

O/400/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3373979

BY

FITZROY HAWK LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 9

Mapily

AND OPPOSITION THERETO (NO. 416313)

BY

MAPPY S.A.

Background and Pleadings

1. Fitzroy Hawk Ltd (“the Applicant”) applied to register the trade mark “Mapily” on 8 February 2019 for goods in class 9, as listed below. It was accepted and published on 15 February 2019.

Class 9: Augmented reality game software; Augmented reality software; Augmented reality software for creating maps; Augmented reality software for education; Augmented reality software for simulation; Augmented reality software for use in mobile devices; Augmented reality software for use in mobile devices for integrating electronic data with real world environments.

2. MAPPY S.A. (“The Opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act (“the Act”) relying on its earlier European Union trade mark (“EUTM”) no. 5703814 MAPPY filed on 21 February 2007 and registered on 16 February 2010. Whilst the Opponent’s mark is registered for goods and services in a number of other classes, for the purposes of this opposition, it relies only on those goods and services in classes 9 and 42 as outlined below:

Class 9: Computer equipment, namely: software; computer software and software packages in particular for the calculation online of road itineraries and providing of tourist information; computer database servers providing access to information for the calculation online of road itineraries and to tourist information; software to be used with (satellite and/or GPS) navigation systems; software for information systems relating to travel, for providing advice and/or information relating to travel concerning service stations, car parks, restaurants, car dealerships and other information relating to travel and transport; software for information management for the transport and traffic industries; software to be used for electronic maps; electronic cards; software for route planners; route planners; position finding, orienteering and navigation apparatus and global positioning systems (GPS).

Class 42: Technical consultancy relating to automation, design and development of navigation systems, route planners, electronic cards and digital dictionaries; technical appraisals, consultancy and advice in the field of telecommunications and computing, and in particular for the supply online of road itineraries and road and tourist information; design of computer software; design and development of computer software; design and development of computer software for navigation systems (GPS and/or satellite); design and development of computer software for information systems relating to travel, for providing advice and/or information relating to travel concerning service stations, car parks, restaurants, car dealerships and other information relating to travel and transport; design and development of computer software for the management of information for the transport and traffic industries; design and development of computer software for electronic maps; design and development of electronic maps; design and development of computer software for route planners; leasing access time to a computer database server, dedicated to the supply of tourist information, in particular for global telecommunications networks (Internet).

3. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) of the Act because the respective trade marks are similar and that the goods and services are identical or similar.

4. The Applicant filed a defence and counterstatement denying the claims made and putting the Opponent to proof of use of the goods and services relied upon.

5. Both parties are professionally represented; the Applicant by Temple Bright LLP, the Opponent by Carpmaels & Ransford LLP. The Opponent filed initial submissions together with evidence in the form of three witness statements completed by Elisabeth David de Roux, Jean-Charles Nicollet and Julia Popescu. The Applicant filed evidence in reply from Adam Doherty. Neither party requested a hearing nor filed further submissions in lieu. This decision is taken following the careful perusal of the papers.

Preliminary issues

6. In his witness statement Mr Adam Doherty refers to various other trade marks which appear on the register using the prefix MAP arguing that they are able to coexist without leading to a likelihood of confusion. In this regard he states that:

“7. I do not understand the Opponent’s position that MAPPY is inherently distinctive of the goods and services listed in classes 9 and 42 such that the Mark cannot be registered. The Opponent appears to argue that they have sufficient rights in the word MAPPY to block any brand use that includes the word “map” in connection with map related products. This appears to me to go against the evidence of existing “map” brands that are in use and/or registered with the UK IPO.”

10. ... if the Opponent is entitled to registered rights in connection with the word MAPPY, such rights are to be construed very narrowly and are capable of co-existing with many different MAPPY brands relating to the use of maps.

11. To further demonstrate the numerous trade mark interests in words beginning with MAP in class 9, a search of the UK IPO database for live trade marks that begin with the word MAP in class 9 reveals 389 trade marks. We acknowledge that a small portion of these marks are registered in the Opponent’s name but a significant number of Map brands relating to the use of maps.”

7. I note that in the case of *Zero Industry Srl v OHIM*, T-400/06 the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere

fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS (Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71).”

8. Consequently, the existence of other trade marks on the register using the prefix MAP does not form part of my assessment since I am required to assess the similarity between the marks in issue. I note that two of the trade marks referred to by Mr Doherty have expired and therefore presumably are not being used. Furthermore, there is no evidence that the remaining trade marks are actually in use or in relation to what goods. The presence of other trade marks on the register does not necessarily demonstrate that there has (or has not been) confusion, nor that the distinctive character of the Opponent’s MAPPY trade mark has been weakened in the marketplace because of the frequent use of marks with the prefix MAP.

9. In addition the Applicant submits that the original examination report did not raise the Opponent’s mark and therefore this demonstrates that its presence in the marketplace would not cause confusion. In this regard Mr Doherty states:

“12. When I applied for the Mark on behalf of the Applicant the mark was published straight away by the UK IPO - without the UK IPO raising any potential similar mark - such as the Opponent’s – in correspondence with me. Although I recognise this is not definitive evidence that there is no likelihood of confusion between the two brands it does demonstrate that on the face of it the risk of any confusion between the mark and the Opponent’s prior rights was not a cause for concern for the UK IPO.”

10. The fact that the examination report did not raise the Opponent’s mark in opposition has no bearing on the outcome of my assessment. The initial search undertaken, for potentially similar marks, is not an exhaustive search of the register. Furthermore, the opposition against trade marks is not exclusively reserved only to

those parties identified by this office as having potentially similar marks to the applied for mark. The Applicant was notified by this office by way of letter dated 13 February 2019 that there was “a 2 month opposition period in which anybody may oppose its registration.”

11. On this basis any party may oppose an application and their case will not be prejudiced by the fact that the trade mark examiner did not identify them within their initial search. Ultimately the matter to be determined must take into account the global assessment of all relevant factors as identified by the caselaw. Failure of the examiner to include the Opponent’s mark within its initial search will therefore have no bearing on the outcome of whether there is any likelihood of confusion.

12. In the evidence of Elisabeth de Roux, the Opponent refers to its registration in the UK of MAPPY HOUR under no. 013966999 to demonstrate that consumers will perceive its earlier mark as having a connection to the word Happy. In reply the Applicant conducted a search on Google and found that the trade mark was in active use by a number of different organisations around the world not necessarily connected to the Opponent. Since the Opponent is not relying on this mark in its pleadings any reference to this registration is not relevant to the issues in hand and will have no bearing on the outcome as to whether a likelihood of confusion exists between the marks at issue.

Evidence

The Opponent’s evidence

13. The Opponent’s evidence consists of the witness statement of Ms Elisabeth David de Roux dated 11 October 2019 accompanied by eighteen exhibits marked EDR1-18; the witness statement of Ms Iulia Popescu dated 6 November 2019 and the witness statement of Mr Jean-Charles Nicollet dated 6 November 2019.

Iulia Popescu and Jean-Charles Nicollet's statements

14. These witness statements have been provided in order to confirm the translations which accompany exhibits numbered EDR 1, EDR 2, EDR 6, EDR 7, EDR 9, EDR 15 contained within Ms de Roux's statement; on this basis I do not propose to summarise these statements. Whilst both Mr Nicollet and Ms Popescu confirm that their translations accurately represent the content of the original documents, I note that neither are professional translators, not all the documents have been translated and where translations are provided a number of documents have only been translated in part. In addition, Ms Popescu states that her translations and annotations have been completed with the aid of google translate.

Elisabeth David de Roux's statement

15. Ms de Roux is the Administrative and Legal Manager of the Opponent, being employed by the company since October 1998. She is authorised to make the witness statement on behalf of the Opponent and confirms that the contents come from her personal knowledge and/or from the Opponent's records. I have summarised Ms de Roux's evidence to the extent that I consider it necessary. Throughout her statement Ms de Roux describes the Opponent as "the Company" and I shall therefore use the same reference in my summary.

16. Ms de Roux provides background information as to her role and responsibilities within the company and the history regarding the company's formation, confirming that it is a French public limited company and a subsidiary of the SoLocal Group (formerly called Yellow pages).

17. Ms de Roux confirms that the mark MAPPY has been continuously used in France since 2000 in both its word and stylised form.

18. Ms de Roux confirms that the company provides an "itinerary planning digital service" called MAPPY which she refers to throughout her statement as "the product".

This “product” she states supports “mobility and travel, by providing maps, routes, points of interest and aerial photos, accessible on various telecommunications networks” irrespective of the receiving terminal.

19. Ms de Roux describes the product as being able to establish a suitable route for up to 13 modes of transport and in support of this exhibits at EDR 2 an internal presentation dated September 2019 (which I note is outside the relevant date).

20. Ms de Roux confirms that the product is made available on the Company’s website and via mobile applications (both iOS and Android) and since 2012 it has increased its user base by 50%, amounting to between 10 and 13 million users per month. Ms de Roux states that during 2018 the product was used to calculate 4 billion itineraries operating across France.

21. Ms de Roux confirms that the Opponent partners with other transport companies to include “Kapten”, “leCab”, “Eurolines” and “Expedia.fr” which forms part of the strategy to expand the “MAPPY service offering” across Europe.

22. Ms de Roux states that in 2018, “MAPPY” had 11 million unique visitors per month and in 2017 almost 350 million visits, of which 50% were via mobile applications.¹ She states that according to Mediametrie (described as the French leader of media and reference studies in audience measurement) “Mappy’s” estimated share of the total market for itineraries and mapping services in France was 22.5%.

23. Ms de Roux states that the Opponent received a Golden trophy award in the “best data strategy” category at the G20 Strategy and Management Summit held in Paris in May 2018.²

¹ para 11

² Page 10, exhibit EDR 1

24. Ms de Roux provides the company's total annual turnover figures which are reproduced below:

Year end 31 December	Total net sales (Euros)
2014	€13,604,700
2015	€12,589,500
2016	€12,398,700
2018	€11,604,700

25. Ms de Roux states that a number of companies have entered into licensing agreements with the Opponent to include Century 21, PageJaunes Groupe, Pole Employ and LOGICOM. Ms de Roux states that LOGICOM holds an operating licence to use the MAPPY trade mark and logos throughout France and Western Europe.³

26. The Opponent is described by Ms de Roux as investing widely in promoting its product mainly online but also through various printed publications and through its social media accounts.

27. Ms de Roux includes details of several other trade marks used by the Opponent which contain the word MAPPY however since the Opponent is not relying on these marks for the purposes of its opposition, I do not propose to expand any further on the details provided.⁴ Similarly, Ms de Roux provides a list of domain names registered to the company.⁵

³ Para 17 and 18, EDR 7 and EDR 8

⁴ Para 26 and exhibit EDR 17

⁵ Para 27 and exhibit EDR 18

Exhibits⁶

28. Exhibit EDR 1 is described as two articles which refer to the company's formation the first taken from "LCI" dated 19 July 2017 and the second from "Decideurs Magazine" dated 14 June 2018. The first article consists of a screen shot taken from the French website "www.lci.fr/high-tech" headed "30 years later Mappy still shows the road of holidays" and refers to Mappy as a "French mapping service" available on the internet as well as mobile application. Throughout the article "Mappy" is used interchangeably to refer to both the company and the trade mark. The article contains information provided by Florence Leveel - Mappy's marketing director – describing "Mappy" as having been designed as a "route calculation service" supported by the iPhone mobile application in 2007 and later launching a second app in 2010 which integrated GPS with different modes of transport. The article includes the following statements "Mappy continues to be among the Top 30 most visited French sites and to record some 13 million unique visitors for 45 million visits each month" and "Mappy is the second mapping site used behind Google Maps". Ms Leveel provides details of the launch of a new version "last October" (which presumably refers to October 2016 taking into account the date of the article). The article explains that Mappy "wants to be something other than a service offering the best route" describing its partnership with TomTom as enabling it to add a real time traffic option to its calculator.

29. The second article is an interview with Bruno Dachary, the company's managing director, published on the website "www.magazine-decideurs.com" dated 14 June 2018. Within the article Mr Dachary describes "Mappy" as a "multimodal displacement comparator". Mr Dachary outlines that in 2012 approximately 8 million visitors browsed [their] website whereas now [they] attract 12 million unique visitors per month. He continues, stating that "of these users 50% connect via a PC and 50% via a smartphone". The remainder of the article discusses the company's strategy to "pre-ship our application in smartphones" and "to develop a default installation on mobile devices" in order to raise awareness in the Mappy brand. Mr Dachary confirms that Mappy is currently a "French player whose audience is 90% French".

⁶ Where referred to, the extracts are taken from the English translations provided by Mr Nicolle and Ms Picoulet

30. Exhibit EDR 2 is described as an internal presentation dated September 2019 (outside the relevant date) setting out the wide range of modes of transport catered for by the “product”. The document is in French and only a proportion of the headings have been translated by way of hand written annotations. I note however that the mark in both its written and stylised form is produced throughout the document. Reference is made to an opinion poll undertaken by “Harris Interactive” in January 2018 which when measuring “spontaneous consumer recognition” placed the company first within the mapping and itinerary market in France. According to this same source when prompted “45% of French consumers know the MAPPY brand” positioning it as a key player in the digital mapping market and as the French alternative to Google Maps.

31. Exhibit EDR 3 is described as an article taken from the website “www.mobilitesmagazine.com” dated 27 March 2018 which provides information as to the company’s partnerships and expansion strategy. Reference is made within the text to “Mappy having just announced the arrival in its comparator of long-distance coaches Eurolines and isilines”.

32. Exhibit EDR 4 is described as an article that illustrates that the company’s website has become one of the most visited travel sites in France. The article is dated 1 June 2018 and is taken from the website “www.rudebague.com”. Mappy is described as the “French leader in cartography and route calculation and a direct competitor of Google maps” with “12 million unique visitors each month”. Mappy is described as “available on the web and mobile applications (iOS and Android), the service places the user at the heart of a new mobility ecosystem and is offered a new comprehensive and innovative service offer”.

33. Exhibit EDR 5 consists of a ranking table of unclear origin marked as “updated on 19 September 2019”. I note that as at July-August 2019, Mappy was ranked 27th of the most visited mobile sites in France.⁷ (outside the relevant date)

34. Exhibit EDR 6 is described as showing that the product is the second most known itinerary brand after Google and consists of a French press release dated 6 September 2017 published by “Mediametrie” annotated as “global internet audience in France in July 2017”. On page 2 Mappy is listed second in the table headed “top 10 category map/itineraries brands”. I note that the document has not been translated in full and no further explanation or context is given.

35. Exhibit EDR 7 consists of extracts of a trade mark licensing contract dated 8 October 2013 between MAPPY S.A. and LOGICOM, together with two signed but undated amendments. The contracts are in French and have not been translated in full and several pages of the original contract have been omitted. The original contract appears to be for a period of 3 years and has been extended twice, the last period expiring on 31 December 2020. Under the terms of the agreement MAPPY (the company) grants LOGICOM a license to use the MAPPY trade mark for the manufacture, import and marketing of “Products and Services” related to geographical location and GPS navigation. It is unclear which products and services are included as no translation or further explanation has been provided.

36. Exhibit EDR 8 is described as “invoices for royalty payments for the years 2014-2019 from the Opponent to its licensees”. It consists of a number of invoices addressed to LOGICOM marked “Royalties” at various dates predominantly during 2016, 2017 and 2018. At the bottom left hand corner of each invoice reference is made to the trade mark as follows “”, “mappy.com” and “mappy est une marque de SoLocal Group”. No further explanation is given as to what the royalty payments represent.

⁷ Page 5

37. Exhibit EDR 9 is described as copies of operating licences granted to Century21, Pole Emploi and PageJaunes Groupe permitting these companies to use the MAPPY trade mark/brand in France. The partnership agreements and contracts are not produced in their entirety and of those produced only extracts have been translated.

38. Exhibit EDR 10 is described as copies of third party commercial catalogues and consist of two supermarket promotional fliers, the first from “E.Leclerc” dated 3 to 13 June 2015 and the second from “ELECTRO DEPOT” dated 25 February 2016. No translation is provided for either document. However, I note that three electrical devices are displayed as being offered for sale at a price of €59, €79,90 and €99,97 respectively and each bears the stylised mark “m▲ppy”. Underneath the photographs the mark is also produced in the following formats:



39. Exhibit EDR 11 is described as an extract from the company’s principal website and consists of an undated screen shot taken from “www.fr.mappy.com” with a print date of 9 October 2019 (outside the relevant date). The mark is displayed in its stylised form as m▲ppy.

40. Exhibit EDR 12 is described as You Tube tutorials “planning itineraries and on how to use the product” and consists of three screen shots dated 29 October 2015, 16 February 2017 and 4 December 2017 taken from the website “www.youtube.com”. I note that the first screen shot taken from the Opponent’s website shows that the video has had 24,806 views as at 16 February 2017. The screen shots however are in French with no translations, but I note that the mark in its stylised form is displayed as

m▲ppy and  within the body of the text and as displayed on the electrical device itself.

41. Exhibit EDR 13 is described as screenshots taken from the company's social media accounts used to promote its products. It consists of screen shots taken from the company's Twitter and Facebook posts. The screen shot from the Opponent's Facebook page is undated, save for a print date of 4/10/2019 and page creation date of 16 February 2011. The mark is displayed as as "m▲ppy", "Mappy Online" and "@MappyOnline" and has generated 77,123 likes. The posts taken from the Opponent's Twitter account have a print date of 4/10/2019. The mark is displayed as "Mappy", "@Mappy" and "fr.mappy.com". The account has 2,004 followers.

42. Exhibit EDR 14 is described as examples of the product featuring in the press and on French TV. It appears to consist of stills taken of live interviews with Mr Dacharty from the websites "www.autok7.press" (dated 24 October 2017) and "www.cnews.fr" (dated 7 July 2017).

43. Exhibit EDR 15 is described as a selection of press articles taken from French media and newspapers, during 2014 and 2019, which Ms de Roux states demonstrates that the product has been widely publicised in various online publications, vlogs and in the press. The exhibit includes extracts from the following publications:

- "le Parisien" dated 19 December 2016 describing Mappy's website as now enabling Autolib stations.
- "Francetvinfo" dated 28 April 2015 which refers to the Mappy application updating its data and includes photographs of the "Mappy car" spending two weeks in Limousin taking aerial photographs.
- "www.forbes.fr" dated 17 April 2017 which describes how Mappy launched a "multimodal displacement comparator" in October 2016 and attracts "between 10 and 13 million unique monthly visitors".
- "www.ladn.eu/news-business" dated 25 October 2016 headed "Mappy launches the first multimodal displacement comparator" which is "available on its iPhone, iPad and Android mobile applications, the service offers users various modes of travel to reach their destination, on all types of distances."

- “www.midilibres.com” dated 21 September 2015 headed “mappy updates her photos of the street of Nimes” and describes photographs being updated on “this French website Solocal group which totals one million page views per day and ten million unique users per month.”
- “We are MOBIANS” dated 18 July 2013 (outside the relevant period) titled “New Mappy GPS Free: The pocket mate of the summer, for a serene road” which describes the launching a new version of its mobile application “Mappy GPS Free available on Smartphones” with “more than two million applications currently downloaded.”
- “www.journaldunet.com” dated 15 December 2016 outlining that in October 20.2 million French Internet users visited “at least one site of maps and routes on fixed Web” and that “the two French men, mappy and ViaMichelin are neck and neck with respectively 7.4 and 7 million unique visitors.”

44. Exhibit EDR 16 is described as an article dated 19 June 2018 taken from the website www.edubourse.com which demonstrates the company being a key player in the French digital mapping market. It describes “Mappy as positioning itself as a French alternative for mapping purposes” with more than 80,000 customers. It describes Mappy as available on the web “www.mappy.com” and mobile application on iOS and Android. It describes how the “hosting” (via its site and integrated APIs) attracts “a million visits per day and 4 billion routes calculated in 2018” as well as “the Group generating sales of €756 million in 2017, 84% of which were on the Internet, leading European players in terms of Internet advertising revenue.”

45. This concludes my summary of the Opponent’s evidence. I note that the evidence was also accompanied by written submissions and whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them where necessary in my assessment.

The Applicant's evidence in reply

46. The Applicant's evidence consists of the witness statement of Mr Adam Doherty dated 6 January 2020 together with four exhibits marked AD1-AD4. Mr Doherty is the sole director and shareholder of the Applicant. The contents of Mr Doherty's statement contain both submissions in reply to the opposition and evidence of fact the main points of which are summarised as follows:

- The MAPILY product is intended to be an augmented reality app directed at tourists to provide them with an engaged experience of relevant historical information
- Its product offers advertising opportunities to local industries and rewards and savings to users
- The Opponent's offerings appear to relate predominantly to providing online mapping services to French road users for planning purposes
- There does not appear to be anything on the Opponent's website to suggest a connection between the earlier mark and the concept of "happy"
- The Applicant's mark is innovative and capable of being distinguished from any other undertaking
- The Opponent has only submitted evidence of use in France and has not demonstrated use of the Mappy branding in the UK.
- Any likelihood of confusion between the respective marks are diminished given that the Applicant only seeks protection in the UK

Decision

47. Section 5(2)(b) of the Act states as follows:

"5(2) A trade mark shall not be registered if because-

(a)

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

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

48. In these proceedings the Opponent is relying on its EUTM registration as shown in paragraph 2 above which qualifies as an earlier mark under section 6 of the Act, because it was applied for at an earlier date than the Applicant's contested mark. Since the Opponent's mark has been registered for more than five years at the date the application was filed it is subject to the proof of use provisions contained in section 6A of the Act. Consequently, in order for the Opponent to rely upon the goods and services listed within classes 9 and 42, it must demonstrate that genuine use has been made of its mark for those goods and services.

Proof of Use

49. The relevant provisions regarding Proof of Use are set out as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union

Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

50. Section 100 of the Act is also relevant it states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

51. Accordingly, under section 6A(3)(a) of the Act the relevant period in which genuine use must be established is the five year period ending on the filing date of the applied for mark namely from 9 February 2014 to 8 February 2019.

52. What constitutes genuine use has been subject to a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG*

v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

53. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

....

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

...

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

54. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

55. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to

the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

56. The GC restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and

cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where the market for the goods/services are not limited to that area of the Union.

57. The Applicant challenges the Opponent's evidence as only demonstrating use throughout France and that no use has been demonstrated within the UK. In this regard the Applicant states:

“15. I note that the Opponent has only submitted evidence of use of their prior rights in France. I reserve our position on whether or not this demonstrates genuine use of the Opponent's prior rights to the standard required to support this Opposition. And I consider that any likelihood of confusion between the mark and the Opponent's prior rights is significantly diminished given that I seek only registered protection for the Mark in the UK and the Opponent has not provided any evidence of use of their Mappy branding in the UK.”

58. Even though I accept that the Opponent has not shown use within the UK, since the earlier mark is an EUTM its scope of protection extends throughout the EU. Taking into account the decisions in *Leno* and *London Taxi*, proof of use within one member state may be sufficient to satisfy the criteria even if the use has not been demonstrated over the community area as a whole or specifically within the UK.

Form of the mark

59. The Opponent has filed evidence where the mark is presented not only in its registered form but in a number of variations. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its

registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

60. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

61. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is not used as registered, but as part of a composite mark.

62. Where the earlier mark has been used in the format in which it is registered this will clearly be use upon which the Opponent may rely. The earlier mark as registered is in upper case, however notional and fair use would allow it to be presented in any font or case.⁸ The Opponent has produced articles, screen shots from webpages, social media posts and invoices where the mark is referred to as "Mappy" and "mappy" and therefore I do not consider that the use in title or lower case prevents this form being use upon which the Opponent may rely. In addition, the Opponent's evidence

⁸ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

includes variations of the mark (on webpages, electrical devices and catalogues) where it is displayed as follows:

i.



ii.



iii.



63. Whilst the Applicant has not challenged the Opponent's mark appearing in a variant form to the one as registered, I must still undertake an assessment as to whether they are acceptable variations. In variations ii. and iii. the word "mappy" is presented on a circular device which includes an image of a street map and the world in the background. It is clear from the case of *Colloseum* that where the additional elements do not alter the distinctive character of the mark this is an acceptable variation. These marks are still essentially the word "mappy" where the circular device and images act as decorative backgrounds and do not detract from the mark as registered. These variations therefore fall within scope of acceptable use and may be relied upon by the Opponent. However, in variation "i" the word mappy itself is altered where the letter "a" is replaced by a green triangular device. Whilst it still may be identified by the average consumer as the word "mappy" in order to do so, the consumer would be required to fill in the missing letter "a" for the device. In my view this does not show use of the word "mappy". Taking account of the requirements of section s6A(4)(a) of the Act I consider that the distinctive character of the earlier mark lies in the word "MAPPY". If consumers are required to replace the device with the letter "a", effectively they would be filling in the missing part themselves for it to read as the word "mappy" and therefore I consider that this would in fact alter the distinctive character of the mark. In my view this is not an acceptable variant of the registered mark and the Opponent may not rely upon it for the purposes of its opposition.

Genuine Use

64. Whether the use shown is sufficient, will depend on whether there has been real commercial exploitation of the earlier EUTM, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the Union during the

relevant five-year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown
- b. The nature of the use shown
- c. The goods and services for which use has been shown
- d. The nature of those goods/services and the market(s) for them
- e. The geographical extent of the use shown

65. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is not genuine use.

66. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

....

28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

67. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

68. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated from the evidence filed. The responsibility is on the appropriate party, in this case the Opponent, to provide sufficiently solid evidence to counter the application, a task which should be

relatively easy to attain.⁹ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁰

69. From the outset there are a number of deficiencies in the evidence filed by the Opponent. It is clear from the decisions in *Awareness Plymouth* and *Gucci* that the onus is on the Opponent to put forward its best evidence and that it must be directed towards the goods and services as relied upon. The main evidence is contained within Ms de Roux's statement and exhibits, consisting of a number of documents and articles originally published in French. Although translations have been provided, not all of the documents have been translated in full and those that have, are generally of poor quality in so far as they appear to have been translated using google translate and not by a professional translator. In many instances it has been difficult to understand as to what the contents are referring to. For example, the following extracts are taken from the various translations which are disjointed and make no real sense in the context of demonstrating use of the goods and services relied upon:

“Mappy still shows the road of holidays.”

“Mappy now wants to be something other than a service offering the best route. So, he has completed his offer.”¹¹

“The idea is that we can directly integrate them and a means of payment for tickets, eg, to get a dematerialized ticket in the app.”¹²

“Google has arrived on the market and jostled the business model plethora of players in the sector (....) They have, in a way, radically reformat the market to their sauce,” says *Forbes France* the CEO of Mappy, Bruno Dacharty.”¹³

“the objective is clear: to become national reference and first comparator of displacements in France.”

⁹ *Awareness Limited v Plymouth City Council*, Case BL O/236/13

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, GC Case T-415/09

¹¹ Page 5 Exhibit EDR 1

¹² Page 6 EDR 1

¹³ Page 4 EDR 4

70. Throughout the evidence the Opponent describes its product as a “multimodal displacement comparator”. However, I am not familiar with this term and the Opponent has not sought to explain it, nor has directed me towards any part of its specification which would cover this term in its list of goods and services.

71. In the decision of *Palmerwheeler Ltd v Prnnet*¹⁴ Amanda Michaels sitting as the Appointed Person, considered the position regarding evidence which failed to indicate which exhibits were relied upon in support of which parts of the specifications. She found that the witness statement had made broad claims to use, which was not supported when read with the exhibits and which did not provide cogent proof of use across the range of goods and services claimed by the Registered Proprietor. Ms Michaels reaffirmed the position in *Awareness Plymouth* namely that the onus is on the Proprietor to file sufficiently solid evidence. It is not for me to surmise what the evidence shows or what the goods and services relate to, since I can only assess the matter on what is before me.

72. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a

¹⁴ BL-O/484/13

tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

73. I note that the Opponent has produced turnover figures, but these are global annual figures for the company as a whole and are not broken down by category. No specific accounts, invoices or sales figures are produced. The absence of any breakdown means there is no way for me to determine with any precision how the revenue was generated under the mark or to what extent. Extracts of licencing agreements have been produced which suggest revenue is generated from use of the Mappy trade mark by third parties. However other than extracts of the contracts themselves, no actual use by these licensees have been produced. The reference to royalty payments in relation to Logicom have also not been clearly explained. Whilst invoices have been produced within the relevant period, I am told that they are invoices for royalty payments from the Opponent to Logicom but not in relation to what. There is no context to the invoices themselves and I am unable to discern as to what these documents represent or how Logicom has made use of the mark.

74. In addition, whilst reference is made within the evidence to the Opponent's social media accounts, they are undated save for a print date of October 2019. Moreover, the posts are mainly in French with no translation provided and therefore not only are they outside the relevant period, they do not assist in clarifying that the mark has been used in relation to the goods and services relied upon.

75. The evidence in the main is in the form of articles which describes MAPPY as the most visited travel site in France and the second most known itinerary brand after Google. Whilst a number of these articles refer to MAPPY in the context of referring to the company rather than the mark, provided the public establishes a link between the goods/services and the undertaking responsible for them, then this is sufficient to establish use of the mark in relation to the goods/services themselves.¹⁵

76. Furthermore, throughout the Opponent's evidence, reference is made to "Mappy" attracting millions of visitors. The article published in "www.rudebaguette.com" for example refers to "12 million of unique visitors each month or nearly one in four Internet users who use its services, mappy is the alternative to Google maps in France"¹⁶ and "In October, nearly 20.2 million French Internet users visited at least one site of maps and routes on Fixed Web."¹⁷

77. Whilst I have a number of criticisms in the way the evidence is presented to me it is still necessary for me to assess the evidence as a whole and to determine whether and to what extent the evidence establishes genuine use of the Opponent's mark to maintain or create a market for the registered goods and services as relied upon.

78. Even discounting the evidence filed outside the relevant period and the difficulties as outlined above, there can be little doubt that that the Opponent has used its earlier registered trade mark and the acceptable variations (as outlined in paragraphs 62 and

¹⁵ *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11

¹⁶ Page 4 EDR 4

¹⁷ www.journaldunet.com page 39 EDR 15

63) throughout France, in relation to its website and web-based route planning service. The difficulty, however, is that I see no reference nor am I directed to any services of this kind within the specification.

79. The Opponent relies on *Computer equipment, namely: software; computer software and software packages in particular for the calculation online of road itineraries and providing of tourist information; software to be used with (satellite and/or GPS) navigation systems; software for information systems relating to travel, for providing advice and/or information relating to travel concerning service stations, car parks, restaurants, car dealerships and other information relating to travel and transport; software for information management for the transport and traffic industries; software to be used for electronic maps; software for route planners* in class 9.

80. In relation to establishing use for these goods the Opponent submits that Ms de Roux's statement and exhibits establishes that the earlier mark in both its word and stylised forms "have been in use since 2000 in connection with all aspects of software, providing access to information for the calculation of online road itineraries and tourist information and software used with satellite and/or GPS navigation systems".¹⁸

81. The term *software*, however, is a broad term. The mere fact that the Opponent provides a route planning facility via the internet, which requires software support, does not in itself demonstrate use for software. Almost every business and commercial undertaking relies on information technology and software to some degree in order to function. In general terms the use of the Opponent's software as described in the evidence in reality is directed towards internal use in order for the Opponent to maintain its own website and web-based online route planning service or to bring its product to market. The mere fact that a company uses computer software in the background to provide its service and to run its commercial undertaking does not necessarily mean that use has been demonstrated for the software itself.

¹⁸ Para 7 submissions

82. The Opponent has, however, filed a number of articles within the relevant dates which refer to MAPPY attracting millions of visitors (overall in 2017, 350 million and in 2018, 11 million per month) of which 50% were via mobile applications “iOS, Android and Smartphones”. The article taken from “www.lci.fr” in 2018,¹⁹ for example, refers to Mappy as a French mapping service available via mobile application. The interview with Bruno Dachary in June 2018, published in Magazine-Decideurs’ website, refers to 50% of its Mappy users connecting via a smartphone and to the company’s strategy of pre-shipping applications in mobile devices. Whilst no evidence is provided displaying the MAPPY mark as it appears on the screen icon before the application is downloaded or that the word MAPPY is visible on the application itself, a number of separate references indicate that not an insignificant number of users/visits to the Opponent’s website were directed via its mobile application. Whilst I am not told of any sales or the number of downloads of the application, the article from www.Edubourse.com refers to Mappy having 80,000 customers and the article taken from “We are Mobians”²⁰ (albeit published outside the relevant period) indicates that the application is available for free which according to the decision in *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.*,²¹ may still be sufficient to demonstrate genuine use, if it was intended to create or maintain a commercial market for its software applications.

83. In addition, reference is also made to mobile applications within the partnership agreement with Century 21 (executed on 19 May 2014) which includes the following preamble:

“MAPPY integrates on its MAPPY.COM Website and its mobile applications a Digital Network Showcase highlighting the Partner Data that the latter makes available to it and ensures, via Partner Links, the routing of MAPPY.COM Website Users who clicked on these Links to the Partner Website. In return the Partner pays a fee to MAPPY.”

¹⁹ EDR 1

²⁰ EDR 15

²¹ Case C-320/07 P

84. Therefore taking into account the evidence as a whole, it is clear, that the Opponent has created a market for a mobile phone application under the Mappy trade mark.

85. The Opponent also relies upon "*route planners; position finding, orienteering and navigation apparatus and global positioning systems (GPS)*" however only limited evidence has been provided. Two references are made to devices of the kind that could be regarded as route planners and apparatus. The first within the catalogues produced in Exhibit EDR 10. Whilst these documents are within the relevant period no translation is provided and no information has been provided as to the number of catalogues distributed or the number of units sold either directly by the Opponent or through third parties with its consent. In any event the devices themselves within the catalogues produced bear a variation of the mark ("i" at para 62) which I have already determined cannot be an acceptable variation upon which the Opponent may rely. The second reference is produced at EDR 12 in the form of photographs of screen shots taken from YouTube videos described as "tutorials on planning itineraries and how to use the product."²² Pages 1 and 3 are screen shots of the Opponent's website with no translation attached and page 2 is a photograph of one device bearing variation iii of the mark. Whilst I note that the screen shot on page 2 displays 8,951 views as at 4 December 2017 no other explanation or supporting evidence is provided. Therefore, even if I were to accept that these references demonstrate some use of the mark for *route planners; position finding, orienteering and navigation apparatus and global positioning systems (GPS)*, since there is no other corroborative evidence it is insufficient to establish that the Opponent has maintained or created a market for the goods within the relevant period. Since I have found that the Opponent has not demonstrated use for the devices themselves, I see no evidence that it has demonstrated use for *software to be used with (satellite and/or GPS) navigation systems* that ordinarily would accompany such devices.

²² Para 22.3 statement

86. In relation to the Opponent's *computer database servers providing access to information for the calculation online of road itineraries and to tourist information; electronic cards* in class 9, I have not been directed towards any use of the mark for such goods or evidence that the Opponent provides such goods externally. Providing access to information on computer servers is a service not a trade in computer servers. No evidence has been provided that the Opponent has created a market or commercially exploited the mark for these goods.

87. The Opponent's also relies upon the following services in class 42:

design of computer software; design and development of computer software; design and development of computer software for navigation systems (GPS and/or satellite); design and development of computer software for information systems relating to travel, for providing advice and/or information relating to travel concerning service stations, car parks, restaurants, car dealerships and other information relating to travel and transport; design and development of computer software for the management of information for the transport and traffic industries; design and development of computer software for electronic maps; design and development of electronic maps; design and development of computer software for route planners;

88. There is no evidence that support's the Opponent's claim that it provides these services to others. The Opponent performs these activities so that it can sell the goods it develops or so that it can maintain and update its own website. I cannot see any evidence of these services being provided to external customers. The press releases and articles which refer to design and development services are illustrative of the functionality of the Opponent's products, the development of its business and the improvements to the quality of its website rather than the provision of these services to others. Developing one's own product is not a 'service' for the purposes of trade mark law. No evidence has been filed that third parties have commissioned the Opponent to design and develop a customised product for a third party.²³ Other than

²³ *Alpex Pharma v EUIPO*, Case T-355/15

design and development for its own purpose I see no evidence that shows that the Opponent provides a design and development service externally.

89. In relation to the additional class 42 services relied upon, namely: *Technical consultancy relating to automation, design and development of navigation systems, route planners, electronic cards and digital dictionaries; technical appraisals, consultancy and advice in the field of telecommunications and computing, and in particular for the supply online of road itineraries and road and tourist information; leasing access time to a computer database server, dedicated to the supply of tourist information, in particular for global telecommunications networks (Internet)*, I cannot find any reference at all, even at a base level, that the Opponent provides technical consultancy/appraisal services or that it provides a service for leasing access time to a database server, or that the mark has been put to actual use in relation to these services. There is no evidence that it provides these services in order to create or maintain a share in the market place for them.

Fair specification

90. In light of my findings whilst I agree that the Opponent's evidence demonstrates the requisite use of MAPPY, it does not do so in respect of all its class 9 goods and class 42 services and, in particular, computer software at large. The use has been restricted to downloadable software mobile applications in class 9. Whilst the Opponent has demonstrated use for its services in the field of web browsing and search engine navigation services, it does not appear that the specification of goods/services in classes 9 and 42 it relies upon covers this. It is therefore necessary to consider what is a fair specification to reflect the use shown.

91. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

92. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because

he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

93. I take note of the above case law and in particular I must approach the evidence produced, from the standpoint of the average consumer and what they would consider to be a fair description of the use demonstrated. The Opponent should not be allowed to monopolise the use of a trade mark in relation to a broad category of goods if it has only demonstrated use in relation to a narrow subcategory. This must be balanced against not limiting the Opponent's specification too far so that the specification is unduly restrictive or overly specific.

94. It is clear that the Opponent has demonstrated use of its mobile application, for the reasons as I have already outlined earlier in my decision. On this basis I consider that a fair specification upon which the Opponent may rely for the purposes of the opposition is:

Class 9: Downloadable software for the calculation online of road itineraries and providing of tourist information

95. I will now go on to consider the section 5(2)(b) ground, with the scope of the Opponent's goods as outlined and defined above.

Section 5(2)(b)

96. 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.

The principles:

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

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

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

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

comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

97. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

“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”.

98. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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 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.

99. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“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 Applicant relies on those goods as listed in paragraph where the goods

designated by the trade mark application are included in a more general category designated by the earlier mark”.

100. In addition in order to establish a likelihood of confusion between the marks it is also essential for there to be at the very least some identity or similarity between the goods. This was highlighted in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that (my emphasis):

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

101. As the Opponent’s goods in class 9 have been limited to its field of activity, following my proof of use findings, this has resulted in it only being able to rely on *downloadable software for the calculation online of road itineraries and providing of tourist information*. The Applicant has applied to register its mark for the goods outlined in paragraph 1.

102. The Opponent submits that the contested goods are to be considered similar to the goods covered by the earlier mark. The Applicant has made no submissions regarding the similarity of the contested goods other than those contained in its counterstatement. In this regard it submits that “the Opponent’s specification seeks protection.. for computer software and services that do not relate to augmented reality and that focus particularly on computer software relating to the movement of cars including road navigation road itineraries route planners and the provision of information relating to travel.”

103. To my mind augmented reality software adds a digital computer-based image/view to a real time environment which is available as a downloadable application onto mobile devices and computers. I therefore consider that the Opponent's *downloadable software for the calculation online of road itineraries and providing of tourist information* would cover software which includes augmented reality technology and could be used within route-planning and itinerary applications to enable users to simulate a real life navigational experience. On this basis I regard the Applicant's *Augmented reality software; Augmented reality software for creating maps; Augmented reality software for education; Augmented reality software for simulation; Augmented reality software for use in mobile devices; Augmented reality software for use in mobile devices for integrating electronic data with real world environments* as being caught by the Opponent's broader category and vice versa and are therefore identical according to *Meric*. Whilst the Applicant has not specifically explained the term *augmented reality software for education* I consider that education within this context would be akin to the imparting of knowledge regarding points of interest and landmarks and therefore would also be covered by the Opponent's *downloadable software for providing of tourist information* and therefore be identical according to *Meric*. If however I am wrong in this regard then I consider that the respective parties' goods as outlined are highly similar sharing in use, users, nature and channels of trade.

104. In relation to the Applicant's *Augmented reality game software* I consider that these goods share no similarity to the Opponent's goods other than on a general basis in so far as they are both computer software which is capable of being downloaded. It would be wrong therefore to determine that the goods are similar based on this point alone. On a very general level the nature of the goods may be similar, but their purpose would differ in so far as a downloadable game would be for recreational and entertainment purposes whereas the Opponent's itinerary application is for navigational purposes. Whilst the channel of trade may overlap to some degree, I do not consider that consumers would consider those producing augmented reality games software as also producing downloadable software for the calculation of road itineraries and tourist information; there is too tenuous a link. The items belong in different markets and could not compete with one another. There is no

complementarity between them either where one could be used or was indispensable to the other so that consumers would think that the same or linked undertakings were responsible. The mere fact that a certain type of software or operating system may be used in the functionality of the product is not sufficient for a finding of similarity.²⁴ If however, I am wrong in this regard then they would be similar to only a low degree.

Average consumer

105. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect.

106. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

107. Neither party addresses the issue as to who the average consumer is for the respective goods. To my mind the majority of the goods in particular downloadable applications are aimed at the general public who use android /smart phones or those members with an interest in computer-based gadgetry, games and technology. Although I do not discount specialist business users, I consider that goods are overall aimed at the general populous. For this category of consumer, I consider that an average level of attention would be undertaken as they would take into consideration

²⁴ *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-316/07*

reviews of the application/software, the quality, ease of use and suitability before purchasing or downloading the product. Visual considerations will therefore dominate in the decision-making process following searches in mobile application stores or via websites or search engines. I do not discount aural considerations however following aural recommendations.

Comparison of the marks

108. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

109. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

110. The Opponent argues that the marks are visually similar to a high degree sharing the prefix MAP and ending in the letter Y, only differing by the two letters “IL”; the

marks share a similar length and overall structure making them phonetically similar and have a shared conceptual allusion to “happy” and “happily”.

111. The Applicant however argues that there is nothing to suggest a connection between the earlier mark and the concept of “happy” and that the Opponent should not be entitled to monopolise the word MAP in connection with map related products. In contrast it argues that its mark Mapily is a more playful hybrid of the words map and happily combining these two well known truncated and fused forms which is entirely different from the Opponent’s simple derivative version.

112. The respective marks are shown below:

Opponent’s mark	Applicant’s Mark
MAPPY	Mapily

113. The Applicant’s mark consists of the six letter word “Mapily”. There are no other elements to contribute to the overall impression, which is contained in the word itself.

114. The Opponent’s mark consists of a five letter word only mark, namely “MAPPY”. Again, there are no other elements to contribute to the overall impression, which resides solely in the entirety of the word.

Visual Comparison

115. A word trade mark protects the word itself irrespective of font, capitalisation or otherwise and therefore a trade mark in capitals covers use in lower case and vice versa.²⁵ The difference in casing therefore will have little impact on my assessment regarding the visual similarities of the marks. The marks coincide with four out of the five/six letters; the letters M-A-P and Y being identical. The differences lie with the

²⁵ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

Opponent's mark containing the additional letter "P" and the Applicant's mark containing the additional letters "I" and "L". Since greater emphasis is given to the beginning of words, combined with the differences being less noticeable, positioned as they are within the middle of the marks; I consider that the marks are visually similar to a high degree since both marks begin with the identical three letters MAP and end with the letter Y and are of similar length.

Aural Comparison

116. I consider that the Opponent's mark will be pronounced as MAHP-EE or MAP-EE whereas the Applicant's mark will be pronounced as MAHP-IL-EE or MAP-IL-EE. Whilst the Opponent's mark has three syllables and the Opponent only has two irrespective of the pronunciation given in either scenario, the marks coincide in at least two out of the three syllables. I consider therefore that the marks are aurally similar to a medium to high degree since the pronunciation with the additional syllable in the middle of the Applicant's mark is likely to make only a limited impact. Whilst I do not discount that there may be other variations in the pronunciation of the respective marks I do not consider that these are obvious ones or ones put forward by either party. In any event, to assess every possible variation in the pronunciation of the marks would result in an overly analytical assessment, which I do not consider would be undertaken by the average consumer when first encountering the marks.

Conceptual Comparison

117. I note both parties' submissions in relation to the conceptual comparison but for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²⁶ I do not find that the average consumer will undertake a detailed analysis as envisaged by the parties or connect the marks with a reference to the word happy. To my mind the marks will be perceived as invented or at the very least will recognise the word map within the mark as a reference to cartography. Grammatically adding the letters ILY/Y to the end of an adjective converts it into an adverb, however, I do not consider that consumers will necessarily go through this thought process when

²⁶ Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

coming across the respective marks, especially since the word MAP is recognised as an ordinary English word rather than an adjective. In so far as a conceptual comparison is concerned, the marks will be similar to the limited extent that they bring to mind a connection to maps, which is not a very distinctive similarity in the context of software for mapping and route planning purposes.

Distinctive Character of the earlier mark

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

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

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

119. Registered trade marks possess varying degrees of inherent distinctive character; descriptive words tend to have a low level of inherent distinctiveness, whereas invented words are regarded as possessing a high level of distinctive character, and dictionary words that are neither descriptive nor allusive are somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The distinctive character of a mark can be enhanced by virtue of the use made of it.

120. The Opponent has not pleaded that the distinctiveness of its mark has been enhanced through use but nevertheless filed evidence in support of its claim that it had used its mark for the goods and services relied upon. Notwithstanding my earlier findings regarding genuine use, no evidence has been filed to demonstrate that the Opponent's mark has been used in the UK and, therefore, on this basis I am only able to consider the position based on inherent characteristics.

121. As I have already noted the average consumer will regard the Opponent's mark as an invented word with at the very least an allusive association with cartography. Whilst not directly descriptive of the goods, the distinctive character of the mark resides in the grammatically incorrect use of the word map as an adverb. On this basis, overall, I consider that the Opponent's mark possesses a medium degree of inherent distinctive character.

Likelihood of confusion

122. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods and services originate from the same or related source.

123. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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, I conclude that it is another brand of the owner of the earlier mark.”

124. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

125. Earlier in my decision I found that the majority of the Applicant’s goods were identical to the Opponent’s (or at least highly similar) but that its *augmented reality games software* were dissimilar or at most had a low degree of similarity to the Opponent’s *downloadable software for the calculation online of road itineraries and providing of tourist information*. I also considered that the average consumer, being a member of the general public, would select the goods primarily visually (but not discounting aural considerations) paying an average degree of attention. I found the earlier mark to possess a medium degree of inherent distinctiveness. I found that the

marks were visually similar to a high degree and aurally similar to a medium to high degree. Conceptually both marks were similar to the limited extent that they had a connection to cartography.

126. Taking into account these conclusions and the fact that consumers rarely have a chance to compare marks side by side, I consider that the similarities between the marks as a result of the identical first three and last letters would in my view cause the marks to be misremembered or mistakenly recalled, especially for identical or highly similar goods. I recognise that in some circumstances the difference of one or two letters within a relatively short mark can be more significant, but I do not consider that this applies in the case before me, due to the positioning of the different letter/s within the middle of the marks, giving them less impact than if those differences were at the beginning. The difference in pronunciation with the additional syllable in the Applicant's mark will be swallowed to some extent by the identity of the remaining letters meaning that the marks are unlikely to be distinguished by the consumer. In any event, the goods are likely to be selected mainly through visual means. I do not therefore consider that these differences override the high visual and medium to high aural similarities between the marks which, in my view, dominate the global assessment.²⁷

127. Bearing in mind the principles of imperfect recollection, I am satisfied that there is a likelihood that the Applicant's mark will be mistaken for the Opponent's earlier marks or vice versa leading to a likelihood of direct confusion.

128. In relation to the Applicant's *augmented reality games software*, even if I were to accept that these goods share a low degree of similarity to the Opponent's goods, I do not consider that consumers would directly confuse the marks for these goods since they would not believe the producers of *augmented reality game software* were also responsible for *downloadable software for the calculation online of road itineraries and providing of tourist information*. Turning to the likelihood of indirect confusion, I

²⁷ *Wolf Oil v EUIPO*, C-437/16 P, EU:C:2017:737

note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that the finding of indirect confusion should not be made merely because two marks share a common element. The fact that both marks begin with MAP is not in itself enough to create a belief that these are variant marks used by the same undertaking, especially in relation to goods which at best share a low degree of similarity. In light of the caselaw I must be careful not to give the earlier mark too great a protection for computer software goods. Therefore, for these goods, other than both being computer software products, I see no reason for the average consumer to make the assumption that they are ones provided by the Opponent or a connected undertaking.

Conclusion

129. The opposition under section 5(2)(b) succeeds in part. Subject to appeal the application is refused for:

Class 9: Augmented reality software; Augmented reality software for creating maps; Augmented reality software for education; Augmented reality software for simulation; Augmented reality software for use in mobile devices; Augmented reality software for use in mobile devices for integrating electronic data with real world environments.

130. The opposition having failed in relation to the following goods, the application may proceed to registration for:

Class 9: Augmented reality game software.

Costs

131. Since the Opponent has had the greater share of success it is entitled to a contribution towards its costs and ordinarily an award of costs in proceedings is based upon the scale as set out in Tribunal Practice Note 2 of 2016. I bear in mind however that overall the Opponent's evidence was poorly drafted and that it failed to

demonstrate use of the full breadth of its specification as relied upon. Applying the guidance and taking into account the poor standard of the evidence filed, I award costs to the Opponent on the following basis, having reduced the award for the preparing of the evidence on the basis that a significant proportion of it was unnecessary or incomprehensible:

Preparing a Notice of opposition and reviewing the counterstatement:	£200
Preparing evidence and submissions	£200
Official Fee:	£100

132. I order Fitzroy Hawk Ltd to pay MAPPY S.A. the sum of £500 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of August 2020

Leisa Davies
For the Registrar