

**BLO/212/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3350681  
BY COLLECTIVWORKS LIMITED  
TO REGISTER AS A TRADE MARK:**



**IN CLASSES 9 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 416096  
BY CRAIG HUNTER**

## **BACKGROUND AND PLEADINGS**

1. On 4 November 2018, CollectivWorks Limited (“the applicant”) applied to register the trade mark displayed on the front page of this decision, under number 3350681 (“the application”). It was accepted and published in the Trade Marks Journal on 25 January 2019 in respect of the following goods and services:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; software; magnetic data carriers; data processing equipment, computers; computer software; mobile phones; downloadable smart phone applications; application software for mobile phones.

Class 35: Advertising, marketing and promotional services; Advertising, marketing and promotional consultancy, advisory and assistance services; Marketing services relating to wireless internet connection; Wifi connection marketing and business advisory services.

2. However, on 28 March 2019, the applicant limited the scope of the specifications by way of Form TM21B to the following:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; software; magnetic data carriers; data processing equipment, computers; computer software; mobile phones; downloadable smart phone applications; application software for mobile phones; none of the aforesaid relating to the provision of online dating and social introduction services.

Class 35: Advertising, marketing and promotional services; Advertising, marketing and promotional consultancy, advisory and assistance services; Marketing services relating to wireless internet connection; Wifi connection marketing and business advisory services; none of the aforesaid relating to the provision of online dating and social introduction services.

3. The lists of goods and services were duly amended, as per the applicant's request, and the application was republished in the Trade Marks Journal on 2 April 2019.

4. On 23 April 2019, Craig Hunter ("the opponent") filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against the following services of the application:

Class 35: Advertising, marketing and promotional services; Advertising, marketing and promotional consultancy, advisory and assistance services; Marketing services relating to wireless internet connection.

5. The opponent relies upon its United Kingdom trade mark number 3261136, **swipe** ("the earlier mark"). The earlier mark was filed on 4 October 2017 and was registered on 19 January 2018 in respect of a range of services in classes 35 and 38. The full list of services for which the earlier mark is registered is included as an annex to this decision. For the purposes of the opposition, the opponent relies upon the following services:

Class 35: Advertising, marketing, and promotional services; Advertisement for others on the Internet; Advertising via mobile phone networks; Advertising and advertisement services; Advertising and marketing services provided via communications channels; Advertising, including on-line advertising on a computer network; Advertising of business websites; Advertising services provided via the internet; Advertising through all public communication means; Advertising via electronic media and specifically the internet.

6. The opponent's mark is an earlier mark, in accordance with Section 6 of the Act, but as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements as per Section 6A of the Act.

7. The opponent argues that the services offered by the respective parties have a high degree of similarity and that the competing trade marks are "extremely similar". The applicant maintains that "it is without doubt that visually, phonetically and conceptually the marks show high degrees of similarity". The opponent also argues that the

respective business offerings and marketing efforts are similar. These factors, the opponent contends, will result in a likelihood of confusion.

8. The applicant filed a counterstatement denying the grounds of opposition. The applicant argues that the application is not confusingly similar to the earlier mark due to the presence of visual, aural and conceptual differences. The applicant also contends that the goods and services of the competing trade marks are dissimilar. The applicant denies that there is a likelihood of confusion.

9. The opponent has not been professionally represented. The applicant has been professionally represented throughout these proceedings by Lincoln IP Limited. Only the opponent filed evidence but both parties filed written submissions in lieu of an oral hearing. I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. Both parties were given the choice of a hearing but neither asked to be heard on this matter. Therefore, this decision is taken following a careful perusal of the papers, keeping all submissions in mind.

## **EVIDENCE**

### **Opponent's evidence**

10. The opponent's evidence consists of a witness statement of Craig Hunter, together with Exhibits CH1 to CH3.

11. Exhibit CH1 comprises Google search results for the term "Swipe Wifi" which, the opponent contends, demonstrates use of the mark by the applicant as two words. The exhibit also includes a print from the 'swipewifi' website [www.swipewifi.com](http://www.swipewifi.com), which shows that the applicant is "trading as Swipe WiFi". Also incorporated into the exhibit is a print from Companies House, displaying the company information for SWIPE WIFI LIMITED. The exhibit also includes further prints from the 'swipewifi' website [www.swipewifi.com](http://www.swipewifi.com), which show more instances of the applicant referring to its business as "Swipe Wifi". None of the aforementioned parts of the exhibit are dated.

12. Exhibit CH2 consists of a comparison of prints from the 'swipe' website www.getswipe.co.uk and the 'swipewifi' website www.swipewifi.com. The opponent contends that the exhibit demonstrates how the respective parties use their marks in trade. The exhibit is not dated.

13. Exhibit CH3 is a list of five companies which, according to Mr Hunter, use "wifi" as a suffix to their house brand. In this sense, the opponent argues that the word "WiFi" would not suffice to differentiate between separate undertakings. The exhibit is undated.

### **PRELIMINARY ISSUES**

14. In its evidence and written submissions, the opponent describes how the marks are being used in trade and refers to similarities between how the services are marketed by the respective parties. The opponent contends that, in trade, both marks contain a red or mauve coloured circle combined with the verbal elements, and that the applied for mark is often displayed as two words, i.e. "SWIPE WIFI". Moreover, the opponent highlights the intention to use provisions in the Act and feels that the applicant's use in trade differs to that of the application. For reasons I will now explain, the opponent's points about the similarities between the forms of the marks used in trade and marketing by the parties will, as a matter of law, have no bearing on the outcome of this decision.

15. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, Section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

16. The mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required

to prove use for any of the services for which the earlier mark is registered. The earlier trade mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of that earlier mark for all the services listed in the register.

17. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

18. So far as the opponent's claimed use of the applied for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the opponent has suggested the ways in which the applied for mark will be used and marketed, and the services for which it will be used, my assessment later in this decision must take into account only the applied for mark as it appears in the application – and its specification – and any potential conflict with the opponent's earlier registered mark. Any similarities between the actual services provided by the parties, or similarities in their trading styles or marketing, are not relevant unless those similarities are apparent from the

applied for and registered marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

19. The opponent also contends that the applicant business is registered with Companies House as “SWIPE WIFI LIMITED”. As previously explained, my assessment later in this decision only the applied for mark – and its specification – and any potential conflict with the opponent’s earlier mark. Consequently, the views expressed by the opponent regarding company name registrations will not have any bearing on my decision. However, I would, at this juncture, clarify that the application has been made in the name of CollectivWorks Limited.

20. In its submissions, the opponent refers to dilution and argues that allowing the registration of the application would cause damage and detriment to its business. These arguments would be relevant to an opposition brought under Section 5(3) of the Act. However, this opposition is based upon Section 5(2)(b) of the Act and my decision as to whether there is a likelihood of confusion under these provisions must be based on an objective assessment of the relevant factors (which will be discussed below). Therefore, the opponent’s argument that registration of the application would be detrimental to its business is not relevant for the purposes of this assessment.

21. Finally, in its counterstatement the applicant argues that the goods and services of the competing trade marks are dissimilar and, as such, there cannot be a likelihood of confusion. This argument appears to have been formulated solely on the basis of the goods specified in class 9 of the application in comparison with the opponent’s services. I would like to reiterate that the opposition is directed against some of the services in class 35 of the application, as outlined above; for the sake of completeness, the opposition is not directed against class 9 of the application. Furthermore, the

opponent only relies upon some of its services in class 35 for the purposes of this opposition, as explained above.

## **DECISION**

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

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

“5(2) A trade mark shall not be registered if because -  
[...]

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of services

24. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, 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):

“29. 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 fur 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”.

25. The services to be compared are:

Opponent’s services	Applicant’s services
Class 35: Advertising, marketing, and promotional services; Advertisement for others on the Internet; Advertising via mobile phone networks; Advertising and advertisement services; Advertising and marketing services provided via communications channels; Advertising, including on-line advertising on a computer network; Advertising of business websites; Advertising services provided via the internet; Advertising through all public communication means;	Class 35: Advertising, marketing and promotional services; Advertising, marketing and promotional consultancy, advisory and assistance services; Marketing services relating to wireless internet connection.

Advertising via electronic media and specifically the internet.	
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26. The contested services of the application are considered identical to those of the earlier mark relied upon for the purposes of the opposition. Some of the services, such as ‘advertising, marketing and promotional services’ appear in both specifications and are self-evidently identical. The remaining services are considered identical, based upon the principle in *Meric*; both specifications include broad terms which are worded in such a manner whereby they could reasonably encompass those of the other party.

### **The average consumer and the nature of the purchasing act**

27. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

28. 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. 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.”

29. Due to the nature and purpose of the services at issue, I consider the average consumers of such services to be business users. While the services are available to the general public, the overwhelming majority of consumers are likely to be members

of the business community. There is potential for these services to be purchased relatively frequently and, on the whole, the cost of such services will typically require an above average outlay. The act of purchasing these services is not merely casual but is likely to follow a more measured thought process. It would be a relatively important choice for the average consumer, to ensure that their business receives the correct quality and quantity of exposure to the most appropriate audience. The average consumer would want to ensure that the services they purchase will be provided professionally and will meet their particular business needs. In my view, the purchasing process for these services would predominantly be visual in nature; they are likely to be purchased after viewing information on the internet, in advertising or brochures. However, I cannot discount aural considerations such as word of mouth recommendations or consultations. I am of the opinion that the level of attention of the average consumer of these services would be higher than average.

### **Comparison of trade marks**

30. 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.”

31. 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.

32. The respective trade marks are shown below:

Earlier trade mark	Applicant's mark
swipe	 The logo for 'swipewifi' consists of a black circle containing a white Wi-Fi symbol (three curved lines), followed by the text 'swipewifi' in a lowercase, sans-serif font.

33. The opponent has submitted that the marks are visually, aurally and conceptually similar to a high degree and has contended that the addition of the word “wifi” in the application would not allow consumers to adequately differentiate between the undertakings. Conversely, while the applicant has accepted that the competing marks both contain the word “swipe”, it has highlighted that the application also includes the word “wifi” and a “prominent logo”. The applicant has argued that these additional elements would allow consumers to distinguish between the earlier mark and the application, when considered as a whole. The applicant has contended that the marks are considerably different visually and that there also exist aural and conceptual differences.

34. The earlier mark is a plain word consisting of the word “swipe”. As this is the only element of the mark, the overall impression is dominated by the word “swipe”.

35. The applicant's mark is a composite, figurative mark comprised of two elements. The mark contains the words “swipe” and “wifi” in a standard typeface, the former being bolder than the latter. Although the verbal element is conjoined, both words are two common, easily understood words in the English language. This, and their particular formation, means that the average consumer will still identify them as two individual words; with or without a space between them, they will still be perceived as the words “swipe” and “wifi”. In my view, the word “wifi” will simply indicate to consumers that the services are provided by means of, or for, wireless internet. This,

combined with the fact that the word “swipe” is presented in a bolder font, results in the word “wifi” playing a lesser role in the impression of the mark. Preceding the words appears a black circle device; within the circle there are three curved lines, arranged horizontally and decreasing in length from top to bottom. The longest curved line is accompanied by a small white circle, giving the impression that the curved line is broken. Overall, the device is strikingly reminiscent of a wireless signal icon. When used in conjunction with the word “wifi”, the device could be perceived by consumers to be an indication that the services are provided by, or for, wireless internet. Therefore, the device also plays a lesser role in the impression of the mark. In light of the above, the overall impression of the mark is dominated by the word “swipe”.

36. Visually, the marks are similar because they share five letters in the same order; the word “swipe” is the entirety of the earlier mark and appears, in full, within the earlier mark. While the application is a figurative mark, the verbal element is presented in a standard typeface with no significant stylisation; registration of a word-only mark – such as the earlier mark – covers use in any standard typeface, so this does not create a point of difference between the marks. The marks are visually different insofar as the application also contains the word “wifi”. It has no counterpart in the earlier mark and is conjoined to the word “swipe”. As explained above, the word “wifi” plays a lesser role in the mark and, therefore, even though it has no counterpart in the earlier mark, the inclusion of this word in the application does not create a vast difference between the marks. In respect of the conjoined nature of the application, as both words will be identified as ordinary dictionary words by the average consumer, this does not create a significant difference. Moreover, the word “swipe” is presented in a bolder font than “wifi”, which serves to further distinguish the two words. The marks also diverge visually as the application contains a device at the beginning of the mark. This element is lacking from the earlier mark. Nevertheless, as outlined above, the device is likely to play a lesser role in the mark. For this reason, in my view, the difference created by the device is not overly substantial. Bearing in mind my assessment of the overall impressions, I consider the marks to be visually similar to a medium degree.

37. Aurally, the earlier mark consists of a one-syllable word, i.e. (“SWYPE”). In respect of the applicant’s mark, there is nothing in the device which could be articulated by the average consumer. Moreover, I am not entirely convinced that consumers would

verbalise the word “wifi”. It is difficult to say with any certainty. Where it is pronounced by consumers, the application will consist of a one-syllable word followed by a two-syllable word, i.e. (“SWYPE-WYE-FYE”). In this event – and bearing in mind the overall impressions – the marks will be aurally similar to a medium to high degree. If the word “wifi” is not pronounced by consumers, the mark will consist of a one-syllable word, i.e. (“SWYPE”), resulting in the marks being aurally identical.

38. Conceptually, the marks are similar as they both share the word “swipe” as the dominant element. It is an ordinary dictionary word which will be given the same meaning in the contested marks. It would generally be understood by consumers as either meaning a sweeping blow or an act of moving one's finger across a touchscreen to activate a function. This is the full extent of the earlier mark's conceptual message. However, the marks are somewhat conceptually different as the application also includes the word “wifi”. This introduces a new conceptual aspect which is not replicated in the earlier mark. The application would be understood as above, but somehow characterised by, or relating to, wireless internet. The device could serve to reinforce this message as consumers are accustomed to seeing this kind of imagery as indicators of wireless internet. On this basis, and in consideration of my assessment of the overall impressions, I consider the marks to be conceptually similar to a medium degree.

### **Distinctive character of the earlier marks**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

41. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

42. I have no submissions from the opponent regarding the distinctiveness of the earlier mark. The applicant has submitted that the earlier mark has a low degree of distinctiveness. However, the applicant's argument that the word "swipe" has a clear meaning and message for consumers appears to have been formulated on the basis of technology related goods and services in classes 9 and 38, neither of which are relied upon by the opponent for the purposes of the opposition.

43. The registration process for the earlier mark was not completed more than five years before the filing date of the application and, therefore, the opponent has not been required to provide proof of use. Although the opponent has filed evidence in this matter, none of it demonstrates that the mark enjoys an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

44. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

45. As the earlier mark consists of one plain word, the distinctive character lies indivisibly in the word itself. The word "swipe" is an ordinary dictionary word which is easily understood in the English language. As outlined above, the word would be understood by consumers to mean a sweeping blow or an act of moving one's finger across a touchscreen to activate a function. If consumers understand the mark to mean a sweeping blow, the mark has no meaning relevant to the services at issue. Alternatively, if consumers understand the word to mean an act of activating a function on a smartphone, for example, by moving one's finger across the touchscreen, the word can be considered to possess a loosely allusive quality in relation to the services in class 35; it could be perceived by consumers as alluding to mobile advertising services, for example, which incorporate some form of swipe function. Nevertheless, I accept that this meaning is not immediate, and the word is not directly meaningful in relation to the services at issue. All things considered, I find that the earlier mark possesses a medium degree of inherent distinctive character.

## Likelihood of confusion

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods or services down to the responsible undertakings being the same or related.

48. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given

those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar."

49. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

50. Earlier in this decision I concluded that:

- The services of the competing marks are identical, either self-evidently or under the principle in *Meric*;
- Average consumers of the services are likely to be members of the business community who would demonstrate a higher than average level of attention during the purchasing act;
- The purchasing process for the respective services would be predominantly visual in nature, though I have not discounted aural considerations;
- The overall impression of the earlier mark would be dominated by the word “swipe”, being the only element of the mark;
- The overall impression of the applicant’s mark would be dominated by the word “swipe”, while the word “wifi” and the wireless internet device play lesser roles;

- The competing trade marks are visually and conceptually similar to a medium degree;
- Aural similarity would factor upon whether the word “wifi” is articulated by consumers, the marks being aurally similar to a medium to high degree if they do or aurally identical if they do not;
- The earlier mark possesses a medium level of inherent distinctive character.

51. I appreciate that the services at issue in these proceedings would be purchased with an above average level of attention and that they may be repeated purchases. I also accept that there is a subtle difference in the conceptual identity of the competing trade marks and that I have found the earlier mark to possess no more than a medium level of inherent distinctiveness. Nevertheless, I must bear in mind the identical nature of the respective services, as well as the similarities between the marks previously outlined. Moreover, I must pay due regard for the dominant components of the competing trade marks.

52. In my view, although they have no counterparts in the earlier mark, the word “wifi” and the wireless signal device in the applicant’s mark are insufficient to distinguish the services of the applicant from those of the opponent. As explained previously, the average consumer is likely to perceive the word “wifi” as an indication that the services are offered by, or for, wireless internet. As such, the word is low in distinctiveness and does not possess independent distinctive character enabling it to differentiate between the respective undertakings. The device is of a type that consumers would be accustomed to seeing to indicate a connection with wireless internet and, therefore, it would reinforce the concept conveyed by the word “wifi”. It is established that words have a tendency to have more impact than devices, especially in circumstances where the device does not possess a high degree of independent distinctive character. Further to this, I remind myself that the device plays a lesser role in the overall impression of the mark. I have found the dominant element of the applicant’s mark to be the word “swipe”, which is identical to the entirety of the earlier mark; in this regard, the marks share a dominant common element. This element is the whole of the earlier

mark and appears at the beginning of the verbal elements of the applicant's mark. It is recognised that the attention of the consumer is usually directed toward the beginning of marks and that similarities at the beginning of marks can be decisive. Furthermore, I have found the respective services identical, which, to my mind, would offset the subtle visual, aural and conceptual differences previously identified (interdependency principle). In light of the above and taking into account the imperfect recollection of the consumer, the average consumer may not recall the respective marks with sufficient accuracy to differentiate between them; consumers may misremember one for the other, assuming they are one and the same. Consequently, I consider there to be a likelihood of direct confusion.

53. For the sake of completeness, if I am wrong about direct confusion, I will now consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

54. In the event that consumers do immediately notice the differences between the competing marks, they will also recognise the common element “swipe”, which dominates both marks. Applying the principles from case law, I believe that the average consumer will assume the opponent and applicant are economically linked undertakings on the basis of the competing trade marks. The addition of the word “wifi” and the wireless signal device play lesser roles in the applicant’s mark and could simply indicate to consumers that the services are offered by, or for the purposes of, wireless internet. It is entirely plausible for an undertaking offering advertising services to have a specific service for providers of wireless internet, for example, to market their products. To my mind, the differences between the marks are conducive to a logical brand extension and I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared dominant element “swipe”. The word “wifi” and the device do not serve to sufficiently distinguish the marks; the applicant’s mark could be perceived as a brand extension by the opponent to inform consumers that the services are now offered by, or for, wireless internet. In my view, it is likely that the competing trade marks would be perceived in this manner. Therefore, I am of the opinion that there is also a likelihood of indirect confusion.

## **CONCLUSION**

55. The partial opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused in respect of the following services:

Class 35: Advertising, marketing and promotional services; Advertising, marketing and promotional consultancy, advisory and assistance services; Marketing services relating to wireless internet connection.

56. The mark will become registered in relation to the following goods and services which were not opposed:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; software; magnetic data carriers; data processing equipment, computers; computer software; mobile phones; downloadable smart phone applications; application software for mobile phones; none of the aforesaid relating to the provision of online dating and social introduction services.

Class 35: Wifi connection marketing and business advisory services; none of the aforesaid relating to the provision of online dating and social introduction services.

## **COSTS**

57. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. As an unrepresented party, the opponent submitted a completed Cost Proforma on 7 February 2020, which I have reviewed. Although the opponent filed evidence, it was of no assistance to me in making this decision and I make no award in respect of it. In the circumstances I award the opponent the sum of **£394.50** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement <sup>1</sup>	£114
Considering the applicant's written submissions and preparing written submissions in lieu of an oral hearing <sup>2</sup>	£180.50
Official fee	£100
<b>Total</b>	<b>£394.50</b>

58. I therefore order CollectivWorks Limited to pay Craig Hunter the sum of **£394.50**. 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 3<sup>rd</sup> day of April 2020**

**James Hopkins**  
**For the Registrar,**  
**The Comptroller General**

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<sup>1</sup> Calculated on the basis of £19.00 per hour for 6 hours, as per the Litigants in Person (Costs and Expenses) Act 1975

<sup>2</sup> Calculated on the basis of £19.00 per hour for 9.5 hours, as per the Litigants in Person (Costs and Expenses) Act 1975

## **ANNEX: FULL SPECIFICATION OF EARLIER MARK UK00003261136**

Class 35: Marketing, advertising, and promotional services; Advertisement for others on the Internet; Advertisement via mobile phone networks; Advertising; Advertising and advertisement services; Advertising and marketing; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels ;Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising of business web sites; Advertising of commercial or residential real estate; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising services provided via the internet; Advertising the goods and services of online vendors via a searchable online guide; Advertising through all public communication means; Advertising via electronic media and specifically the internet.

Class 38: Access to content, websites and portals; Audio and video broadcasting services provided via the Internet; Audio, video and multimedia broadcasting via the Internet and other communications networks; Broadcasting of audiovisual and multimedia content via the Internet; Broadcasting of motion picture films via the Internet; Broadcasting of programmes via the internet; Broadcasting of television programs via the Internet; Broadcasting of video and audio programming over the Internet; Cellular telephone communication; Cellular telephone communications; Chat room services; Chat room services for social networking; Chatroom services for social networking; Collection and delivery of messages by electronic mail; Communication between computers; Communication by computer; Communication by electronic means; Communication by mobile telephone; Communication by online blogs; Communication of data by means of telecommunications; Communication of information by computer; Communication services; Communication services between computers; Communication services by electronic means; Communication services for the electronic transmission of images; Communication services for the electronic transmission of voices; Communication services for the transmission of information;

Communication services for the transmission of information by electronic means; Communication services, namely, electronic transmission of data and documents among users of computers; Communication services provided electronically; Communication via computer terminals; Communication via fibre optical networks; Communications by cellular phones; Communications by means of mobile phones; Communications by mobile phones; Communications by mobile telephones; Communications services by mobile phone; Communications services provided over the Internet; Computer aided transmission of messages, data and images; Data broadcasting services; Data communication services; Data communication services by electronic means; Delivery of digital audio and/or video by telecommunications; Delivery of digital music by telecommunications; Delivery of messages and data by electronic transmission; Delivery of messages by electronic media; Digital communications services; Digital transmission of data via the Internet; Electronic communication services; Electronic forwarding of messages; Electronic message sending, receiving and forwarding; Electronic transmission of data; Electronic transmission of images, photographs, graphic images and illustrations over a global computer network; Electronic transmission of instant messages and data; Electronic transmission of messages, data and documents; Exchange of messages via computer transmission; Forwarding messages of all kinds to Internet addresses [web messaging]; Information transmission services via digital networks; Information transmission via electronic communications networks; Interactive broadcasting and communications services; Internet based telecommunication services; Internet broadcasting services; Message sending and receiving services; Message sending via a website; Message services; Mobile communication services; Mobile communications services; Mobile telephone communication; On-line communication services; On-line information services relating to telecommunications; Operation of broadcasting facilities; Packet transmission of data and images; Providing access to information on the Internet; Providing access to information via the Internet; Providing access to multimedia content online; Providing access to platforms and portals on the Internet; Providing access to platforms on the Internet; Providing access to portals on the Internet; Providing access to web sites on the internet; Providing access to websites on the Internet or any other communications network; Providing on-line chat rooms for transmission of messages among computer users; Providing online chatrooms for the transmission of messages, comments and multimedia content

among users; Providing online facilities for real-time interaction with other computer users; Providing telecommunication connections to the internet or databases; Providing user access to platforms on the Internet; Providing user access to portals on the Internet; Providing user access to the internet; Provision of access to data via the Internet; Provision of access to web pages; Provision of communications facilities for interchange of electronic data; Provision of communications facilities for the interchange of digital data; Provision of communications facilities via radio; Provision of information relating to media communications; Provision of on-line communications services; Provision of radio broadcasting equipment for outside locations; Provision of telecommunications links to computer databases and websites on the Internet; Rental of broadcasting equipment; Rental of wireless communication systems; Telecommunication of information (including web pages); Telecommunication services provided via platforms and portals on the Internet and other media; Transfer of information and data via online services and the Internet; Transferring and disseminating information and data via computer networks and the Internet; Transmission of data via the Internet; Transmission of information for business purposes; Transmission of information for domestic purposes; Transmission of information on-line; Transmission of multimedia content via the Internet; Transmission of short messages [SMS], images, speech, sound, music and text communications between mobile telecommunications devices; Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet; Web messaging; Web site forwarding services; Webcasting services; Wireless communication services; Wireless communications services; Wireless digital messaging services; Wireless electronic transmission of data; Wireless electronic transmission of facsimiles; Wireless electronic transmission of images; Wireless electronic transmission of informations; Wireless electronic transmission of voice signals; Wireless transfer of data via digital mobile telephony; Wireless transfer of data via the Internet.