminals; updating of software and databases, computer programming services for electronic memory cards intended for apparatus for vehicle parking management.

Goods and services of the earlier mark

Class 9: Computer programs and software for recognising and identifying vehicles and numberplates; Computer programs and software for detecting and identifying mobile communications devices and radio frequency identification tags (RFID); Computer programs and software for data transmission between devices over short distance via radio technology; Apparatus for the transmission of data; Computer programs and software for recognising parking manoeuvres; Computer software and software for automated calculations and payment services; Computer applications for automated vehicle parking control; Devices for automated parking checks and number plate recognition; Computer applications (downloadable) and mobile apps for searching for, reserving, use and paying for parking spaces; Radio-frequency identification (RFID) tags; Labels and cards with integrated RFID chips; Readers for radio frequency identification (RFID) and recognition of data codes; Card reading equipment; Encoded cards; SIM cards; Electronic card readers; Software for card readers; Encoded cards for use in point of sale transactions; Cards bearing electronically recorded data; Encoded cards for use in relation to the electronic transfer of funds; Smart cards [integrated circuit cards]; Smart card readers.

Class 35: Business management and professional business consultancy relating to the construction and management of parking spaces, in particular multi-storey car parks, car parks and other parking installations; Administrative management of multi-storey car parks, parking spaces and other parking facilities; Professional business consultancy, for others, regarding market-development measures, including sales, marketing, advertising campaigns and development and implementation of marketing concepts in relation to the management, by means of rental and leasing, of parking spaces, as well as the design and marketing thereof; Data processing for the collection

of data for business purposes; Collection of data relating to parking manoeuvres about users and vehicles for commercial purposes.

Class 36: Rental and leasing and management of properties; Financial affairs and payment collection in relation to parking charges and fines; Electronic payment services, including via the internet and mobile terminals (via SMS and application software or apps); Payment by means of radio frequency identification (RFID); Automated payment services; Money transfer services utilising electronic cards; Processing electronic payments made through prepaid cards; Bank card, credit card, debit card and electronic payment card services.

Class 37: Providing of information concerning electrical charging options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of electric charging bays on the internet, on telecommunications networks and via mobile telephone services and application software (apps).

Class 38: Telecommunications, mobile telephone services, radio communications and providing access to application software (apps) for providing information on the internet for searching for, reserving, use and paying for parking spaces; Delivery of messages and data by electronic transmission; Data transmission.

Class 39: Car park services; Car parking; Car park services; Provision of car parks and car parking services; Rental of multi-storey car parks, parking spaces and other parking facilities; Operation of multi-storey car parks and parking facilities; Rental, leasing and reservation of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities, on the basis of rental, leasing and business service agreements, in particular providing tailored services for parking customers; Rental and leasing of parking spaces; Arranging of parking spaces, for others, in particular via the Internet; Providing of information relating to parking options on the internet, on telecommunications networks and via mobile telephone; Reservation and booking of parking spaces on the internet, telecommunications networks and via mobile telephone and applications software (apps); Transport and traffic logistics, in particular operation and control of traffic and parking guidance systems for moving and stationary traffic; Traffic management services; Taxi management; Shuttle services.

Class 42: Technical consultancy for the design, development and building design of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities; Design and development of computer programs and apparatus for recognition of numberplates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Technical consultancy for design, development and building design of parking facilities with automated parking checks and automated payment services; Software design and development; Design and development of computer hardware.

Class 45: Licensing of computer software for the use of Internet platforms for online and offline management of parking spaces; Licensing of software for the recognition of number plates and vehicles, for navigation in buildings, for radio frequency identification, for technology for data transmission between devices over short distance via radio technology, for detecting of parking manoeuvres, parking checks and for processing of payment procedures; Monitoring of parking areas, in particular of multi-storey car parks, parking spaces and other parking facilities (security services); Monitoring of compliance with parking and usage rules and imposing penalties (legal services and security services).