

O/501/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3472970 BY
EDDID MARKETING LIMITED
TO REGISTER:**

EDDIDSON

AS A TRADE MARK IN CLASSES 9, 36, & 42

AND

**OPPOSITION THERETO
UNDER NO. 421328
BY
EDISON S.P.A.**

BACKGROUND & PLEADINGS

1. Eddid Marketing Limited (“the applicant”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 6 March 2020. It was accepted and published in the Trade Marks Journal on 5 June 2020 in respect of the following goods and services:

Class 9: Computer programs, downloadable; computer software applications, downloadable; computer software platforms, recorded or downloadable; downloadable e-wallets; data processing apparatus; computer operating programs, recorded; all of the aforementioned goods being on the subject of or relating to finance and financial investments.

Class 36: Insurance brokerage; Insurance underwriting; Financial evaluation (insurance); Insurance consultancy; Providing insurance information; Credit bureau services; Financial analysis; Financial consultancy; Providing financial information; Financial sponsorship; Business liquidation services, financial; Repair costs evaluation (financial appraisal); Providing financial information via a website; Financial management of reimbursement payments for others; Financial research; Capital investment; Trustee; Securities brokerage; Stocks and bonds brokerage; Stock exchange quotation.

Class 42: Computer programming; computer software design; rental of computer software; computer system analysis; computer system design; computer software consultancy; rental of web servers; software as a service [SaaS]; information technology [IT] consultancy; providing information relating to computer technology and programming via a web site; cloud computing; creating and designing website-based indexes of information for others [information technology services]; software development in the framework of software publishing; platform as a service [PaaS]; development of

computer platforms; all of the aforementioned services being on the subject of or relating to finance and financial investments.

- EDISON S.p.A. (“the opponent”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the following figurative marks:

Trade Mark no.	EU015710353 ('353)
Trade Mark	
Goods & Services Relied Upon	Classes 4, 9, 16, 35, 36, 37, 39, 40, 41, & 42
Relevant Dates	Filing date: 01 August 2016
	Date of entry in register: 21 February 2017

Trade Mark no.	EU016378788 ('788)
Trade Mark	
Goods & Services Relied Upon	Classes 4, 6, 7, 9, 11, 16, 35, 36, 37, 39, 40, 41, & 42
Relevant Dates	Filing date: 17 February 2017
	Date of entry in register: 22 June 2020

- Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the opposition was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit)

Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.

4. On 23 January 2021, the Tribunal allowed the above second earlier mark '788 to be added as an additional ground of opposition in these proceedings as per Tribunal Practice Notice 4/2000.
5. For the purpose of this opposition, the opponent only relies on goods and services in Classes 9, 36 and 42 for the first earlier mark '353, and on services in Class 36 for the second earlier mark '788 as shown later in this decision.
6. Under Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier trade marks. Further, as the registration of the opponent's earlier marks were completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
7. In its amended notice of opposition,¹ the opponent argues that "[...] the substantial degree of similarity between the mark applied for EDDIDSON and EDISON, which is the dominant and distinctive feature of the Earlier Trade Mark, there is a likelihood of confusion on the part of the relevant public [...]". Also, it claims that there is "substantial degree of similarity" between the contested mark and the second earlier mark '788, and the respective services in Class 36 are identical while the goods in Class 9 and the services in Class 42 are "closely similar to the Class 36" of the second earlier mark '788. Therefore, registration of the contested mark should be refused under Section 5(2)(b) of the Act.
8. In response, the applicant filed a counterstatement prior to the addition of the second earlier mark '788, denying all the grounds regarding the first earlier mark '353. Further, the applicant states that because of the opponent's omission to "complete Q5 in the Notice of Opposition or to

¹ Following the addition of the second earlier mark '788.

explain the grounds of opposition, including why a likelihood of confusion is considered or exist. [...] the Applicant reserves the right to comment in relation to any future submissions made or evidence filed by the Opponent.” In agreement with the Registry’s letter of 24 September 2020,² the applicant reiterates that the opponent should make clear submissions as to the similarity of the respective goods and services.

9. Only the opponent filed submissions during the evidence round in these proceedings which will not be summarised but will be referred to as and where appropriate during this decision.
10. Neither side filed written submissions in lieu of a hearing nor requested a hearing. Thus, this decision has been taken following a careful consideration of the papers.
11. In these proceedings, the opponent is represented by Haseltine Lake Kempner LLP and the applicant by Albright IP Limited.
12. 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.

² In these proceedings, the Registry directed, under Rule 62 of the Trade Mark Rules 2008, that the opponent indicates its best case at the filing of its evidence, making clear submissions as to which particular goods and services in each class are similar to the applicant’s specification. In this regard, the opponent made detailed submissions which I have taken into consideration.

DECISION

Section 5(2)(b)

13. The relevant statutory provisions are as follows:

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

“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.”

14. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct

comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

COMPARISON OF GOODS & SERVICES

15. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

17. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

18. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

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

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

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast

range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

22. Although the opponent indicated that it relies on all goods and services covered by the first earlier mark ‘353, it focusses with its submissions, as I will do, on the marks’ terms below. The competing goods and services to be compared are shown in the following table:

Opponent’s Goods & Services First Earlier Mark ‘353	Applicant’s Goods & Services
Class 9: Programs for computers; Central processing units; Integrated circuits.	Class 9: Computer programs, downloadable; computer software applications, downloadable; computer software platforms, recorded or downloadable; downloadable e-wallets; data processing apparatus; computer operating programs, recorded; all of the aforementioned goods being on the subject of or relating to finance and financial investments.
Class 36: Research services relating to finance; Economic research services; Insurance research; Financial sponsorship of sporting activities; Financial	Class 36: Insurance brokerage; Insurance underwriting; Financial evaluation (insurance); Insurance consultancy; Providing insurance information;

<p>sponsorship of entertainment activities; Fundraising and sponsorship; Financial advice; Insurance consultancy; Philanthropic services concerning monetary donations; Investment of funds for charitable purposes; all the above except for philanthropic services and charitable fund-raising services.</p>	<p>Credit bureau services; Financial analysis; Financial consultancy; Providing financial information; Financial sponsorship; Business liquidation services, financial; Repair costs evaluation (financial appraisal); Providing financial information via a website; Financial management of reimbursement payments for others; Financial research; Capital investment; Trustee; Securities brokerage; Stocks and bonds brokerage; Stock exchange quotation.</p>
<p>Class 35: Cost price analysis; Business information; Sponsorship search; Business consulting; Business consultancy and advisory services; Cost price analysis; Cost benefit analysis.</p>	
<p>Class 42: Computer programming; Providing of IT programs designed in accordance with the specifications of others; Computer software design; Design and writing of computer software; Design and development of systems for data input, output, processing, display and storage; Software development; Software design and development; Design and development of computer software for logistics; Computer rental; Rental of computer programs; Rental of application software; Computer system analysis; Computer software consultancy; Electronic data storage; Hosting of databases; Hosting of computerised data, files, applications and information; Hosting memory space on the internet; Web site design and creation services; Hosting of web portals</p>	<p>Class 42: Computer programming; computer software design; rental of computer software; computer system analysis; computer system design; computer software consultancy; rental of web servers; software as a service [SaaS]; information technology [IT] consultancy; providing information relating to computer technology and programming via a web site; cloud computing; creating and designing website-based indexes of information for others [information technology services]; software development in the framework of software publishing; platform as a service [PaaS]; development of computer platforms; all of the aforementioned services being on the subject of or relating to finance and financial investments.</p>

<p>Opponent's Goods & Services Second Earlier Mark '788</p>	
<p>Class 36: Insurance; Financial affairs; Monetary affairs; all the above except for philanthropic services and charitable fund-raising services.</p>	

23. The opponent made lengthy submissions in relation to the identity and/or similarity of the goods and services for each of its earlier marks which I have considered in this decision.
24. Prior to the addition of the second earlier mark '788 in these proceedings, the applicant denied any identity or similarity to the goods and services of the earlier mark '353.
25. I note that the applicant's specification contains a limitation in that the goods in Class 9 and services in Class 42 are all on the subject of, or relate to, "finance and financial investments"; and the opponent's specification in Class 36 for both of its earlier marks has an exclusion reading "all the above except for philanthropic services and charitable fund-raising services".
26. For the purpose 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 for the same reasons.³
27. I will begin by considering the opponent's position in relation to the goods and services of the first earlier mark '353, before then moving on to consider the position with the second earlier mark '788.

³ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Computer programs, downloadable; computer software applications, downloadable; computer software platforms, recorded or downloadable; downloadable e-wallets; computer operating programs, recorded

28. The applicant's contested term "*computer programs, downloadable*" is identical to the opponent's "*programs for computers*" on the basis that it is identically worded or ostensibly the same. In addition, the rest of the contested terms in Class 9 set out above are encompassed by the opponent's broad term "*programs for computers*". As such, they are considered identical, based on the *Meric* principle, or else highly similar. I should add that this is so, notwithstanding the limitation in the applicant's specification, the specifications still covering identical goods.

Data processing apparatus

29. The contested term refers to the processing of data by a device/machine. The opponent submits that this is similar to its term "*central processing units*" ("CPUs"), stating:

"[CPUs] are the electronic circuitry components within computers which enable operations, as instructed by software, so that data can be input and processed. Since they are an integral part of data processing apparatus, they are not sold separately to end-consumers of computer products, and are therefore complementary. Additionally, CPUs and data processing equipment overlap in their nature and intended purpose (being part of the same overarching processing product), and are distributed through the same channels of trade."

I concur with the above analysis that CPUs can constitute an integral part, if not the core, of data processing apparatus. This is because the CPU itself processes the data thereby being an indispensable component of the apparatus. Thus, there is complementarity between the respective items. Further, I consider there to be an overlap in users, method of use, trade

channels, and purpose. Therefore, I find a medium to high degree of similarity.

I also find that there is similarity between the opponent's term "*programs for computers*" and the applicant's term "*data processing apparatus*". In order for the latter to process data and instructions, the use of the former is required. In other words, a computer program/software instructs an apparatus to execute the task of data processing. Such data processing programs include data processing in the financial field, so it is not as though the limitation in the applicant's specification avoids this potential point of similarity. Even if they differ in nature (tangible and intangible), both have the same general purpose (processing of data), and both are complementary to each other. Also, there is an overlap in users, method of use, and trade channels. In light of the above, it is considered that there is a medium to high degree of similarity between the respective goods.

Insurance consultancy; financial research

30. The applicant's terms "*insurance consultancy*" and "*financial research*" are self-evidently identical to the opponent's terms "*insurance consultancy*" and "*research services relating to finance*".

Financial sponsorship

31. The applicant's broad term "*financial sponsorship*" includes the opponent's "*financial sponsorship of sporting activities; financial sponsorship of entertainment activities; fundraising and sponsorship*". Consequently, I find that the respective services are identical under the *Meric* principle.

Financial consultancy; providing financial information; providing financial information via a website

32. All of the applicant's services listed above can be described as financial services concerning the provision or utilisation of information relating to

monetary assets and investments. As such, I consider them to fall within the ambit of the opponent's broad term "*financial advice*". The respective services are identical in accordance with the *Meric* principle.

Credit bureau services; financial evaluation (insurance); financial analysis; business liquidation services, financial; repair costs evaluation (financial appraisal); financial management of reimbursement payments for others

33. The above contested services essentially concern the utilisation of financial data and information, the valuation of assets, either tangible or intangible, including loan- and debt-related activities and advisory. Such services are similar in nature to the opponent's term "*financial advice*" to the extent that they are financial of one type or another, especially when the advice relates to the type of financial service applied for. I find that they share the same general purpose that involves consultation enabling the management and use of monetary funds to make or enhance the investment of funds. The method of use will be the investment itself following consultation/advice. The services may also be provided by the same or related undertakings as well as sharing the same trade channels. Also, the respective users will overlap. Lastly, "*financial advice*" can be considered to be complementary to the applicant's services – the advice can relate to the types of financial service being considered. This is because such services can form an intrinsic part of the applicant's services. Thus, in my view, there is a medium degree of similarity between the respective services.

34. In its submissions, the opponent claims that the contested terms "*business liquidation services, financial; repair costs evaluation (financial appraisal); financial management of reimbursement payments for others*" are closely similar to its terms in Class 35 "*cost price analysis; business information; sponsorship search; business consulting; business consultancy and advisory services; cost price analysis; cost benefit analysis*". However, the opponent does not provide any explanation and in my view the link between these service is not particularly clear. Thus, such a claim does

not take the opponent further forward as any similarity would be much less than that assessed above.

Capital investment; trustee; securities brokerage; stocks and bonds brokerage; stock exchange quotation

35. The contested terms are all services that involve the trading of stocks and bonds. Such services relate to financial services as does the opponent's "financial advice". Therefore, the respective services coincide in nature, trading channels, and users. Although each of them serves a different purpose, they can be considered to be complimentary as, for example, one may first seek advice before proceeding with the trading of their funds. Therefore, I find the respective services to be similar to a medium degree.

Insurance brokerage

36. The contested term "insurance brokerage" involves services that cover the arrangement and procurement of insurance products or policies by an agent on behalf of their clients. Since the contested term and the opponent's "insurance consultation" could be about the same type of insurance, they could be complementary to each other. Although each of them serves different purpose, they target the same users and could be bundled together. The distribution channels will be the same or very similar and there may be competition and/or complementarity. Thus, I find the services to be similar to a medium degree.

Insurance underwriting

37. The contested "insurance underwriting" relates to the service of evaluating the risk profile of the potential policy holder on behalf of the insurance company, or the service of a financial institution underwriting the risk of another financial service provider. There is complementarity between the contested term and the opponent's "insurance consultation" as the latter could cover the subject matter of the former, i.e. risk and underwriting. The

respective services could also form part of a bundle, and, thus, the distribution channels will be the same or very similar. Thus, I find the services to be similar to a medium degree.

Computer programming; computer software design; computer system analysis; computer software consultancy; rental of computer software; design and writing of computer software; computer system design

38. These contested services are identical to the opponent's, sharing identical or ostensibly the same wording.

Information technology [IT] consultancy; providing information relating to computer technology and programming via a web site

39. The applicant's terms are all consultancy services in relation to information technology ("IT") that can be encompassed by the opponent's broad term "computer software consultancy". Therefore, I find them to be identical as delineated in *Meric*, or else they must be highly similar, even with the limitation in the applicant's specification.

Cloud computing; software as a service [SaaS]; platform as a service [PaaS]; development of computer platforms; rental of web servers

40. All of the above contested terms are IT-related services as the opponent's "design and development of systems for data input, output, processing, display and storage; electronic data storage; hosting of databases; hosting of computerised data, files, applications and information; hosting memory space on the internet; hosting of web portals" which involve the use of computer, telecommunications and related means for the development, processing, and storage of data. Such services target the same consumers and are provided through the same distribution channels. It is commonplace that undertakings provide a wide range or bundle of such solutions. These are also complementary as they can be indispensable to

each other. Therefore, I find that they are similar to at least a medium degree.

Software development in the framework of software publishing; creating and designing website-based indexes of information for others [information technology services]

41. The applicant's terms are sub-categories of the opponent's general terms "*Computer software design; Design and writing of computer software*". Therefore, I find them to be *Meric* identical.
42. I will consider below the opponent's position by addressing the similarity/identity of goods and services in relation to the second earlier mark '788.
43. The applicant's goods in Class 9 and the opponent's services in Class 36 are different in nature, purpose and method of use. However, I accept the opponent's submission that the contested goods in Class 9 can be considered to be complementary to the opponent's services, as they facilitate the conduct of such services. This is particularly the case when considering the examples of online/digital and mobile applications (mobile banking) and card readers (e.g. Chip Authentication Program reader) relating to financial services. Further, the respective goods and services could be distributed through the same trade channels. Therefore, they are similar to a low to medium degree.
44. The contested terms in Class 36 are identical to the opponent's services in the same Class because part of them is identically worded and part is broad enough to encompass the contested terms as per *Meric*.
45. The contested term "*software as a service [SaaS]*" in Class 42 relates to a software distribution model with which the service provider makes the software (e.g. applications) available to the customers over the Internet. These services are akin to the goods in Class 9 (albeit with different

delivery models), which I exemplified above, and will be complementary to the opponent's services in Class 36, as they could be deemed essential to the provision of (financial/insurance) web-based software, offered as part of the opponent's services. The respective services could be distributed through the same trade channels, targeting the same consumers. Therefore, they are similar to a low to medium degree.

46. In relation to the remaining contested terms in Class 42, namely "*computer programming; computer software design; rental of computer software; computer system analysis; computer system design; computer software consultancy; rental of web servers; information technology [IT] consultancy; providing information relating to computer technology and programming via a web site; cloud computing; creating and designing website-based indexes of information for others [information technology services]; software development in the framework of software publishing; platform as a service [PaaS]; development of computer platforms*", and the opponent's services in Class 36, they are different in nature, method of use, and purpose, even if they primarily target businesses or professionals in the financial sector. However, the respective services may potentially overlap in trade channels, as the contested services are specified for the financial sector. Consequently, I find that the services at issue are similar to a low degree.

AVERAGE CONSUMER AND THE PURCHASING ACT

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

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

48. The average consumer of the goods and services at issue will be either a member of the general public or professionals and businesses in the financial sector, such as institutional investors or financial institutions. The goods and services range from relatively commonplace, such as IT consultancy (commonplace for business users at least), to more bespoke and sophisticated ones, such as business liquidation. The degree of attention for goods in Class 9 and services in Class 42 will vary from average to high depending on the importance, cost, suitability, and software and hardware compatibility. In relation to the Class 36 services, some of which are infrequent and expensive purchases, a higher than average to a high level of attention will be paid when selecting a service provider in order to ensure the safety of financial investment and that the services meet their particular needs, both in terms of immediate cost and future expectations. Typically, for all the above goods and services, prior consultation or research is conducted before purchase.
49. Primarily, the average consumer’s encounter with such services will be on a visual level, such as signage on premises, promotional material, journal advertisements and reports, and website use. Also, particularly for services such as brokerage, word-of-mouth recommendations, and independent reviews, will play a large part in the selection process.

COMPARISON OF TRADE MARKS

50. 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.”

51. 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.

52. The marks to be compared are:

Earlier Marks	Contested Mark
<p data-bbox="435 248 612 284">1. Mark '353</p> 	<p data-bbox="940 568 1110 600">EDDIDSON</p>
<p data-bbox="435 629 612 665">2. Mark '788</p> 	

Overall Impression

53. The contested mark consists of the word “EDDIDSON” presented in capital letters and a standard font. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation.⁴ The overall impression of the mark lies in the word itself.
54. The first earlier mark ‘353 consists of the word elements “FONDAZIONE EDISON”, appearing in upper case and standard font. Further, there is a round device element, sitting at the top of the word elements, with a black background containing the initials of the word elements in cursive script. I find that the word elements and the round device element contribute roughly equally to the mark’s overall impression.
55. The second earlier mark ‘788 consists of the word element “EDISON”. The letters are all of the same size, but I note that the letter ‘E’ is presented in lower case while the rest is in upper case in white standard script against

⁴ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

a green rectangular background. In agreement with the opponent's submissions, the overall impression of the second earlier mark resides more strongly in the word elements from which it is composed.

Visual Comparison

Contested mark and earlier mark '353

56. There is a visual overlap between the second word element "EDISON" of the earlier mark and the contested word mark "EDDIDSON". Both those words share the same first two and last three letters (EDDIDSON). However, there are visual differences between the marks. There is no counterpart of the round device and the first word element "FONDAZIONE" in the contested mark. Also, they differ by the addition of the two 'D' letters (EDDIDSON) appearing in the contested mark. Therefore, I find the marks to be similar to a low to medium degree.

Contested mark and earlier mark '788

57. Following the analysis in the preceding paragraph, the contested mark incorporates all the letters of the earlier mark but with the only difference being the addition of the two 'D' letters in position 3 and 5 (EDISON /EDDIDSON). Although there is a colour and case difference between the marks, this divergence will play no material role due to the notional and fair use of the contested word mark in any standard font, case, and colour. Taking all the above into account, I find there is a medium to high degree of visual similarity.

Aural Comparison

58. The first earlier mark '353 consists of the two verbal elements, "FONDAZIONE EDISON", and the initials found in the round device. The first word element is a foreign language word, and the UK average consumer may attempt to pronounce it as "FON-DA-ZI-ONE", and the second as "ED-I-SUHN". The initials in the round device will be articulated

as the letters “F” and “E”. The verbal element of the second earlier mark ‘788 will be similarly pronounced as “ED-I-SUHN”, and the contested word mark, EDDIDSON, will be pronounced as “ED-EED-SUHN”.

59. In terms of the verbal elements ED-I-SUHN and ED-EED-SUHN, they share the same number of syllables and the same beginning and ending, while only the second syllable is different. In addition, there is no phonetic counterpart of the word element “FONDAZIONE” and the round device of the earlier mark ‘353 in the contested mark. Overall, I find the marks to be aurally similar to a low to medium degree when considering the first earlier mark ‘353, and similar to a medium to high degree when considering the second earlier mark ‘788.

Conceptual comparison

60. In its submissions, the opponent contends that:

“11. The Italian word “fondazione” means “foundation” in English. According to the UKIPO trade marks manual, Italian is one of the most widely understood languages in the UK. Even if the average consumer is found not to have a working knowledge or understanding of Italian, they will have an appreciation for words used in common parlance [citation is omitted]. Moreover, the Italian word is sufficiently similar that consumers would be able to recognise its English equivalent meaning.

12. Given that ‘foundation’ is a commonly used word and as it is semi-descriptive revealing something about the Opponent’s type of organisation, the distinctiveness of both Earlier Marks lies in the EDISON name. EDISON carries no obvious meaning or reference in connection with the protected goods and services.”

61. There is no evidence that supports that the average UK consumer would either be familiar with the meaning of the Italian word “FONDAZIONE” or attribute any perceptible meaning to the mark. Also, the respective goods

and services do not suggest that they merely target the Italian-speaking public. In this regard, the average consumer will likely perceive it as a foreign language word or an invented term, followed by the surname “EDISON”. Similarly, the average consumer will likely perceive the word element “EDISON” of the earlier mark ‘788 and the contested term “EDDIDSON” as surnames with no identifiable concepts beyond their surnominal significance. Since there is no evidence or submissions to the contrary, the marks refer to surnames which will be perceived as emanating from a similar root resulting in some conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARKS

62. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

63. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the Court of Justice of the European Union found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

64. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

65. As to the distinctiveness of its earlier marks, the opponent submits that

“34. The Earlier Marks do not have an inherent concept or direct link to any of the goods or services for which they are registered. They are neither descriptive nor allusive in relation to the goods and services relied upon.

35. They should, therefore, be considered to have at least a normal level of distinctiveness.”

66. The opponent has not shown use of its marks and, thus, it cannot benefit from any enhanced distinctiveness; hence, I have only the inherent distinctiveness of the earlier marks to consider. I bear in mind that only the common elements between the respective marks should be considered to

evaluate the relevant (to the question of confusion) distinctiveness.⁵ In this regard, the device element and the foreign word “FONDAZIONE” add to the distinctiveness of the first earlier mark ‘353, but I note that there are no counterparts in the contested mark, so this is unlikely to increase the likelihood of confusion. As I have discussed above, the word element “EDISON” will be perceived as a surname, but it is not descriptive or suggestive of the registered goods and services. In my view, the surname “EDISON” can be considered to be a standard surname. Therefore, I find that the second earlier mark ‘788 is inherently distinctive to a medium degree, as the stylisation does not have a material impact sufficient to elevate the degree of inherent distinctiveness, whilst the other earlier mark may be more distinctive on account of the device, but the common element is likewise distinctive to a medium degree.

LIKELIHOOD OF CONFUSION

67. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred previously in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁶ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon what may be an imperfect recollection of them.⁷
68. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that

⁵ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

⁶ See *Canon Kabushiki Kaisha*, paragraph 17.

⁷ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., 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.”

17. 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).

(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)."

I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.⁸

69. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance

⁸ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

70. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

71. Earlier in this decision I have concluded that:

- The goods and services at issue range from being identical to having a low degree of similarity;
- the average consumer of the parties’ goods and services is a member of the general public, specialised customers, such as professionals and businesses. The level of attention paid will range from average to high in relation to Classes 9 and 42, and higher than average to high in relation to Class 36. The selection process is predominantly visual without discounting aural considerations;
- the contested mark and the earlier mark ‘353 are visually and aurally similar to a low to medium degree and has some conceptual similarity based on surnominal significance;

- the contested mark and the earlier mark '788 are visually and aurally similar to a medium to high degree, and has some conceptual similarity based on surnominal significance;
- the second earlier mark '788 has a medium degree of distinctiveness and the first earlier mark '353, whilst having a more distinctive character, boosted by the device, has a medium degree of distinctiveness from the perspective of the common element.

72. As the earlier marks differ in one or more points, I will evaluate them separately.

73. Considering the earlier mark '353, notwithstanding imperfect recollection and the slightly higher than average degree of distinctiveness, the factors persuade me that there is no likelihood of direct confusion. I find that when the marks are considered as a whole, the average consumer would recall the presence/absence of the device and the first foreign language word element, "FONDAZIONE", enabling them to distinguish between the marks. Therefore, the average consumer will not mistake the applicant's mark for the opponent's.

74. In terms of indirect confusion, the average consumer, having identified that the marks are different (foreign language word and device), will, though, assume that the identical/similar goods and services are offered by the same or economically linked undertaking. The similarities between the second word element (EDISON) of the earlier mark and the contested word mark (EDDIDSON), namely the identical first two and last three letters and word structure, would, in my view, cause that common element to be misremembered or mistakenly recalled as the additional 'D' letters may well be lost based on the doctrine of imperfect recollection. Notably, the surnominal significance of a similar root will aid the average consumer to establish a link between the undertakings. In addition, the competing goods and services are identical or similar to a high or medium degree, thereby increasing the likelihood of confusion. Against this background, it

is my view that a significant proportion of average consumers⁹ would believe that the marks are indicative of a sub-brand and there is some connection between them. As a result, I find there is a likelihood of indirect confusion.

75. In the case of the earlier mark '788, I find that there is direct confusion. Taking all of the above into consideration, as well as the principle of imperfect recollection, I am persuaded that the visual similarity of the marks, particularly the shared structure and letters of the words; and in light of the sector in which the parties operate, the identity and/or similarity of the competing goods and services, including those services that I found to be similar to a low degree, will lead the average consumer to mistake one for the other. As delineated above, the similar root of the surnames between the marks will assist with the recollection of the average consumer to confuse them. Also, the difference in the additional letters is not so noticeable, and any apparent difference on account of font/colour is not material, given the notional use of the contested mark in any standard colour and font. Therefore, I am satisfied that the consumers will mistake one mark for the other.

OUTCOME

76. Given that the first earlier mark '353 and second earlier mark '788 succeed in full, the opposition under Section 5(2)(b) of the Act is successful in its entirety. Therefore, subject to appeal, the application will be refused.

⁹ See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at paragraph 34.

COSTS

77. The opponent has been successful and 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 opponent the sum of £850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£100	Official opposition fee
£250	Filing a notice of opposition and considering the counterstatement
£500	Preparing written submissions
£850	Total

78. I, therefore, order Eddid Marketing Limited to pay EDISON S.p.A. the sum of £850. 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 1st day of July 2021

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General