O/1070/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3793906
IN THE NAME OF AFTERLIFE SERVICES LIMITED
TO REGISTER AS A TRADE MARK

INNER CORE

IN CLASSES 9 AND 42

AND

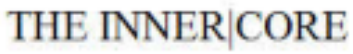
IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 437165
BY CEM JIM LEO

BACKGROUND AND PLEADINGS

1. On 30 May 2022, Afterlife Services Limited ("the applicant") applied to register trade mark number UK3793906 for the mark "**INNER CORE"** in the United Kingdom. The application was accepted and published for opposition purposes on 29 July 2022, in respect of goods and services in classes 9 and 42, as listed in the table under paragraph 15 of this decision.

2. The application is opposed by Cem Jim Leo ("the opponent"). The opposition was filed on 28 October 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following two marks:

UK trade mark registration number 3266686
Filing date: 27 October 2017
Registration date: 26 January 2018
Registered in Classes 9, 18, 25, 38 and 41
Relying on some goods in Class 9 only, as listed in the table under paragraph 15 of this decision.
(The '686 mark); and



UK trade mark registration number 3257297
Filing date: 18 September 2017
Registration date: 15 December 2017
Registered in Classes 9, 18, 25, 38 and 41
Relying on some goods in Class 9 only, as listed in the table under paragraph 15 of this decision.
(The '297 mark).

3. Each of the trade marks upon which the opponent relies qualifies as an earlier trade mark under section 6(1) of the Act. As neither mark had completed its registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that because of the similarity between the contested sign and the earlier signs, and the identicality/similarity between the competing goods and services, that there exists a likelihood of confusion. As such, it submits that the application should be refused under section 5(2)(b) of the Act, and requests an award of costs in the opponent's favour.

5. The applicant filed a counterstatement denying each and every claim, and seeks dismissal of the opposition, with an award of costs made in its favour.

6. Only the opponent filed written submissions during the evidence rounds, which will be referred to as and where appropriate during this decision. Neither party filed written submissions in lieu and neither party elected to file evidence. As neither party requested a hearing, this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Baron Warren Redfern and the applicant is represented by Keystone Law Limited.

Preliminary Issues

8. In its counterstatement, the applicant submits that it is unclear which goods and/or services are relied upon by the opponent. However, the amended form TM7 served upon the applicant on 9 November 2022 clearly indicates that the opponent is relying on the Class 9 goods as shown in the table under paragraph 15 of this decision.

9. The applicant also questions why the opponent is relying on only two of its three earlier registered "INNER CORE" marks. However, there is no requirement for the opponent to rely on all its earlier marks nor a minimum number of earlier marks that can be relied on, regardless of how many similar marks the opponent may have

registered. Indeed, parties are encouraged to focus the opposition on their strongest case, and, as outlined in Tribunal Practice Notice ("TPN") 1/2018, the number of earlier marks relied upon should not be either unnecessary nor disproportionate.

DECISION

10. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

11. Section 5(2)(b) is relied on and reads as follows:

> "5(2) A trade mark shall not be registered if because -
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

12. Section 5A states:

> "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. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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 will wrongly 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. Section 60A of the Act provides:

"(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

15. The goods and services to be compared are:

Opponent's goods	**Applicant's goods and services**
Identical to both the earlier marks: <u>Class 9</u> *Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; reproductions of sound and/or video in electronic and digital form, all supplied by means of multimedia, remote computers or on-line from databases or from facilities provided on the Internet (including Websites); sound storage media, image storage media and data storage media, all being pre-recorded; computer apparatus; computer software; computer programs; sound and/or video recording on corresponding recording carriers; sound and/or video cassettes; cassettes for the storage of, or containing, tapes for or bearing sound or video recordings; magnetic tapes, discs, and magnetic wires, all for sound or video recording; digital audio and video devices; photographic and cinematographic apparatus and instruments; television and radio*	<u>Class 9</u> *Scientific, research, navigation, photographic, cinematographic, audio visual, apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, black digital or analogue recording and storage media; software applications; software; content management software; databases; interactive databases; database management software; video recordings; video tapes; music recordings; software for generating virtual images; computer programs for editing images, sound and video; software for processing images, graphics, audio, video and text; audio visual instruments; audio visual recordings; holographic images; downloadable images; virtual and augmented reality software; downloadable virtual assistant software; virtual server software; virtual reality headsets; virtual reality goggles; virtual reality games software; virtual reality cinemas; software*

apparatus; coin or counter-feed sales, sound or video reproduction apparatus; films, videos, cassettes, recordings, compact disc, records; sound and/or video recordings; apparatus for recording, transmission or reproduction of sound or images; scientific, nautical, surveying and electric apparatus and instruments; photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), and life-saving apparatus and instruments.[1]	*for generating virtual images; software for processing digital images; security tokens [encryption devices]; computer application software for blockchain-based platforms.* Class 42 *Scientific and technological services and research and design relating thereto: industrial analysis and industrial research services; design and development of computer hardware and software; electronic storage of business and financial information; computer services for securing personal information; programming of customised web pages featuring user defined information, personal profiles and information; computer and technology services for secure personal and financial information; manufacturing databases; database development services; hosting computer databases; hosting computer application software in the field of knowledge management for creating searchable databases of information and data; electronic storage of digital images; digitisation of images; development of virtual reality software; design of virtual reality software; design services relating to virtual reality software; providing virtual computer environments through cloud computing; providing virtual computer systems through cloud computing; creating an online community for*

[1] The addition of the word “and” (highlighted in red) in the ‘297 mark is the only difference between the specifications of the two earlier marks and is immaterial to the comparison to be made.

	registered users to form virtual communities and engage in social networking services; creating and maintaining websites for registered users to form virtual communities and engage in social networking services.

16. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".[2]

17. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "In assessing the similarity of the goods or services concerned, … all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".[3]

18. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996] R.P.C. 281 include an assessment of users and the channels of trade of the respective goods or services.

[2] Paragraph 29
[3] Paragraph 23

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".[4]

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."[5]

21. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. … Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."[6]

[4] Paragraph 82
[5] Paragraph 5
[6] Paragraph 12

22. In *Avnet Incorporated v Isoact Limited,* [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

23. In its Statement of Grounds, the opponent has identified how it considers the opposed goods and services to be similar to the earlier goods in class 9, which I will consider and refer to as I consider appropriate during my own comparison of the goods and services at issue.

The contested goods in Class 9

24. The applicant's "*Scientific, … apparatus and instruments"* are self-evidently identical to the opponent's *"scientific, … apparatus and instruments".*

25. The applicant's " … *photographic, cinematographic, … apparatus and instruments"* are self-evidently identical to the opponent's "*photographic and cinematographic apparatus and instruments".*

26. The applicant's "*apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data"* are self-evidently identical to the opponent's "*Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information".*

27. The applicant's "… *computer software, …"* is self-evidently identical to the "*computer software"* of the earlier marks.

28. I consider that the applicant's *"audio visual, apparatus and instruments; audio visual instruments; virtual reality headsets; virtual reality goggles; virtual reality*

cinemas; security tokens [encryption devices]" would all encompass or be encompassed by the opponent's "*Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information",* and are therefore identical, as per the principle outlined in *Meric*.

29. *"Software applications; software; content management software; database management software; software for generating virtual images; software for processing images, graphics, audio, video and text; virtual and augmented reality software; downloadable virtual assistant software; virtual server software; virtual reality games software; software for generating virtual images; software for processing digital images; computer application software for blockchain-based platforms"*. All of the applicant's aforementioned goods are clearly forms of software which either encompass or are encompassed by the opponent's "*computer software".* As such, the competing goods are identical as per *Meric*.

30. The applicant's broad terms "*recorded and downloadable media, …, black digital or analogue recording and storage media"*, encompass the opponent's "*sound storage media, image storage media and data storage media, all being pre-recorded"*, and as such are *Meric* identical.

31. The applicant's "*video recordings; video tapes; music recordings; audio visual recordings; holographic images; downloadable images"* are covered by the opponent's broad terms "*sound storage media, image storage media and data storage media, all being pre-recorded"*, rendering them identical as per *Meric.*

32. I consider the term "computer programs" to be interchangeable with the term "computer software", and I note that the Collins English dictionary states that "Computer programs are referred to as software"[7]. As such, I find the applicant's "*computer programs for editing images, sound and video"* to be covered by the opponent's broad term "*computer software*", rendering them identical as per the principle outlined in *Meric.*

[7] Collins Dictionary online, sourced on 7 November 2023.

33. To my understanding, a database is a collection of data that is stored in a computer, while software is a type of program that can be used with a computer system. Therefore, the applicant's "*databases; interactive databases*" are not the same as the opponent's "*computer software"*. The opposing goods are different in nature and method of use, although there will be an overlap in users and channels of trade. Furthermore, I consider that the goods are complementary, software being essential to the use of the database, to the extent that it would not be unreasonable for the average consumer to expect both to be provided by the same undertaking. In my view, the opposing goods are similar to a medium degree.

34. The applicant's "*… research, navigation, … apparatus and instruments"* is a broad term which could encompass various different goods, as could the opponent's "*scientific, nautical, surveying and electric apparatus and instruments".* Research apparatus could well be of a scientific nature, and navigation instruments could easily be used for nautical purposes. While I am mindful of the guidance in *YouView* not to apply too liberal an interpretation, I would expect there to be an overlap in users of the respective goods, which I consider to be similar in nature and purpose, as well as there to be an overlap in distribution channels. While the degree of similarity will vary depending on the exact nature, purpose and method of use of the individual apparatus and instruments covered by the broad terms, I do not consider it unreasonable for the average consumer to expect them to be provided by the same, or economically-linked undertakings. Overall, I consider the goods to be similar to at least a medium degree.

The contested services in Class 42

35. "*Electronic storage of business and financial information; computer services for securing personal information; programming of customised web pages featuring user defined information, personal profiles and information; computer and technology services for secure personal and financial information; manufacturing databases; database development services; hosting computer databases; hosting computer application software in the field of knowledge management for creating searchable*

databases of information and data; electronic storage of digital images; digitisation of images."

The opponent submits that the applicant's above listed services are similar to the earlier "*Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; computer apparatus; computer software; computer programs"* in Class 9. It submits that the services are all IT related which are highly complementary to the IT related goods. I agree that there will be an overlap in end users of the applicant's above services and the opponent's goods in Class 9. The respective goods and services may be in competition, for example, the consumer may elect to either rent the likes of electronic storage space and computer software or access it via the internet or "cloud", or alternatively choosing to purchase equivalent apparatus or software as goods, with an overlap in trade channels. However, the method of use and nature of the goods and services will be different. Consequently, I consider the goods and services at issue to be similar to a medium degree.

36. *"Providing virtual computer environments through cloud computing; providing virtual computer systems through cloud computing."*

To my understanding, the term *"cloud computing"* refers to the delivery and management of computing services, including software, over the internet, on a temporary basis. For the same reasons given earlier under paragraph 35, I consider the applicant's services to be similar to the opponent's "*computer software; computer programs"* in Class 9 to a medium degree.

37. "*Design and development of computer hardware and software; development of virtual reality software; design of virtual reality software; design services relating to virtual reality software".*

While services are not the same as goods, I consider the opponent's "*computer apparatus"* and "*computer software*" in Class 9 to be the end result of its design and development. As such, there exists a complementary relationship with the contested "*design and development of computer hardware and software; development of virtual reality software; design of virtual reality software; design services relating to virtual reality software"* as without the design services there would be no end product in the

form of the apparatus or software. In my view, while the services relate to hardware and software, the nature, purpose and method of use is different, although there may be an element of competition, with the consumer selecting either bespoke goods from the designer, or choosing specific apparatus or software already on the market. I do not consider it unreasonable for the consumer to believe that the goods and services derive from the same or related undertakings. Considered overall, I find there to be a medium degree of similarity between the applicant's "*Design and development of computer hardware and software; development of virtual reality software; design of virtual reality software; design services relating to virtual reality software"* and the opponent's "*computer apparatus; computer software*".

38. *"Creating an online community for registered users to form virtual communities and engage in social networking services; creating and maintaining websites for registered users to form virtual communities and engage in social networking services".*
In order to provide the applicant's above services, computer software is likely to be used in order to create the online community or website. In *Commercy AG v OHIM* Case T-316/07, the Board of Appeal ("BOA") found that just because goods are used by an undertaking in order to provide its services, the respective goods and services are targeted at different consumers, and as such, there can be no complementary connection between them.[8] Neither are they in competition. In my view, it is unlikely that the average consumer would expect the opponent's "*computer software*" in Class 9 and the applicant's services to be provided by the same undertaking, being different in nature, purpose, method of use and channels of trade. Considered overall, I find the goods and services to be dissimilar.

39. *"Scientific and technological services and research and design relating thereto: industrial analysis and industrial research services".*
I consider that the colon in the applicant's above-listed services serves to focus the services preceding the colon as being only in relation to industrial analysis and industrial research. The opponent's various "*scientific, nautical, surveying and electric apparatus and instruments"* in class 9 are likely to be utilised in the provision of the applicant's *"Scientific and technological services and research and design*

[8] At [49-62].

relating thereto: industrial analysis and industrial research services". As per *Commercy*, although the opponent's goods may support the provision of the applicant's services, they are different in nature, method of use and intended purpose. While there may be some overlap in users, the applicant's services are targeted towards industry, while the user of the opponent's goods are directed towards a more general public. Observing the guidance given in *Avnet* which says that specifications for services should not be given a wide construction, I consider that any overlap in users is insufficient for a finding that the respective goods and services are similar.

40. A degree of similarity between the goods and services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

41. In relation to the services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such services, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

42. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

43. In its written submissions, the opponent submits that the goods and services in common are fairly common consumer products and services which broadly consist of software, database, electronic goods and services, the average consumer of which is the general public, who are likely to pay a medium level of attention.[9]

[9] At paragraph 2.3 of the written submissions dated 13 March 2023.

44. The respective goods and services at issue include, inter alia, sound and video recordings, software, and the provision of IT related services. As submitted by the opponent, such goods and services are commonly purchased by members of the general public, although I acknowledge that some services may be targeted at business customers, e.g. hardware and software design and development services. The goods and services are sold through a variety of channels, from high street stores or via the internet, to specialist providers, with the frequency of purchase ranging from infrequent for the more specialised goods and services, to relatively frequently for the likes of audio-visual recordings and cloud computing services. The selection process would be predominantly visual, although I do not discount aural considerations, for example, where the consumer would receive verbal advice and recommendations from sales representatives.

45. Accordingly, the level of attention will vary, being lower for the purchase of more everyday goods and services, whereas for the more bespoke goods and services, considerations such as technical reviews, price, quality, ease of use, suitability of the product and the reputation of the provider would be taken into account before purchasing those goods or accessing the services, leading to a higher degree of attention being paid by the consumer of those goods and services.

Comparison of marks

46. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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."[10]

47. 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.

48. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
The '686 mark: INNER|CORE The '297 mark: THE INNER|CORE	**INNER CORE**

Overall impression

49. The opponent's '686 mark consists of the words "INNER" and "CORE" which are separated by a vertical line "|" (known as the 'pipe' symbol on a standard UK keyboard). The Opponent's '297 mark comprises the identical mark, with the addition of the definite article "THE" at the beginning of the mark. Both marks are presented in a black typeface in capital letters. While I note that the marks are stylised, I do not consider the typeface to deviate from a standard font. As neither mark contains any additional elements, the overall impression of each mark rest in the words and symbol combination.

[10] Paragraph 34

50. The applicant's mark consists of two separate words, "INNER" and "CORE", presented in a standard black typeface in capital letters. There are no other elements that contribute to the overall impression of the mark, which rests in the combination of the words.

Visual comparison

The '686 mark

51. The opposing marks both contain the identical two words "INNER" and "CORE". Visually, the marks differ by virtue of the space between the two separate words in the applicant's mark, while the same two words in the opponent's mark are separated by the vertical line or pipe symbol. While I acknowledge that the typeface used in each mark is not identical, I consider each would be found as standard on word processing software applications. Considering the marks as a whole, I find there to be a very high degree of visual similarity between them.

The '297 mark

52. The earlier mark comprises the identical elements contained within the earlier '686, as outlined above, with the addition of the word "THE" at the start of the mark, which is unlikely to go unnoticed. Taking the additional word into consideration, I find the opposing marks to be similar to a medium to high degree.

Aural comparison

The '686 mark

53. The common element of the competing marks are the word "INNER" and "CORE", which would be pronounced identically in both marks. I do not consider that the vertical line contained within the earlier mark would be articulated, and as such the marks are aurally identical.

The '297 mark

54. I consider that the earlier mark would be pronounced as three separate words, "THE INNER CORE", made up of four syllables, whereas the contested mark would be pronounced in its entirety as two words, "INNER CORE", being only three syllables.

As the “INNER CORE” element of each of the marks would be pronounced identically, the pronunciation of the marks overall differ by only the additional first word/syllable. Consequently, I find there to be a medium to high degree of aural similarity between the two marks.

Conceptual comparison

55. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][11].

56. In each of the competing marks, the word “CORE” is qualified by the word “INNER”. While the combination may be used to refer to the central layer of a planet, as submitted by the opponent, I consider it likely to be understood by a significant proportion of the average consumer as referring to the fundamental issue of the relevant topic of discussion. I agree with the opponent’s submission that the definite article “the” in the ‘297 mark does not alter the concept in this particular case, although I acknowledge that this is not always the case. In whichever way the marks are interpreted, I consider that the meaning will be perceived identically in each of the marks. As such, the marks are conceptually identical.

Distinctive character of the earlier marks

57. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

58. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

[11] Paragraph 56.

> "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)."

59. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its marks have enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the marks to consider.

60. The opponent submits that the earlier ('686) mark has a high level of distinctive character because it does not describe the goods of the registration.[12]

[12] See paragraph 2.6 of the opponent's written submissions dated 13 March 2023.

61. Both earlier marks consist of the dictionary defined words “INNER” and “CORE”, separated by a vertical line, as previously described. The ‘297 mark contains the additional non-distinctive word “THE” at the beginning of the mark. The combined words “INNER CORE” form a dictionary-defined term in the English language, and is not unusual as an invented term would be. It does not, however, describe the goods for which the marks have been registered. To my mind, the vertical line between the “INNER” and “CORE” elements will be seen as nothing more than performing the function of separating the two words. While the use of a space to separate words is more usual, I do not consider that the vertical line adds much to the distinctiveness of the marks as a whole. Overall, I find the earlier marks to be inherently distinctive to a medium degree.

Likelihood of confusion

62. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

63. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> “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)."

64. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

65. Earlier in this decision, I found that all the contested goods were either identical or similar to at least a medium degree to the opponent's goods. The contested services were either similar to a medium degree, or dissimilar to the earlier goods, as shown under paragraphs 35 - 39 of this decision. I found the average consumer of the goods

and services at issue would be the general public as well as business users, where the level of attention overall would vary, being lower for the purchase of more everyday goods and services, and higher for the more bespoke goods and services. Both groups, whilst not ignoring aural considerations, will select the goods and services by predominantly visual means.

66. I found the contested mark to be visually similar to the '686 mark to a very high degree and visually similar to the '297 mark to a medium to high degree. It is aurally identical to the '686 mark and aurally similar to the '297 mark to a medium to high degree. I considered all of the competing marks to be conceptually identical. I also considered the earlier marks to be inherently distinctive to a medium degree.

67. I have weighed up each of the competing factors in my decision, including the differences as well as the similarities between the competing marks. The average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. Given the degree of visual and aural similarity between the marks, and the conceptual identity, in my view, the similarities between the marks are such that they are likely to be mistakenly recalled as each other. Consequently, I find that there is a likelihood of direct confusion in relation to all of the contested goods and for those services for which I found similarity.

68. The opposition under section 5(2)(b) of the Act succeeds in respect of all of the goods in Class 9 and for the following services in Class 42:

Class 9 – *in its entirety.*
Class 42 - *Design and development of computer hardware and software; electronic storage of business and financial information; computer services for securing personal information; programming of customised web pages featuring user defined information, personal profiles and information; computer and technology services for secure personal and financial information; manufacturing databases; database development services; hosting computer databases; hosting computer application software in the field of knowledge management for creating searchable databases of information and data; electronic storage of digital images; digitisation of images; development of virtual reality software; design of virtual reality software; design*

services relating to virtual reality software; providing virtual computer environments through cloud computing; providing virtual computer systems through cloud computing.

69. The opposition fails in respect of the remaining services which I found to be dissimilar, shown below under paragraph 70.

CONCLUSION

70. Subject to any successful appeal, the application by Afterlife Services Limited may proceed to registration in respect of the following services only:

Class 42 - *Scientific and technological services and research and design relating thereto: industrial analysis and industrial research services; creating an online community for registered users to form virtual communities and engage in social networking services; creating and maintaining websites for registered users to form virtual communities and engage in social networking services.*

COSTS

71. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. I have made a slight reduction to the costs on account of the partial success of the opponent. Applying the guidance in that TPN, I award the opponent the sum of £700, which is calculated as follows:

Official fee:	£100
Preparing a statement and considering the counterstatement:	£400
Filing written submissions:	£200
Total:	**£700**

72. I therefore order Afterlife Services Limited to pay Cem Jim Leo the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of November 2023

Suzanne Hitchings
For the Registrar,
the Comptroller-General