

**BL O/0087/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. UK3706849  
IN THE NAME OF EARTHMARK SOLUTIONS LIMITED  
TO REGISTER AS A TRADE MARK**

**Earthmark**

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

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 430800  
BY EARTH MARKET SA**

## BACKGROUND AND PLEADINGS

1. On 05 October 2021, Earthmark Solution Limited (“the applicant”) applied to register trade mark number UK3706849 for the word mark “Earthmark” in the United Kingdom. The application was accepted and published for opposition purposes on 05 November 2021, in respect of the following goods and services:

Class 9: *Downloadable software and hardware, including for analysing the sustainability practices of businesses and for analysing, evaluating and comparing companies.*

Class 35: *Updating, compilation, systemisation, sorting, editing and inputting of information in databases; Compilation of statistical information for trade and business purposes; Market research and analysis; Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing third party transaction descriptions; Business management and business administration, namely analysis, evaluation, comparison and consultancy with regard to companies, including companies' sustainability practices; Providing reviews and ratings of commercial goods and services; Preparation of statistical trade and business information.*

Class 38: *Telecommunication; Providing online forums via global computer networks for the exchange of reviews, ratings and user experiences.*

Class 42: *Design, development and maintenance of computer software, including updating of computer programs; Computer programming; Providing search engines on the Internet; Preparation, maintenance and updating of search engines (software) on telecommunications networks.*

2. The application is opposed by Earth Market SA (“the opponent”). The opposition was filed on 04 February 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following marks:

## **EARTH MARKET**

UK trade mark registration number 801423945

Filing date: 11 June 2018

Priority date claimed: 31 May 2018

Registration date: 25 February 2019

Registered in Classes 29, 30, 31, 32, 33, 35, 39, 41 & 43

Relying on some services in classes 35 and 41 only, namely:

Class 35: *Advertising; commercial business management; commercial administration; office functions; dissemination of advertising material (leaflets, prospectuses, printed matter, samples); newspaper subscription services (for others); arranging subscriptions to telecommunication services for others; presentation of goods on all communication media, for retail sale; business management and organization consultancy; accounting; document reproduction; employment agency services; business management for freelance service providers; computerized file management service; web site traffic optimization; organization of exhibitions for commercial or advertising purposes; online advertising on a computer network; rental of advertising time on all communication media; publication of advertising texts; rental of advertising space; dissemination of advertisements; advice regarding communication (advertising); public relations; advice regarding communication (public relations); company audits (commercial analyses); commercial intermediation services.*

Class 41: *Education; training; entertainment; sporting and cultural activities, information relating to entertainment; information relating to education; vocational retraining; provision of recreational facilities; publication of books; book lending; provision of non-downloadable films via video-on-demand services; motion picture production; rental of television sets; rental of show scenery; photography services; organization of competitions (education or entertainment); organization and conducting of colloquiums; organization and conducting of conferences;*

*organization and conducting of congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; game services provided on-line from a computer network; gambling services; electronic publication of books and journals online.*

(**Mark 1**); and



International Registration No.: WO00000001569417

International Registration date: 11 June 2020

Based on Swiss Trade Mark No. 747805 with a Priority date of 22 May 2020

UK Date of Designation: 11 June 2020

Date protection conferred in the UK: 19 August 2021

Protected for goods and services in Classes 1, 9, 29, 30, 31, 32, 33, 35, 39, 41 & 43.

Relying on some goods and services in classes 9, 35 and 41 only, namely:

Class 9: *Downloadable or recorded media, software, blank digital or analog recording and storage media.*

Class 35: *Advertising; commercial business management; commercial administration; office functions.*

Class 41: *Education; training; entertainment; sporting and cultural activities.*

(**Mark 2**).

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing

registered EUTM or International Trade Mark designating the EU. As a result, the opponent's Mark 1, which is based on the EU designation of the International Registration ("IR") 1423945, was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.<sup>1</sup>

4. The opponent submits that the dominant and distinctive element of its Mark 2 is the words "EARTH MARKET". It submits that both the earlier marks are highly similar to the contested mark as they differ only by the last two letters, and that the lack of space between "EARTH" and "MARK" is irrelevant. Although it admits that the competing marks are conceptually different, overall it submits that there is a close similarity between the marks, and that the applicant's mark covers identical and/or similar goods and services to the opponent's marks. It therefore submits that there is a likelihood of confusion which includes a likelihood of association. It requests that the contested 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. It submits that the space and extra letters in the earlier marks are significant, and that the difference conceptually between "MARK" and "MARKET" has been conceded by the opponent. It further submits that the goods and services covered by the opposing marks are significantly different. In light of the differences between the marks and the goods and services, the applicant submits that there is no likelihood of confusion or association and requests that the application proceed to registration and an award of costs be made in favour of the applicant.<sup>2</sup>

6. Only the opponent filed written submissions, which will be referred to as and where appropriate during this decision, and only the applicant elected to file evidence.

---

<sup>1</sup> See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

<sup>2</sup> I note that as the applicant is unrepresented, it was invited to complete a costs pro-forma outlining the number of hours spent on the different stages of this opposition. The completed pro-forma was returned by the applicant and shall therefore be taken into account as appropriate, subject to the outcome of this decision.

Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Wynne-Jones IP Limited and the applicant is unrepresented.

## **PRELIMINARY ISSUES**

8. I note that in its written submissions, the opponent refers to the witness statement of Jack Linnett for the applicant, and in particular the exhibit attached to the witness statement labelled as Exhibit JL3, which comprises correspondence between the applicant and the representatives of the opponent, relating to possible settlement of the matter before me. The opponent submits that the discussions are privileged and should not have been disclosed without the agreement of both parties, and it requests that the comments by Mr Linnett regarding the same should be disregarded. In *Unilever PLC v The Procter & Gamble Company*, Walker LJ quoted Lord Griffiths as stating in *Rush & Tompkins v Greater London Council* ((1989) AC 1280 at 1299):

“The ‘without prejudice’ rule is a rule governing the admissibility of evidence and is founded upon the public policy of encouraging litigants to settle their differences rather than litigate them to a finish. It is nowhere more clearly expressed than in the judgment of Oliver LJ in *Cutts v Head* (1984) Ch. 290 at 306:

That the rule rests, at least in part, upon public policy is clear from many authorities, and the convenient starting point of the inquiry is the nature of the underlying policy. It is that parties should be encouraged as far as possible to settle their disputes without resort to litigation and should not be discouraged by the knowledge that anything that is said in the course of such negotiations (and that includes of course, as much the failure to reply to an offer as an actual reply) (my emphasis) may be used to their prejudice in the course of the proceedings.”

9. Accordingly, I will make no further reference to the applicant's submissions on this matter.

## **APPLICANT'S EVIDENCE**

10. The applicant's evidence consists of seven witness statements.

11. The first witness statement is by Jack Linnett, who is a director of Earthmark Solutions Limited, being the applicant in these proceedings. The witness statement is dated 7 September 2022, to which there are attached four exhibits, labelled **Exhibit JL1** to **Exhibit JL4**. The main purpose of the evidence is to support the applicant's submissions that the competing marks are significantly different and are able to exist without a likelihood of confusion on the part of the consumer.<sup>3</sup>

12. The second witness statement is by Hedley Smith, the company director of HOMEBOX.IO LTD, which Mr Smith states has an existing partnership agreement with the applicant. The witness statement is dated 19 August 2022, to which there are attached four exhibits, labelled **Exhibit HS1** to **Exhibit HS4**.

13. The third witness statement is by Roger Seed, being the director of Proseed Consulting Limited. The witness statement is dated 25 August 2022, to which there are attached two exhibits, labelled **Exhibit RS1** to **Exhibit RS2**.

14. The fourth witness statement is by Martyn Sellers, a partner of K & MP Sellers. The witness statement is dated 27 August 2022, to which there are attached two exhibits, labelled **Exhibit MS1** to **Exhibit MS2**.

15. The fifth witness statement is by Martyn John Rhodes, a partner of MJ and J RHODES. The witness statement is dated 21 August 2022, to which there are attached two exhibits, labelled **Exhibit MJR1** to **Exhibit MJR2**.

---

<sup>3</sup> I note Mr Linnett's references to the reputation, or lack thereof, of the opponent's mark and the cited case law in relation to the reputation of an earlier mark. However, as these proceedings are based upon Section 5(2)(b) of the Act, and not Section 5(3), this is not pertinent to the issues before me. As such, I take no account of any such submissions when making my decision.

16. The sixth witness statement is by Jag Minhas, CEO of Sensing Feeling Limited. The witness statement is dated 6 September 2022, to which there are attached two exhibits, labelled **Exhibit JM1** to **Exhibit JM2**.

17. The seventh witness statement is by Mike Gadd, the Chief Operating Officer of Kindred Soul Ltd. The witness statement is dated 9 August 2022, to which there are attached four exhibits, labelled **Exhibit MG1** to **Exhibit MG4**.

18. The main purpose of the evidence by way of the second – seventh witness statements and accompanying exhibits is to demonstrate that the respective parties' goods and services are marketed in different fields, and that there is a lack of actual confusion between the marks on the part of the average consumer.

19. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the course of the decision.

## **DECISION**

20. 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)**

21. The opposition is based upon Section 5(2)(b) of the Act, which read 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”.

22. 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.”

23. 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 or international trade mark (UK) 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,

...

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

...”

24. Each of the trade marks upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As neither of the trade marks had been registered/protected 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 and services indicated without having to prove that genuine use has been made of them.

25. 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 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 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**

26. 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.”

27. I am therefore mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

28. The goods and services to be compared are:

Opponent’s services Mark 1	Opponent’s goods and services Mark 2	Applicant’s goods and services
	<u>Class 9</u> <i>Downloadable or recorded media, software, blank digital or analog recording and storage media.</i>	<u>Class 9</u> <i>Downloadable software and hardware, including for analysing the sustainability practices of businesses and for analysing, evaluating and comparing companies.</i>
<u>Class 35</u> <i>Advertising; commercial business management; commercial administration; office functions; dissemination of</i>	<u>Class 35</u> <i>Advertising; commercial business management; commercial administration; office functions.</i>	<u>Class 35</u> <i>Updating, compilation, systemisation, sorting, editing and inputting of information in databases; Compilation of statistical</i>

<p><i>advertising material (leaflets, prospectuses, printed matter, samples); newspaper subscription services (for others); arranging subscriptions to telecommunication services for others; presentation of goods on all communication media, for retail sale; business management and organization consultancy; accounting; document reproduction; employment agency services; business management for freelance service providers; computerized file management service; web site traffic optimization; organization of exhibitions for commercial or advertising purposes; online advertising on a computer network; rental of advertising time on all communication media; publication of advertising texts; rental of advertising space; dissemination of advertisements; advice regarding communication (advertising); public relations; advice regarding communication (public</i></p>		<p><i>information for trade and business purposes; Market research and analysis; Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing third party transaction descriptions; Business management and business administration, namely analysis, evaluation, comparison and consultancy with regard to companies, including companies' sustainability practices; Providing reviews and ratings of commercial goods and services; Preparation of statistical trade and business information.</i></p>
---	--	---

<p><i>relations); company audits (commercial analyses); commercial intermediation services.</i></p>		
		<p><u>Class 38</u>  <i>Telecommunication; Providing online forums via global computer networks for the exchange of reviews, ratings and user experiences.</i></p>
<p><u>Class 41</u>  <i>Education; training; entertainment; sporting and cultural activities, information relating to entertainment; information relating to education; vocational retraining; provision of recreational facilities; publication of books; book lending; provision of non-downloadable films via video-on-demand services; motion picture production; rental of television sets; rental of show scenery; photography services; organization of competitions (education or entertainment); organization and conducting of colloquiums; organization and conducting of conferences;</i></p>	<p><u>Class 41</u>  <i>Education; training; entertainment; sporting and cultural activities.</i></p>	

<p><i>organization and conducting of congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; game services provided on-line from a computer network; gambling services; electronic publication of books and journals online.</i></p>		
		<p><u>Class 42</u>  <i>Design, development and maintenance of computer software, including updating of computer programs; Computer programming; Providing search engines on the Internet; Preparation, maintenance and updating of search engines (software) on telecommunications networks.</i></p>

29. 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”.<sup>4</sup>

---

<sup>4</sup> Paragraph 29

30. 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”.<sup>5</sup>

31. 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.

32. 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”.<sup>6</sup>

33. 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:

---

<sup>5</sup> Paragraph 23

<sup>6</sup> Paragraph 82



“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 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.”<sup>7</sup>

34. 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.”<sup>8</sup>

35. 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.”

36. In its written submissions, the opponent has provided examples of where it states that the opposed goods and services are identical and/or similar to the opponent’s goods and services.<sup>9</sup> I do not intend to fully reproduce those submissions here, however, I have taken them into consideration in making my own comparisons.

---

<sup>7</sup> Paragraph 5

<sup>8</sup> Paragraph 12

<sup>9</sup> See, in particular, paragraphs 34 – 37, and the comparison table under paragraph 38 of the submissions dated 15 November 2022.

## Class 9

*Downloadable software and hardware, including for analysing the sustainability practices of businesses and for analysing, evaluating and comparing companies.*

37. Whilst I note that the applicant's "*Downloadable software and hardware*" includes goods which are for analysis and evaluation purposes, the broad term is not limited to these functions. Consequently, I consider the applicant's "*Downloadable software and hardware, including for analysing the sustainability practices of businesses and for analysing, evaluating and comparing companies*" to encompass the opponent's "*Downloadable or recorded media, software, blank digital or analog recording and storage media*" as included in the Class 9 specification of its Mark 2, and I therefore find the competing goods identical as per the principle outlined in *Meric*.

38. However, I do not find any similarity between the applicant's aforementioned goods with any of the services being relied upon by the opponent under its Mark 1.

## Class 35

*Business management and business administration, namely analysis, evaluation, comparison and consultancy with regard to companies, including companies' sustainability practices.*

39. I consider the applicant's "*Business management and business administration, namely analysis, evaluation, comparison and consultancy with regard to companies, including companies' sustainability practices*" to be encompassed within the opponent's broader term "*commercial business management*" (Marks 1 & 2) and therefore find the services to be identical as per *Meric*.

*Updating, compilation, systemisation, sorting, editing and inputting of information in databases.*

40. I consider the above services to be encompassed within the broad term "*computerized file management service*", as included in the Class 35 specification of

the opponent's Mark 1, rendering the services identical, as per the guidelines outlined in *Meric*.

41. It could be argued that the broad term "*office functions*", as included in the Class 35 specification of the opponent's Mark 2 encompasses the applicant's "*Updating, compilation, systemisation, sorting, editing and inputting of information in databases*", and therefore should be considered identical as per *Meric*. In *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, Case C-307/10, the CJEU held that the use of the general indications of the class headings of the Nice Classification may be acceptable<sup>10</sup>, and thus the terms within the registration were accepted at examination stage. However, in relation to this opposition, I also note the guidance outlined in *Avnet* regarding broad specifications. In my view, while there is likely to be an overlap in users of the respective services, as well as in channels of trade, I do not consider "*Updating, compilation, systemisation, sorting, editing and inputting of information in databases*" to be at the core of "*office functions*" to the extent that the average consumer would automatically expect the respective services to be provided by the same or economically linked undertakings. I therefore find there to be a low degree of similarity between the services.

#### *Market research and analysis.*

42. I consider that the applicant's "*Market research and analysis*" may be an additional service offered by the opponent alongside its "*Advertising*" services, as included in the Class 35 specification of both its earlier marks. The respective services are closely allied, and are similar in nature, purpose and channels of trade to the extent that it would be reasonable for the average consumer to believe that the responsibility for the services lie with the same or commercially linked undertakings. I therefore find "*Market research and analysis*" to be similar to "*Advertising*" to a medium degree.

*Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing third party transaction descriptions.*

---

<sup>10</sup> At [64].

43. The opponent submits that the above services are identical to its “*commercial intermediation services*” as included in Class 35 of the earlier Mark 1. To my understanding, the role of commercial intermediation is to act as a liaison, or broker to facilitate transactions between two businesses and as such, I consider that there would be an overlap in users of the respective services, as well as in channels of trade, although as stand-alone services, I do not consider them identical. Consequently, I consider the applicant’s “*Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing third party transaction descriptions*”, to be similar to “*commercial intermediation services*” to no more than a medium degree.

44. With regards to the opponent’s earlier Mark 2, there would be an overlap in users and channels of trade of its “*commercial business management*” and the applicant’s “*Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing third party transaction descriptions*”, although I do not consider the average consumer would necessarily expect the respective services to be provided by the same or commercially linked undertakings. I therefore find them similar to no more than a medium degree.

*Compilation of statistical information for trade and business purposes; Preparation of statistical trade and business information.*

45. The opponent submits that the above services are identical to its “*commercial business management*” and its “*commercial administration*”, as covered in class 35 of both its earlier marks. I cannot agree. To the best of my knowledge, “*commercial business management*” and “*commercial administration*” are terms which broadly speaking relate to activities such as sales, procurement, marketing and finance, although there does not seem to be a single clear definition for either term. Without further evidence to the contrary, I consider the applicant’s above services to be a stand-alone service separate to the core services offered under the opponent’s “*commercial business management*” and “*commercial administration*” as covered under Class 35 of both its Mark 1 and Mark 2. While there may be an overlap in users, I do not consider that the average consumer would expect the applicant’s “*Compilation of statistical information for trade and business purposes; Preparation*

*of statistical trade and business information*” to automatically form part of the general “*commercial business management*” and “*commercial administration*”, and I therefore find the respective services to be similar to a low degree.

*Providing reviews and ratings of commercial goods and services.*

46. The opponent submits that the above services are identical to its “*Advertising*” (Marks 1 & 2) and “*publication of advertising texts; dissemination of advertisements*” (Mark 1). I am mindful of the guidance regarding the correct approach to scrutinising services as per *Avnet*, and while there may be an overlap in end users, the essential nature and purpose of the respective services differ, the providers of which are likely to be specialists in their particular fields. I therefore find that if there is any similarity between the services, it is only to a low degree.

### Class 38

*Telecommunication.*

47. The opponent submits that the applicant’s “*Telecommunication*” is similar to certain of its own Class 35 services, including “*arranging subscriptions to telecommunication services for others*” (Mark 1), although it does not state to what degree. As guided by *Avnet*, I am reminded that services should not be given a wide construction. To my mind, “*Telecommunication*” involves the electronic transmission of information over distances, while the “*arranging subscriptions to telecommunication services for others*” may facilitate this to the same end user, the physical nature and methods of use of the respective services are different, the applicant’s services being of a technical service, while the opponent’s services relate to the arrangement of regular access to those services for an agreed price, and as such, in my view, is a sales service. Although the same provider could provide both services, the opponent’s services may also be provided by an independent ‘middle man’. Consequently, it would not be a foregone conclusion that both services would be provided by the same or economically linked undertakings. I find there to be a low degree of similarity between the services.

48. The opponent has made no comparison between any of the goods and services covered under its Mark 2 and the applicant's "*Telecommunication*", and I find nothing which is obviously similar to any of those goods and services being offered under classes 9, 35 and 41 of the earlier mark.

*Providing online forums via global computer networks for the exchange of reviews, ratings and user experiences.*

49. The opponent submits that the applicant's above services are similar to several of its own Class 35 services, including "*arranging subscriptions to telecommunication services for others*" (Mark 1). While a subscription service may be arranged in order to access the applicant's online forums, for the same reasons given at paragraph 47, I consider the opposing services to be similar to only a low degree.

50. Once again, I find no correlation between the applicant's aforementioned services and the opponent's goods and services being provided under classes 9, 35 and 41 of its Mark 2.

#### Class 42

*Design, development and maintenance of computer software, including updating of computer programs.*

51. While services are not the same as goods, I acknowledge the opponent's submission that its "*Downloadable or recorded media, software, blank digital or analog recording and storage media*" (in class 9 of its Mark 2) is similar to the contested "*Design, development and maintenance of computer software, including updating of computer programs*". I consider computer software to be the end result of its design and development, and as such, 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, 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. Considered overall, I consider there to be no more than a medium degree of similarity between the applicant's "*Design, development and maintenance of computer software, including updating of computer programs*" and the opponent's "*Downloadable or recorded media, software, ...*".

52. In relation to the services relied upon under the opponent's Mark 1, I find nothing which is obviously similar to the applicant's "*Design, development and maintenance of computer software, including updating of computer programs*".

#### *Computer programming.*

53. Again the opponent submits that there is similarity between the above services and its "*Downloadable or recorded media, software, blank digital or analog recording and storage media*" (under Class 9 of Mark 2). To my understanding, computer programming involves writing code to facilitate specific actions in a computer, application or software program, and instructs them on how to perform. With the absence of any opposing evidence, I consider computer programming to be a niche service which is one step removed from the design and development of the opponent's goods themselves, differing in nature, purpose and method of use to the end product. Overall, I consider "*Computer programming*" to be dissimilar to "*Downloadable or recorded media, software, blank digital or analog recording and storage media*".

54. I find nothing within the opponent's Class 35 and Class 41 of its Mark 1 which strikes me as being in any way similar to the applicant's "*Computer programming*".

#### *Providing search engines on the Internet.*

55. The opponent submits that the applicant's "*Providing search engines on the Internet*" is similar to its own "*online advertising on a computer network*" as relied upon under Class 35 of its Mark 1. Whilst a search engine is a software system designed to carry out web searches on the internet, and such search engines place paid adverts into the results based on the key words input into the search engine by

the user, the fundamental purpose of the competing services is different. I do not consider, as outlined in *Boston Scientific*, that there is a clear complementary relationship between “*Providing search engines on the Internet*” with the provision of “*online advertising on a computer network*”. Overall, I find the services at issue to be dissimilar.

56. For the same reasons as above, I find the applicant’s “*Providing search engines on the Internet*” to be dissimilar to the opponent’s broad term “*Advertising*” in Class 35 of its Mark 2.

*Preparation, maintenance and updating of search engines (software) on telecommunications networks.*

57. The opponent submits that “*Preparation, maintenance and updating of search engines (software) on telecommunications networks*” is similar to “*Downloadable or recorded media, software, blank digital or analog recording and storage media*” (under Class 9 of Mark 2), and “*online advertising on a computer network*” (under Class 35 of Mark 1). I disagree on both counts, since the earlier goods and services are different in nature, purpose and use to “*Preparation, maintenance and updating of search engines (software) on telecommunications networks*”, and while there may be an overlap in end users, they each share different trade channels. Neither do I consider the goods and services to be complementary or in competition with each other. I therefore find the respective goods and services at issue to be dissimilar.

58. 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.”

59. In relation to the goods and 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 goods and services, with the opposition failing to that extent.

60. For the sake of clarity, I summarise my findings on the goods and services comparison in the following table:

<b>Applicant’s goods and services</b>	<b>Opponent’s Mark 1 comparison</b>	<b>Opponent’s Mark 2 comparison</b>
<b>Class 9</b>		
<i>Downloadable software and hardware, including for analysing the sustainability practices of businesses and for analysing, evaluating and comparing companies.</i>	<b>Dissimilar to all services</b>	<b>Identical to <i>Downloadable or recorded media, software, blank digital or analog recording and storage media.</i></b>
<b>Class 35</b>		
<i>Business management and business administration, namely analysis, evaluation, comparison and consultancy with regard to companies, including companies' sustainability practices.</i>	<b>Identical to commercial business management.</b>	<b>Identical to commercial business management.</b>
<i>Updating, compilation, systemisation, sorting, editing and inputting of information in databases.</i>	<b>Identical to computerized file management service.</b>	<b>Similar to a low degree to office functions.</b>

<i>Market research and analysis.</i>	<b>Similar to a medium degree to Advertising.</b>	<b>Similar to a medium degree to Advertising.</b>
<i>Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing third party transaction descriptions.</i>	<b>Similar to no more than a medium degree to commercial intermediation services.</b>	<b>Similar to no more than a medium degree to commercial business management.</b>
<i>Compilation of statistical information for trade and business purposes; Preparation of statistical trade and business information.</i>	<b>Similar to a low degree to commercial business management; commercial administration.</b>	<b>Similar to a low degree to commercial business management; commercial administration.</b>
<i>Providing reviews and ratings of commercial goods and services.</i>	<b>Similar to a low degree to Advertising; publication of advertising texts; dissemination of advertisements.</b>	<b>Similar to a low degree to Advertising.</b>
<b>Class 38</b>		
<i>Telecommunication.</i>	<b>Similar to a low degree to arranging subscriptions to telecommunication services for others.</b>	<b>Dissimilar to all goods and services</b>
<i>Providing online forums via global computer networks for the exchange of reviews, ratings and user experiences.</i>	<b>Similar to a low degree to arranging subscriptions to telecommunication services for others.</b>	<b>Dissimilar to all goods and services</b>

<b>Class 42</b>		
<i>Design, development and maintenance of computer software, including updating of computer programs.</i>	<b>Dissimilar to all services</b>	<b>Similar to no more than a medium degree to</b> <i>Downloadable or recorded media, software, blank digital or analog recording and storage media.</i>
<i>Computer programming.</i>	<b>Dissimilar to all services</b>	<b>Dissimilar to all goods and services, including</b> <i>Downloadable or recorded media, software, blank digital or analog recording and storage media.</i>
<i>Providing search engines on the Internet.</i>	<b>Dissimilar to all services, including online advertising on a computer network.</b>	<b>Dissimilar to all goods and services, including Advertising.</b>
<i>Preparation, maintenance and updating of search engines (software) on telecommunications networks.</i>	<b>Dissimilar to all services, including online advertising on a computer network</b>	<b>Dissimilar to all goods and services, including</b> <i>Downloadable or recorded media, software, blank digital or analog recording and storage media.</i>

### **The average consumer and the nature of the purchasing act**

61. 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”.<sup>11</sup>

62. 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.

63. In my view, the average consumer for the competing goods will be both the general public and businesses in need of a particular type of software, while the average consumer of the services will be a professional user, such as commercial entities seeking, inter alia, business management and administration services, advertising services and bespoke software in order to run their businesses, and who may require services tailored to their specific business needs.

64. The goods and services are sold through a range of channels, including high street retail outlets, via the internet or through telesales. For both the goods and the services for which I found similarity under the competing marks, considerations such as customer and technical reviews, 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.

65. I consider that the goods are likely to be bought relatively frequently, where the general public as the consumer will pay at least a medium degree of attention to the initial choice, which I consider would be by predominantly visual means, although I do not discount aural considerations. The business consumer of the goods is likely to pay a higher than medium degree of attention during the purchasing act, as they will want to ensure that the software procured is appropriate to their particular business needs.

---

<sup>11</sup> Paragraph 60

66. The selection of the services is likely to follow a measured thought process and they are unlikely to be purchased casually or as a matter of routine. Such services will be purchased infrequently, although I recognise that the consumer may seek to review and upgrade existing specifications from time to time. The purchasing process for the services would be a combination of visual and aural; some consumers would seek information from brochures or the internet, whereas others would receive verbal advice from sales representatives, particularly in the case of telesales. 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.

### **Comparison of marks**

67. 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.”<sup>12</sup>

68. 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.

---

<sup>12</sup> Paragraph 34

69. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p><u>Mark 1</u></p> <p style="text-align: center;"><b>EARTH MARKET</b></p>	<p><b>Earthmark</b></p>
<p><u>Mark 2</u></p> 	

70. The opponent submits that with regards to its Mark 1, it is highly similar to the applicant's mark as they differ only by the last two letters, and that the lack of space between "EARTH" and "MARK" in the contested mark is irrelevant. It submits that the competing marks are visually and aurally highly similar, although it admits that they are conceptually different.

71. With regards to its Mark 2, the opponent submits that the dominant and distinctive element is "EARTH MARKET" as the average consumer tends to remember more the pronounceable element of a combined mark. Therefore, for the same reasons as its Mark 1, the competing marks are visually and aurally highly similar.

72. The applicant submits that the differences between the marks with regard to the space between the words and the additional letters of the earlier marks are significant, and that the competing marks are conceptually entirely different.

### **Overall impression**

73. The opponent's Mark 1 consists of two dictionary defined words, "EARTH" and "MARKET", presented in a standard typeface in capital letters. Neither word dominates, and as the mark contains no other elements, the overall impression therefore rests in the combination of the words themselves.

74. The opponent's Mark 2 consists of a number of elements. The words "Earth" and "Market", which are written in title case in a relatively standard white typeface, are positioned within a green infilled circle where each word follows the bottom curve of the circle from left to right. Between the words is a short vertical red line, and above the words are what the opponent describes as two coloured leaf shapes, one of which is of a paler green than the infilled circle in which it is set, and is overlaid with a larger red coloured 'leaf' shape, both shapes being outlined in white and with contrasting thin white curved horizontal lines within each "leaf". Although the device element takes up the greater area of the mark overall, in my view, the device and the words contribute equally to the overall impression.

75. The applicant's mark consists of the single word "Earthmark", presented in title case in a standard typeface without any other elements to contribute to the overall impression. In my view, a significant proportion of consumers would immediately construe the proprietor's mark as two distinct, dictionary-defined words, "Earth" and "mark", rather than perceiving it as an invented word. In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

"62. ... it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)"

Neither word dominates, and as the mark contains no other elements, the overall impression therefore rests in the combined (conjoined) words.

## Visual comparison

76. The contested mark and the opponent's Mark 1 comprise the same initial nine letters "E A R T H M A R K", which appear in the same order in both marks, with the earlier mark presented in capitals, and the contested mark presented in title case, although I do not consider the difference in capitalisation/title case is relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. The applicant's mark is wholly encompassed within the opponent's mark, which contains the additional letters "E T" following the common element. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. The space between the words "EARTH" and "MARK" in the earlier mark creates a further visual disparity. Considering the position of the identical letters "E A R T H M A R K", I consider the marks to be visually similar to at least a medium degree.

77. The opponent's Mark 2 shares the same word elements as its Mark 1, with the additional device element as previously described making a noticeable difference between it and the contested mark. Consequently, I consider the opposing marks to be visually similar to a low degree.

## Aural comparison

78. The common element of all three marks are the letters "E A R T H M A R K", which would be pronounced identically in each. The opponent's marks have the additional letters "ET" at the end of the common element which will also be pronounced, the whole being articulated as three syllables, "URTH-MARK-IT" (ʒ:rθ mɑ:rkɪt), while the applicant's mark will be pronounced as two syllables, "URTH-MARK" (ʒ:rθ mɑ:rk). With regards to the opponent's Mark 2, the additional figurative elements would not be articulated. Consequently, I consider the competing marks to be aurally similar to a medium degree.



## Conceptual comparison

79. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]<sup>13</sup>.

80. In its written submissions, the opponent submits that neither of its earlier marks (as a whole) enjoy any conceptual meaning and that the term “EARTH MARKET” will be perceived as a purely fanciful term, while the opposed mark contains the wording “EARTHMARK” which is devoid of any semantic content or conceptual meaning and has no material distinguishing role from a conceptual point of view.<sup>14</sup>

81. The common element of all three marks is the word “EARTH”. While there are several different meanings of “earth”, being, inter alia, the planet on which we live, a hole in the ground where animals such as foxes reside, and the safety wire inside an electric plug, I consider that whatever meaning the average consumer attaches to the word, they would perceive it as the same for each of the competing marks. The additional words in the earlier and later marks, being “MARKET” and “MARK” respectively, are conceptually distinct when taken in isolation. Further, when taken as a whole, the two words in each of the respective marks do not naturally go together, so in my view, the consumer would identify the separate meanings of each individual word. I do not consider the device element in the earlier Mark 2 would have any conceptual impact.

82. Although case law directs me to bear in mind the dominant and distinctive elements of the marks, the average consumer views the mark as a whole and is not in the habit of unnaturally dissecting words in order to find an underlying conceptual meaning. I do not consider that any of the competing marks as a whole send an immediate, clear conceptual message. Taking into account both the differences and the shared

---

<sup>13</sup> Paragraph 56.

<sup>14</sup> See paragraphs 26.6, 26.7, 27.6 and 27.7 of the written submissions dated 15 November 2022. I note that at paragraphs 40-41, the opponent submits that the competing signs display a low conceptual similarity.

concept of the “EARTH” element, overall, I consider the marks to be conceptually similar to a medium degree.

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

83. 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.

84. 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).”

85. 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 marks have enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the marks to consider.

86. The opponent submits that its Mark 1 has “a good degree of distinctiveness” and that its Mark 2 has a high degree of distinctiveness of which the words “EARTH MARKET” form a dominant part.

87. I will first consider the inherent distinctiveness of the opponent’s Mark 1. The mark is made up of two ordinary, dictionary defined words, which when considered in combination, and in direct reference to the goods and services, neither describe nor allude to those goods and services. Consequently, I consider the mark to possess a medium degree of inherent distinctive character.

88. Turning to the opponent’s Mark 2, the device as a whole is not strikingly distinctive, neither is it particularly weak. It follows that if the word element “EARTH MARKET” alone is considered to possess a medium distinctive character, then the additional device element elevates the mark to what I consider to be an above medium degree of distinctiveness, although not to the highest degree.

### **Likelihood of confusion**

89. 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]).

90. 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 then was), 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).”

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

92. With regard to the opponent’s Mark 1, earlier in this decision, I found the contested goods to be dissimilar to the opponent’s services, however, I found identity/similarity between some of the opposing services, as set out in the table under paragraph 60 of this decision. I found the competing marks to be visually similar to at least a medium degree, aurally similar to a medium degree, and conceptually similar to a medium degree owing to the shared concept of the common element “EARTH”. I considered the average consumer of the services in common to be a business user, who would be likely to pay a high degree of attention to the selection of said services, with the services being selected through a combination of visual and aural means. I found that the earlier mark possessed a medium degree of distinctive character.

93. With regard to the opponent’s Mark 2, I found the contested goods to be identical to the opponent’s goods, and I found identity/similarity between some of the opposing services, as set out in the table under paragraph 60. I found the competing marks to be visually similar to a low degree, aurally similar to a medium degree, and conceptually similar to a medium degree owing to the shared concept of the common element “EARTH”. I considered that the average consumer of the competing goods would be the general public who would pay a medium degree of attention to the selection process, which I considered to be a mainly visual purchase, although I do not discount aural considerations, and professional users who are likely to pay a higher than medium degree of attention during the purchasing act. Meanwhile, the consumer of the services in common would be a business user, who would be likely to pay a high degree of attention to the selection of those services. I found that the earlier mark

enjoyed an above medium degree of distinctive character, but not of the highest degree.

94. I acknowledge the evidence submitted by the applicant to support its claim that the parties' goods and services are positioned in the marketplace in entirely different ways and that the respective parties operate in significantly different markets.<sup>15</sup> However, I must make my assessment based on how the goods and services might fairly be used now or in the future. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

95. I also note the evidence submitted by the applicant by way of the various witness statements to support the claim that actual confusion between the competing marks has not arisen, and the applicant's submission that no evidence has been provided by the opponent to highlight confusion.<sup>16</sup> However absence of evidence of confusion does not necessarily mean an absence of actual confusion. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar

---

<sup>15</sup> See, in particular, the witness statements and accompanying exhibits of Roger Seed, Martyn Sellars, Martyn John Rhodes, Jag Minhas and Mike Gadd.

<sup>16</sup> See paragraph 3 of the witness statement of Jack Linnett.

to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

96. I will first consider the likelihood of confusion between the opponent’s Mark 2 and the application mark, before turning to the likelihood of confusion between the contested mark and the opponent’s Mark 1.

97. 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 the later mark for the opponent’s Mark 2. Given the low degree of visual similarity between the marks for goods which would be purchased by predominantly visual means, and the higher degree of attention paid to the procurement of the services, it is my view that the average consumer will notice and recall the differences between the marks. When considered overall, I do not consider the commonalities to be sufficient to give rise to a likelihood of confusion. I find this even where the respective goods/services are held to be identical, which offsets a lesser degree of similarity between the marks, and even when taking into consideration the degree of distinctive character of the earlier mark.<sup>17</sup>

98. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. 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.

---

<sup>17</sup> In this regard, I note that some of the distinctive character attributable to Mark 2 derives from the presence of the device, whereas the contested mark has no device.

99. Keeping in mind the global assessment of the competing factors in my decision, although the marks share the common word “EARTH”, and for some consumers, sight of one mark may bring to mind the other mark, given the conceptual differences between the words “MARK” and “MARKET”, in my view, it is unlikely that the average consumer would assume that there is an economic connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. are not exhaustive, but I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other. I therefore find no likelihood of indirect confusion between the later mark and the earlier Mark 2.

100. Turning to the opponent’s Mark 1, I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, including the degree of aural and visual similarity between them, as identified above, both of which play a part. Despite the higher level of attention paid by the average consumer to the purchasing process of the services, bearing in mind the principle of imperfect recollection, I consider the differences between the marks to be insufficient to avoid them being mistakenly recalled as each other for services which were considered to be identical or similar to a medium or no more than a medium degree. Consequently, I find that there is a likelihood of direct confusion between the marks for these services. For the services which I found to share only a low degree of similarity, which offsets the degree of similarity between the marks, having made a multi-factorial assessment of the various considerations in play, realistically, I do not consider that the average consumer would mistake those services with those of the opponent and I therefore find there to be no likelihood of direct confusion for those services.

101. As I have found a likelihood of confusion between the applied-for mark and the earlier Mark 1, the opposition under section 5(2)(b) succeeds in respect of the following services only in class 35:

Class 35

*Updating, compilation, systemisation, sorting, editing and inputting of information in databases; Market research and analysis; Procurement and information services for others (purchasing goods and services for other businesses) in the form of sharing*



*third party transaction descriptions; Business management and business administration, namely analysis, evaluation, comparison and consultancy with regard to companies, including companies' sustainability practices.*

102. The opposition fails in respect of the remaining goods and services.

## **CONCLUSION**

103. The applicant has been partially successful. Subject to any successful appeal, the application by Earthmark Solution Limited may proceed to registration in respect of the following goods and services only, in classes 9, 35, 38 and 42:

### Class 9

*Downloadable software and hardware, including for analysing the sustainability practices of businesses and for analysing, evaluating and comparing companies.*

### Class 35

*Compilation of statistical information for trade and business purposes; Providing reviews and ratings of commercial goods and services; Preparation of statistical trade and business information.*

### Class 38

*Telecommunication; Providing online forums via global computer networks for the exchange of reviews, ratings and user experiences.*

### Class 42

*Design, development and maintenance of computer software, including updating of computer programs; Computer programming; Providing search engines on the Internet; Preparation, maintenance and updating of search engines (software) on telecommunications networks.*

## **COSTS**

104. Both parties have enjoyed a share of success, with the greater degree of success on the part of the applicant, who is therefore entitled to a contribution towards its costs. The applicant is a litigant in person and I acknowledge the completed proforma detailing the time spent on particular activities associated with its defence of this opposition. In relation to the hours spent on these proceedings, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this.

105. Taking into account the relevance of the evidence submitted by the applicant, and the partial extent of the success, I have made a reduction to the costs to reflect this, and as such, I consider the following to be reasonable:

Considering the opposition filed by the opponent	4 hours
Preparing and filing a defence	8 hours
<b>Total</b>	<b>12 hours</b>

106. I therefore award the applicant the sum of £228 (12 hours at £19 per hour).

107. I therefore order Earth Market SA to pay Earthmark Solution Limited the sum of £228. 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 27<sup>th</sup> day of January 2023**

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