

O-268-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2485292

BY LOK8U LIMITED

TO REGISTER IN CLASSES 9, 38, 39 & 45 THE TRADE MARKS:

LOK8U
&
Lok8u

AND

IN THE MATTER OF OPPOSITION NO 98362 BY

ABSOLUTE SERVICES GROUP LTD

TRADE MARKS ACT 1994

In the matter of application no 2485292
by Lok8u Limited to register two trade marks in classes 9, 38, 39 & 45

and

an opposition thereto (no 98362) by Absolute Services Group Ltd

Background and the pleadings

1) On 18 April 2008 Lok8u Limited (“the applicant”) applied to register a series of two trade marks, namely:

LOK8U
&
Lok8u

2) Registration is sought in relation to the following goods and services:

Class 09: Scientific, measuring, signalling, navigation and checking (supervision) apparatus and instruments; apparatus for recording, transmission or reproduction of signals, sound or images; data processing equipment and computers; computer software; telecommunications, communications, GPS and satellite apparatus and instruments; vehicle, person and animal tracking and tracing apparatus and instruments; radio signalling instruments for tracking or tracing a location; target location hardware and software; electrically encoded identity devices including wrist bands; downloadable computer software; parts and fittings for all the aforesaid goods; all the aforesaid goods relating to the tracking and tracing of vehicles, persons, animals, letters, packages, luggage, and high value assets

Class 38: Telecommunications and communications services; GPS and satellite tracking services; providing user access to the Internet, data bases including data bases containing maps and GPS data and co-ordinates; advice, information and consultancy services relating to the aforesaid services.

Class 39: Tracking and tracing services; advice, information and consultancy services relating to the aforesaid services.

Class 45: Security services; location services relating to missing persons, animals and goods; advice, information and consultancy services relating to the aforesaid services.

3) On 27 November 2008 Absolute Services Group Limited (“the opponent”) opposed the registration of the above marks. By the time of the hearing that subsequently took place before me the opponent had reduced its grounds of opposition to being under sections 5(2)(b) & 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), the opponent relies on its own trade mark, namely:

UK registration 2402353 for the trade mark:



Filed on 24 September 2005 with the registration procedure being completed on 21 April 2006. The mark is registered in relation to:

Class 09: Cellular communications devices, global positioning satellites, tracking devices.

Class 38: Telecommunication location services, telecommunication services being Global Positioning tracking services; satellite communications services.

4) Given the above mark’s filing date, it qualifies as an earlier mark in accordance with section 6 of the Act. Furthermore, I note that it completed its registration procedure only two and a half years before the publication of the applicant’s mark and, consequently, the proof of use provisions contained in section 6A¹ of the Act do not apply. The earlier trade mark may, therefore, be taken into account in these proceedings for its specification as registered.

5) Under section 5(4)(a), the earlier sign relied upon (under the law of passing-off) is said to be “Lok8me” with such a sign said to have been first used in the United Kingdom between 2003-2004 in relation to “location based services”.

6) The applicant filed a counterstatement denying the grounds of opposition. Both sides then filed evidence, a summary of which follows. The matter then came to be heard before me on 10 June 2010 at which the opponent was

¹ Section 6A was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force on 5th May 2004.

represented by Mr James Setchell of Trade Mark Consultants Co. and at which the applicant was represented by Dr Peter Colley, of Counsel, instructed by Potter Clarkson LLP.

The evidence

The opponent's primary evidence – witness statement of Mr Harbeer Danga dated 12 June 2009.

7) Mr Danga is a director of the opponent. He states that the opponent's trade mark LOK8me was first used in the United Kingdom in 2005. He sets out the details of the opponent's earlier registered trade mark (details of it are provided in his Exhibit ABS1) which I do not need to repeat here. In relation to the use of the mark he states:

“Used in website www.verifyandlocate.com year 2005-2009, for Location Based Services and GPS tracking products.”

8) Prints from the above website are provided in Exhibit ABS2. One carries a date of 7 June 2009 and another the date of 2 May 2009. The prints carry two different word and device representations which I set out below:



9) The prints also carry in plain font the text: “The Lok8me – Mobile phone location service” and “THE LOK8ME”. Underneath the latter term the following text also appears:

“Locate family, friends, elderly employees, effectively anyone with a mobile phone, almost immediately with no monthly subscription and from as little as 25p. Quick and simple sign up.”

10) Mr Danga states that since October 2005 the opponent has made substantial use of the name LOK8ME in relation to the provision of tracking and location services and, in particular, such services utilizing mobile cell and GPS

satellite tracking. He says that the opponent is now a market leader and that its services are used by major public agencies and private companies including: the NHS, various emergency services, local authorities, government agencies, child protection, telecare services etc.

11) Advertising expenses are said to be: “at year end 2005-2008 is over £50,000.00”. This is said to include radio, national newspaper, local paper, PR and magazine advertising. Examples of advertising said to have occurred prior to the filing of the applicant’s mark are shown in Exhibit ABS3. The exhibit shows internet advertising on various websites (TEIS, at Dementia, AskSARA, DeepDarkSee, LOCATOR SOLUTIONS & Missing Children TV). Only one, DeepDarkSee, can categorically be placed before the filing of the earlier mark (the print has a blog type response dated 17 August 2006). Some of these documents use Loc8me rather than Lok8me.

12) Mr Danga believes that the use he has set out shows that members of the public come to understand that the name LOK8ME, when used in relation to the provision of tracking and location services (particularly mobile cell and GPS), as meaning, exclusively, the services of the opponent and that it has a substantial goodwill and reputation. He believes that the use of the applied for mark will lead to the public believing that they [the applicant] are, or are connected, associated or endorsed by the opponent.

The applicant’s primary evidence – witness statement of Jackie Tolson dated 18 September 2009.

13) Ms Tolson is a trade mark attorney at Potter Clarkson, the firm with conduct of these proceedings on behalf of the applicant. Ms Tolson refers to the applicant’s own use of its mark which relates to a GPS locator designed to be concealed within a child’s digital watch. Through the use of a computer or mobile phone it is possible to find the child’s location or to receive an alert if the child moves out of a designated “safe zone”. Exhibit JT1 contains further information about the product. Exhibit JT2 contains some press coverage the product has received (from early 2009). I note that the product itself is called the NuM8. Lok8u is referred to as the company behind the product.

14) Ms Tolson then gives her opinions as to the similarity of the marks in question. This is not evidence of fact so I will not summarise this here. She then refers to what she says are significant numbers of trade marks on the register based around the words LOCATE/LOCATOR in classes 9 & 38. Exhibit JT3 contains prints of such marks which include the words: LOC8TOR, LOC8ER, LOC8, ILOC8, LOK8IT, VODAPHONE LOCATE YOU, iLocate, SECURELOCATE, DELOCATED, GLOBAL LOCATE, LOCATEL, LOCATE AND TRACK, BREW LOCATE & LOCATEC.

15) Ms Tolson then refers to two *Google* searches that she undertook for the terms *loc8 phone* & *locate mobile phone*. The first two pages of results are shown in Exhibit JT4. I note that both searches were conducted for the web as a whole rather than being limited to United Kingdom websites. In terms of hits, the first search revealed over 6000 hits the latter over 3 million. Prints from some of the underpinning websites are provided, namely:

MobileLocate – the print describes the service provider as the leading UK provider of mobile phone tracking services.

Locate Mobiles.com – another UK mobile phone tracking system.

Vodafone Loc8 – a business directory service accessed via text message, available on the Vodafone network in New Zealand.

Phonelocator – an application to view the location of your mobile phone (there is nothing to verify UK use).

Loc8tor – a mobile phone and key finder which uses homing fobs (this appears to be UK use as the device is priced in £s)

Loc8ter – an extract from a blog referring to a locator device for keys etc – this could be a reference to the above product.

16) The remainder of Ms Tolson's evidence is, in the main, submission/critique rather than fact. This will be borne in mind but not summarized here. In terms of factual evidence, Ms Tolson says that the opponent's claim that the website www.verifyandlocate.com has carried the mark from 2005-2009 is not supported by the archive website www.archive.org. Ms Tolson states that the archive website shows that [verifyandlocate.com](http://www.verifyandlocate.com) only came into being in late 2007. It is also highlighted that as of 25 October 2007 the website made no mention of LOK8ME but only the sign VERIFY AND LOCATE. Exhibit JT5 shows a print from the archive website (the well known WayBack Machine tool) which makes no reference to Lok8me.

The opponent's reply evidence – witness statement of Mr Harbeer Danga dated 12 December 2009

17) The majority of Mr Danga's reply evidence is submission/critique rather than evidence of fact. This will be borne in mind but not summarised here. In terms of what could be regarded as factual evidence, the following emerges:

That the applicant's device (a GPS locator digital watch) was released in 2009 even though a similar watch was designed and released by a US company under the name Wherify Wireless in around 2004.

That whilst the opponent's mark is used on its current website at www.verifyandlocate.com, it has also been used on its previous website at www.verifyandlocate.co.uk between 2004-2009, in respect of location based services and GPS tracking products. Exhibit ABS1 shows a list of archived pages for the ".co.uk" version dated between October 2005 and April 2008.

Exhibit ABS2 shows an Internet print (obtained using the WayBack Machine) showing that in October 2005 the mark Loc8me (as opposed to Lok8me) was used on the website www.verifyandlocate.co.uk.

The claim of advertising expenses of £50,000 at year end 2005-2008 is repeated. This is said to include advertising in LBS 97.3 FM, London Chronicle, Guardian, Guardian Magazine, the Mail, The Mail Magazine, Observer, local papers, the web, PPC adverts, web optimization ranking and PR agency fees.

Exhibit ABS3 shows a print from the current ".com" website showing the mark as per paragraph 8 above (the second image depicted) and, also, the words Lok8me/The Lok8me. A list of archived webpages from the WayBack Machine is provided (in Exhibit ABS4) dated between October 2007 and May 2008.

Reference is made to a number of listings the opponent has had with organisations such as TEIS, MISSINGCHILDRENTV.ORG and Disabled Living Foundation which, it is explained, are unpaid and have been inserted due to the opponent's credibility, goodwill and extensive reputation.

Section 5(2)(b)

18) Section 5(2)(b) of the Act reads:

"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."

19) In reaching my decision I have taken into account the guidance provided by the European Court of Justice ("ECJ") in a number of judgments: *Sabel BV v.*

Puma AG [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) (“*Medion*”) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

20) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods/services are similar (and to what degree), other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

The average consumer and the purchasing act

21) As matters must be judged through the eyes of the average consumer, I will begin with an assessment of who this is. The specifications cover a range of goods and service, however, most relate (or could relate) to the tracking and tracing of people and items so that their location can be monitored or discovered. The average consumer can be split into two distinct groups, namely, the general public who may require such goods for location monitoring/discovery of children, other relatives or, indeed, their own possessions. The average consumer could also be a business user perhaps monitoring important items (such as plant or equipment) or its staff. Business users could also include health authorities who wish to monitor patients (such as elderly patients or those with dementia).

22) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). However, this general presumption can change (or at least the degree of attention that the average consumer displays during the purchasing act) depending on the particular goods/services in question (see, for example, the decision of the General Court² (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Both sides agree that the goods/services are considered purchases. The goods/services will not constitute frequent purchases. Whilst they are unlikely to be of the highest cost (a point the opponent makes), they are not low cost casually purchased items. Issues of function, operability and reliability will also be important. I believe that the degree of care and attention likely to be used by the average consumer will be a little higher than the norm. I cannot, though, assess it at much more than that. It is not as though huge sums of money, on average, are likely to be paid neither is it likely to be the most important of purchasing decisions the average consumer is ever going to make.

Comparison of the goods/services

23) When comparing the respective goods and services I note the judgment In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the ECJ stated:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

24) Guidance on this issue also comes from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 (“*British Sugar*”) where the following factors were highlighted as being relevant in the assessment of similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

² Previously known as the Court of First Instance of the European Communities.

whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

25) In terms of understanding what a “complementary” relationship consists of, I note the judgment of the General Court in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

26) In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade³. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. In relation to services, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“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.”

27) Finally, when comparing the respective goods and services, if a term clearly falls within the ambit of a term in the competing specification then identical

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 (“*Beautimatic*”).

goods/services must be held to in play⁵ even if there may be other goods/services within the broader term which are not identical.

28) This is not a straightforward comparison given the breadth of the respective specifications. I will conduct my analysis with reference to the applicant's specification, identifying which goods/services in the opponent's specification are identical or similar (and why) or, alternatively, why the applicant's goods/services are not similar. I will look firstly at the applicant's goods and services in classes 9 & 38. There is because the applicant concedes (in paragraph 12 of its skeleton argument) that "...it is clear that there is a modest degree of overlap and/or similarity between the goods and services specified for the Opposed mark and the Earlier Device Mark in classes 9 & 38". The applicant's class 9 specification reads:

Scientific, measuring, signalling, navigation and checking (supervision) apparatus and instruments; apparatus for recording, transmission or reproduction of signals, sound or images; data processing equipment and computers; computer software; telecommunications, communications, GPS and satellite apparatus and instruments; vehicle, person and animal tracking and tracing apparatus and instruments; radio signalling instruments for tracking or tracing a location; target location hardware and software; electrically encoded identity devices including wrist bands; downloadable computer software; parts and fittings for all the aforesaid goods; all the aforesaid goods relating to the tracking and tracing of vehicles, persons, animals, letters, packages, luggage, and high value assets

29) The opponent contends that of the above, the following goods are identical to goods within its application:

Apparatus for recording, transmission or reproduction of signals, sound or images; telecommunications, communications, GPS and satellite apparatus and instruments; vehicle, person and animal tracking and tracing apparatus and instruments; radio signalling instruments for tracking or tracing a location; target location hardware; electrically encoded identity devices including wrist bands; parts and fittings for all the aforesaid goods; all the aforesaid goods relating to the tracking and tracing of vehicles, persons, animals, letters, packages, luggage, and high value assets

30) The opponent's goods in class 9 are:

Cellular communications devices, global positioning satellites, tracking devices.

⁵ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-133/05 ("*Gérard Meric*").

31) In my assessment, I agree with the applicant that these goods (as per paragraph 29) are identical. Each of the terms sought by the applicant could include within its ambit goods of the same nature as specified by the opponent. For example, cellular communications devices and tracking devices (some of the opponent's goods) will, to some extent, record, transmit and reproduce signals etc. (the applicant's goods). This is particularly clear given that such apparatus for recording, transmitting and reproducing signals etc. is qualified by the applicant as being for the tracking and tracing of vehicles, persons, etc. Even if I am wrong on strict identity, the goods would, in any event, be highly similar given their nature, purpose and method of use and, also, they would be competitive. The remaining goods in class 9 are:

Scientific, measuring, signalling, navigation and checking (supervision) apparatus and instruments; data processing equipment and computers; computer software; target location software; downloadable computer software; parts and fittings for all the aforesaid goods; all the aforesaid goods relating to the tracking and tracing of vehicles, persons, animals, letters, packages, luggage, and high value assets.

32) Given that all of the goods are qualified as being for tracking/tracing then it is clear that there is a similarity of purpose given that the opponent's mark covers tracking devices. Methods of use may not be identical but there is likely to be a degree of similarity, this applies also to the nature of the goods. Some goods of the applied for mark will be competitive, particularly to the extent that the terms cover apparatus, or, in the alternative, I agree with the opponent that there is likely to be a complementary relationship between software (for tracking/tracing) and tracking devices themselves. The goods are likely to be targeted at the same users and through the same or similar trade channels. I come to the clear view that these goods are not only similar, but they are highly so.

33) The applicant's services in class 38 are:

Telecommunications and communications services; GPS and satellite tracking services; providing user access to the Internet, data bases including data bases containing maps and GPS data and co-ordinates; advice, information and consultancy services relating to the aforesaid services.

34) The opponent's services in class 38 are:

Telecommunication location services, telecommunication services being Global Positioning tracking services; satellite communications services

35) Applying the principal set out in *Gérard Meric*, I take the view that the opponent's services will, one way or another, overlap with the applicant's services. For example, "telecommunications location services" falls within

“telecommunications and communications services”. Whilst the applicant’s terms are broad enough to cover a range of services, some of which may not be identical, no fall-back specification has been provided so it is sufficient to record that identical services are in play.

36) I next consider the applicant’s class 39 specification. The opponent has no class 39 specification so identity cannot be found. The applicant’s specification reads:

Tracking and tracing services; advice, information and consultancy services relating to the aforesaid services.

37) Before comparing the specifications it is important to come to a view on what the above services actually cover. In doing so I bear in mind the guidance I set out earlier from *British Sugar*, *Beautimatic* and *Avnet*. In terms of what I should understand from the specification (and also the specification in class 45) the applicant cautioned about giving a wide interpretation particularly as no evidence has been filed for me to be able to understand what such terms cover nor evidence as to any similarity. I agree that caution should be applied, but I must still look at the words themselves and attempt to understand what they cover. For this purpose I must also bear in mind what class the terms fall in as the class is relevant in setting the scope of the specification itself⁶. Furthermore, and to understand what the term may cover, the guidance provided in the International Classification of Goods and Services (ninth edition) (“Nice”) should also be considered. To this extent, I note that in relation to class 39 Nice states that this class:

“includes mainly services rendered in transporting people or goods from one place to another (by rail, road, water, air or pipeline) and services necessarily connected with such transport, as well as services relating to the storing of goods in a warehouse or other building for their preservation or guarding”

38) This fits in with the class heading which Nice records as:

“Transport, packaging and storage of goods; travel arrangement”⁷

39) Taking all this into account, the term “tracking and tracing services” in class 39 is a service which would cover, as a primary example, the tracking and tracing of goods that are in transport. Whilst it may be possible for such a service to also track and trace travellers, there is no evidence to suggest that this is a common

⁶ See to that effect *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34.

⁷ I note that the Intellectual Property Office’s website also lists in its class heading the terms “distribution of electricity; travel information; provision of car parking facilities.”, but this adds nothing to my analysis.

activity which would be understood as the core of the meaning attributable to that term – it is too hypothetical. The closest term to these services as covered by the opponent's specification is "tracking devices". The opponent suggests a complementary relationship. However, no evidence has been filed to show that the type of service identified is the type of service that uses tracking devices. The service may simply use bar codes together with appropriate software. Whilst tracking devices may be built into watches (as per the applicant's actual goods) or mobile phones (as in the opponent's actual goods) it is a step too far to find similarity between the goods as specified in the opponent's specification and the class 39 services. This finding also applies to the accompanying information, advice and consultancy services in class 39.

40) That leaves the applicant's specification in class 45. This reads:

Security services; location services relating to missing persons, animals and goods; advice, information and consultancy services relating to the aforesaid services.

41) Again, I will begin by examining the specification itself and what it covers. In terms of what this class covers Nice states that it includes, in particular:

-services rendered by lawyers to individuals, groups of individuals, organizations and enterprises;

-investigation and surveillance services relating to the safety of persons and entities;

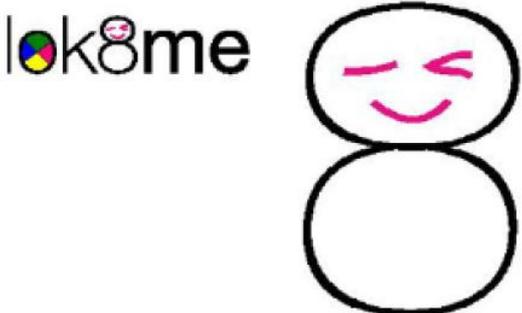
Services provided to individuals in relation to social events, such as social escort services, matrimonial agencies, funeral services.

42) In terms of "security services" this, after considering and applying *Avnet*, would include services that provide security to goods and services such as security guarding (personal or property) or perhaps some form of surveillance of property. I have considered potential conflict with tracking devices and whether the monitoring of such devices constitutes a security service – I come to the view that it does not obviously do so because the monitoring of a tracking device would merely assist in the recovery of property rather than making it more secure to begin with. Therefore, the core of the term security services does not, on the face of it, have any real synergy with a tracking device. I stress that my assessment is based only on what can be considered as common knowledge. If there is similarity between the goods and services then evidence of such would have been required. I do not regard "security services" in class 45 to be similar to tracking devices in class 9 or to any of the other goods and services in the opponent's specification.

43) That leaves “location services relating to missing persons, animals and goods”. Applying *Avnet* and considering the nature of class 45 as per the Nice guidelines, such a service would include investigative missing person (or animals/goods) type services. An investigative service does not, though, strike me as having any real competitive or complementary relationship with tracking devices etc. However, location services would also cover the provision of information about location, as part and parcel of a location or tracking device. A tracking device can only be of use if the device is linked in some way to either software (be it on a user’s computer or on the Internet) or to an accompanying service that provides information on location when the person (or thing) has gone missing. In this scenario, a location service in comparison to a device that tracks location is, effectively, simply the other side of the coin. In view of this, I consider that there is an obvious complementary relationship. This would also apply, despite the applicant’s submissions to the contrary, to the accompanying advice, information and consultancy services as they are clearly and obviously related. I consider there to be a reasonable degree of similarity here.

Comparison of the marks

44) When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). I note that the applicant has two marks, but I do not consider them to require separate analysis as the only difference between them is in terms of casing which does not alter the analysis (neither party have argued to the contrary). For ease of reference, the marks under comparison are set out below:

The applicant’s mark	The opponent’s mark
<p>LOK8U & Lok8u</p>	

45) In terms of the comparison to be made, the applicant submits that the device element in the opponent’s mark provides such a strong cue to the average consumer that this will impact significantly on the various aspects of similarity. The opponent, on the other hand, submits that the word (stylized) element of its mark is the dominant and distinctive element and, thus, highly similar, or that it

still plays a role within the mark as per the *Medion* case. In my view, and whilst the device element (I will call it a “winking 8”) is significantly larger (albeit in height but not width), the stylised word “lok8me” still plays a key role in the overall impression of the mark. I do not consider that it plays a merely subordinate role, but will instead strike the average consumer as playing at least an equal role in terms of indicating trade origin. It is certainly a dominant and distinctive element even if it is not the dominant and distinctive element.

46) In terms of a visual comparison, the fact that the winking 8 device is present in the mark, together with the fact that the other element also has some stylization (a segmented and coloured letter O and a winking numeral 8) and, also, that the stylized word element ends with “me” rather than “U”, are all points of difference. The word element of the opponent’s mark does, though, begin with the letters LOK and is followed by a numeral 8 which will strike the eye of the average consumer as a noticeable point of similarity. A whole mark comparison must, though, be made. Having done so, I consider that there is a degree of similarity of a moderate level.

47) In terms of an aural comparison, I should record my view that the average consumer is unlikely to refer to the opponent’s mark with reference to the winking 8 device. The mark will, therefore, be referred to with reference solely to the word element of its mark. I should also record my view that the applicant’s mark and the verbal element in the opponent’s mark will be pronounced, respectively, as LOCATE YOU and LOCATE ME. It think it will be obvious, particularly in the era of text speak, that the average consumer will immediately appreciate that the letter/numeral combination Lok8, in the context of both marks, is meant to be pronounced as the word LOCATE. There is a difference, though, in that the ends of the verbal elements are YOU/ME, but the beginning is the same as is the overall length and construction. I consider there to be a reasonable degree of aural similarity.

48) In terms of conceptual similarity, it is meanings capable of immediate grasp that are important⁸. To that extent, I have already said that the average consumer will approximate “Lok8U” and “lok8me” to “Locate You” and “Locate Me”. The meaning of these elements are, therefore, capable of immediate grasp. Whilst ME and YOU have different meanings, they still relate to a person and both refer, effectively, to the user of the goods and the ability to locate oneself. The average consumer is also likely to recall the concept of the text speak presentation. This creates a high degree of conceptual similarity. Whilst I cannot rule out the possibility that the winking 8 (or the winking snowman as the applicant calls it) may form part of the concept of the earlier mark – the stronger element and the element most likely to be recalled is still Lok8me (with its meaning of Locate Me)

⁸ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

and, therefore, whatever way one looks at it, there is still a reasonably high degree of conceptual similarity.

49) The net effect of all this is that the marks have a degree of similarity, overall, which should be pitched at a reasonable level.

Distinctive character of the earlier trade mark

50) The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of the inherent qualities of the earlier mark, I consider it to be a highly distinctive mark, but, much of this is based on the mark as a whole including the winking 8 device and the stylization present in the word lok8me. In terms of the lok8me element, this has some clear suggestive qualities in relation to the goods and services covered by the earlier mark, but distinctiveness also lies in its particular construction and text style presentation. I consider the word itself to have at least an average degree of distinctiveness.

51) In terms of the use made of the earlier mark, I am not satisfied that this improves the opponent's position. Whilst the mark may have been used, there are no turnover figures to demonstrate the extent of such use. Whilst advertising figures are provided these strike me as relatively modest. I note that advertising is said to have taken place in some high-profile publications but the frequency or exact nature is not detailed. The examples of Internet advertising provided are not accompanied by any evidence demonstrating the degree to which the websites have been accessed. I do not consider that the distinctiveness of the earlier mark is enhanced to any significant extent through its use.

Likelihood of confusion

52) It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer(s) and determining whether they are likely to be confused. I do not need to consider the services applied for in class 39 or security services (and the related advice, consultancy and information) in class 45 because I have found there to be no similarity between these services and the goods/services of the opponent⁹. I should also say that I do not share the applicant's criticism made at the hearing that no evidence of potential confusion has been filed (which it says could have been obtained from surveys etc.) – the

⁹ See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

question as to the likelihood of confusion is ultimately a jury question for the tribunal to decide, based on the evidence, submissions and jurisprudence, and decided upon the balance of probabilities.

53) In relation to the goods and services which are identical, I bear in mind that the nature of the purchasing process is a considered one (although not of the highest degree). There is a reasonable degree of similarity between the marks. That being said, the average consumer is unlikely to miss the winking 8/winking snowman in the opponent's mark or that the verbal element has a particular form of presentation. However, whilst this may avoid the average consumer from directly mistaking one mark for the other, it does not mitigate fully against the average consumer believing that the goods/services come from the same or an economically linked undertaking. Also to be considered is imperfect recollection and the strongest/only aspect that the average consumer will store away for future recall will be Lok8me/Lok8u and its text speak presentation. It seems to me quite possible for the marks, in terms of concepts, to be misremembered/miss-recalled as each other. Furthermore, even for the attentive average consumer who may identify the U/ME difference, this may be put down to a variant product/service e.g. Lok8me is a variant product of the company who produces Lok8U (or vice versa). That does not mean that I ignore the other elements of the opponent's mark, but this simply reflects the view and appreciation of the marks the average consumer will take. I bear in mind the evidence from Ms Tolson regarding the marks on the register and in use. Whilst borne in mind, the use by others of the words LOCATION/LOCATE is obvious and does not detract from my analysis. Whilst more weight could be put on any evidence showing use of LOC8 or LOK8, there is very little evidence of actual use in the United Kingdom – the only real use appears to be of LOC8TOR so this one instance does little to lessen the likelihood of the average consumer being confused. Balancing all the respective factors, I believe that the average consumer, be it members of the public or businesses, will likely be confused certainly in so far as identical goods/services are concerned.

54) In terms of the other goods/services, these need further consideration particularly in view of the interdependency principle. However, whilst I note that a lesser degree of similarity between the goods/services can offset other factors, the goods/services in question play a key complementary role and the degree of similarity is far from low (I found either a high or a reasonable degree of similarity). For similar reasons to that set out above, I believe that the average consumer will also be confused here. The ground of opposition under section 5(2)(b) succeeds save for the services where I found no similarity and as I identified in paragraph 52 above.

Section 5(4)(a)

55) I do not consider that the opponent is any stronger position under section 5(4)(a). Any goodwill it may have would not necessarily assist with the services which I have found to be dissimilar. Although a common field of activity is not required, it is still an important factor and, all things considered, the opponent would have difficulty in proving misrepresentation in respect of such services. Furthermore, whilst it could be argued that the opponent has used a sign without the large winking 8 device and, so, its sign is closer to the applicant's mark than is the opponent's earlier mark, the opponent's evidence of goodwill is not particularly detailed in terms of custom. Furthermore, its evidence of adoption of the sign is not particularly clear (some of the use exhibited uses the sign Loc8me (rather than Lok8me) and, as the applicant pointed out at the hearing, there is no evidence as to the sign the customer encounters (such as packaging) at the point of sale. In any event, the opponent conceded at the hearing that section 5(4)(a) was not its best case.

Outcome

56) The opposition succeeds in relation to all of the goods and services except for:

Class 39: Tracking and tracing services; advice, information and consultancy services relating to the aforesaid services.

Class 45: Security services; advice, information and consultancy services relating to the aforesaid services.

Costs

57) The opponent has been successful to a large extent and is entitled to a contribution towards its costs. I have, though, reduced the award to reflect that it has not been fully successful. I hereby order Lok8U Limited to pay Absolute Services Group Limited the sum of £1350. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£350

Considering and filing evidence
£400

Attendance at the hearing:
£400

Expenses (opposition fee)
£200

58) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 28 day of July 2010

**Oliver Morris
For the Registrar
The Comptroller-General**