

O-333-18

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3214587
BY FUJITSU LIMITED TO REGISTER:

M12

AND

THE OPPOSITION THERETO UNDER NO 409439 BY
AEGIS TRADEMARKS BV

BACKGROUND

1. On 23 February 2017, Fujitsu Limited (the applicant) applied to register the above trade mark in classes 9 and 42.¹

2. The application was published on 3 March 2017, following which Aegis Trademarks BV (the opponent) filed notice of opposition against the following services in the application:

Class 42

Computer programming services; Computer rental services; Installation and maintenance computer software programs; Design, development, preparation and update of computer software programs; Computer system consulting and advisory services; Provision of temporary non-downloadable software; Software as a service (SaaS) services; Operating cloud computing system in Class 42.

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon the following trade marks and services:

Mark details and relevant dates:	Services relied upon:
UKTM3202633 M1 Filed: 16 December 2016 Registered: 10 March 2017	Class 42 Computer network services; computer programming services; computer network management services for others; computer systems analysis, design, and integration; computer software application development and hosting; computer consulting regarding website development; design of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases; database development; computer system design and development, technical automation services regarding applications for wide area network or local area network computer systems; technical services with regard to computer programs; computer systems management (with the exception of installation, repair and maintenance); support in the use of computer networks; technical consulting

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>in the field of computers; computer system development with regard to opinion polls and marketing studies; design of data processing programs; design, development and research in using computer databases, manuals and in systematizing information in files; graphic design services; web site design; creation, editing and updating of website content; research and design of new products and packaging; providing a web-based portal to allow others to view, sort and analyse business and marketing data related to customers and potential customers; information, advisory and consultancy services relating to the aforesaid services.</p>
<p>UKTM3202707</p>  <p>Filed: 16 December 2016 Registered: 31 March 2017</p>	<p>Class 42 Computer network services; computer programming services; computer network management services for others; computer systems analysis, design, and integration; computer software application development and hosting; computer consulting regarding website development; design of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases; database development; computer system design and development, technical automation services regarding applications for wide area network or local area network computer systems; technical services with regard to computer programs; computer systems management (with the exception of installation, repair and maintenance); support in the use of computer networks; technical consulting in the field of computers; computer system development with regard to opinion polls and marketing studies; design of data processing programs; design, development and research in using computer databases, manuals and in systematizing information in files; graphic design services; web site design; creation, editing and updating of website content; research and design of new products and packaging; providing a web-based portal to allow others to view, sort and analyse business and marketing data related to customers and potential customers; information, advisory and consultancy services relating to the aforesaid services.</p>
<p>EUTM16175531</p> <p>M1</p> <p>Filed: 16 December 2016 Registered: 24 April 2017</p>	<p>Class 42 Computer network services; computer programming services; computer network management services for others; computer systems analysis, design, and integration; computer software application development and hosting; computer consulting regarding website development; design of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases; database development; computer system design and development, technical automation services regarding applications for wide area network or local area network computer systems; technical services with regard to</p>

	<p>computer programs; computer systems management (with the exception of installation, repair and maintenance); support in the use of computer networks; technical consulting in the field of computers; computer system development with regard to opinion polls and marketing studies; design of data processing programs; design, development and research in using computer databases, manuals and in systematizing information in files; graphic design services; web site design; creation, editing and updating of website content; research and design of new products and packaging; creating blogs, apps and games for advertising purposes; information, advisory and consultancy services relating to the aforesaid services.</p>
<p>EUTM16176018</p>  <p>Filed: 16 December 2016 Registered: 24 April 2017</p> <p>Colours claimed: Blue; Orange</p>	<p>Class 42 Computer network services; computer programming services; computer network management services for others; computer systems analysis, design, and integration; computer software application development and hosting; computer consulting regarding website development; design of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases; database development; computer system design and development, technical automation services regarding applications for wide area network or local area network computer systems; technical services with regard to computer programs; computer systems management (with the exception of installation, repair and maintenance); support in the use of computer networks; technical consulting in the field of computers; computer system development with regard to opinion polls and marketing studies; design of data processing programs; design, development and research in using computer databases, manuals and in systematizing information in files; graphic design services; web site design; creation, editing and updating of website content; research and design of new products and packaging; creating blogs, apps and games for advertising purposes; information, advisory and consultancy services relating to the aforesaid services.</p>

4. The opponent submits that the applicant's mark is visually, aurally and conceptually highly similar to the opponent's earlier M1 mark. With regard to the respective services the opponent submits:

“3. The Applicant’s Class 42 mark covers services which are identical, highly similar and complementary to those encompassed by the Opponent’s earlier mark in Class 42...”²

5. The opponent concludes that the applicant’s mark will be taken to refer to services which originate from the opponent.

6. The applicant filed a counterstatement in which it denied the ground raised by the opponent. The opponent's marks are earlier marks, none of which are subject to proof of use. This is because, at the date of publication of the application, they had not been registered for five years.³ Consequently, the opponent is entitled to rely on its full specification in class 42.

7. The opponent filed evidence, the applicant filed submissions. Both sides filed skeleton arguments in advance of the hearing which took place before me by video conference on 24 April 2018. The opponent was represented by Mr Joel Barry of CMS Cameron McKenna Nabarro Olswang LLP. The applicant was represented by Mr Christopher Smith of Wilson Gunn.

Preliminary issues

The opponent’s earlier rights

8. At the beginning of the hearing, Mr Barry, for the opponent, submitted that UK mark 3202633 is its best case and I will proceed on that basis.

The opponent’s evidence

9. Mr Barry clarified that the opponent’s evidence relates to its business in class 38 for marketing and related services and as such, is not relevant to the matter to be decided as the opposition is brought only in respect of services in class 42. As a consequence I will not summarise the evidence here but will refer to any pertinent submissions that may be contained within it, as necessary, throughout the remainder of this decision.

² See Annex 3 attached to the opponent’s notice of opposition.

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

DECISION

10. Section 5(2)(b) of the Act states:

“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,

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

Section 5(2)(b) case law

11. 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

12. The opponent has provided a number of tables in its skeleton argument which give a detailed analysis of its assessment of the areas of similarity between the parties' respective specifications. They are as follows:

Applicant's services	Opponent's services
<u>Identical terms showing identity either on a word or word identical or synonym basis</u>	
Computer programming services;	Computer programming services Technical services with regard to computer programs;
Installation and maintenance computer software programs;	Technical services with regard to computer programs;
Design, development, preparation and update of computer software programs;	Computer systems analysis, <u>design</u> , and integration; Computer software application <u>development</u> and hosting; Computer consulting regarding <u>website development</u> ; <u>Design</u> of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases; Database development; <u>Computer system design and development</u> , technical automation services regarding applications for wide area network or local area network computer systems; Computer system <u>development</u> with regard to opinion polls and marketing studies;

	<p><u>Design</u> of data processing programs;</p> <p><u>Design, development and research</u> in using computer databases, manuals and in systematizing information in files;</p> <p>Graphic design services;</p> <p>Web site design;</p> <p>Creation, editing and updating of website content; research and <u>design</u> of new products and packaging;</p>
Computer system consulting and advisory services;	<p>Information, advisory and consultancy services relating to the aforesaid services.</p> <p>Computer <u>consulting</u> regarding website development;</p> <p>Technical <u>consulting</u> in the field of computers</p>
<u>Identical on the <i>Meric</i> principle</u>	
Computer programming services;	<p>Technical services with regard to computer programs;</p> <p>Providing a web-based portal to allow others to view, sort and analyse business and marketing data related to customers and potential customers;</p> <p>Support in the use of computer networks;</p>
Installation and maintenance computer software programs;	<p>Technical services with regard to computer programs;</p> <p>Support in the use of computer networks;</p>
Computer system consulting and advisory services;	<p>Computer network management services for others;</p> <p>Computer systems management (with the</p>

	exception of installation, repair and maintenance);
Provision of temporary non-downloadable software;	<p>Design of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases;</p> <p>Database development;</p> <p>Providing a web-based portal to allow others to view, sort and analyse business and marketing data related to customers and potential customers;</p> <p>Creation, editing and updating of website content;</p>
Software as a service (SaaS) services;	<p>Computer programming services;</p> <p>Design of graphic user interface and site architecture technology integration to enable e-commerce and integration with client databases;</p> <p>computer software application development and hosting;</p>
Operating cloud computing system in Class 42.	Computer system design and development, technical automation services regarding applications for wide area network or local area network computer systems;
<u>Highly similar services</u>	
Computer rental services;	All of the opponent's services in class 42.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ the General Court stated that:

⁴ Case T- 133/05

“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 für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. Whilst *Meric* deals specifically with goods, its findings are analogous to specifications which relate to services.

15. At the hearing, Mr Smith confirmed that the applicant accepts the analysis provided by the opponent with the exception of the ‘provision of temporary non-downloadable software’, which the opponent submits is identical to a number of terms in its own specification under the principle found in *Meric*. The applicant submits that this term is similar but not identical to the terms identified by the opponent in its own specification.

16. I will proceed on the basis, agreed by the applicant, that the parties’ respective services are identical, but for the ‘provision of temporary non-downloadable software’ and ‘computer rental services’ which are similar to services present in the opponent’s specification.

The average consumer and the nature of the purchasing act

17. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

18. 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*,⁵ Birss J. described the average consumer in these terms:

⁵ [2014] EWHC 439 (Ch)

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

19. In its skeleton argument the applicant submits:

“3. The Contested Services are directed at the professional public. As such, the average consumer can be deemed to be professionals or businesses. Commissioning the design of a bespoke software system or purchasing high performance and technical software services will demand a higher level of attention (Lloyd Schuhfabrik Meyer). By way of context, the Applicant’s proposed use of the Contested Mark is in relation to high performance remote access servers for businesses.”

20. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁶, 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.

21. Furthermore, in *Devinlec Développement Innovation Leclerc SA v OHIM*,⁷ 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

⁶ Case C-533/06

⁷ Case C-171/06P

inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

22. In other words, the way in which the applicant is actually using, or intends to use its trade mark at this point is not a factor which is relevant to the decision. Rather I must consider all normal and fair uses of the applicant’s mark. The same applies to the opponent’s earlier mark.

23. With regard to the particular characteristics of the average consumer, Mr Smith put forward the submission that the average consumer in this case is the ‘professional public’. This was raised, for the first time, in his skeleton argument. As a consequence, just before the commencement of the hearing Mr Barry, for the opponent, filed a copy of *Skyscape Cloud Services Limited v Sky Plc et al.*⁸ I allowed Mr Barry to rely on this case specifically with regard to the nature of consumers purchasing software and IT services and allowed Mr Smith one week following the hearing in which to make submissions in writing on that point only.

24. On 30 April 2018, Mr Smith sent an email to the Tribunal in which he confirmed that the applicant had no further comments in this regard.

25. In the *Skyscape* case, before Hacon J, the average consumer was made up of public sector organisations procuring services via a specific platform. Within that context, Mr Barry relies on paragraph 76 of the decision:

“More significantly, the entities can be small. Several schools, several care homes and social clubs are included. Mr Roberts, by way of example, drew my attention to Abergavenny Baptist Church and Ammanford Nursery School in Carmarthenshire. I cannot assume that either of them has a skilled IT individual to sort out, for instance, obtaining an email account. In all likelihood this would be done by a pastor or nursery teacher with no IT skills above those of any other person delivering the sermon or teaching in the classroom.

⁸ [2016] EWHC 1340 (IPEC)

26. Essentially, Mr Barry's submission on this point is that even in such prescribed circumstances, the court found that the average consumer of IT services included non-professionals, and he concludes that this certainly must be the case in the matter before me, where no such restrictions exist and the terms used are fairly broad.

27. Mr Smith identified the following services that are, in his view, services directed at professionals and not members of the public.

Design, development, preparation and update of computer software;
Computer system consulting and advisory services;
Computer programming services.

28. Whilst I agree that the majority of average consumers for these services will be professionals/businesses, in my experience, and there is no evidence on this point, it is not uncommon for members of the general public to use advisory services, such as helplines or in store experts in respect of particular computer systems. Similarly, members of the public are familiar with installing and updating operating systems and software onto a variety of computers, devices and peripherals. Whilst design, development and preparation of software and computer programming services clearly will be used by businesses and professionals I am not prepared to accept that this is the only type of relevant consumer. For example, a member of the public may have a website or application designed for a hobby or interest group. In other words, whilst these are primarily professional/business services, I do not rule out a smaller number of average consumers being members of the general public.

29. In conclusion, the average consumer may be, for the most part, a business/professional or, in some cases, a member of the public. The purchase of a software update by a member of the general public will be less expensive, more frequent and require a lower level of attention (i.e. average rather than high) to be paid than the commissioning of software design and development for a business, which will be infrequent, more expensive and likely to involve a far longer process. The selection process is likely to be primarily visual, being made from a website or brochure, though

I do not discount the fact that there may be an aural element, particularly given that some of these services may be purchased as a result of recommendation.

Comparison of marks

30. The marks to be compared are as follows:

Opponent:	Applicant:
M1	M12

31. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁹, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

32. The applicant's mark comprises the letter 'M' followed by the numbers '1' and '2', with no gaps between the characters. The mark is presented in upper case and in plain black type with no additional stylisation. The overall impression of the applicant's mark rests in the whole mark.

33. The opponent's mark comprises the letter 'M' followed by the number '1'. There is no space between the two characters. The mark is presented in upper case and in plain black type with no additional stylisation. The overall impression of the opponent's mark rests in the whole mark.

Visual similarity

34. With regard to the comparison to be made between the respective marks, the opponent submits:

⁹ *Sabel v Puma AG, para.23*

“5.4 The Application comprises the distinctive and dominant element, ‘M1’, which is inherently distinctive having no literal meaning or definition. The application only differs from the Earlier Rights in the addition of a numeral ‘2’.

5.5 Visually, the Earlier Right consists of 2 characters which form the first 2 characters of the Application and are 2/3 or 67% of the Application.”

35. The applicant submits that the earlier mark consists of:

“8...just two characters, namely the alphabetic letter ‘M’ and numeral ‘1’, whereas the Contested Mark consists of three characters, namely the alphabetic letter ‘M’ and the numerals ‘1’ and ‘2’. Due to the absence of any grammatical devices or stylisation therefore, the addition of the numeral ‘2’ in the Contested Mark, significantly alters the visual impression of the Contested Mark in comparison with the Opponent’s [earlier mark] which do[es] not contain this element.”

9. The respective marks are short signs not recognisable as words. The Applicant notes the comments of Iain Purvis QC sitting as the Appointed Person in Hachette Filipacchi Presse SA v Ella Shoes Ltd¹⁰ in which he stated:

“20...In considering visual similarity, it was clearly right to take into account the shortness of the marks, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark.”

10. As such, in the case of short signs, the average consumer is able to easily perceive all the single elements of the respective marks and will not fail to notice the differences between them. It is submitted, that the

¹⁰ BL O/277/12

difference between the respective marks in the present case is even more significant than in the case referred to (where the marks to be compared were 'ELLE' and 'ELLA'), given that in the present case the respective marks are; (1) shorter, (2) not of equal length and (3) coincide in respect of fewer elements. Therefore, it is submitted that the visual similarity of the respective marks is low to medium."

36. Visual similarity rests in the fact that the entirety of the opponent's mark makes up the first two characters of the application. The only difference is the addition of the number 2 in the application.

37. I find these marks to be visually similar to a fairly high degree.

Aural similarity

38. The opponent submits in its skeleton argument:

"5.6 Phonetically the Earlier Rights will be pronounced as 'em-one' and the Application as either 'em-one two' or 'm-twelve'. Since there is no evidence as to how the Application will be used and as each is a fair and notional use of the Application, the Opponent submits that each should be considered by the hearing officer. With the pronunciation 'em-one-two,' the sound of the Earlier Right consists of 2 syllables which form the first 2 the syllables of the Application and are 2/3 or 67% of the Application. With the pronunciation 'em-twelve' the respective marks each consist of two syllables with the first syllable being identical."

39. The applicant submits:

"Aurally, the Contested Mark would be pronounced 'M-TWELVE'. Whereas, [the opponent's mark] would be pronounced 'M-ONE'. The only element of overlap is the single alphabetic letter 'M', which would be pronounced the same. The respective marks can therefore be further distinguished from an

aural perspective. The coincidence of the single alphabetic letter 'M' is not sufficient to counteract the aural dissimilarity of the remaining elements of the respective marks, namely 'ONE' and 'TWELVE'. As such, it is submitted that the respective marks are aurally dissimilar or only aurally similar to a very low degree."

40. I agree with the opponent that the applicant's mark may be pronounced in two ways, though I find that 'm-twelve' is the more likely. In that case the first syllable of both parties' marks is 'em'. The second syllables being 'one' and 'twelve'. I find the level of aural similarity between these pronunciations to be medium.

41. Should the average consumer pronounce the applicant's mark, 'em-one-two' then the totality of the earlier mark is the same as the first two syllables of the application, differing only in the additional third syllable, 'two'. In that case I find the level of aural similarity between the parties' marks to be between medium and high.

Conceptual similarity

42. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹¹ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.¹²

43. The opponent submits:

"The Application (as is true of the Earlier Rights) may be conceptually understood as an arbitrary structure of the letter 'm' followed by a low number."

44. The applicant submits that its mark has no meaning. It submits that the opponent's mark would bring to mind the M1 motorway, (which connects Leeds to London), for

¹¹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

¹² See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.

the average UK consumer. It concludes that the respective marks are conceptually dissimilar.

45. At the hearing the parties made a number of submissions regarding the fact that the average consumer may perceive one or both parties' marks as referring to a motorway. The applicant sought to rely on the fact that the M1 is a motorway, whereas the M12 is not, which it concluded results in a clear conceptual difference. In response to that submission the opponent filed a print taken from *Google* showing the M12 motorway near Belfast.

46. I find that if the average consumer makes a connection between the letter 'M' followed by a number and concludes that this refers to a motorway, then it will draw that conclusion with regard to both marks. Absent any evidence to the contrary, I am not prepared to find that the average UK consumer has an encyclopaedic knowledge of all motorways in the UK and their respective numbers. However, that said, in my experience, combinations of letters and numbers are not uncommon in the context of the services at issue and it is far more likely that the average consumer will see both marks as a combination of the letter M and a number or numbers and will give it no more conceptual significance than that. Accordingly, I find the marks to be conceptually neutral.

Distinctive character of the earlier marks

47. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.¹³

48. The opponent does not claim enhanced distinctive character, but claims M1 is 'entirely arbitrary and therefore inherently distinctive'.

¹³ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

49. The applicant submits that the earlier mark is low in inherent distinctive character as it is 'incapable of being read as a word'. The basis of this submission is not clear to me since, as a very general rule, invented words, with no reference to the goods of services for which they are being used, enjoy a high level of distinctive character.

50. In this case, M1 is not an invented word, but a combination of a letter and a number. In terms of inherent distinctiveness M1 has no obvious meaning for the average consumer in the context of the relevant services and the mark is possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

51. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁴ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 services and vice versa.

52. I have made the following findings:

- The average consumer is a business/professional or a member of the general public .
- The level of attention paid to the purchase will vary. That said, the services will require at least an average degree of attention to be paid.
- The purchase will be primarily a visual one, though I do not discount an aural element.

¹⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

- The respective marks possess a fairly high degree of visual similarity and are aurally similar to a medium or medium to high degree, depending on the pronunciation of the applicant's mark. Conceptually, the marks are neutral, the average consumer giving neither any conceptual significance beyond seeing both marks as a combination of the letter M and a number or numbers.
- The earlier mark M1 has a medium degree of inherent distinctive character.

53. The opponent submits that use of ascending numbers to differentiate products or releases is common in the IT industry and concludes that the average consumer of the relevant services will be familiar with the practice. The opponent provides the example of products such as *Windows 7* or *Windows 10*.¹⁵

54. The opponent also draws my attention to *Certmedia International and Lehning Enterprise v OHIM*,¹⁶ in which the GC found the marks 'L112' and 'L.114' to be confusingly similar. The opponent submits that the logic in that case can be directly applied to this case, and provides an extract from that case with its own and the applicant's marks replacing the actual marks at issue in that case.¹⁷ This is not helpful. Whilst there are some similarities such as the fact that the marks in both cases are number and letter combinations and they have fields of activity in common, the actual configuration of the marks is clearly different (i.e. one more numeral and the use of a full stop). I cannot simply import a finding from a different case which happened to deal with a combination of letters and numbers. I must decide this case on its own merits bearing in mind all of the relevant factors.

55. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person outlined the differences between direct and indirect confusion in the following terms:

¹⁵ See paragraphs 7.5 and 7.13 of the opponent's skeleton argument.

¹⁶ Case T-77/10

¹⁷ See paragraph 7.9 of the opponent's skeleton argument.

“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.’”

56. I agree with the opponent, based on my own experience, that it is fairly common within the IT and technology fields for different iterations of products and services to be provided under sequential alpha/numeric systems. In this case, considering the nature of the parties’ marks, the average consumer, the nature of the purchase and the level of attention to be paid to the purchase of these services, I find that for some average consumers there is a likelihood of confusion where the marks are imperfectly recalled and directly confused one for the other. They are both marks that begin with a letter ‘M’ and are followed by the number ‘1’, the only difference being the number ‘2’ in the application. For more attentive consumers (which may include business consumers) I find there to be a likelihood of indirect confusion. Whilst they will notice that the respective marks are not exactly the same, the addition of the number ‘2’ in the opponent’s ‘M1’ marks (for the same or similar services), will simply be seen as another offering in the same line, from the same undertaking.

CONCLUSION

57. The opposition succeeds under section 5(2)(b).

COSTS

58. At the conclusion of the hearing both parties agreed that costs should be awarded on the scale which is provided in Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. The opponent has been successful and is entitled to a contribution towards its costs. At the start of the hearing the opponent’s representative stated that the evidence filed in support of its case did not go to the matter to be decided. Consequently, I will not make an award in respect of it, as it did not assist in reaching this decision. I make the following cost award:

Official fees:	£100
Preparing the notice of opposition and considering the other side’s counterstatement:	£300
Filing submissions: ¹⁸	£200
Preparing for and attending a hearing:	£800
Total:	£1400

59. I order Fujitsu Limited to pay Aegis Trademarks BV the sum of £1400. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of May 2018

**Ms Al Skilton
For the Registrar,
The Comptroller-General**

¹⁸ This relates to documents filed with the opponent’s skeleton argument in response to points raised by the applicant (for the first time) in its skeleton argument.