O/0727/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO1605785
BY JHO INTELLECTUAL PROPERTY HOLDINGS, LLC
TO REGISTER THE TRADE MARK:

WITTY

IN CLASSES 9, 38, 41, 42 & 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 432326
BY WITTY TECHNOLOGIES LTD

Background and pleadings

1. International trade mark no.1605785 ('the contested mark') shown on the cover page of this decision was registered by JHO Intellectual Property Holdings, LLC (the holder) in the USA with effect from 16 October 2020. The holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement on 4 March 2021. The holder seeks protection in relation to the following goods and services:

Class 9: Downloadable software for creating, producing, editing, manipulating, transmitting, uploading, downloading, and sharing electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the internet and other communications networks; downloadable software for advertising and marketing services, namely, online advertising and digital content creation, distribution, and optimization; downloadable software for tracking advertising performance, managing advertising campaigns, analyzing advertising data, and creation of advertising analysis reports.

Class 38: Transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks.

Class 41: Entertainment services, namely, providing an online interactive database of non-downloadable videos and user generated content containing non-downloadable digital images, photos, text, graphics, music, audio, video clips, multimedia content, and visual and audio performances all online providing online non-downloadable music videos over the Internet or other communications networks.

Class 42: Creating a virtual environment in the nature of an online community for registered users to create, produce, edit, manipulate, transmit, share, and comment on videos or other electronic media.

Class 45: Online social networking services.

2. The request to protect the contested mark was published on 31 December 2021. On 31 March 2022, Witty Technologies Ltd (the opponent) opposed the protection of the contested mark in the UK based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act").[1] The opponent relies upon the following trade mark:

UK918162751

WITTY

Filing date: 6 December 2019
Registration date: 20 November 2020

Relying on some of the goods and services from its registration as follows:

> Class 9: Application software; Mobile application software; Software applications; Smartphone software applications, downloadable; Application software for smart phones; Application software for mobile phones; Application software for wireless devices; Downloadable application software; Application software for mobile devices; Software applications for mobile devices; Downloadable application software for smart phones.
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> Class 38: Messaging services; Electronic messaging services; Electronic message transmission; Electronic message sending; Instant messaging services; Instant electronic messaging services; Providing instant messaging services; Electronic and telecommunication transmission services; Electronic transmission of instant messages and data; Voice over Internet Protocol [VoIP] services; Voice over Internet Protocol [VoIP] communication services.
>
> Class 42: Technological services; IT services; Information technology services; All the aforementioned services excluding: Analysis of water, in particular drinking water, wastewater and water for swimming pools, Services of

1 A claim based on section 5(3) of the Act was subsequently withdrawn.

biologists, chemists, hygiene experts, computer scientists, engineers, physicists, in particular in the field of water treatment, swimming pool cleaning or kitchen cleaning, Expert examination of chlorination plants from a technical perspective, Technical examination by means of hygiene inspections and technical consultancy in relation to inspection and safeguarding of hygiene status for swimming pools and kitchens, including in the form of quality control in relation to hygiene in the field of swimming pools and kitchens, Technical consultancy in relation to the optimisation of energy consumption for swimming pools and kitchens.

3. The opponent claims that the marks are identical and that the goods and services in question are identical or similar.

4. The holder filed a counterstatement denying the claims made. However, in their later submissions they accept that the marks are “effectively identical” but that the goods and services are different.

5. The holder is represented by Lane IP Limited and the opponent is represented by Bird & Bird LLP.

6. Neither party filed evidence nor requested a hearing. Both parties provided submissions in lieu. This decision is therefore taken following careful consideration of the papers.

7. 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

8. Section 5(1) of the Act is as follows:

"5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

9. Section 5(2)(a) of the Act is also being relied upon and is as follows:

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

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

…"

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, above, which qualifies as an earlier trade mark under the above provisions. As the earlier trade mark had not completed its registration processes more than 5 years before the filing date of the application in suit, the earlier mark is not subject to use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and 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.

Identity of the Marks

13. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (the 'CJEU') held that:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

14. The holder has admitted within their submissions that the marks are "effectively identical". Both are word marks of the word 'WITTY' and therefore, are evidently identical.

Comparison of Goods and Services

15. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> > (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
> >
> > (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

16. 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."

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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

18. In *Gérard Meric v 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".

19. 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).

20. 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."

21. The goods and services to be compared are:

Holder's Goods & Services	Opponent's Goods & Services
Class 9: Downloadable software for creating, producing, editing, manipulating, transmitting, uploading, downloading, and sharing electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the internet and other communications networks; downloadable software for advertising and marketing services, namely, online advertising and digital content creation, distribution, and optimization; downloadable software for tracking advertising performance, managing advertising campaigns, analyzing advertising data, and creation of advertising analysis reports.	Class 9: Application software; Mobile application software; Software applications; Smartphone software applications, downloadable; Application software for smart phones; Application software for mobile phones; Application software for wireless devices; Downloadable application software; Application software for mobile devices; Software applications for mobile devices; Downloadable application software for smart phones.
Class 38: Transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos,	Class 38: Messaging services; Electronic messaging services; Electronic message transmission;

user-generated content, audio content, and information via the Internet and other communications networks.	Electronic message sending; Instant messaging services; Instant electronic messaging services; Providing instant messaging services; Electronic and telecommunication transmission services; Electronic transmission of instant messages and data; Voice over Internet Protocol [VoIP] services; Voice over Internet Protocol [VoIP] communication services.
Class 41: Entertainment services, namely, providing an online interactive database of non-downloadable videos and user generated content containing non-downloadable digital images, photos, text, graphics, music, audio, video clips, multimedia content, and visual and audio performances all online providing online non-downloadable music videos over the Internet or other communications networks.	
Class 42: Creating a virtual environment in the nature of an online community for registered users to create, produce, edit, manipulate, transmit, share, and comment on videos or other electronic media.	Class 42: Technological services; IT services; Information technology services; All the aforementioned services excluding: Analysis of water, in particular drinking water, wastewater and water for swimming pools, Services of biologists, chemists, hygiene experts, computer scientists, engineers, physicists, in particular in the field of water treatment, swimming pool cleaning or kitchen cleaning, Expert examination of chlorination plants from a technical

	perspective, Technical examination by means of hygiene inspections and technical consultancy in relation to inspection and safeguarding of hygiene status for swimming pools and kitchens, including in the form of quality control in relation to hygiene in the field of swimming pools and kitchens, Technical consultancy in relation to the optimisation of energy consumption for swimming pools and kitchens.
Class 45: Online social networking services.	

Class 9

Downloadable software for creating, producing, editing, manipulating, transmitting, uploading, downloading, and sharing electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the internet and other communications networks; downloadable software for advertising and marketing services, namely, online advertising and digital content creation, distribution, and optimization; downloadable software for tracking advertising performance, managing advertising campaigns, analyzing advertising data, and creation of advertising analysis reports.

22. In my view the opponent's 'downloadable application software' is a broad term that covers *Downloadable software* whatever the purpose of that software may be. I find no operative significance attaching to the word "application" in the opponent's specification. The opponent's downloadable application software' goods are software that, as I understand it, may be downloaded to a range of computing devices, including laptops, tablets and mobile phones. On this basis the respective goods may be considered identical in line with the principle set out in Meric.

Class 38

Transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks.

23. I consider that the above services from the holder's specification will fall within the wider category of the opponent's 'Electronic and telecommunication transmission services' and therefore find them to be identical under the *Meric* principles.

Class 41

Entertainment services, namely, providing an online interactive database of non-downloadable videos and user generated content containing non-downloadable digital images, photos, text, graphics, music, audio, video clips, multimedia content, and visual and audio performances all online providing online non-downloadable music videos over the Internet or other communications networks.

24. I note that the holder's services above contain the word 'namely'. Guidance on how to treat this word is contained within the addendum to the Trade Mark Registry's Classification Guide, which reads as follows:

> "Note that specifications including "namely" should be interpreted as only covering the names Goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are."

25. In this case, the holder's term 'entertainment services' is limited to 'providing an online interactive database of non-downloadable videos and user generated content containing non-downloadable digital images, photos, text, graphics, music, audio, video clips, multimedia content, and visual and audio performances all online providing

online non-downloadable music videos over the Internet or other communications networks' although the term is to be regarded as an entertainment service in some way.

26. I will consider the term against the opponent's 'application software'. Although this term is broad, it can be readily interpreted to include all forms of applications running on a computer or a computing device, such as smartphones and tablets. Against this background, there is a degree of complementarity between the contested term and the opponent's goods. This is in particular due to the potential that such services could be provided via applications where the users will be able to access an online interactive database and view online music videos. Therefore, the consumers will expect that such services are offered by the same undertaking. In this regard, there may be an overlap in users and potentially trade channels. I note that the nature is different (goods v services), but the end purpose may coincide as the respective goods and services aim to make the content of the services available to the public. Taking all the above into account, I find that there is a low degree of similarity.

Class 42

Creating a virtual environment in the nature of an online community for registered users to create, produce, edit, manipulate, transmit, share, and comment on videos or other electronic media.

27. I find that the opponent's 'Technological services" and "Information technology services" is a very broad term notwithstanding the excluded coverage applied in this specification. I see no reason why it would not cover the holder's services as creating an online community would be created through the use of technology. I therefore consider the services to be identical under the *Meric* principles.

Class 45

Online social networking services

28. The holder’s above services are intended to provide a means of connecting and interacting with people of the same interests, activities, backgrounds and real-life connections. I consider that most online social network sites incorporate a means of messaging other members as well as being able to share location, photographs, videos and information. I therefore consider there to be an overlap in use and user with the opponent’s ‘instant messaging services’. There will be an overlap in nature with how the messaging system is set out but the holder’s services will have a much broader nature with profile pages, group pages and timelines etc. There might also be an overlap in trade channels. Since it is my view that most online social network sites incorporate a means of messaging other members, it may also be reasoned that the services are complementary or even in competition. In any event, I find the services to be similar to a medium degree.

29. As I have found the parties’ class 9 goods and their services in classes 38 and 42 to be identical, the opposition succeeds in relation to those goods and services under section 5(1).

30. I will continue the opposition under section 5(2)(a) for the remaining services in classes 41 and 45.

Average consumer and the purchasing act

31. 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.

32. 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."

33. I consider that the average consumer of the services in classes 41 and 45 could be members of the public or professionals/business. The costs of accessing these entertainment and social networking services are likely to be relatively low. The services will be purchased relatively infrequently and the average consumer will need to take into consideration the suitability of these services in accordance with their needs. I therefore consider that the average consumer would pay a medium level of attention during the purchasing process. The services are likely to be selected from through advertisements and online. I therefore find that visual considerations will dominate the selection process, though I do not discount the possibility that there could be aural considerations from word of mouth recommendations.

Distinctive character of the earlier mark

34. 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 1-2779, 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)."

35. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

36. The opponent has not pleaded that the distinctiveness of the earlier mark has been enhanced through use, nor has it filed any evidence to support such a claim. Consequently, I have only the inherent position to consider. The opponent's mark consists of the word 'witty', which is an ordinary dictionary word. I cannot see any relation between the meaning of the word and the goods and services registered and therefore I find that it has a medium degree of inherent distinctive character.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e., a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of

the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

38. In relation to the section 5(2)(a) ground, I have found as follows:

a) The class 41 services have a low degree of similarity and the class 45 services are similar to a medium degree

b) The average consumer is a member of the general public or a business user, who will pay a medium degree of attention during the purchasing process.

c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

d) The marks are identical.

e) The earlier mark is inherently distinctive to a medium degree.

39. Taking all of the above factors into account, I consider that the marks are likely to be mistakenly recalled as each other. Even for those services that are similar to a low degree, I find that, in line with the interdependency principle, the identity between the marks will offset this. Consequently, there is a likelihood of direct confusion.

Conclusion

40. The opposition is successful in its entirety.

COSTS

41. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I award the opponent the sum of **£650**, calculated as follows:

Official fee	£100[2]
Preparing a Notice of opposition and considering the holder's counterstatement	£200
Filing written submissions	£350
Total	**£650**

43. I therefore order JHO Intellectual Property Holdings, LLC to pay Witty Technologies Ltd the sum of £650. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of July 2023

L Nicholas
For the Registrar

2 Although the opponent paid £200 to file its Form TM7, that was based on grounds beyond the section 5(1) and 5(2) grounds on which the opposition ultimately proceeded to decision. The fee for filing a Form TM7 based only on claims under section 5(1) and 5(2) grounds is £100.