

O/1032/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO0000001622745

BY SHOPYMIND

TO REGISTER THE TRADE MARK

ShopiMind

IN CLASSES 9, 35, 38 and 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002377

BY SHOPPI LTD, MASSIMO CARLO ALBERTO ROSSI

AND SALVATORE VACANTE

Background and pleadings

1. International registration no. WO0000001622745 (“the contested mark”) consists of the sign shown on the cover page of this decision. The holder of the contested mark is SHOPYMIND. In this decision, I shall refer to SHOPYMIND as “the applicant”.
2. The contested mark claims a priority date of 23 December 2020 and is registered with effect from 04 March 2021. With effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement.
3. The applicant seeks protection for the contested mark in relation to the following goods and services:

Class 9: *Software; interactive databases; databases (electronic); computer databases; search engines as software.*

Class 35: *Advice to merchants and e-merchants for improving their e-commerce performance; business management consultancy; advice relating to commercial promotion; consultation for business management for improving e-commerce performance.*

Class 38: *Provision of access to a global computer network for online provision, distribution and referencing of databases of catalogs physical products and services of merchants and e-merchants; communications by computer terminals; provision of user access to global computer networks; provision of online forums; provision of access to databases; electronic bulletin board services (telecommunication services); connection by telecommunications to a global computer network; rental of access time to global computer networks; telecommunications; information relating to telecommunications; communication of information by electronic means; data communication via telecommunication; communication of data by electronic means; computer communication and access to the Internet; communication by electronic networks; communication by electronic means; transmission of data and*

messages by teletypewriter; message transmission; telematic services; electronic bulletin board services (telecommunication services); transmission of digital files; communications by telegrams.

Class 42: *Software as a service (SaaS).*

4. The request to protect the contested mark was published on 25 February 2022.

5. On 23 May 2022, Shoppi Ltd, Massimo Carlo Alberto Rossi and Salvatore Vacante (“the opponents”) opposed the contested mark under Sections 5(2)(a) and 5(2)(b) the Trade Marks Act 1994 (“the Act”). The opposition has been lodged using the Fast Track provisions. The opponents are co-owners of the UK comparable mark no. UK00916684797 shown below (“the earlier mark”), upon which they rely:



6. The earlier mark was filed on 08 May 2017 and registered on 04 May 2018.¹ The opponents identify the following goods and services upon which they rely:

Class 9: *Application software; E-commerce software; Mobile apps; Application software for mobile phones; Computer e-commerce software; Computer software for advertising; Computer software for mobile phones; Software for tablet computers; Software for online messaging; Software for mobile phones; Software for interactive television; Virtual reality software; Media content; Media software.*

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.

Class 35: *Advertising for others; Advertising analysis; Analysis of advertising response; Evaluating the impact of advertising on audiences; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising and marketing services provided via communications channels; Provision of an on-line marketplace for buyers and sellers of goods and services; Analysis of the public awareness of advertising; Analysis relating to marketing; Consumer response analysis; Dissemination of data relating to advertising; Grain market analysis; Coupon procurement services for others; Mediation of advertising; Advertising via electronic media and specifically the internet; Promotional marketing services using audiovisual media; Retail purposes (Presentation of goods on communication media, for -); Presentation of goods on communications media, for retail purposes; Presentation of companies on the Internet and other media; Advertising and marketing services provided by means of social media; Presentation of goods on communication media, for retail purposes.*

Class 38: *Photo uploading services; Video uploading services; Providing on-line chat rooms for social networking; Digital transmission of data; Message services; Providing online chatrooms for the transmission of messages, comments and multimedia content among users; Communication services for the transmission of information; Communication services for the electronic transmission of voices; Communication services for the electronic transmission of images; Delivery of digital audio and/or video by telecommunications; Delivery of messages by audiovisual media; Digital transmission of data via the Internet; Digital transmission of voice; Delivery of messages by electronic media; Message sending, receiving and forwarding; Interactive transmission of video over digital networks; Interactive communication services; Inter-active video text services; Video transmission via digital networks; Transmission of messages and images; Provision of access to an electronic marketplace [portal] on computer networks.*

7. The opponents claim that the marks are similar and that the goods and services are similar or identical, giving rise to a likelihood of confusion. In particular, the opponents state that the marks share the letters 'S', 'H', 'O', 'P', 'I', that the differences between

'SHOPI' and 'SHOPPI' are minimal, and that the word 'MIND' in the contested mark is descriptive and will be overlooked.

8. By virtue of its earlier filing date, the mark upon which the opponents rely 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.

9. The applicant filed a counterstatement, in which it admits that some of the goods and services in class 9, 35, 38 and 42 are similar to the opponent's goods and services including software, advertising/promotion and telecommunication, but otherwise it denies the claims. In particular, the applicant states that the share element 'SHOP' is purely descriptive and has a very low level of distinctive character.

10. 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.”

11. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. During the course of the proceedings, the applicant made a request for leave to file evidence about earlier EUIPO decisions concerning the likelihood of confusion between trade marks sharing the word 'SHOP', which was preliminarily refused. The preliminary refusal was then re-examined at a Case Management Conference ("CMC") on 1 June 2023 and was upheld. The applicant eventually provided copy of a EUIPO decision as part of its submissions in lieu; the decision, which is not binding upon me, relates to an appeal against the decision to reject an opposition against the earlier mark based on the trade mark 'SHOPIFY'. The BoA upheld the decision that there was no likelihood of confusion based on the finding that the element 'SHOP' had a low degree of distinctive character.

12. 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.

13. The applicant is represented by Forresters IP LLP; the opponents are without legal representation.

EU Law

14. 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)

15. Section 5(2)(a) and (b) of the Act is as follows:

“A trade mark shall not be registered if because-

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

(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”.

16. 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.”

17. 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

18. 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.”

19. 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.

20. 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.

21. 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.”

22. 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.”

23. 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.

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

The applicant's goods and services	The opponents' goods and services
<p>Class 9: <i>Software; interactive databases; databases (electronic); computer databases; search engines as software.</i></p>	<p>Class 9: <i>Application software; E-commerce software; Mobile apps; Application software for mobile phones; Computer e-commerce software; Computer software for advertising; Computer software for mobile phones; Software for tablet computers; Software for online messaging; Software for mobile phones; Software for interactive television; Virtual reality software; Media content; Media software.</i></p>
<p>Class 35: <i>Advice to merchants and e-merchants for improving their e-commerce performance; business management consultancy; advice relating to commercial promotion; consultation for business management for improving e-commerce performance.</i></p>	<p>Class 35: <i>Advertising for others; Advertising analysis; Analysis of advertising response; Evaluating the impact of advertising on audiences; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising and marketing services provided via communications channels; Provision of an on-line marketplace for buyers and sellers of goods and services; Analysis of the public awareness of advertising; Analysis relating to marketing; Consumer response analysis; Dissemination of data relating to advertising; Grain market analysis; Coupon procurement services for others; Mediation of advertising; Advertising via electronic media and specifically the internet; Promotional marketing services using audiovisual media; Retail</i></p>

	<p><i>purposes (Presentation of goods on communication media, for -); Presentation of goods on communications media, for retail purposes; Presentation of companies on the Internet and other media; Advertising and marketing services provided by means of social media; Presentation of goods on communication media, for retail purposes.</i></p>
<p>Class 38: <i>Provision of access to a global computer network for online provision, distribution and referencing of databases of catalogs physical products and services of merchants and e-merchants; communications by computer terminals; provision of user access to global computer networks; provision of online forums; provision of access to databases; electronic bulletin board services (telecommunication services); connection by telecommunications to a global computer network; rental of access time to global computer networks; telecommunications; information relating to telecommunications; communication of information by electronic means; data communication via telecommunication; communication of data by electronic means; computer communication and access to the Internet; communication by electronic networks; communication by</i></p>	<p>Class 38: <i>Photo uploading services; Video uploading services; Providing on-line chat rooms for social networking; Digital transmission of data; Message services; Providing online chatrooms for the transmission of messages, comments and multimedia content among users; Communication services for the transmission of information; Communication services for the electronic transmission of voices; Communication services for the electronic transmission of images; Delivery of digital audio and/or video by telecommunications; Delivery of messages by audiovisual media; Digital transmission of data via the Internet; Digital transmission of voice; Delivery of messages by electronic media; Message sending, receiving and forwarding; Interactive transmission of video over digital networks; Interactive communication services; Inter-active</i></p>

<i>electronic means; transmission of data and messages by teletypewriter; message transmission; telematic services; electronic bulletin board services (telecommunication services); transmission of digital files; communications by telegrams.</i>	<i>video text services; Video transmission via digital networks; Transmission of messages and images; Provision of access to an electronic marketplace [portal] on computer networks.</i>
Class 42: Software as a service (SaaS).	

Class 9

Class 9: Software; interactive databases; databases (electronic); computer databases; search engines as software.

25. In its submissions in lieu, the applicant states that it does not dispute that *software* and *search engines as software* are similar to the different types of software covered by the earlier mark. However, the applicant denies that the terms *interactive databases, databases (electronic); computer databases* are identical or similar to the goods (and services) of the earlier mark because “*databases are structured data sets held within computer systems that are primarily used to store, sort and access large quantities of information*” and “*a database is not a recorded programme or an app that is downloaded onto a mobile (or other computer) device*” so the goods have a different nature, intended purpose, method of use, trade channels, uses and users and cannot be said to be in competition with, or strictly complementary to, each other.

26. The terms *software* and *search engines as software* in the applicant’s specification are encompassed by the broad term *application software* in the opponents’ specification. These goods are identical according to the principle outlined in *Meric* (and the applicant admitted that they are similar).

27. Contrary to the applicant’s submissions, I find that the opponents’ *application software* includes software for reading the applicant’s *interactive databases; databases (electronic); computer databases*. The goods have the same purpose, i.e.

they allow users to access electronic databases, target the same users and are highly complementary. These goods are similar to a medium degree.

Class 35

Advice to merchants and e-merchants for improving their e-commerce performance; business management consultancy; advice relating to commercial promotion; consultation for business management for improving e-commerce performance.

28. In its submissions in lieu, the applicant states that it does not deny that *advice relating to commercial promotion* is similar to terms such as *advertising, marketing and promotional consultancy* in the earlier mark's specification. However, the applicant denies that the other terms (i.e. *advice to merchants and e-merchants for improving their e-commerce performance, business management consultancy, consultation for business management for improving e-commerce performance*) are similar. In particular, the applicant states that its services are general business advisory and consultancy services that can be used to help businesses boost their productivity and operational efficiencies in order to meet market demands, comply with certain regulations, increase their competitiveness and/or become more profitable, whereas the opponents' services are only offered to those that are specifically looking to outsource advertising and promotional campaigns.

29. I consider that the applicant's *advice to merchants and e-merchants for improving their e-commerce performance* and *advice relating to commercial promotion* fall within the opponents' term *advertising, marketing and promotional consultancy, advisory and assistance services*. These services are identical according to the principle outlined in *Meric*. Whilst the applicant attempts to distinguish between the two terms by saying that it admitted that the latter is similar whereas the first is not, I reject the distinction, because *advice to merchants and e-merchants for improving their e-commerce performance* is sufficiently broad to cover advice relating to advertising and promotion as a way to improve e-commerce performance.

30. The applicant's *consultation for business management for improving e-commerce performance* might include advice about how to increase online sales and engage with

customers through advertising solutions, and how to advertise and promote a business online. Whilst the applicant's consultancy services might be provided in the context of business management services aimed at facilitating the running of a successful business, they might include advice on, *inter alia*, marketing and promotion, creating an overlap with the opponents' advertising consultancy services. The services have a similar nature (insofar as they both cover marketing advice), they also have the same purpose (i.e. improving business performance) and target the same business users. In my view these services are similar to a medium degree. The same goes for the applicant's business management consultancy which is sufficiently broad to cover business management consultancy relating to marketing. These services are similar to a medium degree.

Class 38

Provision of access to a global computer network for online provision, distribution and referencing of databases of catalogs physical products and services of merchants and e-merchants; communications by computer terminals; provision of user access to global computer networks; provision of online forums; provision of access to databases; electronic bulletin board services (telecommunication services); connection by telecommunications to a global computer network; rental of access time to global computer networks; telecommunications; information relating to telecommunications; communication of information by electronic means; data communication via telecommunication; communication of data by electronic means; computer communication and access to the Internet; communication by electronic networks; communication by electronic means; transmission of data and messages by teletypewriter; message transmission; telematic services; electronic bulletin board services (telecommunication services); transmission of digital files; communications by telegrams.

31. In its submissions in lieu, the applicant states that the parties' services in class 38 are dissimilar because the applicant's services are used to access databases and other online data storage systems that contain information relating to merchants and e-merchants, whilst the opponents' services appear to be used for the purposes of social media and/or social messaging. According to the applicant, the services have a

different nature and intended purposes, have different trade channels, end users, method of use, and cannot be said to be in competition with, or strictly complementary to, each other. This appears to be in contrast with the applicant's admission contained in its counterstatement that the parties' telecommunication services are similar. Further, although the opponents' services might cover services that appear to relate to social messaging, i.e. *Providing online chat rooms for social networking; Digital transmission of data; Providing online chatrooms for the transmission of messages, comments and multimedia content among users*, they also cover broader services unrelated to social messaging.

32. The opponents' specification in class 38 covers *Provision of access to an electronic marketplace [portal] on computer networks* which is sufficiently broad to cover the applicant's *Provision of access to a global computer network for online provision, distribution and referencing of databases of catalogs physical products and services of merchants and e-merchants* and can also be covered by the applicant's *provision of user access to global computer networks; connection by telecommunications to a global computer network*. Further, insofar as the provision of the opponents' services can be provided in the form of renting *access to an electronic marketplace [portal] on computer networks* it also covers *rental of access time to global computer networks*; These services are identical according to the principle outlined in *Meric*.

33. The opponents' *Communication services for the transmission of information* is either encompassed by or encompass the following services in the applicant's specification: *communications by computer terminals; electronic bulletin board services (telecommunication services); telecommunications; communication of information by electronic means; data communication via telecommunication; communication of data by electronic means; computer communication and access to the Internet; communication by electronic networks; communication by electronic means; transmission of data and messages by teletypewriter; message transmission; telematic services; electronic bulletin board services (telecommunication services); transmission of digital files; communications by telegrams*. These services are identical according to the principle outlined in *Meric*.

34. The opponents' term *providing online chatrooms for the transmission of messages, comments and multimedia content among users and Interactive communication services* encompass the applicant's provision of online forums. These services are identical according to the principle outlined in *Meric*.

35. The opponents' term *digital transmission of data* covers digital transmission of databases. Even if not identical, these services are highly similar to the applicant's provision of access to databases as the services have a similar nature and purpose, i.e. they provide access or transmission of databases via the internet, target the same users and are likely to share trade channels. Further, the services are complementary insofar as in order for databases to be transmitted, they have to be accessed first. If not identical, these services are similar to a high degree.

36. Finally, information relating to telecommunications is similar to a medium degree to the opponents' *Digital transmission of data via the Internet*, which are essentially telecommunication services. The services target the same users, are likely to share trade channels and are complementary insofar as the provision of information might be important in order to access the services.

Class 42

Software as a service (SaaS).

37. The applicant states that the earlier mark is not protected for any class 42 services and admits that although the services are not identical to any of the terms covered by the opponents' specification, they are similar to a very low degree. In my view, the degree of similarity between the opponents' software goods and the applicant's Software as a service (SaaS) is higher than low, because the goods and services can relate to the same type of software. Hence, a customer can have a choice between purchasing the opponent's software or accessing the same software through the applicant's SaaS which is a licensing model in which access to software is provided on a subscription basis, where the software is located on external servers rather than on servers located in-house. The goods and services have the same purpose, target the same users, are in competition and are likely to share trade channels. These goods and services are similar to a medium degree.

Average consumer

38. As the case law above indicates, it is necessary for me to determine who the average consumer is for the 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.”

39. The average consumer of the goods and services at issue is a member of the general public or a business user. The goods and services will be selected visually with the marks being seen in advertisements, brochures, leaflets and through perusal of websites. However, I do not discount aural considerations entirely as it is possible that the purchasing process would involve oral discussions with sales representatives or word of mouth recommendations.

40. In its submissions in lieu, the opponents state:

“Given the lack of evidence regarding the use of the mark “Shopimind,” we assume it is related to a consumer audience with a relatively low degree of attention. The mark itself does not suggest exclusivity for use by professionals with a higher degree of attention.”

41. I reject the submission. First, the fact that the goods and services at issue might target members of the general public does not necessarily mean that the degree of

attention is less than normal (i.e. medium) as members of the general public are perfectly capable of paying a normal (or higher than normal) degree of attention, depending on the nature of the goods and services they select. Secondly, the parties' goods and services are such that they might be purchased by businesses as well as members of the general public and their specialised nature is likely to result in the average consumer deploying at least a medium degree of attention.

Comparison of marks

42. 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.”

43. 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.

44. The respective marks are shown below:

The applicant's mark	The opponents' mark
<h1 data-bbox="204 353 675 439">ShopiMind</h1>	

Overall impression

45. In its submissions in lieu, the opponents state:

"In comparing the trademarks, it is important to note that the figurative mark for "Shoppi" does not include any specific graphic elements and can be perceived as a word. Thus, the comparison primarily revolves around the word elements. The inclusion of the cart in the figurative mark does not contribute significantly to its distinctiveness and may instead evoke a connection to the act of shopping.

Taking into account that the word "mind" is presented with the capital letter "M," it suggests that the comparable part is only "Shopi." While "mind" is a generic word with various meanings, it still evokes a sense of something related to thinking or cognition. It is through this comparison that the realm of shopping becomes relevant, and a comparison within this realm is plausible. However, the generic term "shop" should not be given undue weight. Instead, the focus should be on the similarity between "Shoppi" and "Shopi," with the repetition of the letter "p" being insignificant to the average consumer. As a result, the marks will be perceived as more similar than dissimilar.

The absence of evidence of use for the "Shopimind" trademark is concerning. The wordmark, comprising the terms "shopi" and "mind," lacks distinctiveness and raises the possibility of separate use in a figurative representation, further increasing the risk of likelihood of confusion. This raises concerns about dilution of existing brands that rely on continued use in the United Kingdom.

Furthermore, the evidence presented from the EUIPO does not offer substantial support to the arguments put forth by the Applicant. The analysis of evidence from the EU, where multiple languages are spoken, mainly focuses on basic knowledge of English. Therefore, it does not account for interpretations beyond the basic level or variations specific to the English language.”

46. Before I turn to the applicant’s submissions, I should say that some of the points raised by the opponents are wholly irrelevant.

47. Firstly, the absence of evidence of use of the applicant’s mark is neither here nor there. As the opposition is based on Section 5(2)(a) and (b), I am only concerned with the likelihood of confusion; furthermore, as the opponents did not raise any objection based on Section 3(1)(b) or (c), they are not permitted to argue that the contested mark is descriptive or lacks distinctiveness. Secondly, the comparison of the marks must be carried out between the marks as they are registered and applied for, respectively, without assuming the presence of additional figurative elements that are not incorporated in the application.

48. The applicant states that the opponents cannot claim a monopoly over the descriptive word ‘SHOP’. It states that *“the only (slight) degree of visual similarity [between the marks] is found within the word "shop" (which is entirely descriptive of shopping/e-commerce/advertising goods and services) and the letter "I" that appears in both marks”* and that *“the fact that the marks coincide with regard to their descriptive and/or low-distinctive elements is not enough to demonstrate more than a very low degree of visual similarity”*. Aurally and conceptually, the applicant’s submissions are based on the contested ‘ShopiMind’ mark being perceived as the three word ‘SHOP’-‘I’-‘MIND’ and states as follows:

“The contested mark will be pronounced by consumers as a three-syllable word "SHOP -I- MIND". Consumers will immediately identify this pronunciation as a result of the contested mark being formed of three, everyday English words. On the other hand, the earlier logo mark will be read as a single, two-syllable word "SHOP – PEE". Crucially, consumers in the UK will immediately identify the use

of a double constant in the earlier logo mark (Shoppi) and incorporate that into the pronunciation of the "SHOP – PEE" word. Consumers in the UK will naturally follow this grammatical rule, and therefore will not adopt a different pronunciation such as "SHOPP.I". This distinction is extremely important when assessing the (lack of) aural similarity between the marks.

When the parties' marks are viewed as a whole, the conceptual comparison also finds a low degree of similarity. This is because the signs only have the descriptive term "shop" in common. Consumers will likely perceive the earlier logo mark as referring to the word "shopping" from which the last part (-ng) has been deleted. On the other hand, it is not possible to easily find a corresponding conceptual meaning when reading the contested mark (SHOP-I-MIND). Fundamentally, the shared descriptive reference to "shop" is not sufficient, in itself, to establish a conceptual link between the parties' marks.

With regard to the overall impression conveyed by the marks, this cannot be dominated by the descriptive word "shop" and therefore the marks, at the very most, have a low degree of similarity".

The applied-for mark

49. The applicant's mark consists of the word 'ShopiMind' presented in standard letters. I note that the letters 'S' and 'M' are presented in upper-case, whilst the other letters are presented in lower-case. Although the mark is presented as one word, the average consumer will, in my view, perceive it as being made up of the two words 'Shopi' and 'Mind' conjoined. This is because (a) the use of upper-case and lower-case letters lends the mark to be readily split into the two elements 'Shopi' and 'Mind' (b) although the word 'Shopi' is not a dictionary word, it is presented as having a unitary character and is followed by the well-known word 'Mind'. Further, I consider somewhat farfetched to state that the average consumer will identify the letter 'i' as the pronoun 'I' as alleged by the applicant because (1) the letter 'i' is presented in lower case (whilst the pronoun 'I' always uses the capital letter 'I') (2) there is no space between the letters 'Shop' and the letter 'i' and (3) the sentence 'Shop I Mind' is not grammatically correct and is unlikely to be identified. Rather on the contrary, as already stated above,

the consumer will view the contested mark as a whole and will perceive it as being made up of the two words 'Shopi' and 'Mind'. The word 'Shopi' is invented but evokes the concept of shopping, which is allusive and/or descriptive of goods and services offered for sale, especially those relating to advertising services and e-commerce, and it is inherently distinctive to a low to medium degree. The element 'Mind' also contributes to the overall impression of the mark, which as a result, lies in the combination of these elements.

The opponents' mark

50. The opponents' mark consists of the word 'Shoppi' presented in title case within a rectangular blue background incorporating the image of a shopping trolley. The word 'Shoppi' is not a dictionary word and will be perceived as evoking the word 'Shopping'. The figurative element will be perceived as reinforcing the concept of shopping and also contributes to the overall impression of the mark, although to a lesser degree.

Visual similarity

51. Visually, the marks coincide in the word element 'Shopi' and 'Shoppi' which, in themselves, are similar to a high degree differing only in the presence of an additional letter 'p' in the opponents' mark. The marks differ in the figurative element of the opponents' mark and in the word 'Mind' of the applicant's mark. The marks are visually similar to a low degree.

Aural similarity

52. Aurally the word 'Shopi' and 'Shoppi' will be pronounced in an identical (or almost identical) manner, whilst the word 'Mind' in the applicant's mark has no counterpart in the opponents' mark. Overall, the marks are aurally similar to a medium degree.

Conceptual similarity

53. Conceptually, the marks coincide to the extent that the words 'Shopi' and 'Shoppi' will be perceived as evoking the word 'Shop' or 'Shopping'. The marks differ in the

concept of 'mind' which is only present in the applicant's mark. Overall, the marks are conceptually similar to a medium degree.

Distinctive character of earlier mark

54. 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).”

55. 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.

56. The opponents make 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.

57. Although the word 'Shoppi' will be perceived as an invented word, it will nevertheless convey the idea of shopping which is very weak in distinctiveness, especially in relation to goods and services relating to e-commerce and advertising/promotion, because the aim of advertising/promotion is to increase sales. Still, being an invented word, even if it conveys a descriptive message it has a degree of distinctiveness. The image of the trolley reinforces the shopping message and it is even less distinctive than the word 'Shoppi' and I consider that as a whole, the earlier mark has a low to medium degree of distinctiveness.

Likelihood of confusion

58. 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.

59. 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).”

60. Earlier in this decision, I concluded that:

- the contested goods and services are either identical or similar to a medium and high degree;

- the average consumer is a member of the general public or a business user 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 similar to a low degree and aurally and conceptually similar to a medium degree;
- the earlier mark is inherently distinctive to a low to medium degree.

61. Before I move on to the likelihood of confusion, I want to deal with a point that the opponents made in their written submissions, namely that *“the arguments presented by the applicant lack substantial evidence and fail to demonstrate good faith use of the trademark”* and that *“there is a risk of bad faith and misuse of the trademark application, which undermines the principles of fair competition in the market”*. As the opponents have not pleaded bad faith, these comments are not pertinent. The question I have to ask myself is whether there is a likelihood of confusion between the marks, not whether the application was filed in bad faith. Hence, I will say no more about it.

62. Turning to the likelihood of confusion, the low degree of visual similarity between the competing marks means that they are unlikely to be mistaken for one another, i.e. there will be no direct confusion.

63. As regards the possibility of indirect confusion, the common elements ‘Shopi’ and ‘Shoppi’ are evocative of the words ‘Shop’ or ‘Shopping’ which call to mind a descriptive concept. The meaning attributed to ‘Shopi’ and ‘Shoppi’ is therefore based on the closeness of these terms to the descriptive (or at best highly allusive) words ‘Shop’ or ‘Shopping’. Even if the average consumer might directly confuse these elements of the marks, the likelihood of confusion must be assessed taking into consideration the marks as wholes. Given that visual considerations form a significant part of the selection process, the differences introduced by the word ‘Mind’ and the absence of the figurative elements in the in the application will not be ignored. The

question is therefore whether the average consumer having notice these differences will still consider the marks to come from the same or economically connected undertakings.

64. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

65. Example: In *General Ecology, Inc. v Wan Jou Lin & Great Ins Company Ltd*, O/0331/23, Phillip Johnson, as the Appointed Person, found that the following trade mark was confusingly similar to the trade mark NATURE PURE, despite the common elements only having low distinctiveness:



66. Having considered all of the relevant factors, I am not convinced that the average consumer will see the applicant's mark as a logical extension of the earlier mark notwithstanding the similarities created by the elements 'Shopi' and 'Shoppi'. This is because (1) the words 'Shopi' and 'Shoppi' will be perceived as evocative of the word 'shopping' which is inherently weak in relation to any goods and services offered for sale and has obvious significance in relation to services relating to advertising/promotion and e-commerce, which seem to be the ones the parties are more concerned about; (2) the impact of the non-coinciding components on the overall impression of the mark is significant and creates different overall impressions – one mark being based on the word 'Shoppi' and the image of a trolley the combination of which creates a mark that clearly and directly revolves around the concept of shopping; the other mark resulting from the combination of the similar word element 'Shopi' (which has a low to medium degree of distinctiveness) with the word Mind, the combination of which, perceived as a whole, creates an ambiguous mark that combines the concept of a mind and the concept of shopping without creating a meaningful phrase and it striking for this reason. Overall, my conclusion is that the lower-than-normal distinctiveness of the coinciding element combined by the different impressions the marks create – the simplicity of the earlier mark being strikingly different from the ambiguity of the contested mark - means that **there is no likelihood of confusion.**

Section 5(2)(a)

67. I can address this ground very briefly. A requirement of Section 5(2)(a) is that the marks are identical. As I found that the marks are not identical, the opposition under this ground fails at the first hurdle.

OUTCOME

68. **The opposition has been unsuccessful.** Subject to any appeal against my decision, the contested mark will be registered.

COSTS

69. As the applicant 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 counterstatement £200

Submission in lieu: £300

Total £500

70. I therefore order Shoppi Ltd, MASSIMO CARLO ALBERTO ROSSI and SALVATORE VACANTE (jointly) to pay SHOPYMIND 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 2nd day of November 2023

Teresa Perks

For the Registrar