

O/0881/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003703250
IN THE NAME OF ONPOINT TECHNOLOGIES, LLC
TO REGISTER THE FOLLOWING MARK:**

ONPOINT

IN CLASS 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433487
BY ONEPOINT**

Background and pleadings

1. These proceedings concern the opposition to an application to register **ONPOINT** as a trade mark in the UK. The application was filed by OnPoint Technologies, LLC (“the applicant”) on 29 September 2021, pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU which enabled applications pending at the European Union Intellectual Property Office (“EUIPO”) on IP Completion Day (31 December 2020) to be filed as applications in the UK and retain the EU filing date. The filing date for this application is therefore 05 May 2020.

2. The application was published for opposition purposes on 25 March 2022 and seeks registration for the following services:

Class 42: *Software as a service (SaaS) services for use in the industrial manufacturing industry featuring a software portal and user interface for use in asset optimization and visualization, management and optimization of production facilities, production operations, and operations data through machine learning, data analytics, and hardware sensors for the control, prediction and alert of production unit in the field of the industrial manufacturing industry; providing temporary use of on-line non-downloadable software for use in asset optimization and visualization, management and optimization of facilities and operations through machine learning, data analytics, and hardware sensors in the field of the industrial manufacturing industry; technical consulting services for production units in the industrial manufacturing industry in the field of asset optimization and visualization, management and optimization of facilities, operations, and operations data through machine learning, data analytics, and hardware sensors.*

3. On 12 May 2022, the application was opposed by ONEPOINT (“the opponent”) based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:¹

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent’s earlier marks were automatically converted into comparable UK trade marks. Comparable UK marks

UK00801194616 (“the first earlier mark”)

ONE POINT

Filing date: 25 October 2013; Registration date: 15 January 2015

Priority date: 01 July 2013; Priority country: France; TM from which priority is claimed
13/4016523

Relying upon some of the services for which the mark is registered, namely:

Class 42: *Computer services, namely consultancy in the field of computers and software; computer programming services; services for the production (design), creation, development, installation, commissioning, updating, maintenance and use of computer programs, Internet sites, internal and global computer networks, databases; computer consulting and advice, and technical support relating to the design, creation, development of computer programs, of Internet sites, internal computer and Internet networks, document management, databases, computers, computer hardware and computer systems, electronic products for telecommunications, security and authentication, conversion of data or documents from physical to electronic or digital media; computer consulting and advice, technical support (computer advice) relating to the installation, commissioning, maintenance of computer programs, Internet sites, internal computer and Internet networks, document management, databases, conversion of data or documents from physical to electronic or digital media; creation of databases containing personal and/or commercial information collected over computer networks, wireless networks and the Internet; hosting of computer sites (web sites).*

UK00915820335 (“the second earlier mark”)

onepoint.

Mark Description/Limitation: Colour Claimed: Black; Turquoise blue.

Filing date: 09 September 2016; Registration date: 19 January 2018

are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing date remains the same.

Relying upon some of the services for which the mark is registered, namely:

Class 42: *Computer services, namely consultancy regarding computers and computer software; Computer programming; Design, creation and development of computer programs, internet sites, internal and global computer networks, databases; Installation and commissioning of computer programs, internet sites, databases; Updating and maintenance of computer programs, internet sites, databases; Technical consultancy relating to the use of computer programs, internet sites, internal and global computer networks, databases; Computer consultancy and advice and technical support regarding the design, creation and development of computer programs; Computer consultancy and advice and technical support regarding the design, creation and development of internet sites; Computer consultancy and advice and technical support regarding the design, creation and development of internal computer networks and the internet; Information technology consultancy and advice and technical support relating to the design, creation, development of document management, databases; Information technology consultancy and advice and technical support relating to the design, creation, development of computers, computer hardware and computer systems; Computer consultancy and advice and technical support regarding the design, creation and development of electronic goods, telecommunications; Computer consultancy and advice and technical support regarding the design, creation and development of security and authentication; Computer consultancy and advice and technical support regarding the design, creation and development of the conversion of data or documents from a physical medium to an electronic or digital medium; Information technology consultancy and advice and technical computer support relating to the installation, operation and maintenance of computer programs, internet sites, internal computer networks and the internet, document management, databases, the conversion of data or documents from a physical medium to an electronic or digital medium; Creation of databases containing personal and/or commercial information collected through computer networks, wireless networks and the internet; Computer services, namely creation of an online community enabling registered users to create virtual communities and to take part in commercial and social networking activities; Design of an online portal enabling users to participate in business and*

social networking activities, to integrate with virtual communities and to make requests in connection with collaborative working spaces; Technical support services, namely troubleshooting in the nature of diagnosing computer hardware and software problems; Hosting of computer sites and websites; Design and development of computer hardware and software; Hosting of electronic infrastructures, for others, for arranging and conducting of presentations, meetings, gatherings and interactive discussions online; Information technology services, namely cloud hosting; Computer rental; Scientific and technological services and research and design relating thereto; Research and development in the fields of science and the digital economy.

UK00915820351 (“the third earlier mark”)



Mark Description/Limitation: Colour Claimed: Black; White; Turquoise blue.

Filing date: 09 September 2016; Registration date: 18 January 2018

Relying upon the same services as those relied upon under the second earlier mark.

UK00915820384 (“the fourth earlier mark”)

onepoint.

Filing date: 09 September 2016; Registration date: 12 January 2018

Relying upon the same services as those relied upon under the second earlier mark.

4. The opponent claims that the marks are highly similar and that the services are identical or highly similar, giving rise to a likelihood of confusion.

5. The trade marks upon which the opponent relies qualify as earlier trade marks under Section 6 of the Act by virtue of their earlier filing dates (or priority dates). Only the first earlier mark had completed its registration process more than 5 years before the filing date of the contested application and it is subject to the proof of use conditions, as per

Section 6A of the Act. As the other earlier marks are not subject to proof of use, the opponent can rely upon all of the services it has identified without having to show that it has used its marks.

6. The applicant filed a defence and counterstatement, denying the claims made and putting the opponent to proof of use of the first earlier mark.

7. The opponent is represented by D Young & Co LLP. The applicant is represented by Baker & McKenzie LLP. Only the opponent filed evidence. I shall refer to the evidence to the extent that I consider necessary. Neither party requested a hearing, nor did they file written submissions in lieu. This decision is taken following a careful perusal of the papers.

The evidence

8. The opponent's evidence consists of a witness statement from David Layani who is the Chief Executive Officer at the opponent's company. Mr Layani's witness statement is dated 27 October 2023 and is accompanied by exhibits 1-11.

EU Law

9. 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 Trade Marks 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.

My approach

10. The opponent relies on four earlier marks, however only one (i.e. the first earlier mark), is subject to proof of use. The first earlier mark is registered for a more restricted specification than the other marks that are not subject to proof of use, so it does not offer a better alternative for the opponent in terms of services. Admittedly, the first earlier mark is a word-only mark consisting of the word 'ONE POINT', whilst the other

earlier marks contain the word 'onepoint' as well as additional figurative elements, including a rectangular background, a dot and colours. However, the visual impact of these figurative elements is minimal, especially in the fourth earlier mark which does not contain any background or colour. Further, it seems to me notwithstanding the dot, the fourth earlier mark is closer to the applicant's mark than the first earlier mark, because the verbal element 'onepoint' is presented as one word (like in the applicant's mark 'ONPOINT') rather than as two separate elements.

11. It makes sense therefore in terms of procedural efficiency to focus on the fourth earlier mark (that is not subject to proof of use) and to return to the other marks only if it becomes necessary.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act is as follows:

"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".

13. Section 5A of the Act is as follows:

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 services

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. 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 complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

17. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

20. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”

21. The services to be compared are as follows:

The applicant’s services	The opponent’s services
<p>Class 42: <i>Software as a service (SaaS) services for use in the industrial manufacturing industry featuring a software portal and user interface for use in asset optimization and visualization, management and optimization of production facilities, production operations, and operations data through</i></p>	<p>Class 42: <i>Computer services, namely consultancy regarding computers and computer software; Computer programming; Design, creation and development of computer programs, internet sites, internal and global computer networks, databases; Installation and commissioning of</i></p>

machine learning, data analytics, and hardware sensors for the control, prediction and alert of production unit in the field of the industrial manufacturing industry; providing temporary use of on-line non-downloadable software for use in asset optimization and visualization, management and optimization of facilities and operations through machine learning, data analytics, and hardware sensors in the field of the industrial manufacturing industry; technical consulting services for production units in the industrial manufacturing industry in the field of asset optimization and visualization, management and optimization of facilities, operations, and operations data through machine learning, data analytics, and hardware sensors.

computer programs, internet sites, databases; Updating and maintenance of computer programs, internet sites, databases; Technical consultancy relating to the use of computer programs, internet sites, internal and global computer networks, databases; Computer consultancy and advice and technical support regarding the design, creation and development of computer programs; Computer consultancy and advice and technical support regarding the design, creation and development of internet sites; Computer consultancy and advice and technical support regarding the design, creation and development of internal computer networks and the internet; Information technology consultancy and advice and technical support relating to the design, creation, development of document management, databases; Information technology consultancy and advice and technical support relating to the design, creation, development of computers, computer hardware and computer systems; Computer consultancy and advice and technical support regarding the design, creation and development of electronic goods, telecommunications; Computer consultancy and advice and technical support regarding the design, creation and development of security and

	<p><i>authentication; Computer consultancy and advice and technical support regarding the design, creation and development of the conversion of data or documents from a physical medium to an electronic or digital medium; Information technology consultancy and advice and technical computer support relating to the installation, operation and maintenance of computer programs, internet sites, internal computer networks and the internet, document management, databases, the conversion of data or documents from a physical medium to an electronic or digital medium; Creation of databases containing personal and/or commercial information collected through computer networks, wireless networks and the internet; Computer services, namely creation of an online community enabling registered users to create virtual communities and to take part in commercial and social networking activities; Design of an online portal enabling users to participate in business and social networking activities, to integrate with virtual communities and to make requests in connection with collaborative working spaces; Technical support services, namely troubleshooting in the nature of diagnosing computer hardware and</i></p>
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	<p><i>software problems; Hosting of computer sites and websites; Design and development of computer hardware and software; Hosting of electronic infrastructures, for others, for arranging and conducting of presentations, meetings, gatherings and interactive discussions online; Information technology services, namely cloud hosting; Computer rental; Scientific and technological services and research and design relating thereto; Research and development in the fields of science and the digital economy.</i></p>
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22. The opponent's *scientific and technological services and research and design relating thereto* include computer and technology related services. Consequently, all of the applied-for services being IT-related services, fall within the broader category of the earlier *scientific and technological services and research and design relating thereto*. **These services are identical according to the principle set out in *Meric*.**

23. Alternatively, the opponent's services cover *design and development of computer hardware and software*, which would cover the design and development of goods that are identical to the software provided by the applicant through its services. In such circumstances, the services would have the same purpose (i.e. the provision of identical software) and target the same business users. Further, the services might share trade channels and are in competition, as a business could choose between a provider who supplies a finished software product, and another who can design and develop a software solution based on the client's requirements. Hence, I find that the following services in the applicant's specification are similar to a medium to high degree to the opponent's *design and development of computer hardware and software*:

Software as a service (SaaS) service for use in the industrial manufacturing industry featuring a software portal and user interface for use in asset optimization and visualization, management and optimization of production facilities, production operations, and operations data through machine learning, data analytics, and hardware sensors for the control, prediction and alert of production unit in the field of the industrial manufacturing industry; providing temporary use of on-line non-downloadable software for use in asset optimization and visualization, management and optimization of facilities and operations through machine learning, data analytics, and hardware sensors in the field of the industrial manufacturing industry.

24. Finally, the opponent's *technical consultancy relating to the use of computer programs, internet sites, internal and global computer networks, databases* are sufficiently broad to relate, for example, to the use of computer programs in the context of production units in the industrial manufacturing industry. It follows that the opponent's technical consultancy services encompass the applicant's *technical consulting services for production units in the industrial manufacturing industry in the field of asset optimization and visualization, management and optimization of facilities, operations, and operations data through machine learning, data analytics, and hardware sensors*. **These services are identical according to the principle set out in *Meric*.**

Average consumer

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

26. The average consumer of the services at issue is a business user. The purchasing process is likely to be dominated by visual considerations. However, I do not discount aural considerations in the form of, for example, oral discussions with sales representatives or word of mouth recommendations. The degree of attention is likely to be higher than normal given the specialised nature of the services in question and their price.

Comparison of marks

27. 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.”

28. 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.

29. The respective marks are shown below:

The applicant's mark	The opponent's mark
ONPOINT	onepoint.

30. The applicant's mark consists of the word 'ONPOINT' presented in upper case letters. The overall impression of the mark lies in the word itself.

31. The opponent's mark consists of the word 'onepoint' presented in low case letters followed by a dot. The word 'onepoint' plays the greater role in the overall impression, with the dot playing a lesser role.

Visual and aural similarity

32. The applicant's mark is a word-only mark which notionally covers use in all possible fonts and typefaces. For the purposes of the comparison of the marks, it is therefore irrelevant that the contested mark is written in upper-case letters and the opponent's mark in title-case letters.

33. The verbal elements 'ONPOINT' (in the applicant's mark) and 'onepoint' (in the opponent's mark) coincide in their first two letters 'ON/on' and in their sequence 'POINT/point'. Although, the word 'onepoint' in the opponent's mark contains an additional 'e' as a third letter, the resulting difference in the length of the signs (a seven-letter-word *versus* an eight-letter-word) is hardly noticeable. The opponent's mark also contains a small dot after the word 'onepoint'; however, given its size and nature, this element is likely to have very little visual impact and will not be articulated. The marks

are visually similar to a high degree. Admittedly, the differences between the pronunciation of the sequences 'ON' and 'one' is more striking than their visual differences, the word 'one' being pronounced as 'UAN'; nevertheless, the coincidence in the sounds of the word 'POINT' makes the marks aurally similar to a medium to high degree.

Conceptual similarity

34. Conceptually, although the verbal element 'onepoint' in the opponent's mark is presented as one word, the average consumer is likely to recognise the ordinary dictionary words 'one' and 'point' within the mark. The opponent's mark will therefore be understood as conveying two concepts, namely that of the number 1 and that of a point. Both concepts are reinforced by the presence of a dot at the end of the word 'onepoint', which will assist the perception of a parallel between the word 'point' and the graphic representation of a point as "a small, round spot" (and related concept).

35. Likewise, the relevant public will identify the elements 'ON' and 'POINT' in the word 'ONPOINT' and will split the applicant's mark into the two components 'ON' and 'POINT'. Insofar as the mark coincide in the concept of a point but differ in the presence of the additional concept of the number 1 (in the opponent's mark), they are conceptually similar to a medium to high degree.

Distinctive character of earlier mark

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 various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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.

38. As it will be recalled, the word ‘onepoint’ in the opponent’s mark will be split into the two components ‘one’ and ‘point’. The phrase is neither descriptive nor allusive of the services in question and, as such, it has a medium degree of distinctiveness.

39. The opponent has filed evidence of use of the earlier mark. However, the use shown is outside the UK (mostly in France) and cannot show that the earlier mark has acquired an enhanced level of distinctive character through use in the UK.

Likelihood of confusion

40. 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 marks may be offset by a greater degree of similarity

between the respective goods and services 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

41. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where 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.”

42. Earlier in this decision I found that:

- The applicant’s services are either identical or similar to a medium to high degree to the services of the earlier mark;
- The average consumer of the services would be a business user who would pay a higher than medium degree of attention during the purchasing process. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;

- The marks are visually similar to a high degree, aurally similar to a medium to high degree and conceptually similar to a medium to high degree;
- The earlier mark has a medium degree of inherent distinctive character, which has not been shown to have been enhanced through use.

43. Taking all of the above into account, in particular the high degree of visual similarity between the marks and the identity (or medium to high degree of similarity) of the services, I find that as a result of imperfect recollection, the average consumer is likely to confuse the marks. The absence of the letter 'e' in the applicant's mark does not remove the risk of confusion, as the words 'onpoint' and 'onepoint' are so close that can be easily misread or misremembered (even when the degree of attention involved is higher than medium) and the absence of a dot can be easily overlooked. There is a likelihood of direct confusion.

COSTS

44. The opponent has been successful and is, consequently, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £900 calculated as follows:

Preparing a statement and considering the applicant's statement:	£300
Preparing evidence	£500
Official fees:	£100
Total	£900

45. I therefore order OnPoint Technologies, LLC to pay ONEPOINT the sum of £900. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 18th day of September 2023

**Teresa Perks
For the Registrar**