O/0941/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003817043
BY DATAUN LTD
TO REGISTER THE TRADE MARK

maplab.world

IN CLASSES 9 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002728
BY MAPLAB SAS

Background and pleadings

1. On 05 August 2022, dataun ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 28 October 2022 in respect of the following goods and services:

> **Class 9:** *Map software; Computer digital maps; Downloadable electronic maps; Augmented reality software for creating maps; Navigation, guidance, tracking, targeting and map making devices.*
>
> **Class 42:** *Mapping; Mapping services; Cartography and mapping; Creation of GPS maps; Services for the design of maps; Providing online geographic maps, not downloadable; Preparation of maps in digital form; Services for the digitalization of maps.*

2. On 26 January 2023, Maplab SAS ("the opponent") opposed the application, based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition has been lodged using the Fast Track provisions. The opponent relies upon the UK comparable mark no. UK00918236699 for the trade mark **Maplab**. The earlier mark was filed on 08 May 2020 and registered on 08 September 2020 claiming a priority date of 15 November 2019.[1] The opponent identifies the following services upon which it relies:

> **Class 35:** *Retailing of computer software, digital tools and mobile applications.*
>
> **Class 42:** *Development of computers; Computer software design; Software development; Research and development for others; Conducting technical project studies; Architecture; Installation of software; Maintenance of software; Updating of computer software; Rental of software; Computer programming;*

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Computer system analysis; Computer system design; Consultancy in the design and development of computer hardware; Software as a service [SaaS]; Cloud computing; Information technology [IT] consultancy; Server hosting; Graphic art design; Electronic data storage; Design and development of computer software, digital tools and mobile applications; Computer consultancy and advisory services; Expert appraisals, development and maintenance relating to computer systems and applications.

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

4. By virtue of its earlier filing date, the mark upon which the opponent relies qualifies as an 'earlier trade mark' pursuant to Section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the applicant's mark, proof of use is not relevant in these proceedings.

5. The applicant filed a counterstatement, denying the claims.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought to file any evidence.

8. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor was it considered necessary; however, both

parties filed written submissions in lieu. This decision has been taken following a careful consideration of the papers.

9. The opponent is represented by Harrison IP Limited; the applicant is without legal representation.

EU Law

10. 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.

DECISION

Section 5(2)(b)

11. 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".

12. 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."

13. 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 goods and services

14. 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."

15. 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.

16. 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.

17. 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."

18. 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 goods/services is to assess whether the relevant public are liable to believe that 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."

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.

19. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

20. In *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main

reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

21. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM,* Case T-105/05*,* at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to

exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

22. The goods and services to be compared are as follows:

The applicant's goods and services	The opponent's services
Class 9: *Map software; Computer digital maps; Downloadable electronic maps; Augmented reality software for creating maps; Navigation, guidance, tracking, targeting and map making devices.*	
	Class 35: *Retailing of computer software, digital tools and mobile applications.*
Class 42: *Mapping; Mapping services; Cartography and mapping; Creation of GPS maps; Services for the design of maps; Providing online geographic maps, not downloadable; Preparation of maps in digital form; Services for the digitalization of maps.*	**Class 42:** *Development of computers; Computer software design; Software development; Research and development for others; Conducting technical project studies; Architecture; Installation of software; Maintenance of software; Updating of computer software; Rental of software; Computer programming; Computer system analysis; Computer system design; Consultancy in the design and development of computer hardware; Software as a service [SaaS]; Cloud computing; Information technology [IT] consultancy; Server hosting; Graphic art design; Electronic data storage; Design and development of computer software, digital tools and mobile applications; Computer consultancy and advisory*

	services; Expert appraisals, development and maintenance relating to computer systems and applications.

23. The opponent's reasoning for claiming that the respective goods and services are similar or identical are as follows:

1. the applicant's *mapping services; cartography and mapping; creation of GPS maps; services for the design of maps; providing online geographic maps, not downloadable; preparation of maps in digital form; services for the digitalization of maps* (in class 42) are encompassed by the opponent's *conducting technical project studies; architecture; information technology [it] consultancy; graphic art design; design and development of computer software, digital tools and mobile applications* (in class 42);

2. the opponent's *retailing of computer software, digital tools and mobile applications* (in class 35) and *rental of software* (in class 42) can cover the sale and rental of the applicant's software products in class 9, which means that the ultimate consumers of the opponent's services in class 35 and 42 and the applicant's software products in class 9 are the same;

3. the opponent's *design of software and digital tools for mobile applications* in class 42 is clearly similar to the applied-for goods in class 9 which are software for mobile devices;

4. insofar as some of the respective goods and services may not be held to be identical, they are nevertheless similar because they are complementary, are sold via the same channels of trade, are directed at similar users and are purchased for similar or connected uses.

24. The applicant maintains that the goods and services for which the application seeks protection are sufficiently distinct and not in direct competition with, or complementary to, those covered by the opponent's earlier mark. In particular, the applicant states that:

1. the opponent’s claim that the respective goods in class 9 and retail services in class 35 are similar is wrong, because it is based on the incorrect assumption that registering a mark in relation to goods equates to the retailing of one's own goods, and because the opponent had the opportunity, when applying for the earlier mark, to register it for goods in class 9 but elected not to do so;

2. The applied-for goods in class 9 do not explicitly nor implicitly refer to *mobile applications* (let alone retail of such goods) and so, in the applicant's view, that is to be disregarded. The comparison is between the opponent’s *retail of computer software and digital tools* and the applicant's *Map software* and *Computer digital maps*. The applicant also argues that (a) the term *map software* does not relate to computer software or digital tools stating that computer software would be a software that runs or operates on a computer or uses a computer, whilst *map software* run on a Global Positioning System (a navigation system more commonly known as a GPS), which is not a computer. By the same principle, *map software* is not a digital tool but rather a piece of software relating to cartography; (b) computer digital maps is a digital map that can be stored on a computer and so it is not a tool or a computer software and (c) given the vague and broad definition of *computer software* and *digital tools*, whilst the applicant accepts that there may be some very low-level overlap with the application's goods in class 9, the nature, purpose and method of use of the applicant’s goods (in class 9) are different to those of the opponent’s retail services (in class 35) and they are not in competition. The applicant also mentions a decision which it cites as *Palewell ltd v Dotcom Retail Limited* without providing the relevant case reference;

3. The respective services in class 42 are completely different because the applicant's services provide cartography and GPS maps whilst the opponent’s services relate to the development of computers; computer software; software as a service [SaaS] and graphic art designs.

Class 9

<u>Map software; Computer digital maps; Downloadable electronic maps; Augmented reality software for creating maps; Navigation, guidance, tracking, targeting and map making devices.</u>

25. I agree with the opponent that the terms *computer software, digital tools and mobile applications* in the class 35 specification of the earlier mark are completely unlimited and encompass computer software, digital tools and mobile applications of all kinds. Further, I find that the distinction the applicant attempted to draw between computer software and map software running on a GPS is artificial because (1) the dictionary definition of software is that of <u>computer</u> programs – this means that the applicant's map software must necessarily be a <u>computer</u> software and (2) the UKIPO classification tool includes the term *GPS software* which confirm my own understanding that GPSs are computer software. It follows that the applicant's terms *Map software; Augmented reality software for creating maps* are encompassed by the *computer software* to which the opponent's retail services relate.

26. The *digital tools* retailed by the opponent include any tool/device that uses or relates to computer technology or the internet and encompass the applicant's *Computer digital maps.* The same goes for the applied-for *Downloadable electronic maps,* which refer to maps which are captured, stored, and displayed by electronic means including computers, and relate to computer/digital cartography.

27. Finally, *Navigation, guidance, tracking, targeting and map making devices* include mapping software (which is covered by the software retailed by the opponent) which allow the user to generate maps with integrated navigation, guidance, tracking and targeting functions.

28. Accordingly, I find that the opponent's retail services in class 35 cover the retail of goods which are identical to the applicant's goods in class 9; applying the guidance from *Oakley, Inc v OHIM,* I find that the applicant's goods in class 9 are similar to a medium degree to the opponent's retail services in class 35.

Class 42

Mapping; Mapping services; Cartography and mapping; Creation of GPS maps; Services for the design of maps; Providing online geographic maps, not downloadable; Preparation of maps in digital form; Services for the digitalization of maps.

29. The applicant states that mapping or mapping services relate to cartography and GPS maps and means providing a service to allow users to access location-based maps. The remaining services in the class 42 specification of the applicant's mark consist in the provision of maps, including digital maps.

30. The closest clash I can see here is with the opponent's *Design and development of computer software, digital tools and mobile applications,* which include the design and development of *computer software, digital tools and mobile applications* that are used to generate, read and access digital maps, or for the digitalisation of maps. Even if the services are not identical, they are clearly in competition, as a customer could choose, for example, between using the contested services to obtain a map designed by the applicant or buying a software from the opponent which would enable the customer to generate or digitalise his own maps. The service of designing the software could be a direct alternative to having the service provided by the applicant. The services have therefore a similar nature and purpose, target the same consumers, are likely to share trade channels and are in competition. These services are similar to a medium to high degree.

Average consumer

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services. I must then determine the manner in which the 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.”

32. The average consumer of the services at issue could be a member of the general public or a business user.

33. The services will be selected visually with the marks being seen in advertisements, brochures, leaflets and through perusal of websites. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word of-mouth recommendations. The relevant consumers will apply a medium degree of attention when selecting the services.

Comparison of marks

34. 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.”

35. 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.

36. The respective marks are shown below:

The applicant's mark	The opponent's mark
maplab.world	Maplab

Overall impression

The opponent's mark

37. The opponent's mark consists of the word 'Maplab' presented in a standard typeface with the first letter 'M' in upper-case and the other letters in lower-case. There are no other elements to contribute to the overall impression, which lies in the word itself.

The applicant's mark

38. The applicant's mark consists of the word 'maplab' followed by a dot and the word 'world'.

39. The opponent states that although the applicant's mark 'maplab.world' is longer than the earlier 'Maplab' mark, the differentiating element '.world' is simply a top-level domain which provides an internet address and, as such, it does not assist the relevant public in differentiating between the marks.

40. In its submissions in lieu, the applicant accepts that the ending '.world' was introduced as a new domain option in 2015 but argues that it remains unestablished and widely unknown.

41. Regardless of whether the average consumer knows that '.world' is a real top-level domain, this element will be perceived as denoting that the whole mark is a domain name (a real one or one of fantasy). This is because the element '.world' reproduces the pattern of a top-level domain, which consists of a dot and a group of letters corresponding to the national extension, and the term 'world' conveys the message that the website (and the business behind it) appeals to customers from around the world or trades on a global scale.

42. But even if I am wrong in that the average consumer will see the applicant's mark as a domain name, the element '.world' is less distinctive than the element 'maplab' because: 1) the element 'maplab' is placed at the beginning of the mark and beginnings of marks tend to be more focused upon; 2) the element 'maplab' will be perceived as an invented word; 3) the word 'world' will be perceived as having its own independent identity within the mark as well as being low in distinctiveness because it will be understood as referring to the international nature of the business using the mark.

Visual and aural similarity

43. Visually, the fact that the opponent's mark is in title case whereas the applicant's mark is in lower case is not a point of difference as both marks are word-only marks and could be used in upper or lower case without affecting their registration.

44. Visually and aurally, the marks coincide in the element 'MAPLAB' which is the entirety of the opponent's mark and the first and most distinctive element of the applicant's mark. They differ in the presence of the dot and the word 'world' in the applicant's mark which has no counterpart in the opponent's mark. However, I have found that these elements are low in distinctiveness and have less weight than the shared element 'MAPLAB'. The marks are visually and aurally similar to a medium to high degree.

Conceptual similarity

45. **T**he word 'MAPLAB', which is present in both marks, is an invented word. The opponent states that the word was coined by the opponent and that whilst it is invented, it brings to mind the ideas of maps, maps' creation and analysis. I agree with the opponent. Whilst the average consumer will perceive 'maplab' as an invented word or a neologism, he will recognise that is made up of the two words 'map' and 'lab', the latter being an abbreviation for 'laboratory'. Hence, the element 'MAPLAB' will convey the same concept in both marks, namely that of a map laboratory. The applied-for mark includes the additional concept conveyed by the word 'world' as well as the concept of a domain name, neither of which is particularly distinctive. Overall, the marks are similar to a medium to high degree.

Distinctive character of earlier mark

46. 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 *WindsurfingChiemsee* 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)."

47. 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.

48. The opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, therefore I only have the inherent distinctiveness of the mark to consider.

49. The earlier mark consists of the words 'Maplab'. As it will be recalled, although the word 'Maplab' will be perceived as an invented word, it will nevertheless convey the idea of a map laboratory. Still, being an invented word, even if it conveys an allusive message in the context of the services which I have found to be similar (which relate to maps), it does it in a distinctive and original way. Overall, I consider that the earlier mark has a medium to high degree of distinctiveness.

Likelihood of confusion

50. 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.

51. 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.
>
> 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)."

52. Earlier in this decision, I concluded that:

- the contested goods and services in classes 9 and 42 are similar to a medium and medium to high degree to the opponent services in classes 35 and 42;

- the average consumer is a member of the general public (including businesses), who will select the goods and services by predominantly visual means, although not discounting aural considerations and will, on average, pay a medium degree of attention to the selection of such goods and services;

- The competing marks are visually, aurally and conceptually similar to a medium to high degree;

- the mark is inherently distinctive to a medium to high degree even if it does not benefit from enhanced distinctiveness from use.

53. Given that the dominant and most distinctive element in the applicant's mark is identical to the opponent's mark, I consider that there is potential for direct confusion. Taking into account the principle of imperfect recollection, I consider it likely that the average consumer will recall the name 'Maplab' and will mistake one mark for the other. This will, in my view, apply even where the marks are used on goods and services that are similar to medium degree, given the medium to high distinctive character of the earlier mark. Further, even if the differences between the marks are recalled, I consider that they are likely to be viewed as alternative marks used by the same or economically linked undertakings as the element '.world' is likely to be viewed as a variant of the opponent's mark denoting a domain name used by the opponent. There is a likelihood of confusion.

OUTCOME

54. The opposition has been successful. Subject to any appeal against my decision, the contested mark will be refused.

COSTS

55. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in fast-track opposition proceedings are governed by Tribunal Practice Notice 2 of 2015. I award costs to the opponent on the following basis:

Filing a notice of opposition £200
Submission in lieu: £200
Opposition fee £100
Total £500

56. I therefore order dataun ltd to pay Maplab SAS the sum of £500. 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 4th day of October 2023

Teresa Perks
For the Registrar