O/0785/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003795541
AND UK00003795547 BY PURPLECUBE INC.
TO REGISTER:

AND

PURPLECUBE

AS TRADE MARKS IN CLASS 42

AND

IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NO. 436427 AND 436428 BY
PURPLE COMPUTING LIMITED

BACKGROUND AND PLEADINGS

1. On 6 June 2022, PURPLECUBE INC. ("the applicant") applied to register the two trade marks shown on the cover of this decision in the UK for the following services:

Class 42: Software as a service [SaaS]; Data and commercial analytics software as a service [Saas]; Platforms for data analysis as software as a service [SaaS]; Software as a service [SaaS] featuring software for data and commercial analysis; Software as a service [SaaS] featuring software for maximizing investments; Consulting services in the field of software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for data and commercial analytics; Software as a service [SaaS] featuring computer software platforms for artificial intelligence; Software as a service [SaaS] services featuring software for machine learning, deep learning and deep neural networks; Computer programming services for data and commercial analysis and reporting in the field of telecommunications, retail, banking, investment, finance, automotive, oil, gas, healthcare and government; Data management, data strategy, data governance, data science, data architecture software as a service [Saas]; All aforesaid in relation to analytics-as-a-service (AaaS) software platform that is hosted on any cloud provider and helps customers solve their data challenges and provide them analytics with the help of machine learning and AI (artificial intelligence) algorithms; none of the aforesaid services being used in the fields of entertainment, television, radio, audiovisual, cinema, press and show business other than offering data analytics services.[1]

2. Both of the applicant's marks were published for opposition purposes on 24 June 2022 and, on 23 September 2022, they were both opposed by Purple Computing

[1] The applicant seeks registration for identical services across both of its marks

Limited ("the opponent"). The oppositions are based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and are reliant upon the following earlier marks:

PURPLE
UK registration no: 3316936
Filing date 11 June 2018; registration date 12 October 2018
Relying on all services as set out in the **Annex** to this decision.
("the opponent's first mark"); and

PURPLE COMPUTING
UK registration no: 2576140
Filing date 24 March 2011; registration date 8 July 2011
Relying on all services as set out in the **Annex** to this decision.
("the opponent's second mark")

3. In respect of both oppositions, the opponent claims that the highly similar nature of the marks combined with the highly similar nature of the services establishes a strong likelihood of confusion on the part of the average consumer, to include a likelihood of association. The applicant has filed counterstatements wherein it denies the claims made.

4. On 20 December 2022, the Tribunal wrote to the parties and directed that, in accordance with Rule 62(1)(g) of the Trade Marks Rules 2008, these proceedings were to be consolidated.

5. The opponent is represented by Blake Morgan and the applicant is represented by Trademarkia. Neither party filed evidence but I note that the applicant filed written submissions during the evidence rounds. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

6. 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

Section 5(2)(b): legislation and case law

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

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

(a) …

(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 or association with the earlier trade mark."

8. Section 5A of the Act states as follows:

"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."

9. The trade marks relied on by the opponent qualify as "earlier trade marks" for the purposes of this decision since they were applied for at earlier dates than the

applicant's marks.[2] The opponent's first mark did not complete its registration process prior to five years before the filing dates of the applicant's mark. As such, it is not subject to proof of use pursuant to section 6A of the Act. As for the opponent's second mark, this did complete its registration process more than five years prior to the filing dates of the applicant's marks. However, no proof of use was requested and it is not, therefore, subject to proof of use. This means that the opponent can rely upon all of the services for which both marks are registered.

10. 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 Harmonization 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;

[2] See Section 6(1)(a) of the Act

(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 services

11. The services of the applicant are set out at paragraph one above. The services of the opponent's marks are set out in the Annex of this decision. As the applicant's specifications are identical I will, for the sake of this comparison, refer to those specifications in the singular.

12. When making the comparison assessing the similarity of the services, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "[...] 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".

13. 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.

14. While I note that the opponent filed two notices of opposition, these did not discuss the comparison of the services at issue. Further, the opponent has not provided any arguments by way of evidence or written submissions in support of its claims. This has left me with some difficulty in conducting the present services comparison on the basis that the services at issue are very technical in nature. Without anything to assist me as to what the services specifically cover and why the opponent considers them similar, I am left to make my own assessment in respect of the same. On this point, I remind the parties that, in Tribunal proceedings, Hearing Officers do not undertake their own research. This means that I am left to assess the services at issue based on my own understanding of the terms. In doing so, I will first consider the applicant's various services for the provision of 'software as a service'. These are as follows:

> "Software as a service [SaaS]; Data and commercial analytics software as a service [Saas]; Platforms for data analysis as software as a service [SaaS]; Software as a service [SaaS] featuring software for data and commercial analysis; Software as a service [SaaS] featuring software for maximizing investments; Software as a service [SaaS] featuring software platforms for data and commercial analytics; Software as a service [SaaS] featuring computer software platforms for artificial intelligence; Software as a service [SaaS] services featuring software for machine learning, deep learning and deep neural networks; Data management, data strategy, data governance, data science, data architecture software as a service [Saas]; All aforesaid in relation to analytics-as-a-service (AaaS) software platform that is hosted on any cloud provider and helps customers solve their data challenges and provide them analytics with the help of machine learning and AI (artificial intelligence) algorithms; none of the aforesaid services being used in the fields of

entertainment, television, radio, audiovisual, cinema, press and show business other than offering data analytics services."

15. I appreciate that all of the above services and the opponent's class 42 services relate to computer software. While the above services relate to the provision of software as a service (for different and specific purposes), the opponent's services relate to advisory, consultancy, analytic and maintenance of software as well as those for the provision of computer updates, the creation of websites and information services relating to computers and software. None of these services are for the actual provision of software in the way that the applicant's are. There may be some overlap in user but there is no overlap in nature, method of use or purpose. As for trade channels, I have nothing before me to suggest that it is common in the trade for the providers of these services to overlap. If it was the case that they did, I would expect evidence or submissions on this point and, without such, I am not willing to infer that there is an overlap in this factor. Taking all of this into account, the fact that there may be an overlap in user is not, in my view, sufficient to warrant a finding that these services are similar and aside from the fact that they all relate to computing, there is no obvious reason why I should conclude as such. As a result, these services are dissimilar.

16. I turn now to the remaining services of the applicant, being the following:

"Consulting services in the field of software as a service [SaaS]; Computer programming services for data and commercial analysis and reporting in the field of telecommunications, retail, banking, investment, finance, automotive, oil, gas, healthcare and government; All aforesaid in relation to analytics-as-a-service (AaaS) software platform that is hosted on any cloud provider and helps customers solve their data challenges and provide them analytics with the help of machine learning and AI (artificial intelligence) algorithms; none of the aforesaid services being used in the fields of entertainment, television, radio, audiovisual, cinema, press and show business other than offering data analytics services.

17. The above covers just two services of the applicant, one being a consulting service and the other being a computer programming service, albeit both with specific purposes and followed by a limitation. In considering the consultancy service, I will compare it with the opponent's "consulting services in the fields of information and telecommunication technology, computer hardware and software" in its first mark's specification and "advisory services relating to computer hardware, computer software" in its second mark's specification. All of these services aim to assist the customer by providing advice, be that in the form of 'advisory services' or 'consultancy'. As a result, I consider that there is an overlap in nature between these services. Further, the opponent's services are not limited in any way (and include reference to 'computer software') meaning that it can be said to cover advice/consultancy in relation to software as a service (even taking into account the limitation of the applicant's term). The services, therefore, have the same purpose. Further, the services will be sought in the same way meaning that the methods of use overlap. In addition, I consider that there is an overlap in user and trade channels. As a result, I consider that these services are similar to a high degree.

18. Turning to the applicant's programming service, I have compared this with the opponent's "installation, maintenance and repair of computer software" in its first mark's specification and "maintenance of computer software" in its second mark's specification. These are broad terms (with no limitation preventing them from being used for the specific services of the applicant) and it is my understanding that the maintenance of computer software will inevitably include some form of programming. The opponent's services are, in my view, likely to involve programming for existing software (in that it aims to maintain it) whereas the applicant's term seems to be a service provided in order to create the software at issue (on this point I note that it makes no reference to maintenance). I do not necessarily consider that the services overlap in nature or method of use but I do consider that there is some overlap in purpose, however, this is not prominent. As for trade channels, I consider that an undertaking that provides the initial programming service is also like to offer services for the maintenance of the same. Further, the users will also overlap because those looking to obtain programming

services for their software as a service are also likely to seek the maintenance of the same. I do not consider that these services are competitive in nature but I do find that they have a complementary relationship on the basis that I consider the maintenance and initial programming services are important and indispensable to one another. Further, I consider that the average consumer is likely to believe that the services are provided by the same undertakings.[3] Overall, I consider that these services are similar to at least a medium degree.

19. As some degree of similarity between services is necessary to engage the test for likelihood of confusion, this means that the opposition under section 5(2)(b) aimed against those services will fail.[4] As a result, the opposition against the dissimilar services reproduced at paragraph 14 above hereby fails.

The average consumer and the nature of the purchasing act

20. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

[3] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06
[4] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

21. In my view, the average consumer for the services at issue will be business users. The services at issue will be available via various specialist retailers or the providers directly. Either way, the services on offer will be displayed in catalogues, lists or on placards. The services will also be available at those retailers' or providers' websites wherein the list of services will be displayed on webpages. Given the specialist nature of the services, I am of the view that regardless of the purchasing scenario, the selection of the services will take place after both a visual inspection and an aural discussion (with a sales assistant, for example). As a result, I find that both the visual and aural components will play an equal role in the selection process of these services.

22. It is my understanding that the services at issue will range in price and frequency of selection. This could be relatively inexpensive and frequent for services such as ad-hoc maintenance for software but could also include expensive services with an infrequent selection such as long running programming maintenance services. Turning to the level of attention paid, I am of the view that the average consumer would pay a higher than medium degree of attention (but not high). This is on the basis that the user is likely to consider the selection of these services an important one because it is likely to be important to the operation of their business. For example, if the maintenance service selected is not in line with the user's expectations, it may be detrimental to that user's business as a result of ongoing and unsolved issues with the software that is being maintained.

Comparison of the marks

23. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

24. 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."

25. 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.

26. The respective trade marks are shown below:

The opponent's marks	The applicant's marks
PURPLE ("the opponent's first mark") PURPLE COMPUTING ("the opponent's second mark")	 ("the applicant's first mark") PURPLECUBE ("the applicant's second mark")

27. I have submissions from the applicant in respect of the comparison of these marks. While I confirm that I have taken these into account, I will not reproduce those here.

Overall Impression

The applicant's marks

28. The applicant's first mark is a figurative mark that consists of a device element and a word element. The device sits at the beginning and is a purple and green 3D cube. The left part of the cube appears as if its disintegrating into purple and green pixels. The word element sits after the device and is the word 'PurpleCube'. While presented as one conjoined word, it will be viewed as two clearly identifiable words, being 'Purple' and 'Cube'. 'Purple' is presented in purple and 'Cube' is presented in green (it is my view that the use of colour assists in separating the words). Given that average consumers tend to focus on the parts of marks that can be read, I am of the view that it is the word element that dominates the overall impression of the mark with the device element and use of colour playing lesser roles.

29. As for the applicant's second mark, this is a word only mark consisting of the same conjoined word as the first mark, being 'PURPLECUBE'. While there is no contrived colour split in this mark, the consumer will still identity the different words in the word, being 'PURPLE' and 'CUBE'. There is nothing else that contributes to the mark meaning that its overall impression is dominated by this element.

The opponent's marks

30. The opponent's first mark is a word only mark that consists solely of the word 'PURPLE'. There are no other elements that contribute to the overall impression of the mark which lies in the word itself. The opponent's second mark is also a word only mark consisting of two words, being 'PURPLE COMPUTING'. For reasons that I will come to discuss below, the word 'PURPLE' will dominate the overall impression of the second mark, with 'COMPUTING' playing a much lesser role.

Visual comparison

The applicant's first mark and the opponent's marks

31. Visually, these marks share the word 'PURPLE'. They differ in the presence of the word 'Cube', use of colour and device element in the applicant's first mark and the word 'COMPUTING' in the opponent's second mark. While I appreciate that 'PURPLE' is the first part of the dominant element of the applicant's first mark, it is the sole element of the opponent's first mark and is the beginning element of the opponent's second mark.[5] I do not consider that this results in a particularly high degree of similarity between these marks. This is because, firstly, from a visual perspective, the device element (regardless of its lesser role in the applicant's mark) and the presence of the word 'Cube' have a significant impact on the applicant's mark. Secondly, the use of colour in the applicant's first mark cannot be replicated in the opponent's marks, despite them being registered as word only marks in black and white.[6] Taking all of this into account, I am of the view that the applicant's first mark is similar to no more than a medium degree with the opponent's first mark. Also taking this into account but also bearing in mind the presence of the word 'COMPUTING' in the opponent's second mark (even accounting for its lessened role in that mark), I find that it is visually similar to the applicant's first mark to between a low and medium degree.

The applicant's second mark and the opponent's marks

32. These marks share the same similarities as those discussed in the preceding paragraph. As for the differences, the same as discussed above also apply here save for the fact that the applicant's second mark does not have any device element and no use of colour. As a result, I consider that this results in a higher degree of visual similarity between these marks in comparison to those assessed

[5] On this point, I remind myself that the average consumers tend to focus on the beginnings of marks (see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02). But I also note that this is not always necessarily important or decisive (see *CureVac GmbH v OHIM,* T-80/08)

[6] Registration of a black and white mark enables the proprietor to use that mark in any colour but this does not extend to contrived colours splits like the one used in the applicant's first mark.

above (though not considerably). Overall, I consider that the applicant's second mark is similar to the opponent's first mark to an above medium (but not high) degree and similar to the opponent's second mark to a medium degree.

Aural Comparison

33. Given the identity of the aural element of the applicant's marks, I can assess them together. Aurally, all of the marks will be pronounced in the ordinary way. Both of the applicant's marks consist of three syllables, the opponent's first mark consists of two whereas its second consists of five.[7] All of these marks begin with the same two syllables, being 'PURR-PL'. While the point of identity sits at the beginning of the marks, I remind myself that this is not always decisive. On this point, I note that the opponent's first mark is only two syllables so, from an aural standpoint, it is a short mark. While there is no special test which applies to the comparison of 'short' marks,[8] I am of the view that, in the present case, the shortness of the opponent's first mark means that the average consumer is more likely to notice the differences. Taking all of this into account, I am of the view that the applicant's marks are aurally similar to a medium degree with the opponent's first mark. As for the opponent's second mark, I consider that the additional 'COMPUTING' element in that mark will act as an additional point of aural difference and result in a finding that it is similar to between a low and medium degree with the applicant's marks.

Conceptual Comparison

34. The concept associated with both of the applicant's marks will be that of a cube that is purple in colour. As a result, I consider that 'PurpleCube' will be viewed as a unit with its own meaning that is distinct from just the concept associated with the colour purple. While the applicant's first mark has a device element, the fact that this is a purple cube (albeit with one green panel), the concept associated with it will remain in line with the word element. As for the opponent's first mark, the word

[7] On this point, I refer to the case of *Purity Hemp Company Improving Life as Nature Intended,* Case BL O/115/22, wherein Mr Philip Harris, sitting as the Appointed Person, found that descriptiveness of an element does not necessarily make it aurally invisible. In the present case, I find that this applies to the word 'COMPUTING'.
[8] See paragraph 44 of *BOSCO*, BL O/301/20

‘PURPLE’ will simply be seen as a reference to the colour purple. The same concept will apply to the opponent’s second mark but the addition of the word ‘COMPUTING’, particularly when viewed on the services at issue, will be considered descriptive of the nature of those services. Given its descriptive nature, I do not consider that it will alter the consumer’s perception of the concept associated with ‘PURPLE’.

35. In comparing the marks from a conceptual viewpoint, I am of the view that the reference to the colour purple will be noted. However, the reference to a ‘Cube’ will be a point of conceptual difference. In my view, this creates a rather different concept to that which is created solely by the opponent’s reference to the colour alone. This is on the basis that the applicant’s marks refer to a physical object, being a cube, that happens to be purple in colour. As a result, I find that the applicant’s marks are conceptually similar to no more than a medium degree with the opponent’s first mark. While the additional word of ‘COMPUTING’ will be noticed, I do not see that it affects the concept of the opponent’s second mark to a sufficient enough degree that detracts from the findings made in respect of the opponent’s first mark. To confirm, I find that the opponent’s second mark is conceptually similar to no more than a medium degree with the applicant’s marks.

Distinctive character of the opponent’s marks

36. 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)."

37. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and has not filed any evidence to that effect. As such, I have only the inherent position to consider.

38. The word 'PURPLE' is an ordinary dictionary word with a meaning that will be well-known to average consumers. It is not allusive or descriptive of the services at issue but neither is the use of an ordinary dictionary word particularly remarkable. As such, I am of the view that it enjoys a medium degree of inherent distinctive character. As the only element of the opponent's first mark, it follows that this finding applies to that mark. As for the opponent's second mark, the word 'COMPUTING' is descriptive of the services at issue and, as a result, its addition will not be enough to take the inherent distinctive character of the second mark beyond that which is created by the word 'PURPLE'. As a result, I also find that the opponent's second mark enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

39. 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 trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the 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.

40. I have found the parties' services to be similar to either a high or an above medium degree. I have found the average consumer for the services to be business users who will select the services at issue via visual and aural means. I have concluded that the average consumer will pay a higher than medium degree of attention (but not high) when selecting the services at issue. I have found that the opponent's marks are inherently distinctive to a medium degree. In respect of the similarity of the marks at issue, I have found that the applicant's first mark is:

    a. Visually and conceptually similar to no more than a medium degree and aurally similar to a medium degree with the opponent's first mark; and
    b. Visually and aurally similar to between a low and medium degree and conceptually similar to no more than a medium degree with the opponent's second mark.

41. I have found the applicant's second mark to be:

a. Visually similar to an above medium (but not high) degree, aurally similar to a medium degree and conceptually similar to no more than a medium degree with the opponent's first mark; and
b. The applicant's second mark is visually similar to a medium degree and aurally similar to between a low and medium degree and conceptually similar to no more than a medium degree with the opponent's second mark.

42. The opponent's pleaded case in respect of direct confusion is as follows:[9]

> "As the Applicant's mark as a whole is highly similar to the Opponent's mark, the average consumer, having an imperfect recollection of the marks would not recall the minor elements of the marks that differ i.e. the word CUBE included in the Applicant's mark."

43. The above hinges on the argument that the word 'CUBE' is a minor element of the applicant's marks and that the marks are highly similar. I have found neither to be the case. As a result, I do not consider that the position put forward by the opponent is of any assistance to the issue of direct confusion.

44. Taking all of the above into account and also bearing in mind the principle of imperfect recollection, I am of the view that the average consumers would notice the differences between all of the marks at issue. While the common use of 'PURPLE' will be noticed and I note that this sits at the beginning of the marks at issue, I am of the view that the addition of 'CUBE' creates a sufficient enough difference between the marks that will allow the average consumer to accurately recall which mark was which. I make this finding not only on the basis of the visual and aural difference it creates but the conceptual difference also. I have found above that the addition of the word 'CUBE' to 'PURPLE', creates a unit in that it refers to a cube that is purple in colour. As such, this will not be forgotten or

[9] This pleading is taken from the opponent's notice of opposition against the applicant's first mark and in reliance upon the opponent's first mark. However, this pleading is consistent with the pleadings in respect of all other marks at issue.

overlooked. I do appreciate that the concepts of the marks are still somewhat similar but they are, in my view, different enough to assist the consumer in accurately identifying the marks at issue. Consequently, I consider that there is no likelihood of direct confusion. I find that this is particularly the case given that the average consumer for the services at issue is a business user who will pay a higher than medium degree of attention (but not high).

45. I turn now to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein 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'.
>
> 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)".

46. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

47. The opponent's argument in respect of indirect confusion is that "if the average consumer did recall the minor distinctions, they would assume the marks must emanate from the same source due to the high degree of similarity." I note that the opponent has not put forward any specific argument as to why it considers this to be the case. Without such, I do not consider it appropriate to give consideration to any argument outside of the examples put forward in *L.A. Sugar* (cited above). This is on the basis that it is not for me, as the Hearing Officer in this matter, to formulate the opponent's arguments on its behalf. So while these categories are not exhaustive, I have no specific argument that gives rise to any additional argument in support of indirect confusion.

48. In considering the marks at issue, I remind myself that the parties' marks all share use of the word 'PURPLE'. Inherently, this is only distinctive to a medium degree (on this point, no evidence of enhanced distinctiveness has been provided) and

given that it is a common word with a well-known meaning, I do not consider it to be so strikingly distinctive that average consumers would consider that only one undertaking would use it. Further, I do not consider the addition of 'CUBE' after the word 'PURPLE' would be viewed as a logical or consistent indication that the opponent has expanded to create a brand extension and neither would it be viewed as something that they would expect to find in a sub-brand. On this point, I see no logical basis for finding that the word 'CUBE' (which creates a unit in the applicant's marks and, therefore, carries a different conceptual hook as a whole) would result in the average consumers thinking that the marks originated from the same or economically linked undertakings. In considering the issue of indirect confusion, I have also borne in mind that the average consumer, when selecting the services at issue, would pay a higher than medium degree of attention. While this does not extend to high, it is enough to find that the level of attention paid would assist the consumer in concluding that the marks were not from the same or economically connected undertakings. Taking all of this into account and also bearing in mind the comments of Arnold LJ in the preceding paragraph, I find that there is no likelihood of indirect confusion.

CONCLUSION

49. The oppositions have failed in their entirety and, subject to any appeal, the applicant's marks may proceed to registration for all services applied for.

COSTS

50. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While these proceedings involve two separate oppositions, the claims brought against the applicant's marks were not particularly detailed and the arguments raised were highly similar, so too were the arguments in defence of the same. While I will make an increased costs award in respect of the duplication of work required, it will only be slight.

51. In the circumstances, I award the applicant the sum of **£700** as a contribution towards its costs. The sum is calculated as follows:

Considering the notices of opposition and filing counterstatements in respect of the same:	£300
Preparation of written submissions:	£400
Total:	**£700**

52. I hereby order Purple Computing Limited to pay PURPLECUBE INC. the sum of £700. The above 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 15th day of August 2023

A COOPER
For the Registrar

ANNEX

The opponent's first mark

Class 37

Installation, maintenance and repair of computer hardware; upgrading and updating of computer hardware; installation, maintenance and repair of telecommunications and telephony systems; upgrading and updating of telecommunications and telephony systems; technical support services, namely, troubleshooting in the nature of the repair of computer hardware; technical support services, namely, troubleshooting in the nature of the repair of telecommunications and telephony systems; information, advisory and consultancy services in respect of all of the aforesaid. .

Class 38

Telecommunications services; providing telephone systems; providing networking systems; providing access to the internet; communications services via the intranet, extranet, internet and other electronic means; provision of telecommunications access to the internet; telephony services; IP telephony services; providing access to electronic communications networks; e-mail services; information, advisory and consultancy services in respect of all of the aforesaid. .

Class 41

Education services; education services relating to computers, computer networking, computer software, computer systems, telecommunications systems and telephony systems; education services relating to the use of computers, computer networking, computer software, computer systems, telecommunications systems and telephony systems; education services relating to the installation, set-up, repair and maintenance of computers, computer networks, computer software, computer systems, telecommunications systems and telephony systems; information, advisory and consultancy services in respect of all of the aforesaid.

Class 42

Consulting services in the fields of information and telecommunication technology, computer hardware and software; computer consulting and support services; technical support services in connection with computer hardware, computer software, computer networking equipment and services, telephony systems, telecommunication equipment, IP telephony; technical customer support services in connection with computer hardware, computer software, computer networking equipment and services, telephony systems, telecommunication equipment, IP telephony; hosting of software and data for others; monitoring computer systems and networks; computer network design; telephony network design; leasing and hiring of computer hardware and computer software; computer programming; computer systems analysis; technological services relating to computers and computer networks; computer network services; computer help-line services; computer help-line services provided online; installation, maintenance and repair of computer software; upgrading and updating of computer software; technical support services, namely, troubleshooting in the nature of the repair of computer software; information, advisory and consultancy services in respect of all of the aforesaid.

The opponent's second mark

Class 37

Computer hardware repair; computer repair; computer hardware maintenance; installation of computer hardware; consultancy services relating to the installation of computer hardware.

Class 38

Advisory services related to telecommunications; telecommunications services; e-mail services; information services related to telecommunications; providing user access to the Internet.

Class 41

Education services relating to the use of computers, computer software; computer training; computer training advisory services; instruction in the repair of computers; Training services relating to computers, computer software.

Class 42

Advisory services relating to computer hardware, computer software; analytic services relating to computers, computer software; maintenance of computer software; services for the updating of computers, computer software; creating, maintaining and hosting the websites of others; consultancy services relating to computers, computer systems, computer hardware, computer networks and computer programming; advisory services relating to the use of computers, computer software; information services relating to computers, computer software.