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In the matter of THE TRADE MARKS ACT 1994

**And in the matter of Application No. 3154420 in the name of TICTRAC
LIMITED**

To register



**and in the matter of Opposition No. 407042
by UNITED DIGITAL GROUP GMBH**

**Appeal from the Decision of the Hearing Officer, Mr C Bowen, on behalf of
the Registrar, the Comptroller General, dated 23 June 2017**

DECISION OF THE APPOINTED PERSON

Introduction

1. This is an appeal from the decision of the Hearing Officer, Mr C Bowen, partially upholding the Opposition of United Digital Group GmbH ('the Opponent') and therefore partially refusing the Application by Tictrac

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Limited ('the Applicant') to register the following as a trade mark in classes 9, 16, 35, 36, 38, 41 and 42:



2. The Opposition was based on s5(2)(b) of the Trade Marks Act 1994 relying on the following European Union Trade Mark ('the Opponent's mark'):



3. The Opponent's mark is registered across a wide range of goods and services. All of the goods and services for which the Applicant's mark was applied to be registered were held to be either identical or similar to corresponding goods and services for which the Opponent's mark is registered, save for certain goods in class 16.
4. The Hearing Officer held that there was a likelihood of confusion between the marks and therefore refused the Application save in respect of the class 16 goods.

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5. No issue is taken on this Appeal in relation to the Hearing Officer's findings as to similarity/identity of goods and services. Nor indeed was I invited by the Appellant to draw any distinction between any particular categories of goods and services so far as likelihood of confusion is concerned. I can therefore proceed on the notional basis that the goods and services for which the Applicant's Mark is applied for are identical to those for which the Opponent's Mark is registered.
6. The Appellant, represented on this Appeal by Ms Amanda Michaels, contends that the Hearing Officer made a number of errors of principle which undermined his decision on likelihood of confusion between the marks in issue.
7. The major alleged error contended for by Ms Michaels was that the Hearing Officer paid insufficient attention to the word element of the Applicant's Mark as a distinguishing element from the Opponent's mark (which of course does not have a word element at all).
8. The Hearing Officer considered the similarities between the trade marks in his Decision at paragraphs 66-74. He started by noting that it was wrong artificially to dissect the trade marks, but that it was necessary to take into account their distinctive and dominant components, giving due weight to any other features which are not negligible and therefore contribute to the overall impressions of the two marks. This statement of the law is not contentious.
9. In paragraph 71, he turned to consider the Applicant's trade mark, noting that the largest component was the device element, described by the Applicant as a device 'resembling a racing track' and by the Opponent as a 'figurative depiction of a fingerprint'. He then noted that the word element 'TICTRAC' appeared below the device, was

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presented in upper case letters in a fine font and was significantly smaller than the device component. He went on to say this:

'As far as I am aware (and there are no submissions to the contrary), both elements are distinctive and both will, in my view, contribute to the overall impression the trade mark conveys.'

10. Ms Michaels does not dispute this statement (which is self-evidently correct). However, she suggests that the Hearing Officer went on to contradict himself in the passages which followed. I do not agree, for the reasons I shall give.
11. The Hearing Officer first quoted the well-known decision in L&D SA v OHIM [2008] ETMR 62 at 55:

'inasmuch as L&D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant suggests, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant.'

12. He then concluded that:

'given its size and positioning, the device component will, in my view, make a greater contribution to the overall impression the applicant's mark conveys than the word which accompanies it.'

I do not regard this as an unreasonable finding in the circumstances, and it is certainly not inconsistent with the earlier statement that both

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components were distinctive and contributed to the overall impression of the mark.

13. He went on to consider and reject the Applicant's contention that the average consumer would observe the letters 'T', 'I' and 'C' within the device component of the mark, and, in combination with the fact that the device (supposedly) resembles a race track, would see the device as a representation of the word 'TICTRAC'. He found that the '*so called letters*' were likely to go largely unnoticed by the average consumer, and even if they were noticed would not lead the average consumer to make the connection with the word alleged by the Applicant. They would in fact make little or no contribution to the overall impression or distinctiveness of the mark.

14. Ms Michaels challenged the Hearing Officer's analysis on the basis that he should have placed more weight on the fact that the device element of the Applicant's mark is an abstract device which cannot readily be verbalized. In those circumstances, she contended, the word component should have been treated by the Hearing Officer as making a greater degree of contribution to the overall impression of the mark applied for than the device component. In support of this proposition she cited the decision of the General Court in Massive Bionics v EUIPO T-223/16 paragraph 62:

'62 It must also be borne in mind that, according to the case-law, where a mark consists of word and figurative elements, the word element of the mark is, in principle, more distinctive than the figurative element, because the average consumer will more readily refer to the goods in question by citing their name than by describing the figurative element (see judgments of 9 September 2008, Honda Motor Europe v OHIM - Seat (MAGIC SEAT), T-363/06, EU:T:2008:319, paragraph 30 and the case-law cited, and of 6 September 2013, Leiner v OHIM - Recaro (REVARO),

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T-349/12, not published, EU:T:2013:412, paragraph 23 and the case-law cited).'

15. There is on the face of it a degree of tension between this statement of principle and that in the L&D decision cited by the Hearing Officer in the passage quoted above. In L&D, we are told by the CJEU that in the case of a mixed mark the word element is not '*systematically*' to be regarded as dominant. In Massive Bionics we are told that case-law establishes that the word element in a mixed mark is '*in principle*' more distinctive than the device element. Of course, the fact that an element is '*more distinctive*' does not necessarily mean that it is '*dominant*', but it is not necessary in this Decision to explore this nuance further.
16. So far as I am concerned, it is a dangerous short-cut to approach the assessment of marks on the basis that some types of element are '*in principle*' more distinctive than others. Many factors go into the question of distinctiveness of individual elements of a mark (e.g. degrees of descriptiveness, common use by other traders, extent of acquired distinctiveness through use, prominence of the elements in the mark as a whole) and each case must therefore be assessed on its merits. That is the message the CJEU were conveying in L&D, and it is plainly correct. It may be noted that in L&D, both the General Court and the Court of Justice found that the image of the fir tree played a '*predominant*' role in the mark, even though the words 'ARBRE MAGIQUE' were written in large letters across the front of the tree.
17. So I see no error of principle in the way the Hearing Officer assessed the Applicant's mark.
18. Ms Michaels' second point is related to the first. She contends that the Hearing Officer was wrong to find that the aural similarity between the marks was 'neutral'. If aural similarity was to be considered at all, then the presence of the word 'TICTRAC' plainly gives rise to an aural

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dissimilarity between the marks, so the position is not 'neutral'. I think this objection may stem from a lack of clarity on the Hearing Officer's part. I believe that he was simply noting that any assessment of aural similarity or dissimilarity was impossible where one mark had a verbal element and the other did not. Ms Michaels accepted that this was the correct position in law according to the CJEU in Golden Eagle T-5/08 to T-7/08 at paragraph [67]. So I do not consider that the Hearing Officer made any error in this respect.

19. The third error relied on was that the Hearing Officer was wrong to find conceptual identity between the marks. The basis of this finding was that the Opponent's mark conveyed the concept of a fingerprint, as did the Applicant's mark. Ms Michaels contended that this was the wrong conceptual approach to the Applicant's mark which did not convey a fingerprint. The combination of the appearance of the device element of the mark with the word TICTRAC would in her submission convey to the average consumer the concept of a track in the sense of a race-track. The impression given by a mark is very much a matter of evaluation and judgment, where an appellate tribunal will be very slow to intervene unless it is clear that the decision-maker was plainly wrong. I do not consider that this is the case here. Here, once one is told that the mark is intended to be a track, then it may be possible to begin to see it as a track, and indeed to make the link with the word TICTRAC. However, I have to say that it is a very strange and impractical race-track, if that is indeed what it is meant to be, and unlike any I have ever seen. As a matter of ordinary impression, I consider that the average consumer would not be likely to make that conceptual leap. I agree with the Hearing Officer that the primary impression given by the mark is that of a fingerprint.
20. I therefore reject the Applicant's appeal against the Hearing Officer's findings. The mark will proceed to grant solely in respect of the class 16 goods identified by the Hearing Officer.

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21. I will direct that the Applicant pay the Opponent the sum of £1,100 towards the costs of the Appeal.

IAIN PURVIS QC
The Appointed Person

6 April 2018