

O/1009/22

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3606659
IN THE NAME OF CRYPTOBLK LIMITED
TO REGISTER AS A SERIES OF 2 TRADE MARKS

 ATLAS ELITE

 ATLAS ELITE

IN CLASS 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 427738
BY GLOBAL INKJET SYSTEMS LTD

BACKGROUND AND PLEADINGS

1. On 9 March 2021, CryptoBLK Limited ("the applicant") applied to register UK3635910 as a series of two trade marks, for the marks shown on the cover page of this decision, in the United Kingdom.
2. The application was accepted and published for opposition purposes on 27 August 2021, in respect of the following services:

Class 42: *Cloud computing; Computer software consultancy; Computer software design; Computer system design; Computer technology consultancy; Development of computer platforms; Installation of computer software; Outsource service providers in the field of information technology; Platform as a service [PaaS]; Software as a service [SaaS]; Software development in the framework of software publishing; Updating of computer software; Computer programming services; Computer programming for others; Design and development of computer software; Customized design of computer software; Installation and customisation of computer applications software; Software maintenance services.*

3. The application is opposed by Global Inkjet Systems Ltd ("the opponent"). The opposition was filed on 25 October 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the services in the application. The opponent relies upon the following marks:

Atlas

UK trade mark registration number 3176606

Filing date: 26 July 2016

Registration date: 21 October 2016

Registered in Class 9

Relying on all goods, namely:

Software development kit [SDK]; software for processing images, graphics and text; software for searching and retrieving information across a computer network; software

for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence.

(“**Mark 1**”); and

ATLAS IQ

Atlas IQ

(Series of 2)

UK trade mark registration number 3544948

Filing date: 16 October 2020

Registration date: 09 April 2021

Registered in Class 9

Relying on all goods, namely:

Software development kit [SDK]; software for processing images, graphics and text; software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence.

(“**Mark 2**”).

4. The opponent submits that its Mark 1 is identical to the first word of the application, with the first word of its Mark 2 also being identical to the first word of the application. It submits that the second word of the application, “ELITE”, is purely laudatory and of no trade mark value, rendering the competing marks visually and aurally highly similar, and conceptually identical. It further submits that the services of the application are identical (in part), if not, highly similar to the opponent’s goods. It concludes that there is a likelihood of confusion on the part of the relevant public, which includes a likelihood of association, contrary to section 5(2)(b) of the Act. It requests that the application be refused in its entirety, and that an award of costs be made in favour of the opponent.

5. The applicant filed a counterstatement denying the claims and submits that when taken as a whole, the applicant's mark is starkly different to the earlier marks, and that the overlapping element of the marks, being the word "ATLAS", is not sufficient to find a likelihood of confusion. It requests that the application proceed to registration.

6. Only the opponent filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. Neither party elected to file evidence *per se*.¹ Neither party requested a hearing, so this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by IP21 Limited and the applicant is represented by Accolade IP Limited.

Preliminary Issues

8. I note that, in accordance with rule 19(2) of the Trade Mark Rules 2008, a Preliminary Indication (PI) was issued to both parties on 28 January 2022, where it was considered that, having taken into account the similarity between, in particular, the opponent's Mark 1 and the applicant's trade mark and the similarity of the goods/services at issue, there is a likelihood of indirect confusion in relation to all of the services in the application.

9. PIs are issued to give the respective parties an indication on a *prima facie* basis as to the likely decision in respect of the grounds of opposition, giving either party the opportunity to withdraw either the opposition or the application accordingly, without incurring costs. The PI is not binding, nor does it replace a full decision by a different Hearing Officer.

10. As the PI was that the application should be refused for all services, if the applicant does not accept the PI, it has the right to give formal notice to that effect. In order to

¹ I note the inclusion of Annex A attached to the applicant's counterstatement which lists 119 registered and protected marks bearing the word element "ATLAS" under Class 9 in the United Kingdom.

proceed, the applicant must file form TM53, otherwise the application is accordingly deemed to be withdrawn. In this instance, the applicant was invited to file Form TM53, with a deadline given for doing so of 28 February 2022.

11. On 11 February 2022, the applicant filed form TM53 to request that the opposition proceed to evidence rounds.

12. As I am not bound by the PI, following careful consideration of the facts before me, I will make my own assessment of the likelihood of confusion between the competing marks and the opponent's goods against the opposed services of the application.

DECISION

13. Although the UK has left the European Union, 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 Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

14. Section 5(2)(b) is relied on, which reads as follows:

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

...

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

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

15. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) 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,

...”

17. Each of the trade marks upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade marks had not been registered for more than five years at the date the application was filed, they are not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon them in relation to all of the goods indicated without having to prove that genuine use has been made of them.

18. I am guided by 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (“OHIM”), Case C-3/03, *Medion AG v.*

Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P 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 greater 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 to mind the earlier mark, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. Section 60A of the Act provides:

- “(1) For the purposes of this Act goods and services —
 - (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
 - (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
- (2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

20. I am therefore mindful of the fact that goods and services are not to be automatically found to be dissimilar simply because they fall in a different class.

21. The goods and services to be compared are:

Opponent's goods	Applicant's services
<p>The goods relied upon under both the earlier marks are identical:</p> <p><u>Class 9</u></p> <p><i>Software development kit [SDK]; software for processing images, graphics and text; software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence.</i></p>	<p><u>Class 42</u></p> <p><i>Cloud computing; Computer software consultancy; Computer software design; Computer system design; Computer technology consultancy; Development of computer platforms; Installation of computer software; Outsource service providers in the field of information technology; Platform as a service [PaaS]; Software as a service [SaaS]; Software development in the framework of software publishing; Updating of computer software; Computer programming services; Computer programming for others; Design and development of computer software; Customized design of computer software; Installation and customisation of computer applications software; Software maintenance services.</i></p>

22. In *Gérard Meric v OHIM*, Case T-133/05, the General Court ("GC") stated that:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".²

² Paragraph 29

23. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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”.³

24. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

25. 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 OHIM*, Case T-325/06, the GC 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”.⁴

26. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the

³ Paragraph 23

⁴ Paragraph 82

extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁵

27. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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.”⁶

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

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

29. In *Sky v Skykick* [2020] EWHC 990 (Ch), Arnold LJ 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:

⁵ Paragraph 5

⁶ Paragraph 12

- (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.”

30. In its Statement of Grounds, and as referred to in its written submissions, the opponent submits that the services covered by the application are similar to the goods covered by the opponent's marks in terms of their nature, users, distribution channels and method of use. It submits that the applicant's services are complementary to the opponent's goods, because for the computer software to exist, it must be designed and developed, and that the services applied for are thus highly similar to the opponent's registered goods.

31. *Cloud computing; Platform as a service [PaaS]; Software as a service [SaaS]*. To my understanding, in broad terms, the above services refer to the delivery and management of computing services, including software, over the internet. While I acknowledge that services are not the same as goods, nevertheless, there will be an overlap in end users of the above services and the opponent's various software products in Class 9, which may be in competition, with the user electing either to access software via the internet or “cloud”, or alternatively choosing to purchase equivalent software as goods. However, the method of use and nature of the goods and services will be different. Consequently, I consider the opponent's Class 9 goods, such as “*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*” and the applicant's “*Cloud computing;*

Platform as a service [PaaS]; Software as a service [SaaS]" to be similar to a medium degree.

32. Software maintenance services.

I consider that there will be an overlap in users and trade channels of the applicant's software maintenance services with the opponent's various software products. While the goods and services are different in nature and method of use, I consider them to be complementary to the extent that the average consumer could reasonably expect the same or economically linked undertakings to provide both the goods and the subsequent maintenance of those goods. I therefore consider the earlier "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*" and the applicant's "*Software maintenance services*" to be similar to a medium degree.

33. Installation of computer software; Installation ... of computer applications software.

In my view, the above services are a stand-alone service, which are different in nature and purpose to of the opponent's "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*", although there will be an overlap in the users of both the goods and the services. Overall, I consider the respective goods and services to be similar to a low degree.

34. Computer software design; Updating of computer software; Design and development of computer software; Customized design of computer software; ... customisation of computer applications software.

I consider computer software to be the end result of its design and development, and I agree with the opponent that to that extent there exists a complementary relationship, as without the design services there would be no end product in the form of the software. However, I consider the link insufficient for the end user of the goods to automatically believe that the services also derive from the same undertaking. In

my view, while the services relate to software, the nature, purpose and method of use is different, with different users, although there may be an element of competition, with the consumer selecting either bespoke software from the designer, or choosing specific software already on the market. Overall, I consider any overlap between the opponent's "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*" and the applicant's "*Computer software design; Updating of computer software; Design and development of computer software; Customized design of computer software; ... customisation of computer applications software*" to be on a superficial level and accordingly, I find them to be similar to a low degree.

35. *Computer software consultancy; Computer technology consultancy.*

The opponent's "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*" are clearly different in nature to the applicant's "*Computer software consultancy; Computer technology consultancy*". In my view, provision of a computer software consultancy service is likely to be linked to the aforementioned design and development stages, and as an after-sales service to those soliciting customised design of software. I do not consider that there is a clear complementary relationship with the provision of the software itself, as outlined in *Boston Scientific*. Overall, I find the goods and services at issue to be similar to a low degree.

36. *Software development in the framework of software publishing.*

To my mind, the above service refers to the development of software which is used to publish other software. As such, it seems to be a specialist field which is different in use and nature to the earlier "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*". I am mindful of the guidance given in *Avnet* which says that specifications for services

should not be given a wide construction, and I therefore find the contested services dissimilar to the opponent's goods.

37. Outsource service providers in the field of information technology.

I understand an outsource service provider to be a third party who, in line with the needs of the client, provides delivery of appropriate IT services. As such the services are likely to be provided by specialists in their field as a stand-alone service. I therefore do not consider that "*Outsource service providers in the field of information technology*" to be complementary to, or in competition with, the "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*" of the earlier mark, and I do not consider that the average consumer would expect provision of the respective goods and services to lie with the same provider. I therefore find them to be dissimilar.

38. Computer system design; Development of computer platforms.

The design of a computer system will involve the set-up of hardware with the running of compatible software, with the computer platform being the stage on which software is executed and computer programs can be run. In both cases, this may include virtual systems and platforms, such as Cloud computing and Platform as a Service. However, this is one step removed from design and development of computer software *per se*, and therefore further removed from the goods at issue. Considering the essential purpose of the services, I find "*Computer system design; Development of computer platforms*" to be dissimilar to "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*".

39. Computer programming services; Computer programming for others.

To my mind, while a computer program is used in the process of creating software, meaning that software can be a program that generally runs on a computer, a program cannot be classed as software. While there is likely to be an overlap in end users, I

consider this to be at a superficial level, insufficient to support a finding of similarity between software itself and computer programming services. I also find that the methods and purpose of use, as well as the channels of trade will be different, and I do not consider them to be complementary in a trade mark sense. I consider the applicant's "*Computer programming services; Computer programming for others*" to be dissimilar to the opponent's "*software for searching and retrieving information across a computer network; software for diagnostics and troubleshooting; all relating to industrial printing; none of the aforementioned goods being on the subject of or relating to computer security, cyber security, network or security intelligence*".

40. A degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, 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."

41. In relation to the services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such services, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

42. 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. (as he was then) described the average consumer in these terms:

"The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.⁷

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

44. In its counterstatement, the applicant submits that its services are expensive and come at a high price tag that frequently costs thousands of pounds. Accordingly, consumers are likely to undertake substantial research before spending large amounts of money in availing such services, and are predisposed to be more meticulous and discerning over their procurement of such services.

45. The opponent's various software products have been qualified as “*all relating to industrial printing*”, therefore I consider the average consumer of the Class 9 goods to be professional users within the printing industry. The Class 42 services covered by the applied-for mark have not been limited to any particular field, however, given their technical nature, I consider that a significant proportion of the average consumer of the services will be professional users such as businesses seeking software and computing solutions in order to run their businesses, be that within the printing industry or otherwise, and who may require bespoke services tailored to their specific business needs. Nonetheless, I do not discount that certain services may also be accessed by members of the general public, particularly in relation to services such as cloud computing.

46. Given the specific nature of the goods, they are likely to be purchased relatively infrequently. I would expect them to be sold through specialist retailers, be that from bricks and mortar premises, through tele-sales, or via the internet. The majority of the services will be procured even less frequently, although I recognise that the consumer

⁷ Paragraph 60

may seek to upgrade existing provisions from time to time. The selection of the services will be relatively important to the average consumer, with the purchasing act likely to follow a measured thought process such that the services are unlikely to be procured casually or as a matter of routine.

47. For both the goods and the services, considerations such as technical reviews of the services/software, price, quality, ease of use, suitability of the product and the reputation of the provider would be taken into account before purchasing the goods or accessing the services. The selection process would be a combination of visual and aural; some consumers would seek information from written reviews and recommendations, particularly on the internet, whereas others would receive verbal advice from sales representatives, particularly in the case of tele-sales.

48. I consider that for the goods, the average consumer will want to ensure that the software procured is appropriate to specific business needs, and as such, they will pay a higher than average degree of attention during the purchasing act. Meanwhile, the cost of the services will vary according to the exact nature, specification and the level of service selected, however, the initial outlay could be substantial. In my view, the business customer will pay a high degree of attention to the selection of the services, while with degree of attention paid by the general public is likely to be at least medium.

Comparison of marks

49. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”⁸

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

51. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade marks
Mark 1	Series of 2
Atlas	 ATLAS ELITE
Mark 2 (Series of 2)	 ATLAS ELITE
ATLAS IQ	
Atlas IQ	

52. The opponent submits that the competing marks share the common element “ATLAS”, being the distinctive and dominant element, which it describes as an English word referring to a book of maps or charts, and which it submits neither describes nor alludes to any of the characteristics of the relevant goods and services. It submits that the applicant’s mark is visually, phonetically and conceptually similar to the opponent’s earlier marks, and that the additional elements “IQ” (in its Mark 2) and “ELITE” (in the contested mark) will be seen as non-distinctive. Further, it is accepted that consumers refer to marks by their verbal elements, with verbal components usually having a stronger impact on the consumer than figurative elements, thus the triangular device within the applicant’s mark does not diminish the similarity with the opponent’s mark.

⁸ Paragraph 34

53. The applicant submits that when taken as a whole, its mark is starkly different to that of the opponent's marks, being characterised by its style and graphic elements, while the opponent's marks consist of only words. It submits that the geometric figure creates the letter "A" which can be argued is the dominant element, while the word "ELITE" is also distinctive as it is a suggestive term that invokes multiple meanings. It further submits that the only overlapping element among the marks is the word "ATLAS", which is insufficient to say that there will be a likelihood of confusion among the marks. The applicant is of the position that the opponent's marks are not at all distinctive such that likelihood of confusion is nil.

Overall impression

54. The opponent's Mark 1 consists of the single word "Atlas", presented in a standard font in title case. As the mark contains no other elements, the overall impression therefore rests in the word itself.

55. The opponent's Mark 2 has been registered as a series of two word marks, pursuant to section 41(2) of the Act. Each mark comprises identical elements, being the plain word "ATLAS" followed by the conjoined letters "IQ". The first mark in the series is presented in capital letters in a standard typeface, with the second mark being presented in the same standard font in title case. The registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. Accordingly, I will refer to the marks in the singular. As the mark contains no other elements, the overall impression rests in the word and letter combination as presented.

56. The applicant's mark has been accepted and published as a series of two marks, pursuant to section 41(2) of the Act. As shown above, the first mark in the series is presented in colour, while the second mark of the series is presented in greyscale. I note that registration of a mark in black and white covers use of the mark in colour.⁹ For convenience, I will from this point refer to the series in the singular, though my

⁹ See paragraph 5, *Specsavers* [2014] EWCA Civ 1294.

comments should be taken as referring equally to both marks in the series, unless expressed otherwise.

57. The contested mark consists of a device element at the beginning of the mark, being a series of lines which form a triangular shape, and which could be perceived by some consumers as a highly stylised letter "A". Following the device are the words "ATLAS" and "ELITE", presented in capital letters in a relatively standard font. While I acknowledge that to some consumers, each of the words will play an independent distinctive role within the mark, with neither word dominating, I consider the proportion of consumers who would view it in this way to be insignificant. To my mind, the average consumer will view the word ELITE as being allusive of the quality of the services, being seen as exclusive, or the best of their kind. While each of the elements are situated in a single line, and the device is slightly larger than the subsequent wording, I consider that it is the word "ATLAS" which will make the greatest contribution to the overall impression, although the word "ELITE" will not be overlooked, while the device element will make a lesser, but still significant, contribution overall.¹⁰

Visual comparison

58. The opponent's Mark 1 and the contested mark share visual similarity by way of the word "ATLAS", which makes up the entirety of the earlier mark and is wholly incorporated in the applicant's mark. However, the word "ATLAS" in the contested mark is preceded by the figurative element as previously described, an element which will not be overlooked by the average consumer. These two components are followed by the word "ELITE", and as neither the device element nor the word "ELITE" is present in the earlier mark, this creates a visual disparity. The word "ATLAS" is positioned between the device element and the word "ELITE" which further reduces any visual similarities between the contested marks. Considering the marks as a whole, I find there to be a medium degree of visual similarity between them.

59. The opponent's Mark 2 consists of the word "ATLAS" followed by the two-letter combination "IQ", the two letters being absent from the contested mark, which

¹⁰ See *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, at [37].

comprises the device element followed by the words “ATLAS ELITE”, as described previously, the only element in common being the word “ATLAS”. Overall, I find the competing marks to be visually similar to no more than a medium degree.

Aural comparison

60. The common element in the competing marks is the word “ATLAS”, which would be pronounced equally as two syllables, AT-LUS (ætləs) and is the only element to be voiced in the opponent’s Mark 1, which is also the first word of the applicant’s mark. The figurative element in the applicant’s mark would not be voiced. I consider this to be the case even where the consumer perceives the device to be an artistic representation of the letter “A”. I consider that both word elements in the contested mark would be articulated, the whole being voiced as four syllables, AT-LUS-ILL-EAT (ætləs ɪlɪ:t). Having considered these similarities and differences, I find there to be a medium degree of aural similarity between the opponent’s Mark 1 and the contested mark.

61. Meanwhile, the opponent’s Mark 2 would be articulated in its entirety as the word “ATLAS” and as the individual letters “I” and “Q”, the whole being voiced as four syllables, AT-LUS-EYE-CUE (ætləs aɪ kju:), compared to the four syllables of the applicant’s mark, AT-LUS-ILL-EAT (ætləs ɪlɪ:t), as considered in the previous paragraph. Overall, I consider the competing marks to be aurally similar to no more than a medium degree.

Conceptual comparison

62. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the

various perceptions which that person has of it and to organise knowledge about it.”¹¹

63. The opponent’s Mark 1 is made up of a single, dictionary defined word, being identical to the first word of the contested mark. I consider that the average consumer would recognise the word “ATLAS”, which is common to all of the competing marks, as referring to a book of maps, which I do not consider either describes or alludes to the goods and services at issue.

64. The opponent’s Mark 2 contains the additional letters “IQ” following the common word “ATLAS”. While there may be some consumers who do not recognise the exact definition of the letters as being an abbreviation of “intelligence quotient”, I consider that they will grasp the general idea that the letters refer to a measure of intelligence, and given the technological nature of the Class 9 goods, they will assume that the letters directly relate to the goods at issue as being “smart”, rendering the “IQ” element of the mark as lower in distinctive character.

65. I consider that a significant proportion of consumers will perceive the figurative element of the applicant’s mark as either an arbitrary inclusion, or as the letter A, being the first letter of the word “ATLAS”. They are likely to construe the word “ELITE” in the applicant’s mark as laudatory, referring to the quality of the services, and will therefore take the word “ATLAS” as being dominant for the services at issue.

66. Overall, I consider there to be a very high degree of conceptual similarity between the marks, owing to the distinctive and dominant common element, “ATLAS”.

Distinctive character of the earlier marks

67. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE) [2002] ETMR 91.*

¹¹ Paragraph 8.

68. 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).”

69. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

70. The earlier Mark 1 comprises an ordinary, dictionary defined word, which to my mind neither describes nor obviously alludes to the goods to which it relates. The

earlier Mark 2 contains the additional element “IQ”, which earlier in this decision I considered would be seen as allusive of a characteristic of the opponent’s goods and therefore does little to enhance the distinctive character of the mark as a whole. Consequently, I find both earlier marks to be inherently distinctive to a medium degree.

Likelihood of confusion

71. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

72. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he was then), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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)."

73. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

74. Earlier in this decision, I found that:

- All the contested services, except for those listed under paragraph 82 of this decision, are similar to at least a low degree to the opponent's goods;
- The level of attention of the average consumer will be higher than average when selecting the goods, while for the services, the business customer will pay a high degree of attention to the selection process, with the general public paying at least a medium degree of attention;

- The selection process of the goods and services would be a combination of visual and aural;
- The contested trade mark is visually and aurally similar to the opponent's Mark 1 to a medium degree, and is visually and aurally similar to no more than a medium degree to the earlier Mark 2. Overall, I considered there to be a very high degree of conceptual similarity between each of the competing marks;
- The earlier marks are inherently distinctive to a medium degree.

75. I note that the applicant has attached "Annex A" to its counterstatement which lists 119 registered and protected trade marks bearing the word element "ATLAS" under Class 9 in the United Kingdom, and which it submits demonstrates that the opponent's mark cannot be deemed to be distinctive and therefore should be accorded only a narrow scope of protection. However, these other registered marks have no bearing on my assessment. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

76. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their

mind, I consider it unlikely that they would mistake one mark for the other. In my view, given the degree of attention paid during the selection process, the average consumer will notice and recall the differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for such confusion to arise.

77. Having found no likelihood of direct confusion between the marks, taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

78. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), 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.

79. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

80. Keeping in mind the global assessment of the competing factors in my decision, given that both the earlier marks and the contested mark share the distinctive word

“ATLAS”, it is my view that a significant proportion of consumers will conclude that the addition of the device element and the laudatory word “ELITE” in the later mark represents a sub-brand of the opponent’s “ATLAS” marks which relates to the provision of a select range of services, or they would assume that there is an economic connection between the undertakings. Consequently, I consider there to be a likelihood of indirect confusion in relation to all services for which I found similarity.

81. The opposition under section 5(2)(b) succeeds in respect of the following services:

Cloud computing; Computer software consultancy; Computer software design; Computer technology consultancy; Installation of computer software; Platform as a service [PaaS]; Software as a service [SaaS]; Updating of computer software; Design and development of computer software; Customized design of computer software; Installation and customisation of computer applications software; Software maintenance services.

CONCLUSION

82. The opponent has been partially successful. Subject to any successful appeal, the application by CryptoBLK Limited may proceed to registration in respect of the following services only in Class 42:

Computer system design; Development of computer platforms; Outsource service providers in the field of information technology; Software development in the framework of software publishing; Computer programming services; Computer programming for others.

COSTS

83. Both parties have enjoyed a share of success, with the greater degree of success on the part of the opponent, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. I have made a reduction to the costs to reflect the partial extent of the success. Applying the

guidance in the TPN, I award the opponent the sum of £500, which is calculated as follows:

Official fee:	£100
Filing a notice of opposition and considering the counterstatement :	£200
Filing written submissions:	£200
Total:	£500

84. I therefore order CryptoBLK Limited to pay Global Inkjet Systems Ltd the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of November 2022

**Suzanne Hitchings
For the Registrar,
the Comptroller-General**