

O-768-21

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3481984
BY WHIZSOLVE PTE. LIMITED
TO REGISTER THE TRADE MARK
SnapSolve
IN CLASSES 9, 16, 41 & 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER No. 421358 BY
SNAP INC.

BACKGROUND

1) On 16 April 2020 (claiming a priority date of 23 March 2020 in respect of a registration in India) WhizSolve Pte. Limited (hereinafter the applicant) applied to register the trade mark "SnapSolve" in respect of the following goods and services:

In Class 9: Computer software; Educational computer software; training software; virtual classroom software; computer and mobile software; data communications software; graphics software; computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and machine learning; Augmented reality software for use in mobile devices for integrating electronic data with real world environments; Electronic publications, downloadable; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; educational instruments; audio-visual teaching apparatus; teaching and instructional apparatus and instruments; recorded and downloadable media, blank digital or analogue recording and storage media; calculating devices; computers and computer peripheral devices; Application software; application software for education; computer software and software applications for taking, capturing, uploading, transmitting, processing, and displaying pictures, videos, and data; downloadable educational materials; downloadable electronic dictionary; downloadable curriculum materials for teaching; covers for mobile phones and smartphones; cases for smartphones and mobile phones; selfie sticks used as smartphone accessories; holders adapted for smartphones; mobile phones; straps for smartphones; tablet computers; batteries; battery chargers; USB charges (battery chargers); USB cables; earphones; headphones; headsets; speakers; protective films adapted for smartphones, mobile phones, or tablets; accessories designed for smartphones, mobile phones or tablets; magnets; alarms; sunglasses; cases for glasses; optical apparatus and instruments; video screens; teaching robots; security surveillance robots; humanoid robots with artificial intelligence; cameras.

In Class 16: Teaching manuals; instructional and teaching materials [except apparatus]; Educational materials for teaching purposes [except apparatus]; Instructional and teaching materials; Educational publications; photographs; Stationery and educational supplies; books and periodicals, magazine, printed matters, printed publications, printed time tables and brochures; bookmarks; composing frames [printing]; drawing materials; desk mats; document holders; marking pens [stationery]; writing

paper; table napkins of paper; paper; pencils; pictures; stands for pens and pencils; ink; plastic sheets; films and bags for wrapping and packaging.

In Class 41: Teaching and educational services; Educational services in the nature of coaching; computer assisted education services; publication of educational and teaching materials; providing training, teaching and tutoring; provision of online tutorials; arranging and conducting of tutorials; providing tutorial sessions in the field of mathematics; providing information in the field of education; publication of electronic books and journals on-line; educational instruction services; Educational services; training services; tutoring services; educational examinations; entertainment services; providing information and analysis in the field of education and entertainment; presentation of videos online; providing online electronic publications, music and videos (not downloadable); multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps; publication of calendars, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; publication of calendars of events; entertainment and amusement information via internet online; entertainment; organization and presentation of shows, competitions, games, concerts and entertainment events; arranging, organizing, conducting, and hosting education and social entertainment events; arranging and conducting education conferences; organization of exhibitions for cultural, educational, or entertainment purposes; Recording studio services; Teaching support services, namely scheduling, notifications and communication services; non-downloadable games for educational use; non-downloadable interactive multimedia computer game programs; Educational services, namely developing curriculum for teachers and educators; photography, film and video production services; Teaching services relating to pedagogy techniques; Online library services, namely, providing electronic library services which feature newspapers, magazines, photographs, pictures and videos via an on-line computer network; information, consultancy and advisory services relating to the aforesaid.

In Class 42: Computer services; Providing non-downloadable computer and mobile software; hosting multimedia educational content; Providing temporary use of non-downloadable software for developing online educational materials; Product development consultancy for inventors in the field of

education; computer and software development systems; design and development of computer hardware and software; Software as a service [SaaS] services featuring software for machine learning, deep learning and deep neural networks; providing artificial intelligence computer programs on data networks; Software as a Service (SaaS); Platform as a Service (PaaS) featuring computer software platforms; Software as a Service (SaaS) relating to hosting of multimedia educational content, game, or entertainment; Platform as a Service (PaaS) relating to hosting of multimedia educational content, game, or entertainment; Platform as a Service (PaaS) relating to hosting online interactive public calendars that allow multiple participants to share event schedules and facility reservations; computer programming relating to the provision of online education, game, or entertainment; information, consultancy and advisory services relating to the aforesaid.

- 2) The application was examined and accepted, and subsequently published for opposition purposes on 5 June 2020 in Trade Marks Journal No.2020/023.
- 3) On 2 September 2020 Snap Inc. (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
SNAP	UK 3268556	06.11.17 16.03.18	45	Internet based social introduction and networking services; provision of information regarding social networking and social introduction via a computer database; providing information and advice regarding secure electronic communication for use in the fields of social networking and social introduction; licensing of intellectual property, namely, user created avatars, graphical icons, symbols, fanciful designs, comics, phrases, and graphical depictions of people, places and things; identification verification services, namely, providing authentication of personal identification information.

SNAP	UK 3268553	06.11.17 16.03.18	42	Hosting digital content and providing online web facilities for managing and sharing online photographs, videos, text, music and digital content; providing photographic images, videos, music, audio, music, text, graphics, and other information from searchable indexes and databases, by means of the internet and communication networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, editing, modifying, posting, displaying, linking, sharing, transmission or otherwise providing photographs, videos, music and electronic media or information over the internet and communication networks; providing temporary use of non-downloadable software applications for photo and video sharing; providing software as a service (SAAS) for processing electronic payments; providing electronic computer generated codes to identify products and process electronic payments; providing electronic verification of on-line orders of digital content and generating electronic permission codes which then allow users to access digital content; providing temporary use of on-line non-downloadable authentication software for controlling access to and communications with computers and computer networks.
SNAP	EU 17436411	04.11.17 10.05.18	42	Providing information and advice regarding secure electronic communication.
			45	Internet based social introduction and networking services; providing computer databases via the Internet in the fields of social networking and social introduction; licensing of intellectual property, namely, user created avatars, graphical icons, symbols, fanciful designs, comics, phrases, and graphical depictions of people, places and things;

				identification verification services, namely, providing authentication of personal identification information.
SNAPCHAT	EU 13632369	12.01.15 15.02.16	9	Downloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software for use as an application programming interface (API); computer software in the nature of an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; computer software for streaming audio-visual media content via a global computer network and to mobile and digital electronic devices; computer application software for processing electronic payments to and from others that may be downloaded from a global computer network.
			35	Online retail store services featuring decorating supplies, cleaning preparations, candles, small items of metal hardware, machines, namely, apparatus and instruments for conducting, switching, transforming, accumulation, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound and images, data processing equipment, computer software, computer programs (downloadable software), transmitters of electronic signals and machine tools, hand tools, consumer electronics, computers, computer peripherals, telephones, cameras, CD's and DVD's, household electric machines, vehicles, cycles, jewelry, clocks and watches, printed matter, leather and imitations of leather, animal

				skins, hides, and goods made of these materials and not included in other classes, namely handbags, purses and wallets, furniture, housewares, household and kitchen utensils and containers, textiles, clothing, footwear, headgear, haberdashery, floor coverings, games and playthings, gymnastic and sporting equipment, foodstuffs, drinks, alcoholic beverages, candy; online retail services of digital media, namely images, movies, musical and audio-visual works and related merchandise.
		36		Electronic transfer of money for others; providing electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check and electronic, mobile and online payments.
		38		Telecommunications services, namely, electronic transmission of data, messages, graphics, images and information; peer-to-peer photo sharing services, namely, electronic transmission of digital photo files among Internet users; providing access to computer, electronic and online databases; providing online forums for communication, namely, transmission on topics of general interest; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, and images; telecommunications services, namely, electronic transmission of photos and videos; telecommunication services, namely, electronic transmission of data, photos, music and videos; broadcasting and streaming of audio-visual media content; transmission of downloadable audio-visual media content.
		41		Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content; publishing services, namely, publishing of

				electronic publications for others; creation, development, production and distribution of entertainment content; providing online audio-visual entertainment information via a global computer network; providing information via a global computer network in the field of entertainment.
		42		Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site featuring technology that allows users to manage their online photograph and social networking accounts; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, providing a web site featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; providing information from searchable indexes and databases of information; providing search engines for obtaining data via communications networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer services, namely, hosting online web facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, linking, sharing or otherwise providing electronic media or information over communication networks; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information; providing information on topics of general interest from searchable indexes and databases of information, including text, electronic documents, databases, graphics

				and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or user-specified information, personal profiles, audio, video, photographic images, text, graphics and data; hosting of digital content on the Internet.
SNAPCHAT	UK 3264951	20.10.17 12.01.18	35	Advertising, marketing, and promotion services; Online retail store services featuring a wide variety of goods and services; Information services, namely promoting the goods and services of others; Managing and tracking all types of payment cards, and other forms of payment transactions for business purposes; Issuing and providing receipts for electronic payments and payment transactions; Electronic processing of orders for others; Promoting the goods and services of others via the internet and communication networks; Market research and information services; Advertising agency services; and Online service for connecting social network users with businesses.

4) The grounds of opposition are, in summary:

- a) The opponent contends that its marks above and the mark applied for are very similar and that the goods of the two parties are identical and / or similar. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent also contends that it has a considerable reputation in its EU 13632369 and UK 3264951 marks above. This reputation resides in its app, photography goods and services, entertainment related goods and services, publishing services, online and downloadable content goods and services and advertising services (amongst others). It states that the

similarity between the marks and goods and services is such that there is a likelihood of consumers assuming a link. It contends that this will enable the applicant to take unfair advantage of the opponent's reputation and free ride on its investment in promoting and advertising the brand. Use of the mark in suit will dilute and tarnish the reputation of the opponent. It contends that the mark in suit offends against section 5(3) of the Act.

- 5) On 23 November 2020 the applicant filed a counterstatement, in which it does not put the opponent to strict proof of use. The opponent denies the grounds of opposition, stating that the marks are not similar. It denies that the opponent has the reputation claimed. No comment is made regarding the similarity of the goods and services of the two parties.
- 6) Both parties filed evidence; both sides seek an award of costs in their favour. The matter came to be heard on 1 September 2021 when the applicant was represented by Mr Muir Wood of Counsel instructed by Messrs Taylor Wessing LLP; the opponent was represented by Mr Stobbs of Messrs Stobbs.

OPPONENT'S EVIDENCE

- 7) The opponent filed a witness statement, dated 3 February 2021 (corrected by another witness statement dated 22 June 2021), by Matt Stratton an Associate General Counsel and Director of the opponent, a position he has held since November 2016. He states that the company began in 2011 and states that in February 2017 Snapchat's UK user base stood at 11.2 million users. He provides details of the snapchat app which appears to revolve around the ability to edit photographs with a variety of visual and sound effects. Unfortunately, he uses generalised comments such as:

“8. The reach of the Snapchat brand is incredibly high with more than 80% of 13-24 year olds and 60% of 13-34 year olds in the UK, France, Canada and Australia.”

“12. More than 90% of the Generation Z population in key markets like the UK and France are engaging with augmented reality...”.

8) Mr Stratton does not provide figures for the UK specifically or even the EU. When he does refer to the EU the figures include Turkey and Russia. For the most part his figures are global or refer to the USA which do not assist my decision. When he does refer to the UK at paragraph 22 of his statement, the figure given is after the relevant date and is said to be the “Snapchat audience size”. I am unsure if this means individual users, the potential market size of generation Z, or the number of uses made of the app. Similarly, he provided “rankings” from the Apple and Google app store for the UK, France and Ireland. Whilst it is clear that the opponent’s products are ranked high in the stores in all three markets it is not clear what proportion of the market these two stores represent. All references to actual services or product appear to be under Snapchat whilst Snap seems to be reserved to simply refer to the opponent company. I note that at annex 1 page 17 the company describes itself as a “camera company”. This is clearly not a correct description of the opponent’s goods as the camera already exists, inbuilt in the mobile phone onto which the opponent’s app is loaded. The opponent’s app allows the user to digitally amend the image and send it along with text to a third party. One of the unique aspects is that the image will erase itself after a short while so no record of it exists. A number of exhibits were also provided which showed that the opponent has a reputation for this app under the mark SNAPCHAT. At the hearing Mr Stobbs contended that:

“We do have, however, the context of the UK where it is confirmed from paragraph 19 onwards in relation to Mr. Stratton’s statement, it talks about the users and talks about the European side of that, the market share, and he is talking about the daily users, daily active Snapchat users. These are huge numbers obviously. At paragraph 22 he identifies the audience size as of October 2020, so that is in terms of the daily active users. He has that by country, including the UK specifically at just over 19 million users.”

9) I questioned this at the hearing but Mr Stobbs was insistent that the Daily Active User (dau) figure for the UK was 19.15 million as set out in paragraph 22 of the witness statement. Having had the benefit of re-examining the figures it is clear that the assertion by Mr Stobbs is incorrect. Paragraph 20 states that the global number of dau’s of snapchat in Qtr 3 of 2020 was 240 million up from 210 million in Qtr 3 of 2019. Paragraph 21 shows the number of DAU in Europe (which includes Turkey and Russia) as 65 million in Qtr 3 of 2019. However, the figures in paragraph 22 are said to be “based

on Snapchat audience size as of October 2020". It lists the top ten countries which total 271.8 million which is significantly higher than the global figure for DAU's but only relates to ten countries. Also, if one adds the figures for the only "European" countries listed (France, UK, Germany & Turkey) these total 64.6 million, meaning that the rest of Europe and Russia account for only 400,000 users which seems unlikely. To my mind, this analysis shows that the figures in paragraph 22 do not relate to DAU's.

APPLICANT'S EVIDENCE

- 10) The applicant filed a witness statement, dated 6 April 2021, by Robert James Hawley, the applicant's Trade Mark Attorney. He provides three exhibits; one gives definitions from a variety of on-line dictionaries which show that the word SNAP is another word for photograph. Another provides evidence of the state of the Register which does not assist my decision; the third points out that the product sold by the opponent is an app which allows the digital alteration of photographs or snaps and which erases them within a short time frame.

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

DECISION

- 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.

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

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

(a)

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

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

14) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

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

15) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The application date, and therefore the relevant date, is 23 March 2020, none of the opponent's marks had been registered for five years at this date and so the proof of use conditions do not apply to any of the opponent's marks.

16) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijzen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

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

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

18) The goods at issue in these proceedings are, very broadly speaking, Computer software; electronic publications; apparatus and instruments for recording, transmitting, reproducing or

processing sound, images and data; Teaching publications and printed matter; stationery; teaching and educational services; entertainment services; organizing and conducting conferences and exhibitions; recording studio services; computer services; product development services in the field of education; computer and software development services.

19) The opponent submitted:

"6. Per Lloyd Schuhfabrik, the Opponent is aware that the relevant consumer must be considered in light of the goods and services covered by the application. The goods and services sought by the application are varied but can broadly be defined as mass consumption goods and services. As such, the Opponent concludes that the relevant consumer will be the public at large, and will afford a reasonable degree of attentiveness and circumspection to their involvement with the relevant mark. None of the goods and services applied for can be described as high value items or services. This being the case, it is fair to say that the level of attention of the consumer will be at its lowest level."

20) The applicant submitted:

"30. The average consumer is primarily a member of the public, although some of the goods and services are targeted more at the professional/corporate market (i.e. advertising services). The average consumer would be expected to pay a moderate to high degree of attention to the goods and services, particularly those, such as education services, which are likely to involve the outlay of funds and which will be of importance to the purchasers (or their children)."

21) To my mind the range of goods and services are such that the average consumer will be the public at large (including businesses), and that the level of attention will vary enormously from some of the goods which may be somewhat inexpensive and not overly important to the purchaser, such as electronic publications, to services relating to education which may be quite expensive and of considerable importance to the career path of an individual. Generally speaking, the goods involved will typically be sold via retail outlets and on the internet, which may include orders being placed by

telephone. I must also take into account personal recommendations. The selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. The services will usually be selected from on-line or printed advertising and so the selection will be predominantly visual although personal recommendations cannot be discounted, and so aural consideration also come into play. Whatever the good or service the average consumer will be concerned to ensure that they obtain the good or service that they require. The attention span will vary accordingly, and I will take this into consideration against each group of goods and services when considered. Even for the cheapest, least important, goods / services they are likely **to pay at least an average level of attention to the selection of the goods. For some of the more important goods and services they will pay a high degree of attention.**

Comparison of goods and services

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

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

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

24) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, 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”.

25) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

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

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

27) 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."

28) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for*

Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-316/07, the GC pointed out that:

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

29) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

30) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

31) In its pleadings the opponent did not specify precisely which of its goods and services were similar / identical to those of the opponent it merely listed all of its goods and services registered for each of its marks. On 13 July 2021 I wrote to the opponent asking them to set out in precise detail which of the goods and services of the two parties it believed were similar / identical with reasons why it held this view. The opponent responded on 26 July 2021 in the following terms:

“The Opponent has relied on classes 9, 35, 36, 38, 41, 42 and 45. Following various discussions with the UKIPO, we understand that the Opponent is required to provide examples of similar terms in each of these classes, as opposed to providing detailed information on every term. As such, please see the below examples:

- Class 9: The identities and similarities in this class are clear to see
- Class 35: The term "online retail store services featuring printed matter" in class 35 of the Opponent's earlier right is similar to the term "printed matters" in class 16 of the application. This is because the party producing the matter is often the same party that retails it, meaning these terms could be offered by the same undertakings to the same consumers.
- Class 36: The term "electronic transfer of money for others" in class 36 of the Opponent's earlier right is similar to the term "Software as a Service (SaaS)" as modern transfers of money rely on the provision of software and platforms as part of the service. As such, these terms would be offered by the same party and would be complementary.
- Class 38: The term "telecommunications services, namely, electronic transmission of data, messages, graphics, images and information" in class 38 of the Opponent's earlier right is similar to "computer software and software applications for taking, capturing, uploading, transmitting, processing, and displaying pictures, videos, and data" in class 9 of the application.

This is because the necessary software is required to provide the service contained in the Opponent's term and forms an integral part of it. As such, these terms would likely be provided by the same party and would be complementary.

- Class 41: The identities and similarities in this class are clear to see
- Class 42: The identities and similarities in this class are clear to see
- Class 45: The term "internet based social introduction and networking services" in class 45 of the Opponent's earlier right is similar to "entertainment" in class 41 of the application. This is because the Opponent's term is a form of entertainment and would be covered by this term.

The Opponent trusts this is sufficient to alleviate your concerns outlined in your letter of 13 July." 2021.

31) I accepted this response at face value as I expected that when I came to consider the specifications of the two parties they would either share almost exact wording, or the opponent would have terms which would encompass the majority of the applicant's specification. For instance, the applicant may have applied for "jackets, trousers, shirts etc. etc. in class 25, whereas the opponent might simply have "clothing". However, when I began preparing for the hearing it was clear that this was not the case and that there were a number of classes of goods and services where the similarity / identicity was far from "clear" as stated by the opponent. A further letter was despatched stating that the reply was inadequate and requesting a detailed table, showing each line of the applicant's specification with the goods / services relied upon by the opponent alongside together with the reasoning why (unless the wording was identical or highly similar). The letter clearly stated that I was preparing for the hearing, a fact that the agent clearly understood as their reply shows. On 24 August 2021 the opponent replied as follows:

"In response to your letter of 20 August 2021, we do not believe the request being made by the Hearing Officer is reasonable at this stage.

In line with previous cases that we have run at the UKIPO the registry has provided guidance to Stobbs in relation to the claimed similarity of good and services. Most notably this has been discussed in case management conferences in respect of opposition no. OP000411378 INDIGO

BLUE and more recently opposition no. OP000408133 IO2. In both of these cases it has been stated by the registry that for the purposes of the statement of grounds, where entire classes are relied upon, the opponent must provide a clear explanation of where similarity or identity is argued to lie. However, the Registry has confirmed that the point of similarity need not be exhaustively identified (whereby references to a few examples will be sufficient) as this point is satisfied further by submissions during the evidence round. For these reasons it was not a requirement (nor do we believe it is generally a requirement) to specify exactly the terms per class which are to be relied upon so long as individual terms considered potentially of relevance within the entire class claimed are highlighted and explained for the benefit of the registry and both parties in the Statement of Grounds. In any case the Opponent contends that whilst there may be disagreement over the substance of the claim this is not a matter for the pleading stage and should be addressed at the evidence rounds and potential Hearings stage.

Please note that we are aware of and believe that the Opponent is in compliance with TPN 1/2018 in relation to explanations of similarity of goods and services covered in view of the fact that the Statement of Grounds has been submitted in accordance with the Registry's prior guidance detailed above. We also note that numerous oppositions have been accepted after the entry into effect of TPN 1/2018 which had followed the same format as this current opposition.

In the present situation, for the following reasons we feel it is not reasonable to request this from the Opponent:

1. The Opponent has provided examples already in line with the requirements set out in TPN 1/2018
2. The Applicant has already submitted some legal observations, showing they are clearly aware of the case against them, and do not require this further information at this stage
3. The Applicant had a period to appeal the decision to allow the explanation provided by the Opponent in line with TPN 1/2018. They did not appeal, showing they are clearly happy with the examples provided.

4. The Opponent will be discussing the similarities between the terms in detail when they submit their skeleton arguments and attend the hearing and this is the correct time to examine the specific similarities between the specifications.
5. Submission of this further information on Thursday, just one day before the deadline to submit skeletons, would likely only be a hinderance to both parties when preparing their skeletons. Both parties have the necessary information at this stage and further information would only confuse the matter.

The Opponent will of course be discussing the similarities between the specification terms in more detail come the skeleton arguments and hearing, the correct time to make the detailed comparisons. Should the Hearing Officer still require further explanation at this stage, I would request further information on the TPN mandating this further information, as this is not a practice we are aware of.”

32) Apart from the fact that the writer completely ignored my instructions that I required further clarity on the matter, the letter was received on Tuesday afternoon (24th) when the deadline for the skeleton arguments was close of play on the Friday (27th). However, the submissions provided by the opponent in its skeleton arguments are barely any clearer than its original pleadings. The opponent has listed what it describes as the goods and services which in each instance provide its “best case”. Given the absence of clarity on this matter prior to the applicant having to file their skeleton argument I allowed the applicant two days after the hearing to provide written submissions on the similarity or otherwise of the goods and services. I shall first turn to the applicant’s goods in class 9, which the applicant split into three parts and made the following admissions.

- a) **The Software:** “Computer software; Educational computer software; training software; virtual classroom software; computer and mobile software; data communications software; graphics software; computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures and machine learning; Augmented reality software for use in mobile devices for integrating electronic data with real world environments; Electronic publications, downloadable;

Application software; application software for education; computer software and software applications for taking, capturing, uploading, transmitting, processing, and displaying pictures, videos, and data; downloadable educational materials; downloadable electronic dictionary; downloadable curriculum materials for teaching.”

Both parties agree that the “Software” is similar to a medium degree to the general software services in classes 42 for which the Class 42 Snap Mark is registered, and that the Software is identical or highly similar to the class 9 software for which the EU Snapchat Mark is registered.

- b) **The Hardware:** “apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; educational instruments; audio-visual teaching apparatus; teaching and instructional apparatus and instruments; recorded and downloadable media, blank digital or analogue recording and storage media; calculating devices; computers and computer peripheral devices; covers for mobile phones and smartphones; cases for smartphones and mobile phones; selfie sticks used as smartphone accessories; holders adapted for smartphones; mobile phones; straps for smartphones; tablet computers; batteries; battery chargers; USB charges (battery chargers); USB cables; earphones; headphones; headsets; speakers; protective films adapted for smartphones, mobile phones, or tablets; accessories designed for smartphones, mobile phones or tablets; magnets; alarms; sunglasses; cases for glasses; optical apparatus and instruments; video screens.”

In respect of the Hardware, the Opponent relies on retail services in class 35 for which the EU Snapchat Mark is registered. Both parties agree that there is a medium degree of similarity between such retail services and the Hardware. The Opponent does not appear to suggest that the Class 42 Snap Mark, the Class 45 Snap Mark or the EU Snap Mark are registered for any goods or services similar to the Hardware. The Applicant agrees.

- c) **The Robots:** “teaching robots; security surveillance robots; humanoid robots with artificial intelligence; cameras.”

Both parties agree that the Robots are dissimilar to all goods and services for which the Earlier Marks are registered.

33) As there is agreement between the parties regarding the goods in class 9 there is no need for me to comment. I next turn to the goods in class 16 which can be split into two parts:

- a. teaching manuals; instructional and teaching materials [except apparatus]; educational materials for teaching purposes [except apparatus]; instructional and teaching materials; educational publications; photographs; books and periodicals, magazine, printed matters, printed publications, printed time tables and brochures (the "**Printed Matter**"); and
- b. stationery and educational supplies; bookmarks; composing frames [printing]; drawing materials; desk mats; document holders; marking pens [stationery]; writing pencils; pictures; stands for pens and pencils; ink; plastic sheets; films and bags for wrapping and packaging (the "**Stationery**").

34) I shall initially consider the goods in (a) above listed as "printed matter". The Opponent contends that the Printed Matter are similar to '*online retail store services featuring printed matter*' in class 35 and/or '*publication of electronic journals and web logs featuring user generated or specified content; publishing services, namely publishing of electronic publications for others*' in class 41 (the "**Class 41 Publishing Services**"), for which the EU 13632369 Snapchat Mark is registered. The applicant accepts that the opponent's class 35 services have a low degree of similarity to its "printed matter". In respect of the publishing services in class 41, the Applicant contends that these are very specific publishing services, focussed at online material and that the class 16 Printed Matter is precisely that: printed material. The applicant submits that Class 16 does not cover electronic documents or online material and therefore, the publishing services in class 41 are too remote to be deemed similar to the Printed Matter. The applicant states that this is particularly the case where the online publishing services are focussed on online content provided by others, such that the user of those services would not expect the Opponent to also be responsible for the content of physical printed matter. For its part the opponent states that the printed matter would be produced by a party offering publication

services, even those that specialise in electronic publication. It referred me to EU Opp No. B2457839 Gestion Elaboracion De Manuales Industriales Ingenieria Y Servicios Complementarios v Germini Ivs where the office stated:

"The contested education; providing of training; publishing and publication services; professional consultancy relating to publishing and publication services and services relating to publications as statute books, accounting books and booklets and judgment 10 collections in electronic format; library services in electronic format; legal and accounting education services; providing continuing legal and accounting education courses; publishing and reporting; translation and interpretation; education and instruction; arranging and conducting of conferences, congresses, seminars, symposiums and workshops [training]; courses; education courses are similar to the opponent's teaching material and printed matter. They can coincide in producers/providers, end users and distribution channels."

35) To my mind, the class 41 services deal solely with on-line publishing services whilst the applicant's goods are actual publications. In the absence of any evidence of why these should be regarded as similar, I am not persuaded by the opponent's contentions that these have any degree of similarity. In my opinion, there is no similarity between the opponent's class 41 publishing services and the physical printed matter in the applicant's class 16 goods.

36) Turning to the "stationery" goods the opponent accepted at the hearing that these were not similar to any of the opponent's goods and services (see page 28 of the transcript). I next consider the applicant's services in class 41 which can be broadly split into 'education', 'entertainment' and 'publication' services". I shall look first at "education" which are as follows:

Education: teaching and educational services; educational services in the nature of coaching; computer assisted education services; providing training, teaching and tutoring; provision of online tutorials; arranging and conducting of tutorials; providing tutorial sessions in the field of mathematics; providing information in the field of education; educational instruction services; educational services; training services; tutoring services; educational examinations; providing

information and analysis in the field of education; arranging, organizing, conducting, and hosting education events; arranging and conducting education conferences; organization of exhibitions for educational purposes; teaching support services, namely scheduling, notifications and communication services; non-downloadable games for educational use; educational services, namely developing curriculum for teachers and educators; teaching services relating to pedagogy techniques; information, consultancy and advisory services relating to the aforesaid.

37) The opponent relies upon its class 41 services under its SNAPCHAT mark EU 13632369, specifically “publication of electronic journals and web logs featuring user generated or specified content; publishing services, namely, publishing of electronic publications for others”. At the hearing Mr Stobbs submitted:

“Two slightly different points. One, the first part of that specification effectively covers the provision of user-generated content. It does not specify the content. You have seen in the actuality of our use, which I appreciate is not necessarily relevant to the interpretation of the specification, as you pointed out, but I think it is helpful, the SNAPCHAT app is used as a provider of content -- third party content, but content. We say in essence that is not specified from a content point of view. It could be any content. It could be educational content and we say, actually, there is a very close similarity between that and really all of the educational terms because either they are very broad and could cover online teaching and educational, and some of them specify that they are computer assisted and so are online, or they are the publication of educational materials which, is more directly overlapping with the publishing side of our specification in class 41, or are very similar to that. We say that is our best case on the educational terms. We mention the similarity between that and the social and networking side as well, but that is more on the entertainment side so that is not as relevant. Our best case on education is that similarity. We then have publication of electronic books and journals, which we say is identical to publishing services.”

And:

“Educational instruction services; educational services; training services; tutoring services; educational examinations -- all education related and the same point as I have just made.”

38) The applicant submitted:

“18. Whilst it is true that the Education Services are not narrowed to offline only services, such that they might be provided online, it is hard to see how any of them are similar let alone identical to any of the services relied upon. The services relied upon, which the Opponent referred to in the generality as online services, are much more focussed and point away from the Education Services.

19. ‘*Social introduction and networking services*’ are not similar, at all, to any of the Education Services. The submissions of the Opponent seemed to focus solely on the words ‘*internet based...services*’, ignoring the purpose of those services.

20. Similarly, the class 41 services referred to above are all focused on entertainment. Whilst they are at least in class 41, it is hard to see how they are similar to the Education Services for which registration is sought. No similarity should be found.

21. Within the Education Services, the Opponent accepted that ‘*educational services, namely developing curriculum for teachers and educators*’ were not very similar given their highly specialist nature. This must be right and the Applicant suggests ‘*teaching services relating to pedagogy techniques*’ at least fall in the same camp, notwithstanding the general submissions above about the overall lack of similarity.”

39) The term “Publishing services, namely publishing of electronic publications for others” covers the activity of preparing and issuing books, journals and other materials for sale for others rather than oneself. It is clear that educational services can be delivered without engaging in publishing services. An educational establishment such as a school may purchase items from a publisher, but that does not mean that the publisher is engaged in educational services any more than the supplier of pencils or paper and vice versa. In the instant case one party provides a publishing service the other an educational service. The same contention holds true for the balance of the specification relied upon by the opponent. I remind myself that the authorities quoted earlier in this decision provide guidance that in the case of services, terms should not be interpreted widely but confined to the core of the possible meanings attributable to the terms. To my mind, there is a significant difference between the

services of the two parties and the opponent has not provided any evidence to persuade me to the contrary, whilst it would appear, *prima facie*, that there is no similarity.

40) I next turn to the second group in class 41, the “Entertainment services which are as follows:

“providing information and analysis in the field of entertainment; entertainment services; entertainment and amusement information via internet online; entertainment; organization and presentation of shows, competitions, games, concerts and entertainment events; arranging, organizing, conducting, and hosting social entertainment events; organization of exhibitions for cultural or entertainment purposes; non-downloadable interactive multimedia computer game programs; photography, film and video production services; information, consultancy and advisory services relating to the aforesaid.”

41) The opponent’s best case is under its class 41 specification for its mark SNAPCHAT EU 13632369 and in particular “Providing computer, electronic and online databases in the field of entertainment; creation, development, production and distribution of entertainment content; providing online audio-visual entertainment information via a global computer network; providing information via a global computer network in the field of entertainment”. At the hearing, Mr Stobbs for the opponent contended:

“We have then got entertainment at large. Again, see above -- identical to our narrower entertainment term. We have then got "organisation and presentation of shows, competitions, games, concerts and entertainment events", which we say is identical, or at least very similar, to our entertainment terms in the 369 mark. You have then got "arranging, organizing, conducting, and hosting education and social entertainment events". We say in so far as there are online events providing content they are not identical but certainly similar to either the provision of entertainment content or other content covered by our 369 specification. You have then got "arranging and conducting education conferences", which we say is similar to, not identical but similar to the provision of educational content, so the provision of our unspecified content in our 41 services, but only similar. The same for "organization of exhibitions for cultural, educational or entertainment purposes". I guess insofar as either of those things are online, they are more similar. I guess they are not specified as being physical. I am imagining them as physical but

nowadays I guess they could be online events, in which case they are much more similar to our coverage. And of course, they are not exclusively indicated as being physical events so we cannot rule that out from a breadth point of view. We have then got "recording studio services", which stands out as a different term, which I would say is similar to our publishing services insofar as that is kind of what a recording studio does but it is more tenuous. We say that is probably our best argument in relation to the similarity there. "Teaching support services, namely scheduling, notifications and communication services". Again, we say it is not specified whether that is online or not and from functionality point of view our provision of online content, unspecified online content, would be plainly similar, but to a lower degree than the other terms that we have been looking at. "Non-downloadable games for educational use; non-downloadable interactive multimedia computer programs". They are non-downloadable so would be I am having access to them but again insofar as we are providing entertainment content in our 369 specification we would say that is similar to the provision of a non-downloadable game, so an online game. We have got "educational services, namely developing curriculum for teachers and educators". That seems like a more specific educational service and less obviously similar to our coverage. We have educational, and there is an argument of some similarity because of unspecified content, but it is less obvious because it is a very specific thing about developing curriculum, so I think you could argue there is only a very low degree of similarity there. Then we have "photography, film and video production services", which we would say is again similar to our publishing. Whilst production is not an identical word to publishing, it is similar functionality. "Teaching services relating to pedagogy techniques". See above comment in relation to the other teaching stuff. It is not specified as not being online and we provide unspecified online content, so there is a similarity there. "Online library services" is plainly similar to our provision of online content. Then we have "information, consultancy and advisory services relating to the aforesaid", which we say would flow with the analysis on the level of similarity for the actual similar terms. Broadly speaking, there are educational terms, there are entertainment terms and there are publishing or content terms; one or two slightly more specific ones. Broadly speaking, we say the first three are either identical because of breadth or very similar to our publishing and content provision terms covered by our 369 trade mark."

42) The applicant submitted:

“22. Social introduction and networking services are not entertainment services. There is no similarity between them and the Entertainment Services, as alleged or at all. The Opponent appears to be focussing on the ‘*internet based...services*’ again, without addressing the subset of services which they cover.

23. The Applicant accepts that the Entertainment Services are at least similar to the class 41 services.”

43) I am willing to accept the applicant’s admission that that the services in class 41 registered under the opponent’s mark EU 13632369 as set out in paragraph 41 above are similar to low to medium degree to those sought to be registered by the applicant as set out in paragraph 40 above.

44) I next turn to the last group of services in this class which are the publication services which read:

“Publication of educational and teaching materials; publication of electronic books and journals on-line; presentation of videos online; providing online electronic publications, music and videos (not downloadable); multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps; publication of calendars, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; publication of calendars of events; recording studio services; online library services, namely, providing electronic library services which feature newspapers, magazines, photographs, pictures and videos via an on-line computer network; information, consultancy and advisory services relating to the aforesaid”.

45) The applicant submitted:

“24. In respect of the Publication Services, the same broad argument set out above in respect of class 16 applies, save that the Applicant accepts that some of the Publication Services are online services. As noted above, however, the Class 41 Publishing Services are focussed on user-based

content and this difference lessens the degree of similarity between those highly focussed services and the Publication Services for which registration is sought.”

46) The opponent’s submissions are contained within paragraph 41 above, as their position and reasoning was not clearly set out as requested but was more a “stream of consciousness” at the hearing. I am willing to accept that there is similarity to a low to medium degree between the class 41 publication services of the two parties, as the applicant does not resist such a finding.

47) Lastly, I turn to the class 42 services. I note that the applicant in its written submissions accepts that:

“25. The Applicant accepts that the class 42 services are either identical to or are at least highly similar to the class 42 services in bold in the table below §16 [see below] of the skeleton argument filed by the Opponent for which the UK 42 Snap Mark and the EU Snapchat Mark are registered.”

48) For ease of reference the services referred to in the previous paragraph are:

UKTM Reg No. 3268553 SNAP: Class 42: Hosting digital content and providing online web facilities for managing and sharing online photographs, videos, text, music and digital content; providing photographic images, videos, music, audio, music, text, graphics, and other information from searchable indexes and databases, by means of the internet and communication networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, editing, modifying, posting, displaying, linking, sharing, transmission or otherwise providing photographs, videos, music and electronic media or information over the internet and communication networks; providing temporary use of non-downloadable software applications for photo and video sharing; providing software as a service (SAAS) for processing electronic payments; providing electronic computer generated codes to identify products and process electronic payments; providing temporary use of on-line non-downloadable authentication software for controlling access to and communications with computers and computer networks.

EUTM Reg No. 013632369 SNAPCHAT: Class 42: Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site featuring technology that allows users to manage their online photograph and social networking accounts; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, providing a web site featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer services, namely, hosting online web facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, linking, sharing or otherwise providing electronic media or information over communication networks; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information; providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user defined or user-specified information, personal profiles, audio, video, photographic images, text, graphics and data; hosting of digital content on the Internet.

49) However, at the hearing the opponent did accept that the term “product development consultancy for inventors in the field of education” was not similar to any of its services. I will therefore accept the concession of the applicant that save from the term listed earlier in this paragraph the services of the applicant are identical or highly similar to the class 42 services registered under the SNAPCHAT mark EU 13632369 and also the class 42 services for which the UK SNAP mark is registered.

50) Following all the submissions it was apparent that three of the opponent's marks (UK 3268556, EU 17436411 & UK 3264951) either had goods / services which were not similar to any of those sought to be registered, or they did not advance the opponent's case. Its strongest case was clearly under its marks UK 3268553 & EU 13632369. Regarding these last two marks, in summary, the position regarding goods and services is as follows:

Applicant's Goods and services	UK 3268553 SNAP	RESULT
Class 9: Software	Class 42	Similar to a medium degree.
Hardware	Class 42	No similarity
Robots	N/A	No similarity
Class 16	Class 42	No similarity
Class 41	Class 42	No similarity
Class 42: "Product development consultancy for inventors in the field of education."	Class 42	No similarity
Class 42: Balance of specification	Class 42	Identical or highly similar
Applicant's Goods and services	EU13632369 SNAPCHAT	RESULT
Class 9: Software	Class 9	Identical or highly similar
Hardware	Class 9	Medium degree of similarity
Robots	Class 9	No similarity
Class 16	Class 35	Low degree of similarity
	Class 41	No similarity
Class 41: Education	Class 41	No similarity
Entertainment	Class 41	Low to medium degree of similarity
Publication	Class 41	Low to medium degree of similarity

Class 42: "Product development consultancy for inventors in the field of education." Class 42: Balance of specification	Class 42 Class 42	No similarity Identical or highly similar
--	----------------------	--

Distinctive character of the earlier trade mark

51) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijzen 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)."

52) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of

confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

53) Of the opponent's five earlier marks three are for the word SNAP the other two for the word SNAPCHAT. The opponent's goods and services cover quite an array of areas in various classes but are mostly concerned with the provision of services in relation to communication in particular the sending of user edited or altered photographs, the software and internet services to enable this communication as well as the retailing etc of the service and associated goods. The term "SNAP" is a well-known dictionary word meaning "break" or "photo" and as such has a meaning in relation to the opponent's goods and services. The opponent vigorously denied that the term "snap" would be known by "generation Z" and "millennials" as meaning photograph as he contended it was an old-fashioned term, used when people actually used to print photographs. It was accepted that there used to be shops on the high street offering developing and printing services under the name Happy Snaps and Snappy Snaps although it was not in evidence and it is unclear if they still exist. To my mind, the average consumer would be well aware of the use of the term SNAP to mean photograph as it is

regularly used by large well-known companies as part of their advertising. Recently, in my own experience I have seen eBay UK using the strapline “Snap it. List it. Sell it.” And also seen an advertisement for a company called Vinted on television encouraging people to sell old clothes again using the term “snap it” when taking a photograph of the item. To my mind the mark SNAP is descriptive and therefore of low distinctiveness, when used on goods and services relating to the editing/ sending etc. of photographs, and **inherently distinctive to an average degree** only when used on goods or services not connected to photographs. The opponent has filed evidence of use but has not provided turnover or market share figures for the SNAP mark. The use shown mostly relates to references to the company name. **The opponent cannot, in my opinion, benefit from enhanced distinctiveness through use in relation to its SNAP marks.** Turning to the opponent’s SNAPCHAT marks, I am aware that the applicant has made concessions regarding reputation of this mark in respect of section 5(3), however, there is a difference between reputation under section 5(3) and enhanced distinctiveness under section 5(2)(b). I will therefore consider the evidence filed and make my own judgment. In my opinion, the mark SNAPCHAT is somewhat descriptive of the service on offer which allows users to alter photographs (snaps) and then add in a message or text (chat). **It is inherently distinctive to a medium degree.** The opponent has shown use of the mark, and although the evidence is far from ideal it is clear that it has a substantial reputation in the UK for the **digital alteration of photographs and the ability to send those photographs with comments to others and so, for these services only, it can benefit from an enhanced reputation through use.**

Comparison of trade marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of

the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

Opponent's earlier marks	Applicant's Mark
SNAP	
SNAPCHAT	SnapSolve

56) The opponent submitted:

“19. As set out above, the Opponent is required to demonstrate that a risk exists that the public may believe that the goods and services being provided by the Applicant in conjunction with the Contested Application, may originate from the Opponent.

20. Visually, the marks differ in the addition of the element SOLVE at the end of the applied for mark. What is clear is that the Opponent's mark is wholly contained as the first element of the applied for mark. The SNAP element continues to be recognised as a word in its own right, and the addition of SOLVE does not alter the meaning or visual nature of the SNAP element. As generally accepted, the start of the mark is where a consumer will focus their attention, and when we consider the imperfect recollection of the consumers, they will be drawn to the coincidence of the SNAP element, and consider these marks to originate from the same undertaking. There have been many cases in the UK where we have seen similar facts as these, and the Office has found the marks to be similar. These have been discussed below:

Case	Mark 1	Mark 2	Quote
Dairy Crest v Vitasoy International Holdings O-426-12		VITALITE	Para 29 "To my mind the average consumer will simply view the applicant's mark as the word "vita" written in a slightly stylised script. They will view the opponent's mark as the words "VITA" and "LITE". Clearly, the two marks share the first four letters. To my mind there are clear visual similarities which outweigh the differences"
Altecnic v Intaco O-276-14	INTABALL		Para 34 "With the applicant's mark consisting of the letters INTA and the opponent's mark consists of an eight letter word beginning with INTA, there is obvious visual and aural similarity. However, I also recognise that the applicant's mark is very mildly stylised particularly the dot above the letter "i". Further, I also note that the word BALL is absent in the applicant's mark providing an element of visual and aural difference. Taking all of this into account, I conclude that the respective marks share a reasonable degree of both visual and aural similarity"
CBM Creative Brands Marken v F.G. O-193-20	HOLY	HOLYSNOW	Para 31 "The opponent submits that the word "HOLY" is the dominant and distinctive element of the contested mark and that therefore an assessment of the visual similarity should primarily focus on the comparison between "HOLY" and the earlier mark. The applicant, on the other hand, submits that the marks are visually "highly dissimilar", as the earlier mark has four letters and the contested mark eight. The applicant's submission discounts the fact that those four letters in the earlier mark are the four letters at the beginning of the contested mark. The average consumer tends to pay more attention to the beginning of words: see El Corte Ingles, SA v OHIM, Cases T-183/02 and T-184/02. I find that there is a medium degree of visual similarity between the marks"
The Football Association Premier League v Gadgetservices.com O-148-21	PREM		Para 35 "Visually, the marks overlap to the extent that the earlier mark is reproduced at the start of both applications. I recognise that a stylised font has been used in the applications. However, as registration of a word only mark (as is the case for the mark relied upon by the opponent) can be used in any standard typeface, I do not consider this to be a significant point of visual difference."

			The visual difference is created by the additional three letters at the end of the applications i.e. SOX and the device in each, which have no counterpart in the opponent's mark. Taking all of this into consideration, I consider the marks to be visually similar to between a low and medium degree"
Waterman Corporate Enterprises v Polished Brands O- 405-21	GROWPRO / GROW MORE / GROW ME	GROW	Para 70 "The contested mark is included within all three earlier marks in its entirety and is the first element in each mark. The earlier marks differ at the end of the marks through the use of 'MORE', 'ME' and 'PRO', which changes the length of the marks to varying degrees. With the addition of only two extra letters, I find the earlier mark GROW ME to be visually similar to the contested mark to between a medium and high degree. Considering the slightly increased number of letters in the marks GROWPRO and GROW MORE, I find these visually similar to the contested mark to a medium degree"

57) The applicant submitted:

"36. Visually, the Sign contains the sign SNAP. It is accepted that, since it is at the start of the Sign, the average consumer is more likely to notice it. The presence of the word SOLVE in the Sign, however, creates a marked visual difference from the sign SNAP.

37. The average consumer will not ignore the additional element and, accordingly, the signs are only visually similar to a medium degree.

38. The sign SNAPCHAT is further away as a result of the concatenation of a different element, namely the word CHAT in place of the word SOLVE. Again, the average consumer will not ignore this difference and the visual similarity is accordingly low to medium.

39. Aurally, the comparison is the same. There are no visual elements to any of the signs that will alter the comparison.

40. As noted above, the sign SNAP is a common English word indicating a game, a photograph, something breaking or something instantaneous.

41. Neither the sign SNAPCHAT nor the sign SNAPSOLVE has a meaning, unless they are broken into their constituent parts.

42. Accordingly, there is no conceptual similarity between the Sign and any of the Earlier Marks.”

58) I shall first compare the mark in suit to the earlier mark SNAP. Clearly, there are visual and aural similarities as they share the same first word. Equally there are obvious aural and visual differences. However, the mark in suit consists of two well-known dictionary words jammed together, which will be readily identified by the average consumer. Conceptually, the opponent's mark has a number of meanings, to break, a photograph, a card game to name but three, which means that when used on goods and services of a photographic nature the mark will be seen as descriptive. Considered as a whole, as an average consumer would do, the mark in suit does not have a meaning and none has been offered by either party, save that the opponent believes that in relation to educational goods and services the term “Solve” will be seen to refer to solving mathematical problems. To my mind, there is a medium degree of similarity between the mark in suit and the opponent's mark SNAP.

59) Moving to consider the mark in suit to the opponent's SNAPCHAT mark, many of the same arguments are applicable. The marks share the first four letters, or the first word in each mark as in my opinion the average consumer will view both marks as consisting of two well-known dictionary words jammed together. The conjoining of the words does not form them into a unit which has a different meaning from their individual parts. Clearly, the second words in each case are significantly different. The marks have visual and aural similarities and differences. Conceptually, the same comments as stated above relate to the mark in suit. The opponent's mark when used on its main product is somewhat descriptive as it allows the consumer to alter photographs and add text or “snap and chat”. There, is therefore conceptual differences. In my opinion, the mark in suit is similar to the opponent's SNAPCHAT mark to a low to medium degree.

Likelihood of confusion

60) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive their trade marks are, the

greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- The selection will be predominantly a visual one for all the goods and services applied for by the applicant, although aural considerations must be taken into account. The level of attention paid by the average consumer will vary considerably according to the goods or services involved, so when choosing an “Electronic transfer of money for others” service the level of attention paid will be high, whereas choosing an “on-line retailer for small items of metal hardware” will be undertaken with only a medium or average degree of attention.
- The opponent’s mark SNAP is inherently distinctive to an average degree when used on goods and services not connected to photographs, otherwise it is descriptive and has only a low degree of distinctiveness (Formula 1). The SNAP mark cannot benefit from enhanced distinctiveness through use, as its use has not been shown to be extensive from the evidence provided. The opponent’s mark SNAPCHAT although somewhat descriptive for services where a photograph and text can be sent is otherwise inherently distinctive to an average degree, whilst it can benefit from enhanced distinctiveness through use in relation to the services in Class 42 for the digital alteration of photographs and the ability to send those photographs with comments to others.
- Overall, there is a medium degree of similarity between the mark in suit and the opponent’s mark SNAP, whilst there is a low to medium degree of similarity between the mark in suit and the opponent’s mark SNAPCHAT.
- My findings on the similarity of the goods and services are as follows:

Applicant's Goods and services	UK 3268553 SNAP	RESULT
Class 9: Software Hardware Robots	Class 42 Class 42 N/A	Similar to a medium degree. No similarity No similarity
Class 16	Class 42	No similarity
Class 41	Class 42	No similarity
Class 42: "Product development consultancy for inventors in the field of education." Class 42: Balance of specification	Class 42 Class 42	No similarity Identical or highly similar
Applicant's Goods and services	EU13632369 SNAPCHAT	RESULT
Class 9: Software Hardware Robots	Class 9 Class 9 Class 9	Identical or highly similar Medium degree of similarity No similarity
Class 16	Class 35 Class 41	Low degree of similarity No similarity
Class 41: Education Entertainment Publication	Class 41 Class 41 Class 41	No similarity Low to medium degree of similarity Low to medium degree of similarity
Class 42: "Product development consultancy for inventors in the field of education." Class 42: Balance of specification	Class 42 Class 42	No similarity Identical or highly similar

61) I take into account the views expressed in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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). ”

62) I note that in *Sutaria v. Cheeky Italian Ltd* (O/219/16), the Appointed Person expanded on the decision in *L.A. Sugar* at 16, noting:

"16.1. First, a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion. It should be kept in mind that the differences which mean that one mark would not be mistaken for the other might well dispel indirect confusion as well.

16.2. Second, if (as here) the differences between the marks are such that there is no likelihood of direct confusion, one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion. This is what Mr Purvis was pointing out in those paragraphs in LA Sugar .

16.3. Third, when making a finding of a likelihood of indirect confusion, in my view it is necessary to be specific as to the mental process involved on the part of the average consumer. Whilst the categories of case where indirect confusion may be found is not closed, Mr Purvis' three categories are distinct, each reflecting a slightly different thought process on the part of the average consumer."

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

64) I also note that a degree of similarity in the goods/services of the two parties is essential. This was stated in *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU) and also in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

65) I shall first consider the position under the opponent's SNAP marks. I found that most of the goods and services registered under these marks were not similar to any of the goods and services sought to be registered by the applicant. In accordance with paragraph 64 above I find that in relation to the following goods and services there can be no finding of a likelihood of confusion with the opponent's SNAP marks: Class 9 Hardware & Robots, all goods in Class 16, all services in Class 41, and "Product development consultancy for inventors in the field of education" in Class 42.

66) Turning to the Class 9 goods classified as "software" I found these similar to a medium degree to the opponent's class 42 services. Whilst I found the marks similar to a medium degree I also found that the opponent's mark had a low degree of inherent distinctiveness when used on goods and services connected to photographs. To my mind, the similarity between the goods and services of the two parties in this category relies heavily upon the digital alteration of photographs and the software behind it, therefore in this comparison the opponent's mark is of low distinctiveness, and consequently its umbra and penumbra is considerably limited. To my mind, even allowing for the concept of imperfect recollection and taking into account the level of attention likely to be paid to such goods, there is no likelihood of consumers being directly or indirectly confused into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it.

67) Lastly, in relation to the opponent's SNAP marks I turn to consider the services of the two parties in Class 42 (other than the applicant's "Product development consultancy for inventors in the field of education"). These services were found to be highly similar or identical. To my mind, allowing for the concept of imperfect recollection and the likely level of attention paid by the average consumer, there is a likelihood of consumers being indirectly confused into believing that the services applied for and provided by the applicant are a brand extension of the SNAP mark and are those of the opponent or provided by an undertaking linked to it.

68) The result of the above findings is that in relation to the opponent's earlier SNAP marks they fail in relation to all goods and services with the exception of the class 42 services applied for by the applicant excluding the term "Product development consultancy for inventors in the field of education".

69) I now turn to the opponent's earlier SNAPCHAT marks. I found that some of the goods and services registered under these marks were not similar to any of the goods and services sought to be registered by the applicant. In accordance with paragraph 64 above I find that in relation to the following goods and services there can be no finding of a likelihood of confusion with the opponent's SNAPCHAT marks: Class 9 Robots; Class 41 Education; and Class 42 "Product development consultancy for inventors in the field of education".

70) I next turn to consider those goods and services which were regarded as being of medium or below similarity i.e. Class 9 Hardware; Class 16 all goods and Class 41: all services. I found earlier that there was a low degree of similarity between the marks whilst the average consumer would pay at least an average or higher degree of attention to the purchase. However, the opponent's mark when used on goods or services other than those where a photograph and text can be sent was inherently distinctive to an average degree and the opponent could rely upon enhanced distinctiveness when used on precisely the services for which it is descriptive. Taken overall, in my opinion, allowing for the concept of imperfect recollection there is no likelihood of consumers being directly or indirectly confused into believing that the goods and services applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it.

71) Lastly, I turn to consider the goods and services which were considered to be highly similar or identical i.e. Class 9 Software and Class 42 (except for "Product development consultancy for inventors in the field of education"). Taking all the factors set out above into account, in my opinion, allowing for the concept of imperfect recollection there is a likelihood of consumers being directly confused into believing that the goods and services applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it.

72) The result of the above findings is that in relation to the opponent's earlier SNAPCHAT marks they fail in relation to all goods and services with the exception of the Class 9 Software and the class 42 services applied for by the applicant excluding the term "Product development consultancy for inventors in the field of education".

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

“(3) A trade mark which-

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

74) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

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

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

characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

75) I must first consider whether the opponent has shown it has the requisite reputation. In *General Motors*, Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

76) The applicant accepted in its submissions that the opponent's mark SNAPCHAT had been shown to have reputation in certain goods and services. It stated:

"51. It is accepted that this evidence shows use of the Snapchat Marks for:

- a. '*computer software for modifying the appearance and enabling transmission of photographs*' and the similar goods in class 9;
 - b. '*advertising, marketing and promotion services*' and similar services in class 32;
 - c. the class 38 services;
 - d. the class 41 services; and
 - e. the class 42 services.
52. It is accepted that where there has been use, the level of use is such as to amount to a reputation under section 5(3) of the Act.
53. For the avoidance of doubt, there is no evidence of use for:
- a. electronic payment software in class 9;
 - b. payment services, market research services and advertising agency services in class 32;
 - c. any class 35 online retail services; and
 - d. any payment services in class 36.
54. Whilst there may be some use for '*in app purchases of Geofilters and personalized merchandise*' there is no evidence to support this, beyond a one line statement from Mr Stratton. In any event, it is not clear that these are covered by the class 35 specification."

77) These concessions go considerably further than my own views on the evidence filed, but I am willing to accept that as the applicant has conceded these points I must go along with their view. However, I note that the applicant states that these comments are conditioned by its earlier comments at paragraph 33 of its submissions where its states that the reputation is only for the concatenation [SNAPCHAT] rather than the individual elements of the sign. I also note that although the opponent's submissions also claimed reputation in its SNAP marks these marks were not included in the pleadings under this ground of opposition and as no request was made to amend the pleadings at any stage of the proceedings the earlier SNAP marks are not under consideration under the section 5(3) ground of opposition.

78) I next turn to consider whether a significant part of the relevant public will make the necessary link between the marks of the two parties. In carrying out this comparison I am aware that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion (*Intra-Presse SAS v OHIM*, Joined cases C-581/13P & C-582/13P).

79) Earlier in this decision I determined that the marks of the two parties had a low degree of similarity, and that the “software” goods in class 9 and the whole of the Class 42 services specification with the exception of “Product development consultancy for inventors in the field of education” were identical or highly similar with the opponent’s goods and services. I further found that the Class 9 “hardware” goods were similar to a medium degree. Given the extent of the reputation of the opponent, as set out earlier, I am of the opinion that a significant part of the relevant public will form a link between the businesses of the two parties if the mark in suit is used on “software” and “hardware” goods in class 9, and the whole of the applicant’s class 42 specification applied for with the exception of “Product development consultancy for inventors in the field of education”.

80) I also found earlier in this decision that in respect of all the Class 16 goods and “Entertainment” and “Publication” services in Class 41, there was a low or low to medium degree of similarity with the opponent’s goods and services. I also found that in respect of “Robots” in Class 9; Education in Class 41; and “Product development consultancy for inventors in the field of education” in Class 42 there was no similarity with any of the opponent’s goods and services. In my opinion the opponent’s reputation rests in goods and services which are so different to the applicant’s goods and services listed in this paragraph that no substantial part of the relevant public will form a link between the two parties.

81) Moving onto the question of damage, detriment and unfair advantage I take into account the comments in *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, where the Court of Appeal held that a change in the economic behaviour of the customers for the goods/services offered under the later trade mark was required to establish unfair advantage.

82) This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC). In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) pointed out that the alleged detriment to the distinctive character of the earlier mark must be connected to the mark's reputation. The judge stated that:

"122. The requirement that the registered trade mark has a reputation therefore underpins and is intimately tied to the possibility that the mark may be injured. Put another way, if and in so far as the registered mark is not known to the public then, in a case in which there is no likelihood of confusion, it is very hard to see how it can be injured in a relevant way. This presents no conceptual difficulty in a case in which it is alleged that the use of the later mark will take unfair advantage of or tarnish the reputation attaching to the registered mark. Self evidently both of these kinds of injury can only be inflicted upon the registered mark to the extent that it has a reputation. But in my judgment just the same must apply to the third kind of injury, that is to say, damage to distinctive character by, for example, dilution or blurring. Just as in the case of the other kinds of injury, there must be some connection between the reputation and the damage."

And

"140. Finally, and most importantly for present purposes, in assessing whether there is detriment to the distinctive character of the earlier mark, it must be considered whether the mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of the mark is weakened (see *Intel* at paragraph [29], set out above)."

83) Accordingly, section 5(3) only covers detriment to the distinctiveness of the mark in relation to the categories of goods/services for which the mark is registered and has a reputation. I accept that use of the mark in suit upon the goods and services listed in paragraph 78 above will cause detriment to the distinctive character of the opponent's mark and indeed it will take unfair advantage of the advertising investment in the earlier mark.

84) The opposition under section 5(3) only succeeds in part, in respect of the “software” and “hardware” goods in class 9, and the whole of the applicant’s class 42 specification applied for with the exception of “Product development consultancy for inventors in the field of education” sought to be registered by the applicant. The opposition fails in respect of Robots” in Class 9; all the Class 16 goods; all services in Class 41 and the term “Product development consultancy for inventors in the field of education” in Class 42.

CONCLUSION

85) The opposition under Section 5(2)(b) under both SNAP (UK 3268553) and SNAPCHAT (EU 13632369) marks was successful in respect of the services applied for in Class 42 with the exception of the term “Product development consultancy for inventors in the field of education”. The section 5(2)(b) opposition under its SNAPCHAT (EU 13632369) mark was also successful in respect of “Software” in Class 9. The opposition under section 5(3) under the opponent’s SNAPCHAT mark (EU 13632369) only succeeds in part, in respect of the “software” and “hardware” goods in class 9, and the whole of the applicant’s class 42 specification applied for with the exception of “Product development consultancy for inventors in the field of education”.

86) The application will therefore proceed to registration in respect of the following specification:

In Class 9: teaching robots; security surveillance robots; humanoid robots with artificial intelligence; cameras.

In Class 16: Teaching manuals; instructional and teaching materials [except apparatus]; Educational materials for teaching purposes [except apparatus]; Instructional and teaching materials; Educational publications; photographs; Stationery and educational supplies; books and periodicals, magazine, printed matters, printed publications, printed time tables and brochures; bookmarks; composing frames [printing]; drawing materials; desk mats; document holders; marking pens [stationery]; writing paper; table napkins of paper; paper; pencils; pictures; stands for pens and pencils; ink; plastic sheets; films and bags for wrapping and packaging.

In Class 41: Teaching and educational services; Educational services in the nature of coaching; computer assisted education services; publication of educational and teaching materials; providing training, teaching and tutoring; provision of online tutorials; arranging and conducting of tutorials; providing tutorial sessions in the field of mathematics; providing information in the field of education; publication of electronic books and journals on-line; educational instruction services; Educational services; training services; tutoring services; educational examinations; entertainment services; providing information and analysis in the field of education and entertainment; presentation of videos online; providing online electronic publications, music and videos (not downloadable); multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps; publication of calendars, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; publication of calendars of events; entertainment and amusement information via internet online; entertainment; organization and presentation of shows, competitions, games, concerts and entertainment events; arranging, organizing, conducting, and hosting education and social entertainment events; arranging and conducting education conferences; organization of exhibitions for cultural, educational, or entertainment purposes; Recording studio services; Teaching support services, namely scheduling, notifications and communication services; non-downloadable games for educational use; non-downloadable interactive multimedia computer game programs; Educational services, namely developing curriculum for teachers and educators; photography, film and video production services; Teaching services relating to pedagogy techniques; Online library services, namely, providing electronic library services which feature newspapers, magazines, photographs, pictures and videos via an on-line computer network; information, consultancy and advisory services relating to the aforesaid.

In Class 42: Product development consultancy for inventors in the field of education.

COSTS

87) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 14th day of October 2021

George W Salthouse

For the Registrar,

the Comptroller-General