

O/0661/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3773444

BY JASON CLARKE

TO REGISTER THE TRADE MARK:

Slide up

IN CLASS 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 435108

BY BELOGICAL PTE. LTD.

Background and pleadings

1. On 3 April 2022, Jason Clarke (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 22 April 2022. The services applied for are as follows:

Class 45: Dating services; Computer dating services; Agency services (Dating -); Video dating services; Internet dating services; Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services; Social escorting; Social work service ; Social introduction agencies; Escort agencies [social]; Social escort agency services; Online social networking services; social introduction agency services; Social introduction agency services; On-line social networking services; Internet-based social networking services; Legal services relating to social insurance claims; Online social networking services accessible by means of downloadable mobile applications.

2. The application was opposed by BELOGICAL PTE. LTD. (“the opponent”) on 20 July 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on the following trade mark:

UK918132483

SLIDE

Filing date: 4 October 2019

Registration date: 2 February 2020

Relying upon all goods and services for which the earlier mark is protected, namely:

Class 9: Downloadable software in the nature of a mobile application for internet-based dating and matchmaking; Downloadable software in the nature of a mobile application in the field of social media, namely, for sending status updates to subscribers of web feeds, uploading and downloadable electronic files to share with others; Computer software, including downloadable computer software and mobile apps; Computer application software for mobile phones; Portable multimedia players and computers; Computer software for taking and editing photographs and for recording and editing videos; Computer software for the live or non-live transmission and dissemination of photographs, videos, images, audiovisual content, data, text, message, comments, advertisements and communications; Computer software for sending and receiving photographs, videos, images, electronic messages and digital text to others via global computer networks; Downloadable computer software for viewing and interacting with a feed of images, audio-visual and video content and associated text and data; Computer software for use in connection with online dating services and social networks; Computer software for social networking; Software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; Computer software enabling users to create and access social networking information, including address books, friends lists, profiles, preferences and personal data.

Class 38: Telecommunications; Telecommunications, namely, electronic transmission of data, messages, animations, images, videos, multimedia content and information in the field of entertainment and social networks; Photo sharing and video sharing, namely, electronic transmission of files containing photographs, videos and audiovisual content in digital form among internet users; Electronic transmission of images, audiovisual content and video content, photographs, videos, data, text, messages, advertisements and advertising communications; Providing access to computer, electronic and online databases; Dissemination via computers, mobile applications, website applications or other communications networks, namely, loading, posting, displaying, tagging and electronic transmission of data, information, messages, animations, videos, multimedia content and images; Dissemination and streaming of audiovisual multimedia content; Transmission of downloadable

audio-visual media content; Providing online forums for communication; Provision of email, electronic messaging and instant messaging services; Online chat rooms for social networking.

Class 45: Personal and social services rendered by other to meet the needs of individuals; Dating services; Internet-based social networking, introduction and dating services; Networking and social introductions based on global computer networks; On-line social networking services; Internet services for social gatherings, networking and meetings.

4. The opponent claims that the earlier mark is entirely subsumed by the applicant's mark and that the marks are highly similar visually, aurally and conceptually. They also claim that their class 45 services are identical to the applicant's services and that some of their class 9 and 38 goods and services are highly similar to the applicant's class 45 services.

5. The applicants filed a counterstatement denying the claim made that the marks are similar although they did concede that their goods and services are "like" those in the earlier mark.

6 The applicant is unrepresented and the opponent is represented by Murgitroyd & Company.

7. Neither party provided evidence nor requested a hearing and no submissions in lieu were filed. This decision is therefore taken following careful consideration of the papers.

8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

9. Section 5(2)(b) is being relied upon and is 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”.

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the services it has identified.

Case law

12. 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 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 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

13. Within the Form TM8 and counterstatement, the holder admits that the goods within their specification are similar to the opponent's goods. In *CX02 BL O/393/19*, Professor Phillip Johnson as Appointed Person stated as follows:

“Once such an admission is made it is deemed to be conclusively proved (a formal admission is sometimes called a “waiver of proof”: Phipson on Evidence (19th Ed), paragraph 4-03). This means neither party can lead evidence contrary to the admitted fact and, accordingly, a Hearing Officer cannot find a

fact contrary to the admission (as doing so is the same as finding facts contrary to the evidence).”¹

14. As the holder did not specify what degree of similarity it considers exists between the parties’ respective goods and services, I must still undertake a comparison in order to identify the degree of similarity between them.

15. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

16. 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;

¹ Paragraph 33

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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".

18. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

19. The Parties' respective specifications are:

Applicant's services	Opponent's goods & services
Class 45: Dating services; Computer dating services; Agency services (Dating -); Video dating services; Internet dating services; Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services; Social escorting; Social work	Class 9: Downloadable software in the nature of a mobile application for internet-based dating and matchmaking; Downloadable software in the nature of a mobile application in the field of social media, namely, for sending status updates to subscribers of web feeds, uploading and downloadable electronic

service ; Social introduction agencies; Escort agencies [social]; Social escort agency services; Online social networking services; social introduction agency services; Social introduction agency services; On-line social networking services; Internet-based social networking services; Legal services relating to social insurance claims; Online social networking services accessible by means of downloadable mobile applications.

files to share with others; Computer software, including downloadable computer software and mobile apps; Computer application software for mobile phones; Portable multimedia players and computers; Computer software for taking and editing photographs and for recording and editing videos; Computer software for the live or non-live transmission and dissemination of photographs, videos, images, audiovisual content, data, text, message, comments, advertisements and communications; Computer software for sending and receiving photographs, videos, images, electronic messages and digital text to others via global computer networks; Downloadable computer software for viewing and interacting with a feed of images, audio-visual and video content and associated text and data; Computer software for use in connection with online dating services and social networks; Computer software for social networking; Software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; Computer software enabling users to create and access social networking information, including address books, friends lists, profiles, preferences and personal data.

	<p>Class 38: Telecommunications; Telecommunications, namely, electronic transmission of data, messages, animations, images, videos, multimedia content and information in the field of entertainment and social networks; Photo sharing and video sharing, namely, electronic transmission of files containing photographs, videos and audiovisual content in digital form among internet users; Electronic transmission of images, audiovisual content and video content, photographs, videos, data, text, messages, advertisements and advertising communications; Providing access to computer, electronic and online databases; Dissemination via computers, mobile applications, website applications or other communications networks, namely, loading, posting, displaying, tagging and electronic transmission of data, information, messages, animations, videos, multimedia content and images; Dissemination and streaming of audiovisual multimedia content; Transmission of downloadable audiovisual media content; Providing online forums for communication; Provision of email, electronic messaging and instant messaging services; Online chat rooms for social networking.</p>
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	<p>Class 45: Personal and social services rendered by other to meet the needs of individuals; Dating services; Internet-based social networking, introduction and dating services; Networking and social introductions based on global computer networks; On-line social networking services; Internet services for social gatherings, networking and meetings.</p>
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Dating services; Online social networking services; On-line social networking services;

20. The above services are found identically within the applicant and opponent specifications. I note the two different spellings of 'online' but consider that they are simply alternate spellings of the same thing.

Computer dating services; Agency services (Dating -); Video dating services; Internet dating services; Dating agency services; Dating services provided through social networking;

21. I consider that the above services from the applicant's specification fall within the wider category of 'Dating services' found in the opponent's specification and therefore, I find them to be identical under the *Merck* principles.

Internet based dating, matchmaking and personal introduction services;

22. I believe that there is an overlap of use and user between the above applicant's services and the opponent's 'Internet based social networking, introduction and dating services' together with an overlap in nature as the respective services are related to meeting people online. The trade channels will likely overlap and there could be competition between the two. I therefore find them to be similar to a high degree.

Social escorting; Escort agencies [social]; Social escort agency services;

23. I believe the above services would overlap in use and user with the opponent's 'Internet based social networking, introduction and dating services' as they both concern the introduction of people for various purposes. The nature might differ as one is solely based online and the other can be done via other methods of introduction-in person, via telephone etc. There could be an overlap in trade channels and there might be some competition between the two services however, they are not complimentary. I therefore find them to be similar to a high degree.

Social work service;

24. Given I have been provided with no evidence to the contrary, I take the above services of the applicant to mean services related to the care and meeting the needs of individuals. On application of the *Treat* guidance, I cannot see any overlap with the above services with the opponent's goods and services however, as the holder has not disputed the similarity of them in this case, I must find them similar to a very low degree.

Social introduction agencies; social introduction agency services; Social introduction agency services; Internet-based social networking services; Online social networking services accessible by means of downloadable mobile applications.

25. I consider that the above services from the applicant's specification fall within the wider category of 'Internet based social networking, introduction and dating services' found in the opponent's specification and therefore, I find them to be identical under the *Meric* principles.

Legal services relating to social insurance claims;

26. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the opponent's goods and services however, as the holder has not disputed the similarity of them in this case, I must find them similar to a very low degree.

Average consumer and the purchasing act

27. 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.

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

29. I consider that for the above services relating to introductions and dating they will likely be used by individuals who will be paying attention to factors such as price, the reach of the site and whether it suits their personal preferences. I therefore believe the average consumer will pay a medium degree of attention. The selection process is likely to primarily be made by visual means including websites and advertisements in print and online. I do not discount that oral recommendations may play a part and that there may therefore be an aural component to the purchase.

30. For ‘legal services relating to social insurance claims; Social work service’ I consider that the average consumer is again likely to be individuals. However, I do not discount that there could also be professionals looking to use them. Factors that will be taken into consideration would be price, level of experience and skillset. The price range of the services could range greatly depending on the matter at hand. I therefore

find that the average consumer will be paying an above medium (but not the highest) level of attention. These services are likely to be selected once more by a visual means on websites, brochures and advertisements but once again I consider that word of mouth recommendations cannot be ignored and so there may be an aural element to the purchasing process.

Comparison of the marks

31. 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.”

32. 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.

33. The respective trade marks are shown below:

Earlier Mark	Contested Mark
SLIDE	Slide up

34. The earlier mark is a word mark consisting of one word. The overall impression lies in the word itself.

35. The contested mark consists of the two words 'Slide' and 'up'. The words combine to form a unit, i.e. up simply acts as clarification of the direction in which the sliding occurs. The word 'Slide' is a longer word than 'up' and, therefore, has a higher level of visual dominance. However, because the words form a unit it is the combination of the two words that creates the distinctive character of the mark rather than any one element.

36. Visually, the earlier mark simply comprises one word of five letters. This word is found identically at the beginning of the contested mark. The contested mark also features a further word containing two letters after which is not replicated in the earlier mark. Given that five out of seven letters are identical and presented together in the same way and taking into consideration the decisions of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends, I find the marks to be visually similar to between a medium and high degree.

37. Next, I turn to the aural comparison of the marks. The earlier mark will be given its ordinary everyday pronunciation of the word which is one syllable. The contested mark will be two syllables, the first syllable will have identical pronunciation to the earlier mark with the addition of 'UP' (also given its ordinary pronunciation) immediately thereafter. I therefore find the marks to be aurally similar to at least a medium (but not the highest) degree.

38. Conceptually, I believe the earlier mark will be assigned its ordinary dictionary definition, that is moving smoothly over or against something.² I note the opponent's assertion that it will be viewed as an action within an application, i.e. sliding in order to accept a match. However, I have not been provided with any evidence in support of this and I therefore do not consider that it will be viewed as such by a significant proportion of average consumers. For the contested mark, I consider that slide will have the same meaning as the earlier mark. The addition of 'up' is an adverb which clarifies the direction of the word 'slide' and does not materially change the concept. I therefore consider the marks to be conceptually similar to a high degree.

Distinctive Character of the Earlier Mark

39. 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

² <https://www.collinsdictionary.com/dictionary/english/slide>

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. The opponent did not file any evidence and has made no claim of an enhanced level of distinctiveness in its earlier marks so I will base my decision on the inherent distinctiveness of the earlier mark.

41. The opponent’s mark consists of the word ‘slide’ which can be said to be an ordinary dictionary term that will be readily understood. The word does not directly describe the goods being provided and does not appear allusive or suggestive. Therefore, I find that the opponent’s earlier marks can be said to be inherently distinctive to a medium degree.

Likelihood of Confusion

42. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

43. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

43. I have concluded that the goods are between identical and similar to a very low degree, the marks are visually similar to between a medium and high degree, aurally similar to a medium degree and conceptually similar to a high degree. I found the earlier mark to be inherently distinctive to a medium degree. Depending on the services sought, I found the degree of attention paid by the average consumer would be either medium or above medium.

44. I have found that the opponent's mark, 'slide', is entirely replicated at the beginning of the applicant's mark. This results in a medium to high degree of visual similarity between the marks which are most likely to be encountered in a predominantly visual purchasing process. Even though I have said there is a medium or above medium degree of attention being paid when taking into account, the effects of imperfect recollection (as the average consumer will rarely have the opportunity to compare the marks side by side) will result in the average consumer mistaking or misremembering one mark as the other. This is further supported by the high similarity in the concepts of the marks. I therefore find there to be a likelihood of direct confusion. The difference, i.e. the addition of the word 'up' is such that it would go relatively unnoticed and I believe consumers could mistake one mark for the other, even where the services in question are similar to a low degree.

Conclusion

45. The opposition succeeds in its entirety.

Costs

46. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings are based upon the scale set out in Tribunal Practice Notice (TPN) 2/2016. After due consideration, I believe that an award of costs to the opponent is appropriate as follows:

Official fee	£200
Preparing the notice of opposition and considering the Counter Statement	£300
TOTAL	£500

47. I therefore order Jason Clarke to pay BELOGICAL PTE. LTD. the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14 day of July 2023

**L Nicholas
For the Registrar**