

**O/989/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3717773  
IN THE NAME OF ZIGBANG CO., LTD  
IN RESPECT OF THE TRADE MARK**

**SOMA**

**IN CLASSES 9, 35, 38 AND 42**

**AND**

**THE OPPOSITION THERETO UNDER NO. 600002255  
BY FRANCISCO JAVIER SORDO MADALENO BRINGAS**

## **Background and pleadings**

1. On 4 November 2021, ZIGBANG Co., Ltd. (“the applicant”) applied to register the trade mark shown on the cover page to this decision in the United Kingdom in respect of the following goods and services:

*Class 9: Instant messaging software; computer software for remote telecommunication; computer software for remote conference; downloadable software for virtual currency; downloadable computer software for remote monitoring and analysis.*

*Class 35: Business networking; providing assistance in the field of business organization; appointment scheduling services [office functions]; wholesale services in relation to video conference system; retail services in relation to video conference system; wholesale services in relation to instant messaging software; retail services in relation to instant messaging software; wholesale services in relation to computer software for remote telecommunication; retail services in relation to computer software for remote telecommunication; wholesale services in relation to software for online messaging; retail services in relation to software for online messaging; wholesale services in relation to computer software for use in providing multiple user access to a global computer information network; retail services in relation to computer software for use in providing multiple user access to a global computer information network; wholesale services in relation to communications software for connecting global computer networks; retail services in relation to communications software for connecting global computer networks; wholesale services in relation to computer software for transmission of sound and video messages; retail services in relation to computer software for transmission of sound and video messages.*

*Class 38: Providing access to an online virtual community via the internet/mobile; network conferencing services; videoconferencing services via the internet; teleconferencing services; communication services for remote conferences; electronic transmission of instant messages and data; providing instant messaging services; web conferencing services; audio teleconferencing services; teleconferencing and video conferencing services; providing access to platforms on the Internet, as well as on the mobile Internet; transfer of data via on-line services.*

*Class 42: Software as a service [SaaS] (for video conference/ network meeting/ web conferencing/ teleconferencing/ instant messaging and data transmission); providing paas (platform as a service) (for video conference/ network meeting/ web conferencing/ teleconferencing/ instant messaging and data transmission).*

2. The application was published for opposition purposes on 7 January 2022 and, on 7 March 2022, Francisco Javier Sordo Madaleno Bringas (“the opponent”) opposed the mark, in its entirety, under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) using the fast track opposition procedure.

3. For the purpose of the opposition, the opponent relies upon the following trade marks and all services for which they are registered.

United Kingdom Trade Mark (“UKTM”) 3472188:

**SOMA**

UKTM 3472183:



UKTM 3472173:



Each mark holds a filing date of 4 March 2020 and a registration date of 11 August 2020 and the specifications are identical, reading as follows:

*Class 36: Real estate management; rental of real estate; rental of offices [real estate]; rental of offices for co-working; providing rebates at participating establishments of others through use of a membership card; rental of buildings; rental of commercial premises; toll collection; real state commercialization; brokerage (included in this class); real estate brokerage; financial appraisals in responding to calls for tenders / financial appraisals in responding to requests for proposals [RFPs]; financial evaluation [insurance, banking, real estate]; financial management; providing information regarding the characteristics of movable property for sale or rent, other than advertising; loans [financing]; lending against security; points-for-money exchange services originated by the purchase of product and services; credit services through individual financial companies; e-wallet payment services; real estate appraisal; arranging finance for construction projects; sale of commercial premises [real state]; insurance services; financial affairs; monetary affairs; real estate affairs; advisory, consultancy and information services in all the fields mentioned before.*

*Class 39: Cash replenishment of automated teller machines; replenishment of vending machines; storage of goods; storage / warehousing; rental of warehouses; car parking; rental of electric wine cellars; car rental; rental of storage containers; unloading cargo; parcel delivery; packaging of goods; garage rental; providing information relating to storage services; courier services [messages or merchandise]; parking place rental; clothing storage; vehicle storage; rental of dump trucks for construction; rental of mechanical parking systems; parking-meter operation services; valet parking services; transport services; packaging and storage of goods; travel arrangement; advisory, consultancy and information services in all the fields mentioned before. .*

*Class 40: Food smoking; rental of air-conditioning apparatus; clothing alteration; embroidering; rental of space heating apparatus; metal plating; gold plating; custom fashioning of fur; freezing of foods; food and drink preservation; beer brewing for others; framing of works of art; treatment of materials; advisory, consultancy and information services in all the fields mentioned before.*

*Class 45: Legal advice in responding to calls for tenders / legal advice in responding to requests for proposals [RFPs]; legal consultancy relating to patent mapping; licensing*

*of computer software [legal services]; concierge services; litigation services; legal advocacy services; fire-fighting; legal research; legal services in relation to the negotiation of contracts for others; legal document preparation services; online social networking services; alternative dispute resolution services; legal watching services; legal administration of licenses; lost property return; mediation; opening of security locks; organization of religious meetings; organization of political meetings; planning and arranging of wedding ceremonies; uniform rental; paperwork management and procedure services to obtain visas; organization of daily tasks for third parties to meet needs of individual [social work services]; legal services; security services for the physical protection of tangible property and individuals; advisory, consultancy and information services in all the fields mentioned before.*

4. In fast track opposition proceedings, Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235 (“the Fast Track Rules”), disappplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. In addition, Rule (7) of the Fast Track Rules provides as follows:

“(7) Where the earlier mark is subject to proof of use under section 6A of the Act, the proof of use that the opponent wishes to rely upon shall be provided with the notice of fast track opposition.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions, other than where proof of use is required. Where proof of use is required, this should be filed with the initial Form TM7F.

7. By virtue of the filing dates of the marks relied upon by the opponent, each qualifies as an earlier mark in accordance with section 6 of the Act. As none of the marks had completed its registration procedure more than five years prior to the filing date of the

applicant's mark, none are subject to the proof of use requirements set out in section 6A of the Act. Consequently, the opponent can rely upon all marks and all services for which they are registered without providing evidence of use.

8. The opponent submits that the parties' respective marks are at least highly similar ("almost identical" in the case of the opponent's word-only registration) and cover identical or similar services, such that there exists a likelihood of confusion on the part of the public, including a likelihood of association.

9. In its counterstatement, the applicant admits that the applied-for mark is similar to those relied upon by the opponent, but denies that the specifications are similar or identical and ultimately that there exists a likelihood of confusion on the basis that the respective goods and services are "clearly distinguishable".

10. The opponent is represented by Lewis Silkin LLP and the applicant by MW Trade Marks Limited. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary and only the opponent filed written submissions in lieu which will not be summarised but will be referred to as and where appropriate throughout my decision.

11. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **Pleaded grounds**

12. The opponent has selected section 5(2)(b) in its form TM7F against each of the marks it relies upon but in its statement of grounds it writes as follows:

“To the extent the applicant’s mark may be considered identical to the word mark SOMA since the stylisation is minimal, we also request that the opposition be considered under sections 5(1) and 5(2)(a).”

I intend to proceed, at least initially, on the basis of section 5(2)(b), given that this ground does not demand an identity between the competing marks. I will return to consider the matter of identity only if it appears necessary.

## **Decision**

### **Section 5(2)(b)**

13. Section 5(2)(b) of the Act reads as follows:

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

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

14. Section 5A of the Act reads:

“5A 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.”

### **Section 5(2)(b) – Case law**

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

*Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;



(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

### **Comparison of goods and services**

16. The goods and services to be compared are set out at paragraphs 1 and 3 to this decision.

17. Section 60A of the Act provides:

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

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

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

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

18. 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.

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“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 (“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”.

20. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so<sup>1</sup>.

**Instant messaging software; computer software for remote telecommunication; computer software for remote conference (class 9)**

21. The opponent relies upon *online social networking services* in class 45. Whilst I acknowledge a natural distinction between goods and services, there is a similarity in the use of the respective goods and services, insofar as they will be accessed for communicative or networking purposes. Generally, the goods and services will be selected by the same users, though I accept that the opponent's services nod towards social use, whereas the goods in the applicant's specification are also utilised in professional environments to support business connections, for example. There may be a difference in the nature of the goods and services, as delivered, though there may be some similarity in the available functions. The trade channels through which the respective goods and services reach the market may not be shared and there is not necessarily a competitive relationship to be found. With regards complementarity, the aforementioned goods may be relied upon for the wider provision of *online social networking services* which may offer an opportunity for instant messaging, for example. The average consumer may, given such a relationship, expect a single origin to provide both the goods and services simultaneously. Weighing all factors, I find the similarity to be of a medium degree.

**Downloadable computer software for remote monitoring and analysis (class 9)**

22. In the absence of any explanation or insight as to what the above term refers to, in practice, I will apply my own understanding. I understand the above to likely refer to software which enables the user to remotely access, or monitor the activity of, another computer or user, for example. When considered against the use of the opponent's *online social networking services*, I see little similarity. The opponent's services are used to interact or share information in an online social environment, whereas the applicant's will be used to monitor and analyse the activity of another account. There

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<sup>1</sup> *Separode Trade Mark* decision, BL O-399-10 (AP)

is likely to be a distinction in the services' users. The opponent's services are likely to be accessed by members of the general public and the applicant's by entities intending to, likely for professional purposes, monitor or analyse the activity on an external account. The trade channels are unlikely to be shared and I see little opportunity for similarity in nature. The services are not competitive and I do not consider them complementary. To my knowledge, they would not typically be provided by a single entity and they are not indispensable for one another, though I do accept that providers of *online social networking services* may, in some circumstances, carry out a degree of activity monitoring, for example, to check for unacceptable behaviour or adherence to terms of use, for example. Still, I do not consider that sufficient for a finding of similarity. I find the services dissimilar.

### **Downloadable software for virtual currency (class 9)**

23. In respect of the above goods, the opponent relies upon, for example, *financial management; credit services through individual financial companies* and *e-wallet payment services* in class 36. The opponent agrees with the applicant that "*there is a difference in view of the guaranteed value of real currency versus the lack of guarantee for a virtual currency*" but "*in any other way virtual and real currencies are used in the same way and for the same transactions. For example, cryptocurrencies such as Bitcoin can be used to purchase goods.*" The use of the respective goods and services may be distinct, but there is likely to be some similarity in their users; those looking to access *e-wallet payment services*, for example, would likely be the same, to an extent, to those looking to access *downloadable software for virtual currency*. There is little similarity in nature and the trade channels are unlikely to be the same, though there are circumstances whereby the applied-for goods may be utilised or relied upon as part of the provision of the opponent's services. The goods and services are not competitive. There may be an expectation for a single entity to offer the goods and services simultaneously and, whilst they may in some circumstances be used alongside one another, they aren't necessarily indispensable. I find a low degree of similarity.

### **Business networking (class 35)**

24. The opponent relies upon *online social networking services*. The respective services share a use insofar as each is intended to allow the consumer to network, though the settings are different, one social and one professional. That may create somewhat of a distinction in the respective users, though the services are not exclusive. The trade channels may differ, to a degree, but there will likely be some similarity in the nature of the services, to support a 'networking' function. The services are not competitive and are not indispensable, though the consumer may expect the respective services to originate from a single entity, offering networking services in a variety of settings. Weighing all factors, I find a medium degree of similarity.

**Wholesale services in relation to instant messaging software; retail services in relation to instant messaging software; wholesale services in relation to software for online messaging; retail services in relation to software for online messaging; wholesale services in relation to computer software for remote telecommunication; retail services in relation to computer software for remote telecommunication; wholesale services in relation to communications software for connecting global computer networks; retail services in relation to communications software for connecting global computer networks; wholesale services in relation to computer software for use in providing multiple user access to a global computer information network; retail services in relation to computer software for use in providing multiple user access to a global computer information network; wholesale services in relation to computer software for transmission of sound and video messages; retail services in relation to computer software for transmission of sound and video messages; wholesale services in relation to video conference system; retail services in relation to video conference system (class 35)**

25. The aforementioned services concern the retail or wholesale of software or systems intended to perform functions which, to my knowledge, are likely to be useful in the provision of (the opponent's) *online social networking services*. The uses of the services are not the same; the opponent's services will be accessed to allow users to communicate socially online whereas the applicant's services are accessed for the buying or selling of a specific software or system. There may be some degree of correlation in the respective users, though not exclusively. The nature of the services

is dissimilar and the trade channels are likely to be distinct. I do not consider the services competitive though, given what I have said regarding the functions of the goods retailed in the applicant's services being utilised in online networking, the services could be used subsequently, with the relevant software or system purchased ahead of access to online networking services. There could therefore be an element of indispensability, though the average consumer may not expect the services to typically be offered by a single entity. I find a very low degree of similarity.

### **Appointment scheduling services [office functions] (class 35)**

26. When considering the above services against the opponent's *online social networking services*, I find the respective uses are dissimilar. The opponent's are used to socialise online whereas the applicant's are used to schedule or manage appointments, with the term indicating that such appointments are expected to be conducted in an office environment. There may be some crossover in the respective users, though the services are used in different settings. The nature of the services is unlikely to have any tangible similarity. Whilst I accept that some social networks may allow users to make or diarise appointments, these are unlikely to be office-related, per se. The trade channels are unlikely to be the same and the services are not competitive. The services are not indispensable and, notwithstanding what I have said regarding the ability to diarise appointments whilst socially networking, given that the applicant's services are intended to be an 'office function', it seems unlikely that the average consumer would expect the services to originate from a shared or related undertaking. On balance, I find the services are not similar.

### **Providing assistance in the field of business organization (class 35)**

27. The opponent relies upon *financial management and advisory, consultancy and information services* related to the same. The services may be accessed for different purposes, on the face of it, though the applicant's services could feasibly incorporate an element of financial assistance or intervention, to support the organisation of the wider business. The applicant's services will likely be accessed specifically by those responsible for a business and the selection will be approached from a professional perspective. The opponent's services have a broader remit and, whilst they may be

selected by a professional entity or business, they are also likely to be of interest to members of the general public, specifically those looking for guidance in how to effectively manage their finances. The trade channels may vary but, given what I have said regarding the incorporation of a financial element in the applied for services, there could be an opportunity for crossover in the services' nature. The services are not directly competitive and there may be an element of complementarity, given the relationship between the two, though they may not be strictly indispensable. I find the services similar to between a low and medium degree.

**Providing access to an online virtual community via the internet/mobile (class 38)**

28. The opponent relies upon *online social networking services*. When considered against the aforementioned services, there is a degree of similarity in the services' use, which will generally be engaged for the purpose of communicating with peers, though I accept that the nature of the 'community' in the applicant's services is unspecified. I would expect the users of the respective services to be shared and for a degree of similarity to exist between the nature of the services. There may also be some crossover in the trade channels through which the services reach the market. The services are not necessarily competitive, though there could be a complementary relationship insofar as the average consumer may expect the services to be provided by a single or related origin. I find the similarity fairly high.

**Providing access to platforms on the Internet, as well as on the mobile Internet (class 38)**

29. With regards the above, the opponent contends that "online social networking is akin to providing access to platforms on the internet and so should... be considered similar" and I note its reference to trade mark decision BL O-693-21 in which *providing access to platforms on the internet* was found similar to services including *providing instant messaging services* and *chat room services for social networking*. I am not bound by that decision and, nonetheless, the respective services are not identical. In the case of the above, the services are likely to be accessed by the same users, broadly speaking, though the uses are not necessarily the same. The internet will be

accessed for a wide array of purposes and in a variety of settings. Given that the opponent's services are available online specifically, and given the broad nature of the applicant's term regarding unspecified internet platforms, there could be some element of similarity in the services' nature. The services are not necessarily competitive but could be provided by a single entity, share a degree of complementarity and move via the same trade channels. I find the services similar to a medium degree.

**Electronic transmission of instant messages and data; providing instant messaging services; transfer of data via on-line services (class 38)**

30. Whilst the opponent's services are intended to be used for networking and the applicant's more narrowly for the exchange or sharing of information, the above services are likely to be an integral part of the delivery of *online social networking services*. The users of the respective services are likely to be the same and there will be some overlap in the nature of the services, though the opponent's services are broader and likely represent a wider range of functions. There may be an element of similarity in the trade channels the services occupy and, given what I have found regarding the potential similarities in the services' functions or use, there could be an element of competitiveness where a consumer is considering its options for communication. The services may not be strictly indispensable but could be used simultaneously and the average consumer may expect a provider of *online social networking services* to offer, as part of those services, a messaging or data transfer function. I find the similarity of a fairly high degree.

**Network conferencing services; videoconferencing services via the internet; teleconferencing services; communication services for remote conferences; web conferencing services; audio teleconferencing services; teleconferencing and video conferencing services (class 38)**

31. The above services enable users to communicate via conferencing facilities, including via telephone and video. The opponent's *online social networking services* likely comprise a wider variety of functions, though those are likely to include networking facilities such as those set out above; both will be used, to a degree, to communicate. The users of the respective services are likely to overlap significantly



and, given the relationship identified, there could be an element of similarity in nature whereby each of the services offers the user an opportunity to communicate via video, for example. There may be some crossover in the trade channels occupied by the respective services and it would not necessarily be unusual for a single entity to offer both, or at least to offer services such as those applied for, as part of an online social networking service. There could be an opportunity for competitiveness, though not exclusively and there is a degree of complementarity in circumstances whereby the applicant's services are integral to the delivery of those relied upon. I find at least a medium degree of similarity.

**Software as a service [SaaS] (for video conference/ network meeting/ web conferencing/ teleconferencing/ instant messaging and data transmission); providing paas (platform as a service) (for video conference/ network meeting/ web conferencing/ teleconferencing/ instant messaging and data transmission) (class 42)**

32. The opponent submits that the applicant's class 42 services should be considered similar to the opponent's class 45 services (specifically *online social networking services*) on the basis that they "include services relating to networking etc." The applicant's services entail the provision of software for various functions which are likely to be similar to those utilised in *online social networking services*; video conference and instant messaging, for example. There could be some similarity in the services' use, insofar as those end functions are shared, but to only a limited degree. The users may be somewhat shared, though the applicant's may be selected by businesses, for example, in addition to members of the general public. The respective trade channels are unlikely to be shared and there is a distinction in the nature of the services, as delivered. The services are not competitive nor are they indispensable, though they may ultimately be used alongside one another, with the software itself used to support the opponent's networking services. I find a low degree of similarity.



### **Comparison of marks**

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

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

34. It would be wrong, therefore, to dissect the trade marks artificially, 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.

35. The respective trade marks are shown in the table below:

Opponent's trade marks	Applicant's trade mark
UKTM 3472188:  <b>SOMA</b>  UKTM 3472183:  	

UKTM 3472173:



36. The opponent's mark ending '188 comprises a single word of four letters (SOMA). Its overall impression resides solely in the word itself.

37. In its mark ending '183, the word SOMA is presented in white in a standard font, in upper case, and sits atop a square black background. The figurative detail makes a small contribution to the mark's overall impression, but the word SOMA carries a greater weight.

38. The opponent's mark ending '173 comprises a rectangular background, in black, with a white inner border, positioned at the bottom of which is the word SOMA, in an unremarkable upper case font, in white. The figurative depiction plays a role in the overall impression of the mark, but the word SOMA is the mark's most dominant element.

39. The applicant's mark comprises only a word of four letters (SOMA). The font is slightly stylised, though not to a great extent. The mark's overall impression lies predominantly in the word SOMA.

#### **The opponent's mark ending '188**

40. Visually, the marks coincide in the word SOMA. Without overlooking the stylisation applied to the font in the applicant's mark, visually, I find the marks highly similar.

41. Aurally, the earlier mark will likely be articulated in two syllables; SO-MAH. I find the later mark likely to be articulated in exactly the same way. The marks are aurally identical.

42. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer<sup>2</sup>. Conceptually, the opponent's mark is unlikely to convey a specific meaning. To my knowledge, SOMA is not an ordinary dictionary word with which the average consumer will be familiar. Instead, it will likely be viewed as an invented word absent of any concept. As the word is identical, I apply the same reasoning to my consideration of the applicant's mark. Both marks will be viewed as invented words with no conceptual insight.

### **The opponent's mark ending '183**

43. Visually, both marks share an identical element in the word SOMA (albeit presented in a stylised font in the applicant's mark). The marks differ in the figurative presentation adopted in the opponent's mark, and the absence of such in the applicant's. That said, keeping in mind what I have said regarding the marks' overall impressions, I find the visual similarity fairly high.

44. Aurally, given that the mark's background is unlikely to be articulated, I find the opponent's mark likely to be articulated in the same way as its word-only mark, which I have considered above. Consequently, as per my earlier finding, I find the respective marks will be articulated identically; SO-MAH.

45. Similarly, the background shown in the opponent's mark is unlikely to add any conceptual clarity, for which consumers will look to the word 'SOMA'. I have already found it likely to be viewed as an invented word. I find both marks absent of any concept able to be grasped by the average consumer.

### **The opponent's mark ending '173**

46. Visually, the marks share an identical element in the word SOMA. The font is slightly stylised in the applicant's mark and, in the opponent's mark, the word is positioned against a black rectangular background with a white border. Notwithstanding those differences, I find the marks visually similar to between a medium and fairly high degree.

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<sup>2</sup> *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

47. Aurally, the earlier mark is likely to be pronounced identically to the previous two. I find the competing marks aurally identical.

48. Conceptually, the earlier mark will not carry any meaning. SOMA will be viewed as an invented word and the mark's embellishment provides no additional insight. Neither of the respective marks conveys a concept identifiable to the average consumer.

### **Average consumer and the nature of the purchasing act**

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

50. 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.”

51. The average consumer of the goods and services at issue is likely to comprise both members of the general public and professional bodies, including businesses. In regards to the goods, the marks will likely be seen by consumers on labels of the goods in the relevant retail environment, or the pages of a catalogue. The services are likely selected from a catalogue or online resource. That said, I do not overlook the opportunity for word-of-mouth recommendations, for example, and the relevance of the marks' aural impressions. In approaching its selection, the average consumer will

consider factors such as function, compatibility and the provider's reputational standing. The selection of the goods and services is unlikely to be made with any meaningful degree of frequency and the costs are variable, with goods such as *instant messaging software* likely to command a fairly small cost but services such as *providing assistance in the field of business organization* carrying a significantly higher price. Weighing all considerations, I find the average consumer, be it a personal or professional exchange, will apply between a medium and high degree of attention.

### **Distinctive character of the earlier trade marks**

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

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

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

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

54. In the absence of evidence showing the use made of the earlier marks, I have only their inherent distinctiveness to consider. Each of the earlier marks incorporate (or consist solely of) the word SOMA. I have found that the average consumer will view SOMA as an invented word and, consequently, in the absence of a specific concept, I do not consider the marks to carry any allusive or descriptive qualities when considered against the services relied upon. Whilst the figurative embellishments adopted in the opponent's second and third mark make a contribution to each mark's distinctive character, it is fairly small, and their overall impressions lay predominantly in the word SOMA. Still, I find each of the marks relied upon to possess a high degree of inherent distinctiveness.

### **Likelihood of confusion**

55. For those services where I have failed to find any similarity, the opposition fails at this juncture. If there is no similarity, there is no likelihood of confusion to be considered<sup>3</sup>.

56. 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 vice versa. As I mentioned above, it is

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<sup>3</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA; *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

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

58. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he 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.””

59. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

60. The marks' visual similarity ranges from between a medium and fairly high degree to a high degree and they are aurally identical. Conceptually, the word SOMA will not signify any particular meaning and instead will be viewed as an invented word and I have found each of the respective marks' overall impressions to reside predominantly,



if not solely, in the common element SOMA. With that in mind, whilst I acknowledge that I have found the average consumer will apply between a medium and high degree of attention to its selection of the goods and services, even where its attention is elevated, I find it likely that wherever the goods or services are similar, the average consumer would mistake one mark for the other, particularly in the case of the applicant's word-only mark. Though invented words may be more difficult to recall (than dictionary words), the marks' common word, SOMA, is relatively short and the consumer will likely believe the parties' respective marks to be the same when encountering them in the relevant marketplace, in a related field, keeping in mind that the purchase is unlikely to be made particularly frequently. 'SOMA' is what makes the greatest impact on the consumer and, in my view, the marks' stylistic differences could easily be overlooked.

61. If I am found to be incorrect in my finding of direct confusion, I move now to consider a likelihood of indirect confusion. A likelihood of indirect confusion operates on the presumption that the average consumer identifies that the marks are not the same and readily acknowledges their differences. In the case of the marks at hand, the differences in the various marks are the figurative embellishments; specifically the background details in the second and third of the opponent's marks and the style of font adopted in the applicant's mark. I have found such embellishments to play a lesser role in regards the marks' overall impressions which, in every mark, is dominated by the word SOMA. In my view, given their nature, if identified, the marks' differences would likely be considered indicative of a stylistic variation or simply a decorative addition. They will nonetheless be seen as 'SOMA' marks and the average consumer would likely reach the erroneous conclusion that they originate from a single or related undertaking. In other words, indirect confusion would arise.

62. Given that I have found a likelihood of confusion under section 5(2)(b) of the Act, at least wherever similarity has been identified between the respective specifications, it would appear to be of no real benefit to the opponent if I were to go on to assess the merits of its claim to identity in any real detail. Where the opposition has failed, it has failed on the basis that I have found no similarity between the respective goods or services, and the position would therefore be unaltered were I to have approached the comparison on the basis of identical marks under section 5(2)(a).

## Conclusion

63. The opposition has failed in respect of the following and, subject to any successful appeal, the application will proceed to registration in regards:

*Class 9: Downloadable computer software for remote monitoring and analysis*

*Class 35: Appointment scheduling services [office functions]*

64. The opposition has succeeded in respect of the following and, subject to any successful appeal, the application will be refused in regards:

*Class 9: Instant messaging software; computer software for remote telecommunication; computer software for remote conference; downloadable software for virtual currency.*

*Class 35: Business networking; providing assistance in the field of business organization; wholesale services in relation to video conference system; retail services in relation to video conference system; wholesale services in relation to instant messaging software; retail services in relation to instant messaging software; wholesale services in relation to computer software for remote telecommunication; retail services in relation to computer software for remote telecommunication; wholesale services in relation to software for online messaging; retail services in relation to software for online messaging; wholesale services in relation to computer software for use in providing multiple user access to a global computer information network; retail services in relation to computer software for use in providing multiple user access to a global computer information network; wholesale services in relation to communications software for connecting global computer networks; retail services in relation to communications software for connecting global computer networks; wholesale services in relation to computer software for transmission of sound and video messages; retail services in relation to computer software for transmission of sound and video messages.*

*Class 38: Providing access to an online virtual community via the internet/mobile; network conferencing services; videoconferencing services via the internet; teleconferencing services; communication services for remote conferences; electronic transmission of instant messages and data; providing instant messaging services; web*

*conferencing services; audio teleconferencing services; teleconferencing and video conferencing services; providing access to platforms on the Internet, as well as on the mobile Internet; transfer of data via on-line services.*

*Class 42: Software as a service [SaaS] (for video conference/ network meeting/ web conferencing/ teleconferencing/ instant messaging and data transmission); providing paas (platform as a service) (for video conference/ network meeting/ web conferencing/ teleconferencing/ instant messaging and data transmission).*

## **COSTS**

65. Both parties have achieved a measure of success, with the greater amount going to the opponent, who is entitled to a contribution toward its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis (reduced accordingly):

Filing a Notice of Opposition (official fee):	£100
Preparing a Notice of Opposition and considering the counterstatement:	£150
Preparing written submissions:	£150
<b>Total:</b>	<b>£400</b>

**59. I order Zigbang Co., Ltd to pay Francisco Javier Sordo Madaleno Bringas the sum of £400. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 11<sup>th</sup> day of November 2022**

**Laura Stephens**

**For the Registrar**